

O/048/21

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 2622528

IN THE NAME OF CCL GROUP

FOR THE FOLLOWING TRADE MARK



IN CLASSES 43 & 44

AND

AN APPLICATION FOR REVOCATION THEREOF

UNDER NO. 502864

BY

NMC HEALTHCARE LLC

Background and pleadings

1. CCL Group (“the proprietor”) is the registered proprietor of trade mark registration no. 2622528 for the mark:



2. The trade mark was filed on 24 May 2012 and registered on 14 September 2012. It is registered in respect of the following services:

Class 43: Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services; apartment hotel services.

Class 44: Nursing and care home services.

3. NMC Healthcare LLC (“the applicant”) filed a notice of revocation on 22 October 2019, seeking full revocation of the trade mark registration. The application for revocation is based on Section 46(1)(a) of the 1994 Trade Marks Act (“the Act”) on the basis of non-use in the five years following registration. The date of revocation claimed is 15 September 2017.
4. The application is also based on Section 46(1)(b) of the Act on the basis that the use of the trade mark has been suspended for an uninterrupted period of five years. Two periods of non-use have been claimed, these are: 14 February 2014 – 13 February 2019 and 21 October 2014 – 20 October 2019. In this regard, the dates of revocation claimed are 14 February 2019 and 21 October 2019. The claim under s.46(1)(b) also relates to all of the services registered.
5. The proprietor has defended its registration, claiming use of the mark on all of the services covered under the mark, during the relevant period.

6. The proprietor submitted a witness statement and evidence which will be summarised to the extent that it is considered necessary. Neither party requested a hearing and so this decision is taken following a careful perusal of the papers.
7. The applicant has been represented by Stobbs IP Limited. The proprietor is unrepresented.

Evidence

8. On 27 July 2020 the proprietor filed evidence to show genuine use of the registered mark during the relevant periods.
9. The evidence is comprised of the witness statement of Mr Apinder Singh Ghura, with three accompanying exhibits numbered AS1 – AS3. In his witness statement Mr Ghura states that he is a partner of CCL Group (the proprietor) and a Director of Chan Commercial Ltd (CCL).
10. He states that CCL Group has been established since 2012 and has a multi-million pounds turnover. The main part of its business is the running of care homes, “apart hotels” and other property interests. Due to the success of the business the name ‘CCL’ has become synonymous with the provision of care home facilities and property in the UK. The mark under attack is the proprietor’s house mark and principal brand and was first used in 2012.
11. Mr Ghura states that the evidence provides the following information:

Exhibit AS1 provides four dated screenshots taken from the CCL Group website showing the trade mark on the front page. These screenshots also provide details of the proprietor’s commercial activities in the area of care homes, apart hotels, property development and land management. The same exhibit also provides company accounts of Chan Commercial Ltd from Companies House. The final part of exhibit AS1 shows the CCL Group website front page, where the mark at issue is displayed. These pages are dated 2016 and 2017.

Exhibit AS2 provides a financial summary and invoices for one of the proprietor’s former care homes ‘West Farm Residential Care’ in Newcastle Upon Tyne. This care

home was sold in December 2015 but was run under the fascia of CCL Group. Pages 2-32 of AS2 provide a summary of customer invoices for residential care and on-site nursing at West Farm between 2012 and 2015 totalling over £1.1 million. Pages 33-40 of AS2 provide examples of copy invoices to residents during the same period and the mark at issue is visible on the right-hand side of these invoices.

Exhibit AS3 provides a financial summary and invoices for the Willow View Care Home, another of the proprietor's properties. This information covers the period 2015 – 2019. Pages 1 -10 are examples of copy invoices to residents of Willow View for residential care and on-site nursing during that period. The mark at issue is visible on the right-hand side of these invoices. Pages 11-32 of AS3 provide a summary of customer invoices for residential care and on-site nursing at Willow View between 2015 and 2020 totalling over £5.6 million.

Decision

12. Section 46(1) of the Act states that:

“(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 purpose 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.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

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

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

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

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

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

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

13. Section 100 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.”

14. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), 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 Bunderversammlung 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 Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it

guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or

preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *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].”

Genuine Use

15. An assessment of genuine use 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.¹

16. I refer back to the findings in *Walton* in respect of genuine and actual use of a trade mark. In particular that 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. The use must be more than merely token. All of the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including the nature of the goods or services and the characteristics of the market concerned. 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, and, as the proprietor correctly submits, there is no *de minimis* rule.

17. Having carefully assessed the evidence provided by Mr Ghura, I conclude that the evidence in fact shows the following:

¹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

Exhibit AS1:

Page 6 of the exhibit shows an image of Willow View Care Home with the mark at issue partially on display. This image is from the proprietor's website and is dated July 2019. Care homes and hotels are mentioned. The words 'CCL Group' can also be seen in the image. Page 8 shows Friar House apart hotel. The mark at issue is on display and this image is dated 2018. Also, in this image the proprietor refers to awards granted to them in 2013 by RICS and RIBA. Page 9 shows the mark at issue in a screenshot dated December 2018, referring to property development, with the image of a Co-op supermarket. A similar image dated June 2017 is also provided.

In all of these screenshots, the name 'Chan Commercial Ltd' is presented directly underneath the proprietor's mark on the top left-hand side of the pages. As Mr Ghura has indicated that he is a partner of the proprietor CCL Group and a Director of Chan Commercial Ltd, I accept that these entities are related in the relevant fields of business. In fact, I think it reasonable to make the assumption that the proprietor's name 'CCL Group' has been based on the initials from Chan Commercial Ltd.

Pages 10 and 11 show financial accounts from Chan Commercial Ltd dated 31 December 2017. Mr Ghura has stated that he is a Director of this company and there seems to be a business relationship between Chan Commercial Ltd and the proprietor CCL Group, however this has not been clearly established by Mr Ghura. The accounts from Companies House show that Chan Commercial Ltd had capital and reserves of almost £6.5 million in the years 2016 and 2017; however, as Chan Commercial Ltd is a different entity to the proprietor, the financial accounts displayed on page 11 of exhibit AS1 do not assist in this matter.

A further screenshot on page 12 of AS1 from the Proprietor's website, shows 'Roomzzz Aparthotels' which appears to be a property of the proprietor. The mark at issue is clearly displayed. This is dated 2016.

Exhibit AS2:

Page 3 of exhibit AS2 comprises a screenshot from 'carehome.co.uk' showing West Farm Care Centre, there is no indication of the mark at issue and no mention of the proprietor or of Chan Commercial Ltd.

The remaining information from AS2 provides invoice summaries from West Farm Care Centre.

Pages 4–5 provide lists of invoices to customers for the year 2012, totalling £128,598.31.

Pages 6–14 cover the year 2013 and total £599,667.16.

Pages 15–24 cover the year 2014 and total £796,213.86.

Pages 25–34 cover the year 2015 and total £1,108,125.22.

None of these invoices shows the mark at issue or display the name CCL Group or Chan Commercial Ltd.

Pages 35–42 of AS2 provide fee invoices to individual residents at West Farm Care Centre between 2012 and 2015. These invoices display the mark at issue at the top right-hand side of each invoice, establishing that the proprietor was involved in the ownership or management of West Farm Care Centre during the period 2012-2015 and therefore in receipt of the amounts set out in pages 4 – 34 of exhibit AS2.

Exhibit AS3:

Pages 3–12 of exhibit AS3 provide individual customer invoices for care home services provided at Willow View Care Home between 2015 and 2019. These invoices show the mark at issue clearly on the top right-hand side.

Pages 13–34 are invoice summaries for residential care services provided at Willow View Care Home between 2015 and 2020. The total revenue across all of these invoices is £5,690,327.37. Although some of this revenue was received later than the relevant dates, the vast majority was received during the periods of interest for this matter. Whilst the mark at issue is not present on these pages and neither is the name CCL Group or Chan Commercial Ltd, they relate to services provided at Willow View Care Home during the period 2015 and 2019 and the customer invoices provided on pages 3-12 of AS3 establish a clear link between the proprietor and Willow View Care Home during that period of time.

18. Accordingly, I conclude that the evidence before me establishes that there has been genuine use of the mark at issue during the relevant periods. Images contained within exhibit AS1 show the mark at issue on website screenshots dated between 2016 and 2019. Financial information in the form of invoices within Exhibits AS2 and AS3 show that the mark was used in respect of West Farm Care Centre between 2012 and 2015 and Willow View Care Home between 2015 and 2019. The proprietor has established a clear link between those care homes and itself, with the use of the mark at issue clearly displayed on customer invoices.

19. However, what is also clear is that the proprietor's claim to have used the mark in relation to all of the registered services is not supported by the evidence.

20. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person stated that:

“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.”²

21. Whilst some of the exhibits refer to hotels, apart hotels and property development, the evidence fails to show that the mark at issue has been used in relation to such services. All of the financial information provided relates to care home services and nursing services within care homes. The proprietor has submitted specific information only in relation to Willow View Care Home and West Farm Care Centre, both being care homes. I must therefore consider the scope of the proprietor’s use and decide on what amounts to a fair specification.

Fair Specification

22. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

23. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“T

² BL O/404/13,

Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; Thomas Pink at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; Thomas Pink at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

24. The proprietor's evidence shows use of the mark at issue in respect of care home services and nursing services within care homes, however, taking note of the findings in *Mundipharma AG*, I must consider the issue of overly restrictive limitations to specifications and the possibility of subcategories within a broader or more general term.

25. Having considered the evidence in this matter, I find that the proprietor has shown no evidence of use of the mark in respect of the following services for which the mark at issue is registered: 'services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services; apartment hotel services'.

26. I have carefully considered the term 'Retirement home services' which the proprietor has registered, as it might be argued that such services are similar to care home services. A retirement home provides accommodation for elderly people, whilst a care home provides specialist care, particularly medical and nursing care, to its residents, who may be of any age group, but are vulnerable and require medical assistance on a regular or constant basis. A retirement home or retirement village may have medically qualified personnel available, however the primary focus of such establishments will be the housing of elderly people and not the administration of medical and nursing care. I find therefore, that due to the narrow scope of the proprietor's evidence, a fair specification in this instance should not include 'Retirement homes'.

27. Based on the evidence before me I conclude that a fair specification in this matter is: 'Nursing and care home services'.

Conclusion

28. The revocation action has largely succeeded. Registration No. 2622528 will remain on the register, but only for the following services:

Class 44: Nursing and care home services.

29. As to the date from which the rights of the proprietor shall be deemed to have ceased in respect of those services that are revoked, in line with section 46(6)(a), the above changes are effective from 15 September 2017.

Costs

30. Whilst both parties have achieved some measure of success in this matter, the applicant can be said to have been successful to a greater degree and is therefore entitled to a contribution towards its costs, which are sought on the usual scale (contained in Tribunal Practice Notice 2/2016). I award the applicant the sum of £600 as a contribution towards the cost of the proceedings. That sum is calculated as follows:

Official notice to revoke a registration	£200
Considering the proprietor's witness statement and evidence	£400
Total	£600

31. I therefore order CCL Group to pay NMC Healthcare LLC the sum of £600. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18 day of January 2021

**Andrew Feldon
For the Registrar
The Comptroller-General**