


O-146-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No.84259
BY PARAMOUNT PICTURES CORPORATION
FOR REVOCATION OF TRADE MARK No. 2423754
STANDING IN THE NAME OF
AYAZ AHMED**

BACKGROUND

1) The following trade mark is registered in the name of Ayaz Ahmed (hereinafter AA).

Mark	Number	Registered Date	Class	Specification
	2423754	15.12.06	30	Cobs, sandwiches, foodstuffs in the nature of spreads, drinks, desserts.

2) By an application dated 22 December 2010 Paramount Pictures Corporation (hereinafter PPC) applied for the revocation of the registration under the provisions of Section 46(1)(a) claiming there has been no use of the trade mark on the goods for which it is registered in the five year period post registration. A revocation date of 16 December 2011 is sought. Further, PPC sought revocation of the mark in suit under the provisions of Section 46(1)(b) claiming there has been no use of the trade mark on the goods for which it is registered in the five year period 20 December 2006 to 19 December 2011. A revocation date of 20 December 2011 is sought.

3) On 10 April 2012 AA filed an amended counterstatement stating that the mark had been used. The original counterstatement had attached ten pro-forma witness statements which were not in the correct format and so were returned to AA and not admitted into the case. The amended counterstatement did not have any such statements attached.

4) Both sides filed evidence. The matter came to be heard at 09.30 on 20 March 2013 when PPC was represented by Dr James of Messrs RGC Jenkins & Co.; Mr Ahmed did not attend and did not provide written submissions. It had been expected that Mr Ahmed would attend the hearing, although the Registry received no communication from him. It later transpired that he turned up at the Registry offices in London at 10.00 after the hearing had finished. No telephone call was received by the Registry to inform us that he had been delayed in his travel and indeed he did not make his presence known to staff until approximately 13.30, having sat in at another hearing as an observer.

AA'S EVIDENCE

5) AA filed five witness statements. The first, dated 9 June 2012, is by Mr Ahmed who states:

“1. The trademark registration number 2423754, The Cobfather, was a sandwich shop at unit 29 West End arcade, Nottingham. I have been trading since 2006 till current date as I supply sandwiches to premier and local fares.

2. We have used our mark on all packaging such as sandwiches, cobs, drinks, bags, flyers, shop signage. An example of sandwich packaging is shown at exhibit F.

3. I can confirm that the branding in exhibit A was on all packaging, page 1.”

6) Mr Ahmed also supplied the following exhibits:

- A: This consists of a reproduction of the mark in suit on a plain piece of paper which is signed and dated by Mr Costa, Mr Rose, Mr Levito and Mr Gahinga.
- B: A copy of a licence, dated 18 May 2006, between Mr Ahmed and the owners of West End Arcade, regarding unit 29 which was for the purposes of running a cob shop. No reference is made to the name of the shop.
- C: Two sheets of headed paper. They have the name of Walkers Snack Services Limited upon them. They are addressed to "Cobb Farther, unit 29, West Arcade". No other details such as the date etc. can be made out. They are said by AA to be invoices for crisps.
- D: A non-domestic rate reminder addressed to Mr Ahmed from Nottingham Council relating to 29 West End Arcade, dated 1 December 2006.
- E: A letter, dated 6 June 2006, from Nottinghamshire Education Business Alliance addressed to "Mr Ahmed, The Cobfather, 29 West End Arcade" dated 6 June 2006 discussing a possible work experience placement.
- F: A photograph of an empty sandwich box with the mark in suit printed upon it, details of the filling (egg mayonnaise) and also an expiry date of 11 June 2011.
- G: A letter from a firm of Chartered Surveyors regarding rent arrears for 29 West End Arcade. The letter is dated 19 May 2008 and is threatening court action for the recovery of the debt. The letter is addressed to Mr Ahmed at his home address. There is no mention of the mark in suit.

7) The four other witness statements are all pro-forma statements, where the witness has simply provided their name and address at the top of the form and signed and dated at the bottom. These are worded slightly differently to the pro-forma statements filed with the original counterstatement. They are all dated 9 June 2012 and are signed by Mr Costa, Mr Topnam, Mr Rose and Mr Gahinga. They all state:

"1. The trade mark registration number 2423754, The Cobfather, was a sandwich shop at unit 29 West End Arcade, Nottingham.

2. I have eaten cobs from there and can confirm that many people ate there and that The Cobfather sold sandwiches, drinks etc with the branding in exhibit A from 2006 to 2007.

3. I can confirm that the branding in exhibit A was on the packaging."

PPC'S EVIDENCE

8) PPC filed a witness statement, dated 13 August 2012, by Stephen Richard James its Trade Mark Attorney. He states that the shop at 29 West End Arcade shut at the latest in August 2007. He provides copies of correspondence with the owners of the premises

and also the local council. The council confirms that there is a legal duty for all food businesses to register with them. They also confirm that their records regarding the business operated by AA was closed as of 5 June 2007, because the company had ceased trading.

9) Dr James also contrasts the evidence provided by Mr Rose, Mr Topham and Mr Costa, which were filed with the original counterstatement and the statements they provided as part of the main evidence. The significant difference in the statements of these gentlemen, are the dates that they state they purchased from the shop. In the original pro-forma statements, dated 7 March 2012, filed with form TM8 the three gentlemen (along with seven others) signed pro-forma witness statements to the effect that they purchased goods from 2006-2008. In the revised statements the date had changed to 2006-2007. He also points out that the existence of an “expiry date” on the sandwich carton is in contravention of the food labelling requirements which state that a “use by” date is required for perishables such as cooked meats, pates, mayonnaise, cheese etc. For other fillings such as peanut butter a “best before” date can be used.

10) That concludes my review of the evidence. I now turn to the decision.

DECISION

11) The revocation action is based upon Sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994, the relevant parts of which read as follows:

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

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

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

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

12) PPC alleges that the mark has not been used in the five years subsequent to its registration i.e. 16 December 2006 – 15 December 2011. They further allege that the mark was not used in the period 20 December 2006 – 19 December 2011. Revocation dates of 16 December 2011 and 20 December 2011 respectively are sought.

13) Where AA claims that there has been use of the trade mark, the provisions of Section 100 of the Act make it clear that the onus of showing use rests with him. 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.”

14) In *Laboratories Goemar SA's Trade Mark (No. 1)* [2002] F.S.R. 51 Jacob J (as he was then) said:

“Those concerned with proof of use should read their proposed evidence with a critical eye — to ensure that use is actually proved — and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

15) In determining the issue of whether there has been genuine use of the mark in suit I look to case O-372/09 (*AMBROEUS*) where Ms Anna Carboni acting as the Appointed Person set out the following summary:

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

(b) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(c) 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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(d) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(i) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(ii) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(e) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(f) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

16) Section 46(6) states:

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

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

(b) If the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.

17) AA has filed scant evidence. It is clear that for a limited time he rented a property at 29 West End Arcade, Nottingham. The licence states that the business was to be a “cob shop”. I note that a cob is, inter alia, the name given to a round bread roll. No photographs of the shop, details of income earned, advertising, copies of invoices from suppliers of either the breads, fillings or packaging is provided. Mr Ahmed refers to packaging but no invoices for bags or cups are provided, or indeed witness statements from the suppliers of same. The only paperwork provided is from Walkers Snack Services Limited addressed to “Cobb Farther”. No details of what was supplied or when can be gleaned from the paperwork from Walkers as it is surprisingly faded for something which is only approximately seven years old. A letter was also filed regarding the placement of a student on work experience, but this letter is merely proposing a visit to discuss the matter. This suggests that the writer was contacted to discuss the issue and confirmed in writing that a site meeting was required. None of this equates to evidence of actual trading in anything. Even the enquiries carried out by PPC do not amount to evidence of actual trading, merely that the business was registered, as seems to be required by law, for a brief time with the local authority. I note that the local council does not consider that the business was trading after 5 June 2007 which

contradicts the evidence of AA. The photograph of an empty sandwich carton appears to be labelled in contravention of the labelling laws and again has not been documented with details such as the supplier of the container or label etc. No details of where such items might have been sold have been provided other than in the vaguest details, when it should have been easy to provide dates of fairs etc attended.

18) Turning to the witness statements of the four independent witnesses. These are pro-forma witness statements, which reduces the amount of weight I would attach to them but would still be regarded as evidence upon which I could rely. I note that these same individuals also signed a similarly worded (other than the dates they had purchased goods from the shop) of the pro-forma statement where the dates referred to were clearly inaccurate as the shop, had long ceased business. These were initially filed with the counterstatement but were returned as they were not properly headed. When a witness statement is signed it is presumed that the witness is giving due consideration to the statement and is telling the truth. In the circumstances I must have doubts that the witnesses gave such due consideration to what they were signing as they were willing to sign statements which contained conflicting details within months of each other.

19) To my mind the evidence does not support the assertion of Mr Ahmed that he used the mark in suit upon the goods for which it is registered in Class 30. At best it shows that for a brief period of time he ran a shop under the mark in suit which sold snacks such as crisps and sandwiches. This might support a registration for a retail service but not for the goods themselves which, at least in the case of the crisps, would have the name "Walkers" upon them, even if they were placed in a bag with the mark in suit upon it. In any event "crisps" were not in the registered specification.

CONCLUSION

20)The mark must therefore be regarded as being revoked in full with effect from 16 December 2011.

COSTS

21) PPC has been successful and it is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering and commenting on the other side's evidence	£500
Preparing for and attending a hearing	£500
TOTAL	£1300

17) I order Mr Ayaz Ahmed to pay Paramount Pictures Corporation the sum of £1300. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of April 2013

**George W Salthouse
For the Registrar,
the Comptroller-General**