O/0896/25

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO. 3096244
IN THE NAME OF GRENVILLE REDMOND
IN RESPECT OF THE FOLLOWING TRADE MARK

IN CLASS 12

AND

AN APPLICATION FOR THE REVOCATION THEREOF
UNDER NO 505962
BY
JAGUAR LAND ROVER LIMITED

BACKGROUND AND PLEADINGS

1. Trade mark No. 3096244 shown on the cover page of this decision stands registered in the name of Grenville Redmond ("the registered proprietor"). It was applied for on 25 February 2015 and completed its registration procedure on 9 September 2016. The goods for which it is registered are as follows:

> <u>*Class 12*</u>
> *Vans.*

2. On 31 March 2023, Jaguar Land Rover Limited ("the applicant") sought revocation of the mark on the grounds of non-use. Under section 46(1)(a) of the Trade Marks Act 1994 ("the Act"), the applicant claims non-use in the five-year period following the date on which the mark was registered, i.e. 10 September 2016 to 9 September 2021. It seeks revocation from 10 September 2021.

3. Under section 46(1)(b), the applicant claims that the mark has not been used during the following period: 30 March 2018 to 29 March 2023. The date on which it wants revocation to take effect is 30 March 2023.

4. The registered proprietor filed a defence and counterstatement denying the claims made. He states that he is *"the designer of the Land Carrier concept"* which he describes as the most aerodynamically efficient vehicle in its class. While he has tested scale models of the van, it is clear that development is at a very early stage and interest has been sought from several manufacturers and investors. The registered proprietor states that three of these have a continued interest. He continues:

> "The next stage in development is manufacture of a prototype. Improving the design, saving personal funds, working with local fabricators on costings and designs to make a prototype. Land Carrier is a work in progress – and though important to my future, it's not currently my main business. The costs are high – for an individual, and I had the impact of covid. So it has taken years."

5. Only the registered proprietor filed evidence. This comes in the form of a witness statement from Mr Redmond dated 6 February 2024 which is accompanied by 15 exhibits. I shall summarise the content of the evidence in due course.

6. The parties were invited to request a hearing or file written submissions in lieu of the same. A hearing was not requested. The registered proprietor filed no submissions and the applicant wrote to the Tribunal on 3 March 2025 referring me to the content of the application for invalidation which I have already summarised.

7. The applicant is represented by CMS Cameron McKenna Nabarro Olswang LLP and the proprietor is unrepresented.

RELEVANCE OF EU LAW

8. 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.

PRELIMINARY POINT

9. Mr Redmond states that the applicant has made the cancellation application in bad faith and alleges that it has carried out a series of hostile actions against him, since it failed to oppose the registration of the contested mark in 2016. Exhibits GR8-GR15 contain entries from trade mark registers in other jurisdictions, showing that the applicant has registered the name "Land Carrier". He states that the applicant cannot prove that it has used these registrations.

10. The motivations of the applicant in bringing this revocation action and/or making applications to register "Land Carrier" in other jurisdictions are not relevant to my consideration of the matter before me. This is simply whether the registered proprietor has made genuine use of the mark during the periods set out in paragraphs 2 and 3 above and, if it has not, whether there are proper reasons for non-use. I shall therefore say no more about the conduct of the applicant.

DECISION

11. Section 46 of the Act is as follows:

> "(1) The registration of a trade mark may be revoked on any of the following grounds –
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> > (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;
> >
> > …
>
> (2) For the purposes 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) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(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 existed at an earlier date, that date."

12. Section 100 of the Act is also relevant. It says:

"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."

13. In his witness statement, Mr Redmond says that the mark remains *"in genuine use by myself"*.[1] I shall therefore begin by assessing this argument.

14. The case law on genuine use was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247:

"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

[1] Paragraph 8.

La Mer Technology Inc v Laboratories Goemar SA [2004] ECR I-1159, Case C-416/04 *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 Bundersvereinigung 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 Merken 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. Gözze 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].
>
> (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) <u>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</u>

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] and [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]."

15. I have underlined part of Arnold LJ's point (4). For the present purposes, this is the most pertinent part of the summary. There were no goods to be marketed during either of the relevant periods. Furthermore, there had been no preparations to secure customers. It is clear from the evidence that this was a project that was still in its early days and the investment necessary to commercialise the concept had not been secured. I therefore find that there had been no genuine use of the mark during either of the relevant periods and will go on to consider whether there are proper reasons for non-use.

16. In *Häupl v Lidl Stiftung & Co. KG*, Case C-246/05, the Court of Justice of the European Union said:

"45. It is therefore for the Court to give a uniform interpretation to the concept of 'proper reasons for non-use', as referred to in Article 12(1) of the Directive.

46. That provision governs cases in which a mark has been registered but its proprietor has not made use of it. If that is the case during a continuous period of five years, the mark is liable to revocation unless the proprietor can demonstrate proper reasons.

47. It must be stated that Article 12(1) does not contain any indication of the nature and characteristics of the 'proper reasons' to which it refers.

48. However, the TRIPS Agreement, to which the Community is party, also deals, in Article 19(1), with the requirement of use of the mark and the reasons which may justify its non-use. The definition of that concept given there may therefore constitute a factor in the interpretation of the similar concept of proper reasons used in the Directive.

> 49. Thus, under Article 19(1) of the TRIPS Agreement, circumstances arising independently of the will of the owner of the trade mark which constitute an obstacle to the use of the trade mark are to be recognised as valid reasons for non-use.
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> 50. It is therefore necessary to determine what kind of circumstances constitute an obstacle to the use of the trade mark within the meaning of that provision. Although, quite often, circumstances arising independently of the will of the owner of the trade mark will at some time hinder the preparations for the use of that mark, the difficulties in question are difficulties which can be overcome in a good many cases.
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> …
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> 54. … only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as 'proper reasons for non-use'. …"

17. The registered proprietor describes himself as an *"amateur aerodynamist"* who has designed and tested large-scale models of a radical design for a commercial van.[2] He first came up with the idea in 2012 and he applied for the contested mark in 2015 in order to give the design a brand identity and attract investment. Potential investors approached included vehicle manufacturers. Mr Redmond's exhibits include an email and letters to three vehicle manufacturers, dated 4 August 2016, 1 September 2021 and 12 November 2021;[3] and letters to two individuals who might provide funding or information about potential investors, dated 14 March 2020 and 3 December 2020.[4] The mark appears on all the letters. He states that these represent a sample of the letters he has sent and show how he has used the mark to attract interest from potential partners, but he has given me no indication of the scale of this activity. Even so, I do not consider that these represent preparations to secure customers. Consequently, this is not genuine use, as explained by Arnold LJ in *easyGroup*.

[2] Witness statement, paragraph 3.
[3] Exhibits GR1-GR3.
[4] Exhibits GR4-GR5.

18. Mr Redmond says that since 2020 he has had to prioritise his main line of business, which is theme park construction, given the adverse effects of the COVID pandemic on his clients. He does not provide any further explanation as to the impact of the pandemic on his ability to use the contested mark. However, I note that the second relevant period extends some point after the periods of lockdown that were introduced in order to reduce the spread of the virus. The letters I have already mentioned show that the registered proprietor was still seeking funding in 2020 and 2021, and Exhibits GR6 and GR7 contain correspondence from a local fabricator about costs for production of a prototype.

19. In *Naazneen Investments Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-250/13, the General Court held that difficulties in manufacturing a product was not outside the registered proprietor's control and therefore did not constitute a proper reason for non-use. It said:

> "66. According to the case-law, 'proper reasons' refers to circumstances unconnected with the trade mark proprietor rather than to circumstances associated with his commercial difficulties (see, to that effect, judgment of 9 July 2003 in *Laboratorios RTB v OHIM – Giorgio Beverly Hills (GIORGIO AIRE)*, T-156/01, ECR, EU:T:2003:198, paragraph 41). The problems associated with the manufacture of the products of an undertaking form part of the commercial difficulties encountered by that undertaking."

20. I appreciate that it may be a long process for a private individual to bring a product to market. However, it was the registered proprietor's choice to apply for a trade mark so early in the process of developing the product. I have noted that he states that the reason he did so was to give the design some brand identity, but he does not explain the value of a trade mark, over and above the designs themselves, in attracting investment in this industry sector. Consequently, it is my view that the circumstances have not arisen independently of the will of the registered proprietor. I find that he has not shown that there are proper reasons for non-use of the mark, and the mark will be revoked from the earliest requested date.

OUTCOME

21. Subject to a successful appeal, UK Trade Mark No. 3096244 is revoked with effect from 10 September 2021.

COSTS

22. The cancellation applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 1/2023. The award has been calculated as follows:

> *£250 for Preparing a statement and considering the other side's statement;*
> *£200 for Official fees.*
> ***£450 in total.***

23. I have not made a contributory award for costs incurred in considering the registered proprietor's evidence or making submissions in lieu of a hearing, as the applicant's letter of 3 March 2025 merely referred me to the contents of the Form TM26(N).

24. I therefore order Grenville Redmond to pay Jaguar Land Rover Limited the sum of £450. 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 26th day of September 2025

Clare Boucher
For the Registrar,
Comptroller-General