O-1163-24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003926829
BY DIMARK LTD TO REGISTER:

AS A TRADE MARK IN CLASSES 29, 30, 31 AND 35

AND

IN THE MATTER OF A FAST TRACK OPPOSITION THERETO
UNDER NO. 600002982

BY VILLAGE QUALITY PRODUCTS

Background & Pleadings

1. On 26 June 2023, Dimark Ltd ("the applicant") applied to register the trade mark shown on the cover page to this decision in the United Kingdom. The applicant seeks registration for the following goods and services:

Class 29: Meat; Meat and meat products; Steaks of meat; Sausage meat; Turkey meat; Cooked meat; Roast meat; Meat burgers; Minced meat; Canned meat; Meat, canned; Crab meat; Duck meat; Fried meat; Tinned meat; Meat, tinned; Meat pate; Meat, frozen; Frozen meat; Sliced meat; Meat boiled down in soy sauce (tsukudani meat); Salted meat; Dried meat; Canned cooked meat; Donkey meat; Dried fish meat; Freeze-dried meat; Processed meat; Meat substitutes; Fresh meat; Quenelles [meat]; Meat jellies; Cooked meat dishes; Meat paste; Ground meat; Fish meat floss; Lyophilised meat; Meat stocks; Prepared meat; Meat gelatines; Meat floss; Bottled cooked meat; Beef steaks; Lyophilized meat; Prepared meals made from meat [meat predominating]; Dried clam meat; Seitan [meat substitute]; Vegetable-based meat substitutes; Beef tallow [for food]; Meats; Shrimp meat floss ; Meat [preserved]; Preserved meat; Meat, preserved; Meat preserves; Beef; Frozen meat products; Bullfrog meat; Pork steaks; Meat spreads; Extracts of meat; Meat extracts; Galbi [grilled meat dish]; Cooked meats; Meat extract; Imitation crab meat; Pie fillings of meat; Mincemeat [chopped meat]; Tajine [prepared meat, fish or vegetable dish]; Tagine [prepared meat, fish or vegetable dish]; Dried whelk meat; Beef fat; Food pastes made from meat; Prepared meat dishes; Roast beef; Meat products being in the form of burgers; Beef meatballs; Beef stew; Processed meat products; Chicken sausages; Beef jerky; Cooked poultry; Cabbage rolls stuffed with meat; Dried razor clam meat; Pork jerky; Fish steak; Fish sausages; Flakes of dried fish meat (kezuri-bushi); Steaks of fish; Fish steaks; Poultry meatballs; Canned pork; Beef tripe; Roast poultry; Beef slices; Pork; Meat, tinned [canned (Am.)]; Vegetarian sausages; Tinned meats; Dried beef; Roast pork; Smoked meats; Meat-based snack food; Fish-based snack food ; Vegetable-based snack food; Casseroles [food]; Oils for food; Lard for food; Lard [for food]; Suet for food; Agar-agar for food; Jellies for food; Snack food (Fruit-based -); Fruit-based snack food; Animal fats for food; Vegetable fats for food; Marrow (Animal -) for food; Animal marrow for food; Animal oils for food.

Class 30: Pies (Meat -); Meat pies; Meat gravies; Gravies (Meat -); Sauces for barbecued meat; Poultry and game meat pies; Seasoned coating for meat, fish, poultry; Meat pies [prepared]; Frozen pastry stuffed with meat and vegetables; Pies containing meat; Sandwiches containing meat; Frozen pastry stuffed with meat; Pastries consisting of vegetables and meat; Crackers flavoured with meat; Boxed lunches consisting of rice, with added meat, fish or vegetables; Pelmeni [dumplings stuffed with meat]; Steamed buns stuffed with minced meat (niku-manjuh); Meat tenderizers for culinary purposes; Flavourings made from meat; Meat tenderizers for household purposes; Meat tenderizers, for household purposes; Cooked rice mixed with vegetables and beef (bibimbap).

Class 31: Beef cattle; Canned foodstuffs containing meat for young animals; Canned foodstuffs consisting of meat for young animals; Foods flavoured with beef for feeding dogs.

Class 35: Retail services in relation to meats.

The application was published for opposition purposes on 14 July 2023.

2. On 2 August 2023, Village Quality Products ("the opponent") opposed the application in its entirety under sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ("the Act") using the fast track opposition procedure. For the purpose of the opposition, the opponent relies upon the following mark and all goods and services for which it is registered, as laid out below:

United Kingdom Trade Mark ("UKTM") 3179604

Filing date: 10 August 2016
Registration date: 25 November 2016

Class 29: *Sausages; Pastrami; Processed Meats; Preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; processed meats; prepared meals; soups and potato crisps; all of the aforesaid goods being Halal products.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes; all of the aforesaid goods being Halal products.*

Class 31: *Agricultural, horticultural and forestry products; live animals; fresh fruits and vegetables, seeds, natural plants and flowers; foodstuffs for animals; malt; food and beverages for animals; all of the aforesaid goods being Halal products.*

Class 32: *Mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; all of the aforesaid goods being Halal products.*

Class 39: *Transport; packaging and storage of goods; food delivery services; all of the aforesaid services adhering to Halal standards.*

3. Under the provisions laid out in section 6 of the Act, the opponent's trade mark qualifies as an earlier mark. In accordance with section 6A of the Act, as it had completed its registration procedure more than five years prior to the filing date of the applicant's mark, it is consequently subject to the proof of use requirements.

4. The opponent contends that the respective parties "have the same market, same goods… Having Village Quality Products trademarked since 2016, should give us the protection against the term Village being used in a brand and/or business which wants to use it in a trademarking serving similar or same items, as well as serving to the same market." It also completed a statement of use within its Notice of Opposition and filed four supporting exhibits. Whilst the opponent has selected that it wishes to rely

upon 'all' goods for which its earlier mark is registered,[1] it also indicates that the 'use' of the mark on which it relies is limited to classes 29, 30 and 31[2].

5. In its counterstatement, the applicant denies the applicant's claim, instead maintaining that "the logos of our respective brands look completely different" and that there is a "clear distinction between the target markets". It also submits that the term "village" is both descriptive and generic, lacks distinctiveness and "cannot be monopolized by a single entity". It also particularises the goods for which it requires the opponent to provide proof of use.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008 but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

> "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit".

7. The net effect of the above is to require parties to seek leave in order to file evidence (other than proof of use evidence which is filed with the notice of opposition) in Fast Track oppositions. As mentioned above, the opponent filed evidence alongside its Notice of Opposition, which also incorporates a statement of use. No leave was sought by either party to file additional evidence. I will return to this point later in my decision.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary, and neither party elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

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[1] See Question 1 of the opponent's Form TM7F

[2] See Question 3 of the opponent's Form TM7F. As a consequence, regardless of the outcome of the proof of use assessment I am required to undertake later in this decision, the opponent is unable to rely upon the goods and services its mark is registered for in classes 32 and 39.

9. Neither party is professionally represented.

Relevance of EU Law

10. 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 5(2)(b)

11. Section 5(2)(b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because –
> (a)…
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

12. Section 5A of the Act reads as follows:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

The opponent's statement of use and supporting evidence

13. In its statement of use, the opponent confirms that it has been trading under Village Quality Products since January 2013. Alongside its Notice of Opposition, the opponent

filed four exhibits. The first two appear to be extracts from a catalogue or brochure (undated). The extracts are headed *Village Quality Products* (presented differently in each) and feature a number of consumable goods, with some bearing the earlier mark. The third exhibit is a table which the opponent describes as a "price list" but appears instead to be a representation of the number of sales of each of the opponent's products from 2019 to June of 2023. At the fourth exhibit the opponent reproduces an image of its earlier mark.

14. That concludes my summary of the opponent's evidence insofar as I consider it necessary.

Proof of use

15. I will begin by assessing whether the opponent has shown genuine use of the earlier marks. The relevant statutory provisions are as follows:

> "6(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."

16. Section 100 of the Act states that:

"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."

17. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the filing date of the application at issue, i.e. 27 June 2018 to 26 June 2023.

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 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]."

19. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed 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" is, therefore, not genuine use.

20. In *Awareness Limited v Plymouth City Council*[3], Mr Daniel Alexander Q.C. 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."

and further at paragraph 28:

[3] Case BL O/236/13

> "28. ..... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as "tuition services", is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to "tuition services" even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted."

21. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*[4], Mr Geoffrey Hobbs Q.C., 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

[4] Case BL O/404/13

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.

23. As above, the opponent has indicated that it has made use of its trade mark in respect of its goods in classes 29, 30 and 31, which I have reproduced at paragraph 2 to this decision. I note also that the applicant has answered question 7 of the Form TM8 which typically asks the defending party to specify which goods or services it would like the other side (the opponent, in this case) to show use of (or if, indeed, it requires evidence of use at all). The form clearly states, however, that "This is not applicable if this is a fast track opposition". The reason behind this is that evidence of use in fast track proceedings is filed alongside the Form TM7F, prior to the completion of a Form TM8, and fast track proceedings do not generally allow for any additional filing of evidence after the counterstatement is filed. The applicant's comments at question 7 will therefore be disregarded for the purpose of a proof of use assessment.

24. Before considering the sufficiency of the opponent's evidence I intend to highlight several deficiencies. The opponent has not provided an insight into its turnover throughout the relevant period, nor has it provided its specific market share. There is no indication of its promotional expenditure, nor does the opponent clarify precisely which means of promotion it chooses to engage in. It is not clear where the opponent's goods are available to purchase nor how many consumers those goods have attracted (or, indeed, the nature of its consumer). The extracts in its evidence are absent of any context; the opponent has not clarified the nature of the publication the extracts are derived from nor how widely that publication was circulated. I also note that only a relatively small proportion of the goods which are advertised in those extracts bear the

earlier mark or are described as “Village” goods, with a selection of other brands’ goods featuring alongside. I am also unaware of precisely *when* the extracts were published, though the exhibits do make reference to the dates on which the particular ‘offers’ on certain products are due to expire (December 2022 in the first exhibit and dates in 2023 and 2024 in the second). On the balance of probability, I am willing to find that the publication dates are likely to fall within the relevant period. I have reviewed the content of the table laid out at Exhibit 3 but note that the “unit sales” to which it refers are not supported by any customer invoices or corroborating narrative evidence. On reflection of the evidence as a whole, I do not find it sufficient to support a finding that the earlier mark has been put to genuine use. Consequently, the opponent cannot rely upon its earlier mark for the purpose of the present proceedings.

Conclusion

25. The opposition has failed. Subject to any successful appeal, the application will proceed to registration in respect of all goods and services applied for.

Costs

26. The applicant has succeeded and is entitled to a contribution towards its costs. Awards of costs in opposition proceedings commenced after 1 February 2023 are governed by Tribunal Practice Notice (“TPN”) 1 of 2023, which also sets out scale adaptations for fast-track proceedings. Using that TPN as a guide, I award £250 to the applicant for considering the statement of grounds and preparing a counterstatement.

27. I order Village Quality Products to pay Dimark Ltd the sum of £250. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of December 2024

Laura Stephens

For the Registrar