O/1019/24

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NUMBER 3946588
IN THE NAME OF TOM HANNAH (AGENCIES) LIMITED
IN RESPECT OF THE FOLLOWING TRADE MARK

BIG LICKS

IN CLASS 30

AND

AN APPLICATION FOR REVOCATION THEREOF
UNDER NUMBER 506702
BY ZED HOLDINGS HONG KONG LIMITED

BACKGROUND AND PLEADINGS

1. Trade mark number 3946588, "BIG LICKS", stands registered in the UK in the name of Tom Hannah (Agencies) Limited ("the proprietor"). It was filed on 7 August 2018 and completed its registration process on 9 November 2018. The mark is registered for the following goods:

Class 30: *Confectionery, namely, candy and liquid candy.*

2. On 16 November 2023, Zed Holdings Hong Kong Limited ("the applicant") sought revocation of the mark, in its entirety, for non-use under section 46(1)(a) of the Trade Marks Act 1994 ("the Act").[1] The period in respect of which non-use is claimed is 10 November 2018 to 9 November 2023, with an effective date of revocation of 10 November 2023.

3. In its statement of grounds, at Section C of the Form TM26(N), the applicant stated, "It is our understanding that the mark has not been used in the relevant period of time and therefore is subject to cancellation action under section 46(1)(a) and (b) of the Trade Marks Act." The applicant did not complete Section B of the Form, which corresponds to section 46(1)(b) of the Act. Accordingly, this decision will proceed on the basis of section 46(1)(a) only.

4. The proprietor filed a defence and counterstatement, on Form TM8(N), denying the claims made in relation only to some goods: *liquid candy.* The proprietor's counterstatement reads as follows:

> "Contrary to what is alleged by the applicant for cancellation, the mark was genuinely used during the relevant period of 10th November 2018 - 9th November 2023, as is attested to in the attached Witness Statement. The mark

[1] 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.

was acquired by the present proprietor from its previous owner on 5 August 2023 and the first sales of goods bearing the mark were made on 25 October 2023, which sales are continuing. The mark is used on liquid candy sold in the United Kingdom."

5. The effect of the proprietor denying the claim of non-use in relation only to *liquid candy* is that, regardless of the outcome of this decision, its mark will be revoked, as of 10 November 2023, in relation to the remainder of the specification: *confectionery, namely, candy*.

6. The proprietor filed evidence of use with its Form TM8(N). During the evidence rounds, the proprietor filed evidence in chief, the applicant filed evidence in chief and written submissions, and the proprietor filed evidence in reply.

7. The applicant is represented by Ansons and the proprietor by Murgitroyd & Company. Neither party requested a hearing and only the applicant filed written submissions in lieu. This decision is taken following a careful consideration of all the papers.

EVIDENCE AND SUBMISSIONS

8. The proprietor filed evidence of use with its Form TM26(N) in the form of the first witness statement of Thomas Cameron Munro ("TCM WS 1"), dated 17 January 2024, and its corresponding four exhibits (labelled "TCM1 – TCM4"). Mr Munro is a director of the proprietor, a position he has held since 1991.

9. The proprietor filed evidence in chief in the form of the second witness statement of Thomas Cameron Munro ("TCM WS 2"), dated 10 May 2024, and its corresponding two exhibits (labelled "TCM1" and "TCM2" but hereafter referred to as "TCM5" and "TCM6", to avoid confusion between identically labelled exhibits).

10. The applicant filed evidence in chief in the form of the witness statement of Brendan Roantree, dated 2 July 2024, and its corresponding 16 exhibits (labelled "ZED1 – ZED16"). Mr Roantree is the Managing Director of Zed Candy B.V. and

explains the relationship between Zed Candy B.V. and the applicant as follows: “The candy marketed by [Zed Candy B.V.] under the Trade Mark Screamers Big Lick is manufactured by Zed Holdings Hong Kong Limited [the applicant].”[2] Written submissions, dated 3 July 2024, accompany the applicant’s evidence.

11. The proprietor filed evidence in reply in the form of the third witness statement of Thomas Cameron Munro (“TCM WS 3”), dated 2 September 2024, and its corresponding one exhibit (labelled “TCM1” but hereafter referred to as “TCM7”).

PRELIMINARY ISSUE

12. As I will come to discuss, the proprietor’s narrative evidence is that it previously sold its liquid candy products bearing a different trade mark and, in March 2023, chose to rebrand its products, which now bear the “BIG LICKS” trade mark. The applicant has filed evidence of use of its own mark, “SCREAMERS BIG LICK”, in an attempt to call into question the reason for the proprietor rebranding its products to “BIG LICKS”. The applicant’s narrative evidence and submissions contends that it is “inconceivable” that the proprietor was not aware of the applicant’s liquid candy goods bearing its “SCREAMERS BIG LICK” trade mark. Mr Roantree, in his witness statement, suggests that the proprietor became aware of the possibility to acquire existing rights in order to inhibit the registration and use of the applicant’s trade mark.

13. Put simply, any evidence or submissions going to the proprietor’s reasons for rebranding its products and/or acquiring its trade mark are not relevant to the proceedings before me. This decision will determine solely the applicant’s non-use revocation action, i.e., whether the proprietor has shown that it has made genuine use of the trade mark, in accordance with the relevant case law. I will say, however, that I have considered the evidence and submissions in full and will refer to anything that is relevant at the appropriate points in this decision.

[2] The witness statement of Mr Roantree at paragraph 1.

DECISION

Statutory provisions

14. The relevant provisions of section 46 of the Act are as follows:

> "(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) […]
> >
> > […]
>
> (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 in 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 is also relevant, which reads:

"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."

Relevant case law

16. 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 Bundervsvereinigung 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) 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]."

17. In *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander QC (as he then was) as the Appointed Person stated that:

"22. The burden lies on the registered proprietor to prove use. […] However, 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 (which in many cases will be the Hearing Officer in the first instance) 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."

18. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

> ‘[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.’
>
> 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *‘show’* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

19. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark.

20. I also bear in mind the Court of Appeal’s decision in *Laboratoire de la Mer Trade Mark* [2006] FSR 5. Neuberger LJ (as he then was) stated that:

> “48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to be

communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be "consistent with the essential function of a trademark" as explained in [36] and [37] of the judgment in Ansul, it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler."

Assessment of the evidence

21. I remind myself that for the purposes of these proceedings the relevant period in which the proprietor must demonstrate genuine use is 10 November 2018 to 9 November 2023.

22. Collectively, Mr Munro's witness statements explain the following:

- The proprietor has been selling liquid candy in the UK under the trade mark "MEGA BRAIN LICKER" since 2010.

- In March 2023, the proprietor decided to change the name of the liquid candy product to "BIG LICKS" but found that this mark was already registered by a third party in the UK for Class 30 goods (UK trade mark number 3329909).

- In April 2023, Mr Munro, via his representatives, approached the owner of the "BIG LICKS" mark and a part-assignment of the trade mark to the proprietor was agreed. The relevant assignment document was executed by the parties on 5 August 2023 and recorded against UK trade mark number 3329909.[3]

- Once the part-assignment had been agreed, the proprietor began making preparations to rebrand its "MEGA BRAIN LICKER" goods as "BIG LICKS BRAIN LICKER".

- The proprietor received the first consignment of "BIG LICKS" liquid candy from its Spanish supplier on 29 September 2023.

- "BIG LICKS" liquid candy was first delivered to the proprietor's UK customers on 9 October 2023.

- The proprietor only sells 90ml products under the "BIG LICKS" mark to two customers – retailers Poundland and Home Bargains. The arrangement the proprietor has with these two customers is that they exclusively sell the 90ml product, hence the proprietor does not have advertising catalogues.

23. In addition to the above narrative, Mr Munro has provided the following sales figures:[4]

October 2023 – 151,200 units @ £1.00 each = £151,200
November 2023 – 129,600 units @ £1.00 each = £129,600

24. The proprietor has provided nine invoices to support its sales figures, only four of which fall within the relevant period.[5] The October invoices total £15,724.80 and the November invoices £69,228.10. These figures are significantly lower than the sales

[3] The partial assignment was recorded on the UK trade marks register on 17 August 2023.
[4] TCM WS 2, paragraph 6.
[5] TCM4 and TCM6.

figures provided by Mr Munro, though he does refer to the invoices as a sample.[6] The description of goods on the invoices reads “Box(24) BL/Mega Brain Licker”. Mr Munro states that the abbreviation “BL” reflected on the invoices refers to “BIG LICKS”.[7] The use of both “BL” and “Mega” on the invoices suggests to me that the goods could be branded with either the previously used trade mark “MEGA BRAIN LICKER” or the “BIG LICKS” trade mark. Mr Munro has addressed this as follows:[8]

> “When the Proprietor invoices their customers this is done under stock code KE0040, but during the transition of moving from the name Mega Brain Licker to Big Licks Brain Licker the Proprietor used the description ‘Box(24) BL/Mega Brain Licker’, with BL being the abbreviation for Big Licks. This was done to avoid any confusion with customers in that the Proprietor is continuing to supply the same product that they have purchased for about 15 years, but with a partial name change.”

25. Mr Munro has also provided images of the proprietor’s products bearing the new branding. TCM1 and TCM5 contain almost identical images (shown below) exhibiting two of the products purportedly sold by the proprietor, displaying a stylised variant of the “BIG LICKS” mark. Whilst the packaging reads “Made in Spain for Key Enterprises”, Mr Munro explains that the proprietor is the exclusive distributor of “BRAIN LICKER” liquid candy in the UK on behalf of Key Enterprises.

[6] TCM WS 2, paragraph 5.
[7] TCM WS 1, paragraph 3.
[8] TCM WS 1, paragraph 3.

26. The above images are undated, and Mr Munro does not explain in any of his witness statements when these images were created; he describes them as "showing bottles of the Goods bearing the Mark as sold in the United Kingdom".[9]

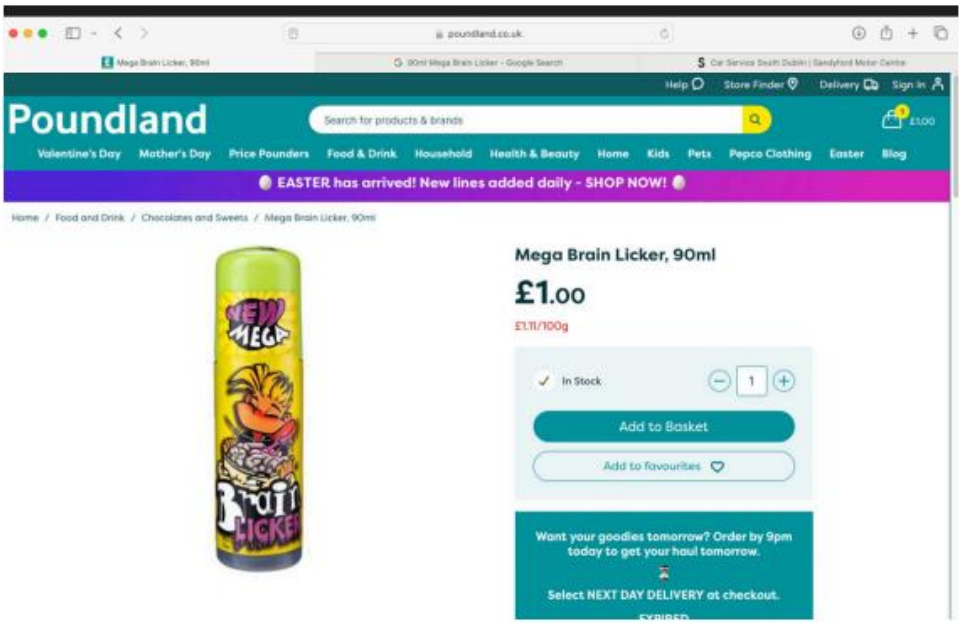
27. Whilst it is not open to me to simply disbelieve Mr Munro on these points - relating to the description of the goods on the invoices and the "BIG LICKS" mark used on the packaging - the applicant has challenged this in its own evidence.[10] The applicant contends that the proprietor's liquid candy goods were on the market branded with the "MEGA BRAIN LICKER" trade mark in 2024 and has provided evidence accordingly:

- A receipt dated 9 February 2024 from a Poundland store in the UK listing "90ML MEGA BRAIN LICKER" at a price of £1.00.[11]

[9] TCM WS 2, paragraph 4.
[10] Mr Roantree's witness statement at paragraph 26.
[11] ZED10.

- A screenshot taken from the UK website of Poundland, said by Mr Roantree to have been taken in 2024, showing a product with the description “Mega Brain

Licker, 90ml" (and a corresponding image of the packaging with the same name) at a price of £1.00.[12]



- Photographs of products available to purchase in Poundland in 2024, the packaging of which displays both the stylised "BIG LICKS" mark and the proprietor's previously used "MEGA BRAIN LICKER" mark. The cartons in which the goods are stored on the shelves display the "MEGA BRAIN LICKER" mark.[13]

[12] ZED11.
[13] ZED12-14.

28. Despite this evidence being dated after the end of the relevant period, it calls into question which mark was visible to the retailers and end users of the goods during the relevant period. Mr Munro, in reply, states as follows:[14]

> "The Proprietor was aware when the registered mark was acquired that the mark required to be put into use in order to remain valid, hence its strenuous efforts to relabel the product and ship it to its customers. The evidence provided in my previous Witness Statements clearly shows that goods bearing the BIG LICKS mark were genuinely sold and shipped to customers of the Proprietor, namely Poundland and T.J. Morris (Home Bargains) before the expiry of the five-year non-use period of the registration."

[14] TCM WS 3, paragraph 6.

29. Mr Munro refers to the exhibits provided with his witness statements. I have already addressed the invoices and the photographs and so, at this point, I turn to the remainder of the evidence filed with Mr Munro's witness statements: a delivery note dated 26 September 2023 referring to a purchase order of "BIG LICKS BRAIN LICKER" by the proprietor from its supplier[15] and eight 'picking lists' referring to goods, described as "Case(4x24) Big Licks Brain Licker", picked at the proprietor's warehouse.[16] Whilst these documents corroborate Mr Munro's narrative evidence that the goods were received from the supplier and prepared for delivery, these documents are not viewed by the market: rather, they are for internal use by the proprietor and its supplier. As per *Ansul*, cited above, at paragraph 37, internal use is not sufficient for demonstrating genuine use.

30. For completeness, though it does not add anything to the proprietor's case, the proprietor filed a document with its evidence in reply, shown below, which provides a timeline of the proprietor's goods to distinguish the various sizes and brands.[17]

[15] TCM2.
[16] TCM3.
[17] TCM7.

31. What I take from this timeline is that, in line with Mr Munro's narrative evidence, only the 90ml goods were intended to be branded with the "BIG LICKS" mark. These are the goods shown in the applicant's evidence branded with the "MEGA" mark after the rebranding is said to have been undertaken.

Conclusions

32. The proprietor's documentary evidence of use can briefly be summarised as nine invoices, undated images of the goods, a delivery note, and several warehouse picking notes, as well as the sales figures provided in its narrative evidence. There is no evidence dated within the relevant period which shows the mark on the goods themselves.

33. There are multiple issues with the evidence. The first is that there is no evidence of sales other than to trade intermediaries. This does not, of itself, prohibit me from finding genuine use. However, as Neuberger LJ said in *Laboratoire*, the more limited the use of the mark, the more doubtful I may be as to whether the use is genuine as opposed to token.[18] In the same case, it was held that sales under the mark to the trade may qualify as genuine use if such use is consistent with the essential function of a trade mark.

34. This leads me to the second criticism of the evidence, which is the way in which the goods are described on the invoices. Whilst I note the proprietor's explanation that "BL" is an abbreviation for "BIG LICKS", which is entirely plausible, "BL" is not the mark as registered and therefore the recipient of those invoices is not exposed to the "BIG LICKS" mark. Further, "BL" is used in conjunction with the previous branding of the goods – "MEGA". Whilst this is also explained by Mr Munro, I am not satisfied that the use of the abbreviation "BL", with what the evidence shows to be the previous trade mark used on the goods, constitutes use that is consistent with the essential function of a trade mark. It raises doubts as to how the consumers are being exposed to the goods.

[18] See also *Naazneen Investments Ltd v OHIM*, Case T-250/13, EU:T:2015:160.

35. Despite the applicant raising the same criticism in its evidence, there was only a vague response by the proprietor in its evidence in reply: "The evidence […] clearly shows that goods bearing the BIG LICKS mark were genuinely sold […] before the expiry of the [relevant] period". In my view, the evidence does not clearly show use of the mark on the relevant goods: in fact, it falls far short of showing this.

36. The delivery note and picking lists are internal documents and are not sufficient to demonstrate genuine use. The images of the goods are undated and are not sufficient to demonstrate use in the relevant period. The invoices provided do not indicate use of "BIG LICKS" in accordance with the essential function of a trade mark, nor do they substantiate the sales figures in the witness statement.

37. Whilst Mr Munro says the invoices are a sample, there are only nine invoices in evidence, and only four which refer to sales before the end of the relevant period. The proprietor was well aware of its need to use the mark in a short period of time and refers to its "strenuous efforts" to do so in Mr Munro's third witness statement. The proprietor was not even close to filing evidence above the threshold: it filed 45 pages of evidence in total, compared to the 450 page limit (comprising 300 pages of evidence in chief and 150 pages of evidence in reply) set by the Tribunal.[19] It is fairly common for only a sample of invoices to be filed in proceedings such as these, for various reasons including to limit the volume of evidence. However, in the case before me, such a small sample has not assisted the proprietor. It was open to, and presumably entirely possible for, the proprietor, in order to demonstrate as much use as possible, to file all of the invoices for October and November 2023, particularly those dated before the end of the relevant period, but it did not. That being said, I repeat here my concern that the trade mark itself is not used on the invoices, rather "BL/Mega". If the remainder of the invoices showed use in the same way, they would have had very little impact on the value of the evidence.

38. Further, once the applicant had filed evidence which cast doubt on whether the packaging of all of the proprietor's goods had been changed to reflect the new branding featuring the "BIG LICKS" mark, I see no reason why the proprietor could

[19] In accordance with Tribunal Practice Notice 1/2015.

not have filed, in reply, dated evidence to demonstrate use of the new packaging on the market.

39. Whilst it would not have been determinative, by itself, it was also open to the proprietor, having referred to sales continuing after the end of the relevant period, to file evidence of further sales beyond November 2023 in order to cast light backwards. Despite having multiple opportunities to file evidence, and doing so in January, May and September 2024, the proprietor filed no evidence of sales during that time, which might have helped to build a picture of what has been done since the proprietor acquired the mark.

40. As per *Awareness Limited*, cited above, the burden lies on the proprietor to prove use; the proprietor was aware of this: apparent from Mr Munro's reply evidence. Considering all of the criticisms discussed above, I find that the material provided is inconclusive and wholly insufficient to demonstrate genuine use within the relevant period.

41. For completeness, I will address one final point raised by the applicant, though it has no bearing on my decision. The applicant submits that use of the stylised "BIG LICKS" logo does not constitute use of the registered, word-only trade mark, given the significant differences.[20] I agree that the use shown in the proprietor's evidence constitutes use in a differing form to that as registered.

42. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is,

[20] See the applicant's written submissions dated 3 July 2024 and submissions in lieu dated 1 October 2024.

the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hyphen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA

were in combination weakly distinctive, and the word MOOD alone was less distinctive still."

43. In *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Mr Philip Johnson, as the Appointed Person, found that the use of the mark shown below qualified as use of the registered word-only mark DREAMS. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

44. In the case before me, the registered mark is the word-only mark "BIG LICKS". The use shown in evidence is below.

45. There are multiple differences between the word-only mark and the stylised variants: the different fonts, the use of three colours (black, white and either pink or orange) and the 'dripping effect' applied to each of the letters in the word "LICKS". These changes clearly alter the mark as registered. However, in accordance with the case law set out above, I am not satisfied that such changes alter the distinctive character of the registered mark. As per *Dreamersclub,* cited above, word marks have a broad protection in that the font (referring to typeface, size and weight) they are presented in must not be taken into account.[21] With regard to the colours used, whilst fair and notional use of a black and white mark does cover use in colour, it does not

[21] See also T-333/15 *Josel v EUIPO*, EU:T:2017:444.

cover complex colour arrangements.[22] In my view, the colours used in the variants do not represent a complex arrangement; they are three solid colours, including black and white, and they are acceptable in line with the relevant case law. The words "BIG LICKS" remain the more distinctive element in the variant marks and the fonts used do not distort those words, which remain visible and dominant. The distinctiveness and relative position of the 'drip' components do not render the mark incapable of being perceived as an indication of the origin of the goods.[23] Overall, had the evidence of use been sufficient to demonstrate genuine use, the stylised variants of the registered word-only mark would have been acceptable.

OUTCOME

46. The application for revocation on the ground of non-use succeeds under section 46(1)(a). Consequently, the trade mark is revoked in full, with an effective revocation date of 10 November 2023.

COSTS

47. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice ("TPN") 1/2023.[24] I award the applicant the sum of £1400, calculated as follows:

Preparing a statement and considering the other side's statement:	£250
Preparing evidence and considering and commenting on the other side's evidence:	£600[25]
Preparing submissions in lieu:	£350

[22] See the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47.
[23] See *Hyphen GmbH,* cited above.
[24] TPN 1/2023 applies to proceedings commenced on, or after, 1 February 2023.
[25] Whilst the applicant filed evidence, much of this went to use of its own mark, which was not relevant to these proceedings, hence an award at the lower end of the scale.

Official fees:	£200
Total:	**£1400**

48. I therefore order Tom Hannah (Agencies) Limited to pay Zed Holdings Hong Kong Limited the sum of £1400. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 25th day of October 2024

MRS E FISHER
For the Registrar