

O/0719/25

TRADE MARKS ACT 1994

**IN THE MATTER OF
UK REGISTRATION NO. 917910106
IN THE NAME OF SMARTSWEETS INC.
IN RESPECT OF THE TRADE MARK**

Smartcandy

IN CLASSES 5 AND 30

**AND THE APPLICATION FOR REVOCATION THEREOF
UNDER NUMBER 506996
BY GREENCLIFF ASSOCIATE LTD**

BACKGROUND AND PLEADINGS

1. Trade mark No. 917910106 for the trade mark “**Smartcandy**” stands registered in the UK in the name of SmartSweets Inc. (“SSI”).¹ The application for registration was filed on 30 May 2018, and the trade mark was registered on 13 September 2018, in respect of goods in classes 5 and 30, as listed under paragraph 19 of this decision.

2. The above mark is a comparable mark. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, SSI’s mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.²

3. On 9 February 2024, Greencliff Associate Ltd (“GAL”) filed an application seeking to revoke SSI’s trade mark on the grounds of non-use under sections 46(1)(a) and 46(1)(b) of the Act.

4. Under section 46(1)(a) of the Act, GAL claims non-use of all goods in the five year period following the date on which the marks were registered, i.e. 14 September 2018 to 13 September 2023, with an effective date of revocation of 14 September 2023. Under section 46(1)(b), GAL claims non-use of all goods from 22 January 2019 to 21 January 2024, with an effective date of revocation of 22 January 2024.

5. SSI filed a counterstatement defending the use of its mark in relation to all of its goods during the relevant periods for which non-use is claimed.

6. Both parties elected to file evidence during the evidence rounds. Neither party requested a hearing; both parties filed written submissions in lieu of a hearing, which

¹ I note that a Form TM16 was filed on 31 October 2023, requesting the transfer of ownership of UK917910106 from Ullich Kranzer to SmartSweets Inc. Confirmation of the recordal of the assignment was issued on 2 November 2023.

² See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

will be referred to as and where appropriate during this decision. This decision is taken following careful consideration of the papers on file.

7. In these proceedings, SSI is represented by FRKelly, and GAL is represented by CMS Cameron McKenna Nabarro Olswang LLP³

EVIDENCE

SSI's evidence

8. SSI filed evidence in support of the defence by way of two witness statements.

9. The first witness statement ("WS1"), dated 20 June 2024, is in the name of Corey Sisson, alongside which are four exhibits, labelled EXHIBIT 1 to EXHIBIT 4. Mr Sisson is the Senior Director of Sales Planning and Global Business Development for SSI.

10. The second witness statement ("WS2"), dated 21 June 2024, is in the name of Tyson Jobke, the VP of Finance & Growth at SSI. Alongside the witness statement, Mr Jobke adduces three exhibits, labelled EXHIBIT 1 to EXHIBIT 3.

GAL's evidence

11. GAL filed evidence in support of the application for revocation by way of a witness statement in the name of David Beckman. Mr Beckman is Director of GAL, a position he has held since 13 January 2016. The witness statement is dated 21 August 2024 and is accompanied by three exhibits, labelled EXHIBIT 1 to EXHIBIT 3.

12. I have read and considered all of the evidence and I will refer to the relevant material throughout this decision to the extent that I consider necessary.

³ Form TM33P appointing CMS Cameron McKenna Nabarro Olswang LLP as representatives to GAL was filed on 29 August 2024, the details of which have been recorded accordingly in these proceedings.

DECISION

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Section 46

14. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade

mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

15. Section 100 of the Act states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it”.

16. As the mark is a comparable mark, pursuant to paragraph 8 of Part 1, Schedule 2A of the Act, SSI may rely upon use of the mark in the EU for any parts of the relevant periods which fall prior to IP Completion Day, being 31 December 2020.

17. As noted previously, the relevant period for assessing whether there has been genuine use of SSI's mark is 14 September 2018 to 13 September 2023 ("the first relevant period") under section 46(1)(a); and 22 January 2019 to 21 January 2024 ("the second relevant period") under section 42(1)(b). A finding of genuine use during the second relevant period will be sufficient to avoid revocation of the mark under section 46(1)(b), and, by virtue of section 46(3), section 46(1)(a). Provided that such use is deemed to be genuine use, this will be the case even if the evidence in relation to the earlier period is deemed insufficient.

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözde Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the

commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.

...

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.”

Evidence of use

19. In its notice of defence, SSI has claimed that use has been made of all of the goods for which the mark is registered. I must consider whether, or the extent to which, the evidence shows genuine use of the mark in relation to those goods (“the goods at issue”), being:

Class 5

Pharmaceutical preparations containing caffeine; Caffeine preparations for stimulative use; Caffeine preparations for medical use; Health food supplements made principally of minerals; Mineral nutritional supplements; Mineral food preparations for medical purposes; Food supplements consisting of trace elements; Trace element preparations for human use; Effervescent vitamin tablets; Anti-oxidant food supplements; Anti-oxidants comprising enzymes; Anti-oxidants derived from honey; Anti-oxidants obtained from herbal sources; Anti-oxidant supplements; Nutraceuticals for use as a dietary supplement; Dietary supplements consisting primarily of calcium; Mineral food supplements; Flaxseed dietary supplements; Flaxseed oil dietary supplements; Propolis dietary supplements; Alginate dietary supplements; Protein dietary supplements; Glucose dietary supplements; Casein dietary supplements; Yeast dietary supplements; Wheat germ dietary supplements; Albumin dietary supplements; Pollen dietary supplements; Enzyme dietary supplements; Lecithin dietary supplements; Wheat dietary supplements; Food supplements consisting of amino acids; Dietary supplements consisting of vitamins; Pine pollen dietary supplements; Dietary supplements for humans not for medical purposes; Nutritional supplements; Food supplements for non-medical purposes; Probiotic supplements; Herbal supplements; Vitamin C preparations; Vitamin D preparations; Gummy vitamins; Vitamin and mineral preparations; Vitamin and mineral supplements; Vitamins and vitamin preparations; Mixed vitamin preparations; Dietary supplements consisting primarily of iron; Nutritional supplements consisting primarily of calcium; Dietary supplements consisting primarily of magnesium; Nutritional supplements consisting primarily of zinc; Delivery agents in the form of dissolvable films that facilitate the delivery of nutritional supplements; Delivery agents in the form of coatings for tablets that facilitate the delivery of nutritional supplements.

Class 30

Breath-freshening chewing gum; Sweetmeats [candy]; Starch-based candies (ame); Red ginseng candy; Sweetmeat made of sesame oil; Bonbons made of sugar; Non-medicated candy; Candy with cocoa; Candy with caramel; Sweetmeats [candy] being flavoured with fruit; Breath mints for use as a breath freshener; Cachou [confectionery], other than for pharmaceutical purposes; Dragees [non-medicated confectionery]; Clear gums [confectionery]; Fruit drops [confectionery]; Fruit drops

[confectionery]; Sweetmeats [candy] containing fruit; Filled sweetmeats; Filled sweetmeats; Jelly beans; Gum sweets; Chewing candy; Gelatin-based chewy candies; Bubble gum; Sweetmeats [candy]; Nonpareils; Lollipops [confectionery]; Candy mints; Breath mints for use as a breath freshener; Candies (Non-medicated -) with honey; Candies (Non-medicated -) with alcohol; Non-medicated candy; Gum sweets (Non-medicated -); Chewing sweets (Non-medicated -); Non-medicated mouth freshening lozenges; Non-medicated mouth freshening lozenges; Non-medicated lozenges; Mint based sweets [non-medicated]; Non-medicated confectionery in the form of lozenges; Acid drops [confectionery]; Sweets (Non-medicated -) in the nature of caramels; Sweets (Non-medicated -) in the nature of caramels; Sweets (Non-medicated -) in compressed form; Sweets (Non-medicated -) being acidulated caramel sweets; Sweets (Non-medicated -) being honey based; Sweets (Non-medicated -) in the nature of sugar confectionery; Sweets (Non-medicated -) in the nature of fudge; Sweets (Non-medicated -) containing herbal flavourings; Sweets (Non-medicated -) being alcohol based; Chewing sweets (Non-medicated -) having liquid fruit fillings; Non-medicated confectionery candy; Toffee; Sugarless sweets; Sugarless sweets; Sugar-free chewing gum; Sweetmeats [candy].

SSI's evidence

20. For ease, I will initially consider each of the witness statements and their accompanying exhibits separately, from which I note the following:

WS1

- Trade mark No. 917910106 was acquired by SSI from the previous owner on 17 July 2023 (see footnote 1). In WS1, Mr Sisson states that SSI have been unable to source any information from the previous owner as to use of the trade mark before this date.
- Mr Sisson states that in addition to the trade mark at issue, on the same date SSI acquired related domain names from the previous owner in preparation for the launch of an online store in the UK and EU. I note that at point 7 of WS1,

Mr Sisson has provided a list of the acquired domains, all of which are either a .com or a .de domain.

- Mr Sisson states that SSI sold goods through the online store in the UK and the EU following the acquisition of the mark at issue in July 2023 and has also made efforts to sell its products in physical stores in the UK and EU. As mentioned previously, evidence in relation to the EU will only be relevant prior to IP completion date, being 31 December 2020.
- SSI has been engaged in discussions with distributors in the UK regarding distribution to physical stores here since March 2023⁴, although I note that the trade mark was not formally acquired until July 2023.
- In March 2023 and in June 2023, Mr Sisson met with representatives from Whole Foods Market (“WFM”), being one of SSI’s existing distribution partners of its goods to physical stores across Canada and the United States. Mr Sisson explains that WFM were identified as a desirable partner for expansion into physical stores in the UK as it already has seven such UK store locations. As WFM imports goods from another UK-based wholesaler, Dundeis (UK) Ltd (“Dundeis”), Mr Sisson was directed to communicate with representatives from Dundeis.

Exhibit 1

At point 10 of WS1, Mr Sissons explains that SSI also own the trade mark “SMART SWEETS” which is registered in various countries, although the UK has not been listed amongst them. Exhibit 1 comprises an article published online at www.cnbc.com on 8 August 2019 relating to the Canadian founder of “SmartSweets” (formerly called “Stevi-Smarts”) and the success of the brand in Canada and the US. However, I see no relevance of this exhibit in relation to the mark at issue, i.e. “Smartcandy”, or in relation to the UK market.

Exhibit 2

At point 16 of WS1, Mr Sissons states that this exhibit is a web page showing WFM’s market plans. I note that the web page is derived from www.retail.eu and comprises an article dated 11 January 2019 detailing that WFM is an American organic

⁴ See point 14 of WS1.

supermarket chain that belongs to Amazon. The article mentions that the WFM range that is being introduced to Continental Europe includes dry foods such as nuts, couscous, rice and dried fruit, which are packaged in the United Kingdom. However, the article makes no mention of either the goods at issue or the trade mark “Smartcandy”. Given that the article is dated some four years prior to the acquisition of the mark by SSI, there is no evidence of any relationship between the previous owner of the mark and WFM at the time the article was published. I therefore find no probative value to this exhibit.

Exhibit 3

This consists of what Mr Sisson describes as a brand introduction deck, dated 6/2/23, which given that the exhibit appears to relate to the Canada and the US, I interpret as 2 June 2023. It is in the form of a slide show presentation, demonstrating the products that SSI could bring to Dundeis and WFM. He confirms that the brand introduction deck was prepared before the trade mark at hand was formally acquired in July 2023. As such, there is no mention of the “Smartcandy” brand anywhere in the exhibit, which only focusses on the “SmartSweets” brand and also focusses on the formula differences and packaging of the candy in Canada and the US. I therefore find no probative value to this exhibit in relation to genuine use of the mark at hand in the relevant territory.

Exhibit 4

This comprises a copy of an email correspondence chain between Mr Sisson and a contact at Dundeis. The emails are dated 26 July, 29 August and 30 August 2023 respectively. The only pertinent email to the brand “Smartcandy” is the last one in which Mr Sisson confirms that SSI secured the “Smartcandy” trade mark in the UK (referred to as “SmartCandy”), and talks of the implications of changing the packaging of the goods from “SmartSweets” for the UK market.

WS2

- Mr Jobke states that the “Smartcandy” trade mark has been used by SSI in the UK since August 2023 in relation to goods falling within the class 30 specification.

- Mr Jobke states that sales totals under the trade mark for the UK amounted to approximately £500 (at the date of the witness statement).
- At point 10 of WS2, he has also provided approximate worldwide yearly sales figures for SSI between 2016 and 2023. However, while sales figures for the UK and EU would be relevant until 31 December 2020, and UK only figures relevant thereafter, no breakdown has been given to reflect the actual sales for these territories. Further, the figures do not give any indication of what percentage of the sales may be attributed to goods sold under the “Smartcandy” brand. As the brand was not acquired by SSI until July 2023, these figures do not provide any overall evidence of value.
- Mr Jobke asserts that SSI has made intensive and significant efforts to maintain the trade mark at hand with use during the relevant period, and that it continues to so. He maintains that the use in August 2023 was genuine use by virtue of being sales to test the market, and that “it must be assumed that the Trade Mark has been put to genuine use in connection with goods falling within ... class 30”.⁵

Exhibit 1

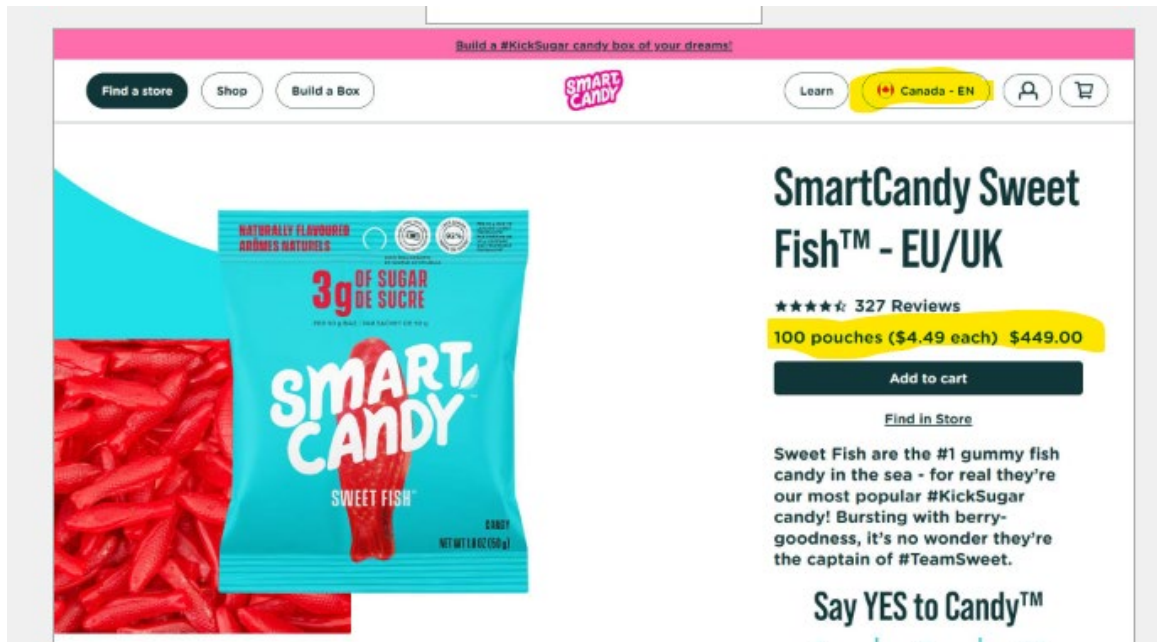
This comprises of two invoices, dated 24 and 28 August 2023 respectively, each of which refers to the sale of 100 packets of “Smartcandy Sweet Fish” (being gummy candy) to a customer in the UK. The sales were made via the online store and the billing and shipping addresses are both in London. I am unable to establish from the (redacted) invoices whether the sales were made to one repeat customer or to two different customers.

Exhibit 2


Mr Jobke describes the exhibit as showing an image of the packaging of SSI’s “Smartcandy Sweet Fish” gummy candy together with marketing information and customer reviews dated within the relevant period. I note that while the goods are referred to as “SmartCandy Sweet Fish™ – EU/UK”, they are priced in dollars (\$) and the top of the page indicates the Canadian (EN) market. Further, in the comparison between SSI’s candy goods and the leading candy alternative, it refers to

⁵ Points 16 - 17 of WS2,

“SmartSweets Sweet Fish” rather than “Smartcandy/SmartCandy Sweet Fish”, although I appreciate that “SmartSweets Inc.” is also the company name:



Us vs. The Other Fish*

	3g Sugar	17g Fibre	130 Calories	23g Net Carbs
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	37g Sugar	0g Fibre	179 Calories	45g Net Carbs
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*SmartSweets Sweet Fish™ 50g versus leading traditional candy equivalent

Five customer reviews have been provided which are dated between 07/13/23 (13 July 2023) and 08/14/23 (14 August 2023), again being dated in the format common to North America. The reviews do not actually mention the “Smartcandy” brand, and there is nothing to show that these reviews were generated by UK customers (which seems to be reinforced by the date format):

Candy Love

★★★★☆ 327 Reviews

[Write A Review](#)

Melissa K.

08/14/23

★★★★★

Love ordering straight from you

Love ordering straight from you guys, buying them in store just aren't as fresh! Been my favourite since the start 😊

What #KickSugar candy should we innovate next? 🗣️:

Cherry or lime lollies or like a blue wale or like kind of froggies? I'm allergic to watermelon be nice for some basic flavours not just tropical type flavours not all of us like tropical fruit

[Share](#)

Was This Review Helpful? [👍 0](#) [👎 0](#)

Stephanie E.

08/04/23

★★★★★

So good

Soft, fresh, amazing flavour and didn't stick to me teeth!

What #KickSugar candy should we innovate next? 🗣️:

Cherry Masters or Licorice

[Share](#)

Was This Review Helpful? [👍 0](#) [👎 0](#)

Stephanie C.

07/29/23

★★★★★

I LOVE it!!!!

Sweet Fish are the absolute best sugar free gummy! Taste, texture, gumminess and fun. It's perfect for a candy lover like me. And with no gluten or sugar alcohols, my stomach stays happy too. Thank YOU SmartSweets for making my life that much sweeter.

What #KickSugar candy should we innovate next? 🗣️:

Sour Soothers
Licorice

[Share](#)

Was This Review Helpful? [👍 0](#) [👎 0](#)

Tammy C.

07/18/23

★★★★★

Excellent

The perfect chew!

[Share](#)

Was This Review Helpful? [👍 0](#) [👎 0](#)

Christie D.

07/13/23

★★★★★

Sweet Fish

These are so close to the 'Swedish Fish'. My fave!!

What #KickSugar candy should we innovate next? 🗣️:

Something similar to jolly ranchers perhaps!

[Share](#)

Was This Review Helpful? [👍 0](#) [👎 0](#)

Exhibit 3

This comprises three screen shots of the packaging for “SMART CANDY SWEET FISH”. However, none of the images are dated, although I note that Mr Jobke states that the photographs are representative of the *type* of shipments (rather than actual shipment) sent by SSI to its UK customers in August 2023:



21. In its written submissions in lieu of a hearing, SSI submit that its use of the “Smartcandy” trade mark is not merely token, and that the commercial exploitation of the mark at issue is real and warranted in the economic sector concerned to maintain or create a share in the market for the goods protected by the trade mark. It further submits that the use of the mark is quantitatively significant.⁶

Counter-evidence and written submissions of GAL

22. Before I make my assessment on the evidence of genuine use as provided by SSI, I will highlight what I consider to be the pertinent points raised by GAL in response to SSI’s evidence:

- In his witness statement, David Beckman states that SSI’s WS1 contains no discernible evidence of the use of the registration in the UK, save for the (bald) statement at paragraph 8 of the WS.
- With regards to Exhibit 2 as attached to WS2, Mr Beckman states that it is unclear how consumers are intended to access the relevant page of the website and he adduces his own Exhibits 1 – 3 in support. He goes on to say that the aforementioned SSI exhibit seems to be simply a test page, rather than a genuine advertisement or offer of goods targeted at a UK or EU market.⁷
- In its written submissions in lieu of a hearing, GAL submit that the evidence provided by SSI has not sought to, and does not suffice to, establish genuine use to the requisite legal standard of the trade mark in the UK during the relevant periods in relation to the goods registered, and that SSI have not sought to establish a factual basis for claiming that there existed genuine reasons for non-use.
- At point 5.3 of the written submissions in lieu, GAL submits that to the extent that the Tribunal does consider that the evidence submitted (by SSI) is sufficiently solid and conclusive, it cannot support a registration across the full breadth of the trade mark’s specification. At point 5.5, GAL refers to point 21 of WS1 where Mr Sisson describes its “Sweet Fish” product, which GAL

⁶ At point 8.

⁷ Points 2.4 – 2.14 of the witness statement by David Beckman.

submits is the only product for which any evidence of use has been provided, as a 'sweets/candy/confectionary non-medicated gummy'. However, GAL disputes that the evidence is sufficient to show genuine use for any goods and maintains that the trade mark should be revoked in respect of all goods covered by the trade mark.

Assessment on genuine use

23. Whether the use shown is sufficient to constitute genuine use will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the EU (as far as use of the mark prior to the end of 2020 is concerned) and in the UK during the relevant five-year periods. In making my assessment, I must consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods for which use has been shown;
- the nature of those goods and the market(s) for them; and
- the geographical extent of the use shown.

24. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself. It is possible for an accumulation of evidence to show use, even if individual items of evidence would on their own be insufficient proof: see *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T- 415/09, paragraph 53. However, where there is no use of the mark in respect of the goods as registered, it follows there has been no genuine use of the mark: *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13.⁸

25. Case law does not specify particular types of documentation that must be adduced in evidence. When considering the evidence, I am entitled "to be sceptical

⁸ At [22].

of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive”: (see *PLYMOUTH LIFE CENTRE*, BL O/236/13, paragraph 22).

26. In its notice of defence, SSI indicated that it was defending the use of the mark in relation to all of the goods of the registration, i.e. those goods registered under classes 5 and 30. The class 5 goods include various pharmaceutical preparations and dietary/nutritional supplements and preparations. At point 21 of WS1, Mr Sisson describes the “Smartcandy” product as “a sweets/candy/confectionary non-medicinal gummy”. At point 25 of WS1, he goes on to describe SSI’s products (but not specifically the “Smartcandy” branded goods) as “plant-based, naturally flavoured, low-sugar, major allergen (tree nut, peanut, wheat/gluten, soyabean, milk, eggs fish or shellfish) free, sugar-alcohol free, gummy candy”. Further, at point 18 of WS2, Mr Jobke states that “the aforementioned illustrates that the use is against class 30 of the trade mark...”, which is reiterated at point 10 of the submissions in lieu of a hearing. No mention is made of the goods in class 5 in either WS1 or WS2, nor in the written submissions in lieu of a hearing. Having reviewed the evidence filed in defence of the application for revocation, I find nothing in the evidence provided that shows use of the mark in relation to the goods as registered under class 5. It therefore does not allow me to find that SSI has demonstrated genuine use of the “Smartcandy” mark on any of the class 5 goods for which it is registered and for which revocation is sought. As such, in respect of the class 5 goods, the application for revocation is successful.

27. I now turn to consider the evidence of use of the mark in relation to the class 30 goods.

28. I note GAL’s submissions on what it considers to be a fair specification of the class 30 goods, should it be found that there has been proven genuine use for any of the goods at issue. I will return to consider GAL’s submissions in this respect, should it be necessary for me to do so.

29. I note the comments of Mr Daniel Alexander Q.C. (as he then was), sitting as Appointed Person in *Guccio Gucci SPA v Gerry Weber International AG*, Case BL

O/424/14, where he refers to the guidance given by the Registrar that “it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence).”⁹ However, I acknowledge that in the case before me, SSI had only acquired the trade mark registration on 17 July 2023 and that it states that it had been unable to source information from the previous owner as to any use of the mark prior to this date.

30. The domain names acquired on 17 July 2023 in preparation for launch of an online UK/EU store are all either .com or .de (for Germany) and do not specifically target the UK market. The .de sites come after IP completion date so are not relevant to the proposed UK launch. The domain addresses of the “.com” websites do not self-evidently actively target the UK market.

31. I bear in mind the principles outlined under paragraph 18 of this decision, which recognise that every proven commercial use may not be sufficient for a finding of genuine use, and that “use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns.” While the brand introduction deck (Exhibit 3 as attached to WS1) does not demonstrate “live” use of the mark, it does demonstrate the efforts of SSI to secure a desirable partner for expansion into physical stores in the UK. That being said, as previously mentioned, the deck is focussed on the “Smart Sweets” brand and makes no mention of the “Smartcandy” brand and is therefore inconclusive.

32. I note Mr Sisson’s submissions that due to the nature of the industry, including market risks and regulatory controls on both product formulation and packaging and messaging, a slow, methodical approach to launching new products internationally is typical in the industry. While the acquisition of the “Smartcandy” trade mark by SSI did not take place until July 2023, the evidence indicates that the mark will be applied to the same goods which are currently provided under the “SMART SWEETS” brand in North America, with the “Smartcandy” rebrand specifically targeting the UK/EU

⁹ At [56].

markets. While I acknowledge that there will be different regulatory controls specific to the relevant territory, it does not appear that the “Smartcandy” branded goods will relate to a ‘new’ product line in itself, even if the trade mark is ‘new’ to SSI. Therefore, I would have expected SSI to have undertaken the appropriate preparatory work in relation to the target UK market prior to the acquisition of the mark and that evidence of the same would have been provided accordingly.

33. I note that Mr Sissons states that SSI has been, and continues to be, diligently and actively pursuing the creation of an outlet in the UK market for the goods throughout the relevant period, and in particular, since it acquired the trade mark from the previous owner. No information has been provided as to how much has been invested in promoting the mark, such as the marketing budget or spend for the brand. Mr Jobke states that the use in August 2023 was genuine use by virtue of being sales to “test the market”.¹⁰ These sales were to a value of approximately £500. Although I have no indication as to the size of the relevant market in the UK, I would expect it to be substantial, since they are ordinary, inexpensive goods. As such, ‘test’ sales amounting to only £500 falls well short of what I would expect in order to demonstrate real commercial exploitation of the mark in order to maintain or create a share in the market for the goods at issue.¹¹ Neither is there any evidence to show the “Smartcandy” branded goods being actively offered for sale in the UK - I agree with Mr Beckman’s assessment of Exhibit 2 as attached to WS2 of SSI’s evidence that it is no more than a test page rather than a genuine advertisement or offer of goods targeted at a UK or EU market.¹²

34. In WS1, Mr Sisson refers to circumstances beyond the control of SSI as the trade mark owner, including COVID, which have delayed entry of the “Smartcandy” brand into physical stores. However, given the date of acquisition of the brand in July 2023 was subsequent to the lifting of the COVID restrictions in the UK, I do not consider

¹⁰ At point 17 of WS2.

¹¹ *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, at [22].

¹² At points 2.4 – 2.13 of the witness statement by Mr Beckman, and accompanying exhibits.

this to be a proper reason for non-use, even if SSI had based its defence on these grounds, which it has not.¹³

35. I have considered the evidence as a whole, however, in my view, it fails to demonstrate real commercial exploitation of the mark in relation to the goods for which use is claimed. Overall, the evidence does not allow me to find that SSI has demonstrated genuine use on any of the goods at issue for which it is registered under the mark for which revocation is sought. The consequence of this is that the registration of the mark will be revoked for all of the goods for which it is registered.

CONCLUSION

36. The application for the revocation of UK00917910106 succeeds in its entirety under section 46(1)(a) and section 46(1)(b) of the Act. As such, subject to any successful appeal, SSI's registration is revoked in full, with effect from the earliest date requested, being 14 September 2023.

COSTS

37. In these proceedings, GAL has been successful in its application for revocation of the SSI's mark, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023. Applying the guidance in the TPN, I consider the following to be fair:

Official fee: £200

Preparing the application for revocation
and considering the counterstatement: £300

Preparing and filing evidence, and considering the other side's evidence: £700

¹³ See point 8 of Form TM8(N), being the counterstatement by the defendant, where it states that if a defence is based on "proper reasons for non-use" then this should be clearly set out in the counterstatement. Rather, the defendant denied that the mark has not been put to genuine use.

Preparing written submissions in lieu of a hearing: £400

Total: £1600

38. I therefore order SSI to pay GAL the sum of £1600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 31st day of July 2025

**Suzanne Hitchings
For the Registrar,
the Comptroller-General**