O/1122/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004077201
BY PEARL COY LTD
TO REGISTER:

IN CLASSES 5 & 30

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP000449943 BY
CAFES RICHARD

Background and pleadings

1. On 18 July 2024, Pearl Coy Ltd ("the applicant") applied to register in the UK the trade mark shown on the cover page of this decision ("the applicant's mark"). The application was accepted and published for opposition purposes on 2 August 2024 and registration is sought for the following goods:

   Class 5: Dietary and nutritional supplements: Vitamins, minerals, amino acids, and other dietary supplements intended to enhance health and well-being. • Herbal and natural remedies: Preparations made from plants, herbs, and other natural sources for medicinal use, including adaptogens like ginseng, ashwagandha, rhodiola, and holy basil, mushrooms.

   Class 30: Products based on coffee, tea, cocoa, sugar, rice, tapioca, sago, and coffee substitutes: All types of coffee (beans, ground, instant), tea (black, green, in bags), cocoa (powder, for drinking, for cooking), sugar (white, brown, in cubes), rice (basmati, arborio, wild), and coffee substitutes (chicory, roasted cereals).

2. On 2 October 2024, Cafes Richard ("the opponent") opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following International Registration:

   PERLE NOIRE

   International registration number WO0000000820172 ("opponent's mark")
   International registration date: 13 February 2004
   Date designated for protection in the UK: 13 February 2004
   Date protection granted in the UK: 8 August 2004
   Relying on all goods, being:

   Class 30: Luxury coffee.

3. The opponent's case is that the marks at issue are visually and phonetically similar, and there is conceptual similarity as both marks relate to a pearl. The opponent submits that its good is identical, highly similar or complementary to the applicant's goods.

4. The applicant filed a counterstatement denying the claims made against it. It is noted that the applicant also elected to request proof of use from the opponent.

5. The opponent is represented by Novagraaf UK. The applicant is not represented. Only the opponent filed evidence in chief. No hearing was requested. Neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

6. 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.

EVIDENCE

7. The opponent's evidence in chief came in the form of the witness statement of Anne Bellanger, dated 20 January 2025. Ms Bellanger is the Director Manager of the opponent, a position she has held since 2016. Ms Bellanger's statement is accompanied by 3 exhibits being Exhibit 1 – Exhibit 3 and was adduced in order to demonstrate genuine use of the opponent's mark in the UK.

8. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
>
> (aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;
>
> (ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.
>
> […]
>
> (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

10. Section 6A is also relevant. It reads:

"(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has 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, or
(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) 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

(b) 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.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

11. Section 100 of the Act is also relevant. It reads:

"100. 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."

12. Given its earlier filing date, the opponent's mark qualifies as an earlier trade mark under the above provisions. The opponent's mark completed its registration process over five years prior to the filing date of the applicant's mark. As set out above, the applicant requested that the opponent provide proof of use in respect of its mark. As a result, the opponent's mark is subject to the proof of use assessment.

13. 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]."

14. 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."

15. 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.”

16. 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.

17. 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.
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> 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."

18. Section 6A of the Act (cited above) confirms that the relevant period for the present assessment is the five-year period prior to the filing date of the applicant's mark, being 18 July 2024. The relevant period is, therefore, 19 July 2019 to 18 July 2024 ("the relevant period").

19. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[1] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

[1] *Jumpman* BL O/222/16

20. Whether the use shown is sufficient 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/services at issue during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:

   a. The scale and frequency of the use shown;
   b. The nature of the use shown;
   c. The goods/services for which use has been shown;
   d. The nature of those goods/services and the market(s) for them; and
   e. The geographical extent of the use shown.

<u>Evidence of use</u>

21. I note the following from the witness statement of Ms Bellanger:

   a. Ms Bellanger sets out that she is a Director Manager of CAFES RICHARD which is a family business founded in 1892 with over 130 years of experience in the coffee roasting industry. Ms Bellanger states that CAFES RICHARD uses the mark PERLE NOIRE as the name of a coffee, more specifically pure Arabica whole coffee beans.

   b. Ms Bellanger provides an undated online extract showing details of the PERLE NOIRE product.[2] As this evidence is not dated, nor explained in the witness statement as pertaining to a particular date, it is not open to me to assume it is dated within the relevant period. Even if I were to infer that this undated evidence was created shortly before the evidence was filed (January 2025), that still falls approximately 6 months after the end of the relevant period. Accordingly, any undated evidence does not assist in demonstrating genuine use. Additionally, this exhibit is just one screenshot of a website that shows a black coffee bag with a variant form of the PERLE NOIRE mark on it. There is no option for a customer to purchase said product on this webpage nor is there a price specified for the product.

[2] Exhibit 1

Additionally, no evidence has been provided regarding the number of visitors to the website.

c. Ms Bellanger submits that CAFES RICHARD has made genuine sales of coffee under the PERLE NOIRE mark to customers in the UK. However, no overall sales figures or turnover figures have been provided.

d. A selection of invoices have been provided showing sales of coffee under the PERLE NOIRE name to wholesale distributor customers in the UK, being Destiny Foods and UDAL Supplies.[3] I note the first invoice dated 7 June 2019 falls outside of the relevant period. Given this, I will not take this invoice into consideration. This leaves three invoices dated 28 August 2019, 13 December 2023 and 5 June 2024. The 28 August 2019 invoice shows sales to UDAL Supplies in Kent and both the 13 December 2023 and 5 June 2024 invoices show sales to Destiny House in London/Manchester. The invoice dated 28 August 2019 details sales of 90 boxes of 250g of PERLE NOIRE coffee, the invoice dated 13 December 2023 details 360 items of 1kg of PERLE NOIRE coffee and the invoice dated 5 June 2024 also details 360 items of 1kg of PERLE NOIRE coffee. Overall, these three invoices show sales of 810 units, totalling 742.5kg of coffee and 9,670.50 euros. The three invoices are dated either towards the start or end of the relevant period, consequently showing no consistent use throughout the relevant period.

e. A selection of five invoices dated 24 January 2024, 8 February 2024, 25 February 2024, 3 March 2024 and 11 March 2024 have been provided showing sales of coffee under the PERLE NOIRE name from the wholesaler, Destiny Foods to Laduree UK in Covent Garden, London.[4] These five invoices show the onward sale of only 120kg of PERLE NOIRE coffee totalling £2,094 from just one wholesaler to one end consumer. No evidence has been provided in respect of the onward sale of the remaining 622.5kg of coffee from the selection of invoices at Exhibit 2. As all five

[3] Exhibit 2
[4] Exhibit 3

invoices in Exhibit 3 are dated after the 13 December 2023 invoice to Destiny Foods but before the 5 June 2024 invoice to Destiny Foods in Exhibit 2, it is reasonable to infer that the five invoices in Exhibit 3 stem from onward sales of goods included in the 13 December 2023 invoice to Destiny Foods in Exhibit 2. I have no evidence of onward sales after the 5 June 2024. Consequently, the onward sales demonstrated in Exhibit 3 cannot be in relation to the invoice dated 5 June 2024 in Exhibit 2. Given the proximity of the invoice dated 5 June 2024 to the end of the relevant period, it is reasonable to infer that the goods sold via this invoice never reached the end consumer during the relevant period.

f. Ms Bellanger submits that the evidence provided demonstrates that there has been genuine use of the PERLE NOIRE mark in respect of "Luxury coffee" in class 30 in the UK during the relevant period.

Assessment of evidence

22. I will now consider an assessment of the evidence. This 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.[5]

23. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as "warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark".

24. The opponent's documentary evidence of use can briefly be summarised as eight invoices (as explained above, five of which cannot contribute to sales figures as they are in respect of onward sales) and one undated image of the opponent's product on a website.

[5] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

25. There are multiple issues with the evidence. The first is that there are no turnover figures and neither is there any information as to advertising or marketing spend. The absence of such is not automatically fatal to the issue of genuine use but it does cause me some issues in that I am not able to determine the overall picture with regard to sales in the UK during the relevant period.

26. This leads me to the second criticism of the evidence, which is whilst Ms Bellanger states Exhibits 2 and 3 show a "selection of invoices", there are only eight invoices, five of which cannot be counted in terms of monetary spend as that will be double counting given they are in relation to onward sales from the wholesaler to a UK consumer and I have already taken into account invoices from the opponent to the wholesaler. The opponent was aware of its need to show use of its mark in the relevant period. 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 selection has not assisted the opponent, especially when they are not accompanied by revenue/turnover figures, for example. It was open to, and presumably entirely possible for, the opponent, in order to demonstrate as much use as possible, to (1) provide overall revenue/turnover figures, (2) file all of the invoices for the relevant period, or (3) even a selection from each year of the relevant period. It did not. Instead it only filed one invoice from 2019, one invoice from 2023 and an invoice from 2024 that were sales to wholesalers. The remaining 5 invoices which showed sales from one wholesaler to Laduree UK were in a 2 month window from January – March 2024. This is an exceptionally short timeframe within which to supply invoices when the relevant period is 5 years. As such, I am not satisfied that there has been consistent use throughout the relevant period.

27. Lastly, three invoices at Exhibit 2 are of sale 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.[6] 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.

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

28. Having considered all of the evidence before me whilst bearing in mind section 100 of the Act and the aforementioned comments of Mr Alexander Q.C. in *Plymouth Life*, I note while the opponent has not provided any turnover figures and, from the invoices provided, I have been able to calculate that it has demonstrated sales to wholesalers of 9,670.50 euros with onward sales of £2,094 throughout the relevant territory. While noted, I must consider this level of sales in the context of the market within which the opponent operates. On this point, I have no evidence for the size of the market for the goods at issue, however I am of the view that the market for coffee is a very large one which is likely to be very competitive and attracts frequent sales in high volumes. As such, I am of the view that these figures are very low in the context of the market at issue. Again, I remind myself that use need not be quantitively significant in order for it to be deemed genuine but, in the present case, I am of the view that the level of use is at such a low level I am not satisfied that it demonstrates that the opponent has genuinely tried to create or preserve a market share for its goods in the UK.

29. As per *Awareness Limited*, cited above, the burden lies on the opponent to prove use. Taking all of the evidence into account and considering all of the criticisms cited above, I find that the material provided is insufficient to demonstrate that the opponent has genuinely used its mark within the relevant period. As a result, the opponent is not permitted to rely on its mark for the basis of this opposition and given that this was the only mark relied upon, the opposition must fail.

CONCLUSION

30. The opposition under section 5(2)(b) fails in its entirety and, subject to any successful appeal against my decision, the applicant's mark is permitted to proceed to registration in respect of all of the goods applied for.

COSTS

31. As the opposition has been unsuccessful, it would ordinarily be the applicant that would be entitled to an award of costs. However, as it has not instructed professional representatives, it was invited by the Tribunal to indicate whether it

intended to make a request for an award of costs by filling out and returning a costs pro-forma. It was made clear by way of the Tribunal's correspondence dated 01 April 2025 that, if the pro-forma was not completed by 29 April 2025, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. The applicant did not return a completed pro-forma to the Tribunal and as it did not incur any official fees in these proceedings, I hereby make no order as to costs.

Dated this 27th day of November 2025

N Barratt
For the Registrar