

O-393-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. 2262305  
IN THE NAME OF PHIROZ SHEIKH  
OF THE TRADE MARK**



**AND THE APPLICATION FOR REVOCATION THERETO  
UNDER NO. 83916  
BY GREYLEG INVESTMENT LTD**

## Background and pleadings

1. On 22 November 2010, Greyleg Investment Ltd (“the applicant”) filed an application for the revocation of registration number 2262305, on the grounds of non-use:



Since the trade mark was applied for, it has at all times stood in the name of the current proprietor, Phiroz Sheikh. The registration procedure was completed on 21 November 2001. The mark is registered for *providing of food and drink ice cream parlour*, in class 42 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2. The applicant seeks revocation of the registration in full under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”). It claims that no use was made of the mark for the services as registered, rather the use has been on ice cream, in the five year period following registration; i.e. under section 46(1)(a) of the Act. The dates relating to the section 46(1)(a) period are 22 November 2001 to 21 November 2006. The earliest effective date of revocation under section 46(1)(a) is 22 November 2006. The applicant claims the effective date of revocation under section 46(1)(a) as 24 November 2006. Under section 46(1)(b), the applicant claims that no use was made of the mark for the services as registered in the five year period 19 November 2005 to 18 November 2010, the effective date of revocation being 19 November 2010.

3. Mr Sheikh filed a counterstatement in which he stated:

“Euro Ice-cream is the original user of the brand name Hokey Pokey in respect of Ice-Cream. We have been using Hokey Pokey in a unique stylish manner and have sale in UK. We present herewith proof of use of the mark Hokey Pokey in respect of Ice-Cream. We have registered the trade mark Hokey Pokey not only in UK but also in India, copy of the trade mark certificate is attached herewith as evidence of registration in Indian Trade Mark Office. We are also enclosing herewith the newspaper cutting wherein it is clearly stated that Euro Ice-cream are launching their new product Hokey Pokey in various flavours published in Birmingham Evening Mail dated Tuesday 11<sup>th</sup> June 2002. This clearly indicated the used of the trade mark Hokey Pokey since 2002 by Euro Ice-cream. We are also enclosing herewith few of our invoices of various years. This clearly shows that we have been continuously using the trade mark Hokey Pokey.”

4. At the time of filing his counterstatement, Mr Sheikh was representing himself, as he was when he filed his first evidence. Subsequently, he appointed Murria Solicitors to act for him and I allowed, at a case management conference<sup>1</sup>, for his evidence to be put in order and supplemented. By the time the proceedings had reached the end of the evidence rounds, Murria Solicitors had withdrawn representation. The registry made repeated attempts to contact Mr Sheikh in relation to the right to be heard on the substantive merits of the case, or to file written submissions in lieu of attendance, but received no response.

5. The applicant filed evidence and written submissions in lieu of a substantive hearing. I confirm that I have taken account of both parties' evidence and submissions in making my decision. These proceedings have been characterised by a forensic approach by the applicant to Mr Sheikh's evidence. The applicant has submitted that the changes to Mr Sheikh's evidence reveal a shift in his position, and at times has alleged forgery. I believe that some of the changes were simply the result of confusion on Mr Sheikh's part as to the substance of the lengthy challenges by the applicant and what he was required to show. He is not a trade mark lawyer. Although the applicant is also not a trade mark lawyer, Mr Garnsworthy, who has been the mouthpiece of the applicant, has spent a substantial amount of time researching the ins and outs of trade mark revocation and the Trade Mark Rules 2008. This is clear from the content of his correspondence with the registry and from his submissions to me at two case management conferences.

6. The evidence filed by both parties has been voluminous and at times difficult to follow. It has been a mixture of fact and submission. I intend to summarise only the evidence which I consider to be relevant and pertinent to the issues I have to decide. Opinions I will treat as submissions, because opinions are not facts. If a point is not included in my summary, this does not mean that I have not considered it; merely that it is not appropriate to include it in an evidence summary, or that it is not relevant to the question of genuine use. I have considered all the evidence and submissions made by both parties.

## **Evidence**

7. Mr Sheikh has filed four witness statements and has also filed witness statements from Shazad Badil, Yasser Khan, Manish Patel, Sabiha Sheikh, Saarah Rasool and Muhammed Shabir<sup>2</sup>. The applicant has filed a witness statement from David Garnsworthy and two witness statements from Deirdre Garnsworthy.

### Mr Sheikh's first witness statement, dated 11 March 2011

8. Mr Sheikh states that the trade mark Hokey Pokey was first used in the UK in 2000 by Penney Corporation Ltd for "our" ice cream products. Afterwards, the mark was used by AMZ (UK) Limited. Mr Sheikh then states that it was used on ice cream and the date of first use was 2001. He exhibits the 'Hokey Pokey Ice Cream parlour' logo at exhibit I, which corresponds to the form in which the trade mark is registered except that it also includes the word 'parlour'. Mr Sheikh says the exhibit shows "use

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<sup>1</sup> Held on 25 October 2011.

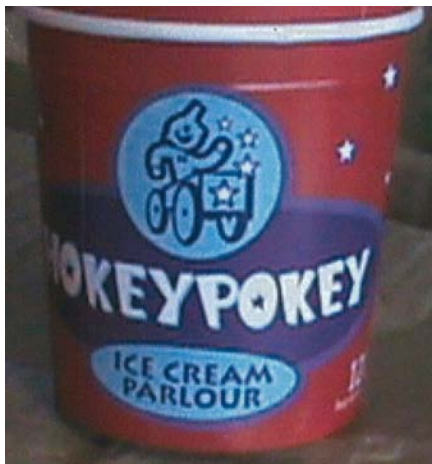
<sup>2</sup> The evidence of Sabiha Sheikh, Saarah Rasool and Muhammed Shabir is the subject of a confidentiality order in relation to pay slips.

of the mark in relation to the goods Ice cream”. It is undated. Exhibit II is an article in the Birmingham Evening Mail which Mr Sheikh states shows the launch of Hokey Pokey ice cream in seven new flavours. The article is dated 11 June 2002 and is a report of a food trade fair at the Birmingham International Arena. Part of the article says:

“Euro Ice Cream – manufacturer of traditional ice creams as well as an extensive range of oriental and Indian ices. The business is promoting its new ‘Hokey Pokey’ ice cream in seven new flavours”.

9. Mr Sheikh refers to ‘Huskey freezer’s offer with Hokey Pokey ice cream” (exhibit III) which he states shows the promotion offer made with the date of art work creation. The advertisement shows the mark as registered but with the addition of the word ‘parlour’ below the words ‘ice cream’. Page 2 of the exhibit is a screenshot of the pop-up menu to save a document to Adobe Acrobat. The document is called retail leaflet and the date of creation is 25 June 2002.

10. Mr Sheikh describes exhibit IV as the Hokey Pokey picture on a small tub showing the packing material used with the trade mark. This is shown below:



The additional word ‘parlour’ appears under the words ice cream. There is no dating.

11. Exhibit V is a photograph of Hokey Pokey ice cream served at a wedding ceremony (allegedly). It is a poor reproduction and it is not possible to see the mark on the tubs; nor is it dated and Mr Sheikh does not say when the event took place.

12. Exhibit VI gives details of product activity for 2010 to 2011 for Hokey Pokey ice cream. The product activity report is dated 18 January 2011 and is headed AMZ (UK) Limited – T/A Euro Ice Cream. It lists various flavours of Hokey Pokey, such as bubble gum, banana toffee and chocolate. There are no references to services. Most of the dates of sale fall after the relevant period, but prior to 18 November 2010, there were, for example, sales on 3 November 2010 for one case of 12 Hokey Pokey Bubble Gum, at a price of £5, twelve cases of Hokey Pokey Banana Toffee (£5 each) on 8 November 2010, sixteen cases of Hokey Pokey chocolate at £5 each on 4 November 2010 and a case of Hokey Pokey vanilla on 3 November 2010. The sales all occur in November and December 2010 and January 2011.

13. Similarly, Mr Sheikh exhibits a product activity report (Exhibit VII) for 2009 to 2010 and states that he exhibits an invoice for £7,103.79, although that is not in the evidence. The product activity report is dated 4 January 2011 and is headed AMZ (UK) Limited – T/A Euro Ice Cream. There is a list of sales of various flavours of Hokey Pokey ice cream during the period pleaded under section 46(1)(b). The number of cases sold is not vast, but shows a regular pattern. There are no references to services.

14. Exhibit VIII is similar, for sales during 2008 to 2009. The report is dated 4 January 2011 and is headed AMZ (UK) Limited – T/A Euro Ice Cream. Mr Sheikh states that, prior to this period, all sales were through Penney Corporation Ltd under licence. Mr Sheikh states that this entity went into liquidation and if details of invoices are required, they will have to be obtained from the liquidator. However, in his second witness statement, invoices from Penney Corporation Ltd are included.

15. Finally, Mr Sheikh states:

“The Trade Mark ‘Hokey Pokey Ice Cream Parlour’ has been used in the whole of UK”.

Of course, the word ‘parlour’ is not present in the registered trade mark.

16. Following the filing of the above witness statement, Mr Sheikh appointed Murria Solicitors to represent him in the proceedings. The evidence was re-filed in correct evidential format, with Mr Sheikh’s signature dating the witness statement on 25 October 2012. The invoices absent from exhibits VI to VIII were also filed with the 25 October 2012 version of the evidence.

#### Phiroz Sheikh’s second witness statement, dated 11 August 2011

17. This evidence was filed while Mr Sheikh was represented by Murria Solicitors. Mr Sheikh states that the trade mark was first used in the UK in 2001, by Penny Corporation Ltd. Mr Sheikh goes on to say that the mark was used for ice cream products. Exhibit IX comprises copies of two deeds of assignment between Mr Sheikh and Penney Corporation Ltd, dated 1 April 2001, and between Mr Sheikh and AMZ (UK) Ltd dated 1 November 2008. Although seven years apart in time, they are identically worded. The assignment documents are unusual. They assign the trade marks but refer to the past tense, reading more like evidence or submissions about how the assignee wanted to use the mark; it is stated that the use was to be for weddings and parties (i.e. as a service). For example, the documents state that the assignee “will not do any other business by using the trade mark “Hokey Pokey Ice Cream” other than it is meant for that is restricted its usage under class 42 for servicing” and “They [the assignee] wanted Unique styled name to be put in the tub and to fill different generic based ice cream like Vanilla, Strawberry, Banana, Bubblegum and many other to provide service to their caterers’ and parlours”. This evidence was filed after the applicant requested summary judgment (which was refused) on the basis that Mr Sheikh’s first witness statement only made reference to use of the mark on ice cream, i.e. on goods, rather than for a service in class 42. The documents also state that the assignee was to pay 2% of its annual sale of Hokey Pokey ice cream as a royalty payment.

18. Exhibit X is described as a brochure for services. The exhibit is undated. The name and address on the back is Penney Corporation Ltd's. The brochure is comprised of two pieces of printed paper which have been placed back to back, folded and stapled all around the perimeter. Exhibit XI is described as brand and packaging for all "our" product range with invoices. There is a copy of an invoice from a designer called Balu Bear Studios. The invoice was sent to Penney Corporation Ltd. The invoice is for brochure design, development and printing for Euro Ice Creams (Hokey Pokey) at a cost of £7500, on 25 November 2002. Presumably, this sum was not in respect of the amateurish folded and stapled brochure described above. Page 5 of the exhibit is an invoice to Euro Ice Cream dated 15 July 2009 from DGA Marketing for the creation of a "Hokey Pokey/Karahi Kulfi poster. Exhibit XII is described as a personalised label on the tub for caterers "with uniquely styled name Hokey Pokey with caterers name". It is undated. The bottom part of the tubs says "Serviced by Euro Ice Cream".

19. A lid carrying the flavour name (undated exhibit) is shown at Exhibit XIII. The registered mark is shown but with the additional word 'parlour'. Exhibit XIV is a letter dated 10 September 2002 to Euro Ice Cream, c/o Milan Catering, from Mr and Mrs More, as a thank you for the service given at their marriage at the Arya Samaj Vedic Mission on 1 September 2002.

20. Exhibit XV is described as an exclusive contract with caterers for service. There are six separate contracts between Penney Corporation Ltd t/a/ Euro Ice Cream and Bilston Catering, Iqbal Catering, Johal Catering, Lahore Kebab House, Milan Catering and M.K.B. Catering. These are the names which appear on the personalised labels shown in Exhibit XII. The contracts are dated, respectively, 13 March 2006, 13 April 2004, 20 March 2006, 10 March 2006, 15 March 2003 and 31 March 2003. The applicant points out that the contracts for Lahore Kebab House and Milan Catering show that there are two companies operating from the same address in 2003 (208 Ladypool Road, Birmingham). The contracts refer to products with the Hokey Pokey name.

21. Exhibits XVI to XX are sales invoices for the periods 2003-4, 2004-5, 2005-6, 2006-7 and 2007-8, respectively, accompanied by a print out for each exhibit of product sales by customer, headed up as Penny Corporation Ltd. The reports were generated in 27 July 2011. The reports and invoices refer to service charges for using the service team. VAT is charged at 17.5% for the most part, although in some instances is listed at 20%; it did not rise to this point until some time after the date of the invoices (2011). The invoices all list various flavours of Hokey Pokey ice cream. Product sales in 2003-4 totalled £61,607.44; £67,734.61 in 2004-5; £63,521.66 in 2005-6; £71,414.88 in 2006-7, and £71,646.66 in 2007-8. The customers include those named in the contracts described above.

Phiroz Sheikh's third witness statement, dated 14 November 2011

22. Mr Sheikh's third witness statement was filed in response to challenges made by the applicant, in relation to his first and second witness statement. The exhibits all form part of Exhibit PS3. Mr Sheikh states that the trade mark has been in use in the UK by Mr Sheikh or with his consent in relation to the services for which the trade

mark is registered. He describes the services on which the mark has been used as “transportation supply of items of food and drinks, including ice cream in a stylish manner (ie. Packaging, which identifies with a particular business as the source of services not the product); the transportation/delivery of items of food and drink; services consisting of serving the product using waiters/waitresses, who are dressed in a uniform bearing the Trade Mark; providing facilities for the storage of food and drinks (e.g. refrigerators and freezer cabinets); the use of expertise and experience in delivering the service”.

23. Mr Sheikh states that the trade mark has been used at functions such as birthday parties, weddings and corporate hospitality. Mr Sheikh exhibits six letters which he states are from customers. Most include wording which indicates they have been solicited for the purpose of these proceedings, referring to events which occurred, in some cases, years before the date of their letter. The letter from Mr and Mrs More, already referred to, is amongst the letters; however, the signature is completely different to that in the earlier version. These letters carry no weight: they are hearsay, have been solicited for the proceedings and the incompatible signature in the More letter puts in doubt their probity.

24. The photographs at pages 7 to 9 of exhibit PS3 show people manning an exhibition stand<sup>3</sup> wearing t-shirts with the mark on the front, although the marks are indistinct and it appears that the word ‘parlour’ is present. The photographs are undated and there is no statement about when they were taken. Mr Sheikh describes the people in the pictures as being waitresses and waiters serving the product; however, they are as I have described.

25. Mr Sheikh states that he was the sole director and shareholder of Penney Corporation Ltd, which was involved in the manufacturing and wholesale distribution of ice cream. Referring to the assignment documents described above, Mr Sheikh states that it was not his intention to transfer ownership of the trade mark but was to grant Penney Corporation Ltd the right to use the mark for certain purposes for a certain period of time (although there is no reference to time periods in the assignment documents). Mr Sheikh goes on to explain that he retained control over the trade mark and its use. He states:

“The assignment was used by PCL to offer a service, as opposed to PCL usual course of business of manufacturing and wholesale distribution of ice cream. In return, I would receive a royalty as the registered proprietor of the Trade Mark.”

26. Mr Sheikh states that some end users wanted the ice cream to be served by waiters, a service provided if wished by Penney Corporation Ltd. Customers ranged from shops to restaurants and caterers. The service was offered in addition to the ice cream itself. As an example, Mr Sheikh refers to the purchasing of the service by MKB Catering, exhibiting a copy of a letter dated 3 November 2011 and copies of the sales contract (as above) dated 31 March 2003 between Penney Corporation Ltd and MKB Catering and between AMZ (UK) Ltd and MKB Catering on 20 September 2008. The letter has been solicited for the proceedings as it refers to support for the

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<sup>3</sup> It is a trade exhibition, as it is possible to see the beginning of a Braun sign above a stand nearby.

current trade mark dispute. It is hearsay (but see Mr Khan's evidence below). Invoices to MKB Catering are shown at pages 28 to 35 and pages 88 to 91. The invoices show lists of Hokey Pokey ice cream flavours and "service charges for using our service team". They are dated in each year from 2005 to 2011. The service charge equates to approximately half of the invoiced sales up to 2008. In the invoices post-2008, i.e. when the trade mark was used by AMZ (UK) Ltd, the sale of ice cream appears very secondary to the cost of serving it. For example, the invoice for 24 October 2010 shows that out of a total of £258, £224 was for the service charge. The invoice for 29 June 2010 shows that out of a total of £175, £112 was for the service charge. These amounts are small in comparison with the invoices up to 2008, which are close to £1000 apiece. The later invoices include amounts for empty Hokey Pokey tubs. Similar evidence is provided in relation to Milan Sweet Center, Iqbal Catering, Lahore Kebab House and Johal Catering.

Shazaad Badil's witness statement, dated 15 November 2011

27. Mr Badil is the designer who owns Balu Bear Studios, which Mr Sheikh states designed the promotional material referred to earlier. During the course of the proceedings, the applicant alleged that Mr Sheikh's evidence in relation to Balu Bear was fabricated because the web address and the business address did not exist in 2002, the date of the invoice. Mr Sheikh filed the witness statement from Mr Badil to meet that challenge. Mr Badil states that he started trading as Balu Bear in 2000 and that in or around April 2002, Mr Sheikh asked him to design brand packaging for his trade mark Hokey Pokey Ice Cream. He invoiced Mr Sheikh on 25 April 2002. In late 2010, during the course of these proceedings, Mr Sheikh asked him to provide a copy of the invoice to use as evidence. Mr Badil points out that this was eight years after he had done the work; although he did not have a hard copy of the invoice, Mr Badil did have an electronic version stored on his computer. He printed the invoice on paper using the 2010 letterhead. He explains that the anachronistic domain name arose because he had planned to use the domain in 2010, but did not get the web page running until 2011. He also moved to a new address in 2010. The anachronisms are therefore explained by Mr Badil using 2010 business paper to print a copy of the 2002 invoice.

Yasser Khan's witness statement, dated 15 November 2011

28. Mr Khan has been an event organiser at MKB Catering since 2001, catering at birthday parties, weddings and corporate hospitality functions. MKB sells Indian cuisine and makes the vast majority of the products sold to the customer, such as kebabs, chicken curry and gajrela (a carrot dessert). Mr Khan states:

"MKB does not provide the actual service at the party or function. MKB just provides the food and drink. The customers would either make their own arrangements for the service of the product or MKB enters into an agreement with a service provider, the customer is billed for the cost incurred by MKB in purchasing the service."

29. Mr Khan's role is to negotiate such agreements. Additionally, if a customer wanted a product not produced by MKB, Mr Khan's role would be to buy the product from the manufacturer or wholesaler. Mr Khan states that he started buying ice



cream from Penney Corporation Ltd in about 2002, having met Mr Sheikh, because MKB did not make ice cream. He also bought ice cream from other businesses. MKB bought the ice cream and sold it to the customer “as MKB’s product, manufactured by Penney Corporation Ltd.” He states that in purchasing ice cream from Penney Corporation Ltd, Mr Khan knew that Mr Sheikh owned a branded service called Hokey Pokey Ice Cream. Mr Khan’s company entered into the agreement with Penney Corporation Ltd on 31 March 2003 for a year; sometimes MKB Catering purchased the ice cream from another company but used the Hokey Pokey Ice Cream service to serve the ice cream. Exhibit YK1 is a copy of the hearsay letter referred to above, in which it is confirmed that MKB Catering used the Hokey Pokey Ice Cream service for a wedding on 28 June 2003. By exhibiting this to his witness statement, Mr Yasser has put the previously hearsay letter into evidential form. Although it has been solicited for the proceedings, Mr Yasser could have been cross-examined on the accuracy of the historical information, whereas as part of Mr Sheikh’s evidence it could not be tested. The letter says that the service was used for serving MKB’s ice cream and drinks, by a Hokey Pokey dressed team with their “unique styled pack”. A similar letter is also exhibited in relation to a wedding held on 7 October 2008 (addressed to AMZ (UK) Ltd). In relation to the event on 28 June 2003, Mr Khan states that it:

“...consisted of a team of waiters and waitresses, dressed in Hokey Pokey Ice Cream uniforms, serving the ice cream at the wedding. The service also consisted of serving the ice cream in packaging bearing the Hokey Pokey Ice Cream brand. The packaging and presentation of the ice cream distinguished MKB as the caterer for the event, and identified the manufacturer of the ice cream. It was perfectly clear that Hokey Pokey Ice Cream was the service provider for the ice cream and drinks. The service also include the storage of the ice cream in branded refrigerators and freezer cabinets”.

30. Mr Khan states that his company purchased the Hokey Pokey Ice Cream service at least fifteen times annually between 2003 and 2008. His company entered into a year-long agreement with AMZ (UK) Ltd on or around 20 September 2008. He states that he is sure that the service was purchased by his company from AMZ (UK) Ltd, but that the ice cream was purchased from another manufacturer. Mr Khan finishes his statement by stating that his company has purchased the Hokey Pokey Ice Cream service every year between 2002 and 2011.

Harish Patel’s witness statement, dated 15 November 2011

31. Mr Patel is a partner in Milan Sweet Centre and the owner of Milan Indian Cuisine, a restaurant which caters for functions. His company buys ice cream from wholesalers and confirms that he bought ice cream from Penney Corporation Ltd until 2007, for selling as his company’s product, manufactured by Penney Corporation Ltd. He states that his company only provides the food and drink at parties; serving the food and drink would be done by the client or another business. He entered into an agreement, on 20 March 2006, with Penney Corporation Ltd to use the Hokey Pokey Ice Cream service. He states that his company was identified as the source of the food and drink, as the caterer; Penney Corporation Ltd as the manufacturer of the ice cream; and Hokey Pokey Ice Cream as the provider of the service. Mr Patel exhibits letters (identically worded to those of Mr Khan) confirming

that the service was provided to his company at weddings on 8 August 2007 and 27 September 2008. He bought the ice cream from another company, but used the Hokey Pokey Ice Cream service for the ice cream to be put into packaging and to be served, along with drinks, by the Hokey Pokey Ice Cream team.

32. Mr Patel states that between 2005 and 2008, he used the Hokey Pokey Ice Cream service in numerous occasions. He entered into a contract with AMZ (UK) Ltd on 17 October 2008 and purchase of the service has continued since that date. He states that he purchases the service five or six times a year.

Witness statements of Sabiha Sheikh, Saarah Rasool and Muhammed Shabir, dated 15 November 2011

33. Mrs Sheikh is Mr Sheikh's wife and she makes her witness statement in relation to her employment as a Hokey Pokey Ice Cream team member, on an ad hoc basis. As part of the role, Mrs Sheikh states that she served food and drink, including ice cream, wearing a uniform consisting of a branded t-shirt with black trousers or a skirt. Mrs Sheikh states that the packaging identified Hokey Pokey Ice Cream as the provider of the service along with the name of the event caterer. Mrs Sheikh states that she undertook this role between three and five times a year between 2003 and 2010.

34. Ms Rasool states that she started working for Penney Corporation Ltd as a Hokey Pokey Ice Cream team member in 2007, serving food and drink, including ice cream at functions. She states that the caterer provided the food and drink and that the ice cream would either be provided by Penney Corporation Ltd or another business. Ms Rasool states that she would wear the uniform and serve the product in the packaging to the end user:

"The packaging used to serve the ice cream to the end user displayed the Hokey Pokey Ice Cream Brand, along with the caterer for the function and identified the manufacturer of the ice cream. I would scoop out the ice cream and serve it to the end user."

35. Between September 2007 and June 2010, Ms Rasool continued her role with AMZ (UK) Ltd (although evidence elsewhere indicates that Penney Corporation Ltd used the mark in 2007). Ms Rasool states that she attended eight to twelve functions a year as a Hokey Pokey Ice Cream team member between 2008 and 2010.

36. Mr Shabir began working as a Hokey Pokey Ice Cream team member in 2003. His job was transportation, e.g. delivering Hokey Pokey ice cream refrigerators and freezer cabinets to the function venue. He also served food and drink wearing the uniform. He repeats the information given by Mrs Sheikh and Ms Rasool in relation to the presentation of the ice cream. Mr Shabir worked for AMZ (UK) Ltd in 2008. Between 2003 and 2008, Mr Shabir states that he carried out his role between eight and twelve times a year.

Deidre Garnsworthy's first witness statement, dated 5 April 2012

37. Mrs Garnsworthy is a retired chartered accountant with a background in auditing. She states that she has applied the principles gained throughout her career to Mr Sheikh's evidence. She begins her statement by stating that she has spent a considerable amount of time researching the internet to find evidence that Penney Corporation Ltd t/a Euro Ice Cream and subsequently AMZ (UK) Ltd t/a Euro Ice Cream for proof of use under class 42 of the trade mark as registered, but found no such evidence. The remainder of Mrs Garnsworthy's witness statement contains a detailed critique of Mr Sheikh's evidence and reveals a forensic approach to the invoices, as one might expect from an auditor. Her critique runs to fifteen pages, at the end of which she says:

"I believe that both the original and later evidence provided by Mr Sheikh to be seriously flawed and unreliable. Without access to the companies underlying accounting books and records including bank statements, annual accounts, quarterly VAT records, complete stock records for all products etc, there can be no reliance placed on any of the sales invoices/product activity records provided. There is no underlying proof that the figures contained on the sales invoices agree with the companies books and records".

38. It would be burdensome to list individually all of the points made, but I have borne them in mind in weighing Mr Sheikh's evidence. I note here the following from her critique:

- There are occasions when VAT is charged at 20%, a rate which only applied after 4<sup>th</sup> January 2011. Mrs Garnsworthy surmises this means that the invoices were created after this date.
- The Product summary sheets contain many arithmetic errors; e.g. the first line of the report in Exhibit XIX refers to 16 units sold at £10.95 as totalling £229.20, which should be £175.20. Mrs Garnsworthy states that this is not normal practice with a SAGE accounting package.
- Mrs Garnsworthy points to numerous pricing errors and suggests that the invoices were altered; e.g. pages 62 and 63 of Exhibit XIX for the same item on the same date, but at different prices.
- Exhibits XIX and XX relate to accounts in the years ending 2007 and 2008 although none were filed at Companies House and Penney Corporation Ltd went into liquidation in 2008.

39. Mrs Garnsworthy attacks the invoice from Balu Bear Studios. She challenges its authenticity. She points out that Penney has been spelt as Penny and balunear.com instead of balubear.com. I do not propose to look in detail at this a) because Mr Badil has made a witness statement explaining the circumstances surrounding the anachronisms in the invoice and (ii) an invoice for design of packaging does not prove that a mark has been used. It might be important in a case where preparations for use is an issue, but that is not the case here.

40. Mrs Garnsworthy exhibits a significant number of pages from the website of Euro Ice Cream using the archive search engine Wayback Machine. The pages cover the period of Mr Sheikh's invoices from 1 April 2003 until 31 March 2008. The majority of pages are pre-2006. The purpose of the evidence is to show that Penny Corporation Ltd only sold ice cream and did not provide the services for which the trade mark is registered. Similar evidence is provided in relation to AMZ (UK) Ltd. My comment about this evidence is that the onus is on Mr Sheikh to prove use, rather than for the applicant to prove non-use. However, I note the point that Mrs Garnsworthy makes about the appearance of 5 litre tubs on the invoices for this period and that they do not appear on the website as a product which is available for purchase. Further, pricing for 5 litre tubs on a 2011 website for Sweetheart Ice Cream, a new venture for AMZ (UK) Ltd, matches that on the invoices in 2003. Mrs Garnsworthy submits that it is highly unusual for a business to maintain the price of a commodity for nine years and that the prices of dairy products and sugar have certainly increased over the period 2003 to 2011.

Deidre Garnsworthy's second witness statement, dated 6 April 2012

41. This statement replies to Mr Sheikh's statement of 14 November 2011. Mrs Garnsworthy disputes again the veracity of the accounts. She also points out that the thank you card dated 24 August 2010 is addressed to Penney Corporation and Hokey Pokey Team, but Penney Corporation went into liquidation in 2008. As in her first witness statement, Mrs Garnsworthy draws conclusions about the use in the relevant periods based on what she states the registered proprietor is currently doing. I have not detailed this aspect of her evidence because I am concerned only with whether Mr Sheikh has proven genuine use in the periods claimed. Supposition based on his current trading activities does not assist me.

David Garnsworthy's witness statement, dated 5 April 2012

42. Mr Garnsworthy states that he is a legal advisor to the applicant and is a retired chartered accountant. In his eleven-page witness statement, Mr Garnsworthy gives a detailed critique in which he disputes the veracity and sufficiency of Mr Sheikh's evidence. He makes particular reference to the inclusion of 20% VAT, introduced in 2011, in invoices from 2003/4 and 2006/7. Mr Garnsworthy asks the question:

“If these invoices came from the original accounting software of Penney Corporation Limited (in liquidation) which ceased trading in 2008 how did a VAT rate of 20% enter such software?”

43. He highlights the fact that the 2003/2004 invoices have an inclusion of £525 at a unit price of £15 without any explanation for the addition. Mr Garnsworthy also states that none of the royalty payments make any sense against the sale of goods and the amounts claimed as royalty. He points out that the individual royalty invoices (pages 15-22 of exhibit PS3 to Mr Sheikh's 14 November 2011 statement) bear “amazing similarity to each other, including misspelling of Mr Sheikh's address, the word Royalty etc. This over a period of some 8 years”.

44. Mr Garnsworthy challenges the amounts referred to in the statements of Yasser Khan and Harish Patel as being paid to staff to serve ice cream in 2004. He states

that a rate of £15 per hour is highly implausible for unskilled staff/labour in 2004. Mr Garnsworthy states that he has written to these witnesses and to six others to give them a chance to independently certify their statements, but received no replies. He also wrote to Mrs Tulsiani, who is the sender of one of the hearsay letters which I refer to in paragraph 23. This letter in Mr Sheikh's evidence refers to the services of the Hokey Pokey Team serving the caterer's food and drink at Mrs Shrina Shah Tulsiani's wedding ceremony on 8 August 2010 at the Royal Opera House and afterwards at the Hilton, Park Lane, London. Mr Garnsworthy states:

"The letter is signed **pp** Shah (Exhibit PS3 page 6). I attach emails between this person and myself (my exhibit 4 pages 1 and 3). The letter (PS3 page 6) is inaccurate, Mrs Tulsiani was not married on 8 August and the caterers have never shared service with Hokey Pokey (I telephoned the caterers – Laguna). Apart from this, I wrote a letter (my exhibit 4 page 5) detailing my questions to Mrs Tulsiani. Mrs Tulsiani was therefore made fully aware of the details prior to my telephone call to her. After a period of time, not having received a reply, I rang Mrs Tulsiani who said she had no knowledge of the letter submitted by Mr Sheikh (PS3 page 6) and would be contacting the caterers. Again, after no reply I telephoned Mrs Tulsiani again. Mrs Tulsiani now changed her story completely. She apparently has an assistant! who, without Mrs Tulsiani's knowledge, wrote this letter with its inaccuracies and pp signed the letter."

45. The content of the emails exhibited runs like this:

15 March 2012 (20:49) from Mr Garnsworthy:

"I refer to my telephone call and subsequent email copying a letter purportedly from you. You stated that you did not write this letter and promised to contact the caterers and come back to me. I look forward to your prompt reply now."

16 March 2012 (09.33) from Shrina Shah:

"Further to our call, I have reviewed the letter and note that it is a letter, the content of which is correct, written on my behalf and addressed to Mr Sheikh. I am not sure what further information you require."

16 March 2012 (10:13) from Shrina Shah:

Further to our telephone conversation and my email below, I confirm that my wedding took place on 15 August 2010 and the reference to the 8 August in the letter to you is a typographical error. I would re-iterate that any letters from me to you or from me to Mr Sheikh have been written in a personal capacity and have nothing to do with my professional qualifications. At no point have I referred to my profession during the course of my discussions with you and I do not wish to become involved in any disputes you may have with any third party. I should be grateful if you would refrain from contacting me in future – in particular, please note that I will not accept any further calls from you at my office."

16 March 2012 (10:15) from Mr Garnsworthy:

“Dear Mrs Shrina Shah Tulsiani (Solicitor),

Further to our original telephone conversation. You stated that you did not write this letter. The letter is unprofessionally written. The date of your wedding is incorrect. I have spoken to Laguna who state that they never share catering services with other firms. You appear to have not known anything about this letter which states “I have passed on your contact details”. “I was delighted to hear praise from my guests about your services”. This was apparently pp signed by your assistant without your knowledge. Please provide details of your assistant.”

16 March 2012 (10:19) from Shrina Shah:

“As far as I am aware, I am under no obligation to respond to you and therefore will not spend any further time doing so.”

46. A similar claim is made against a letter from Mrs Neha Shah. In relation to the letter from Mr and Mrs More, Mr Garnsworthy telephoned the Arya Samaj Vedic Mission and was informed that they do not hold weddings. As there were no contact details for the Mores, Mr Garnsworthy could not follow this up.

47. Mr Garnsworthy challenges the service charge figures given in the invoices provided with Mr Sheikh’s witness statements of 11 August and 14 November 2011, which are nearly 50% of the invoices. He says:

“How are Mr Sheikh’s customers able to absorb such an overhead? I suggest it is highly unlikely”.

48. Mr Garnsworthy also questions the price of Hokey Pokey Butterscotch ice cream as being the same in 2003 and in 2008, which he submits is unlikely in the UK economic climate.

Mr Sheikh’s fourth witness statement, dated 24 October 2012

49. The statement replies to Mr Garnsworthy’s statement and runs to 34 pages. In relation to the 20% VAT point, Mr Sheikh states:

“The discrepancy in the VAT is simply a repetitive data entry error generated on the software package due non professional staff managing the accounts department and when entering the VAT code on the software package.

These employees are not accountants and the mistakes are attributable to simple human error.”

50. Mr Sheikh states that the unnamed charge of £525 at a unit cost of £15 is his service charge for his trade mark, but that the service charge was not described on the invoice due to the data not being entered onto the accounting package for the year 2003-2004. He states that the unit price of £15 covered wages, transportation

and dry cleaning of uniforms. He refutes Mr Garnsworthy's challenges regarding royalty payments and refutes the claims made about the discrepancies between the product summary sheets and the invoices. Mr Sheikh states that the print out summary of product sales per customer always takes the latest price at which the product description has been invoiced. As an example, Mr Sheikh points to the Imrans invoice No 833, 13 July 2006 (exhibit XIX to Mr Sheikh's 11 August 2011 statement, page 30). He states that the HokeyPokey packaging and service was purchased by Imrans for their end user. This was at the time of Penney Corporation Limited. He states that six of the Kulfi Ice Cream 5 litre tubs were sold by AMZ at £19.95 each. Mr Sheikh refers to a later invoice to Imrans, dated 16 March 2007, page 77 of the same exhibit, where the HokeyPokey packaging and service was purchased by Imrans for their end user. Ten of the same product was sold by AMZ at a unit price of £10.95. In the summary sheet for product sales per customer, it shows that sixteen units have been bought with the latest price of £10.95, with the correct value in the invoices being £229.20 (i.e. 6 at £19.95 plus 10 at £10.95).

51. In relation to the exchanges between Mr Garnsworthy and Ms Shrina Shah Tulsiani, Mr Sheikh states that the emails confirm that the letter supplied to him is correct and that the conversation has not been confirmed by Mrs Tulisani; she, in fact, confirms that there was a typographical error. Mr Sheikh refers to the emails and telephone calls as aggressive and harassing behaviour. He states that Mr Garnsworthy has failed to supply any evidence of the contents of his conversation with Laguna Catering, or who he spoke to. He says the same of the alleged conversation with the Arya Samaj Vedic Mission.

52. In relation to the 50% charge for service which Mr Garnsworthy has challenged as being too high, Mr Sheikh states that customers are free at any point to enter into an agreement for the service. Mr Sheikh also states that his pricing strategy is decided by him (this is a reference to Mr Garnsworthy's point about the prices being the same in 2003 as they were in 2008).

## **Decision**

53. Section 46 of the Act reads as follows:

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

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

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(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.

(4) An application for revocation may be made by any person, and may be made either 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.”

54. Section 100 of the Act states:

“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.”



55. Consequently, the onus is upon Mr Sheikh to prove that genuine use of the registered trade mark was made in the relevant periods, rather than on the applicant to prove non-use. The applicant has filed a considerable amount of evidence in these proceedings; some is directed to non-use, but most is in the form of direct challenges to Mr Sheikh's evidence.

56. As explained earlier, the applicant requested summary judgment following the filing of Mr Sheikh's first witness statement in March 2011. This was because the applicant took the view that the evidence only showed use on goods (if at all) not services. There followed a lengthy period during the proceedings which was characterised by Mr Sheikh filing evidence to support use on services and the applicant filing submissions, complaints, and evidence to challenge his evidence, particularly in relation to the veracity of Mr Sheikh's evidence. The only time the applicant has referred to cross-examination has been in relation to a firm of accountants for Penney Corporation Limited. The accountants are not witnesses. There have been no requests to cross-examine Mr Sheikh or any of the other witnesses; the challenges have been written in nature, during the evidential rounds. Tribunal Practice Notice 5/2007 sets out the Registrar's practice in relation to challenging evidence:

**“Procedure for parties to challenge evidence filed in inter partes trade mark disputes**

1. The purpose of this Tribunal Practice Notice is to set out procedures for parties to challenge factual evidence filed by the other side in inter partes disputes. It is normally unacceptable for parties to invite a Hearing Officer to disbelieve the factual evidence of a witness without that witness having had the opportunity to respond to the challenge either by filing further written evidence or by answering the challenge that his or her evidence is untrue in cross-examination. The tactic of raising such challenges without notice at oral hearings has drawn the following comment from Richard Arnold Q.C. as the Appointed Person in *EXTREME Trade Mark* BL O/154/07).

“Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] BusLR 864 and *EINSTEIN Trade Mark* (O/068/07). Another recent example is *Scholl Ltd's Application* (O/199/06). I consider that hearing officers should

guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically).”

**Where prior notice or cross-examination is necessary before a witness can be disbelieved**

2. Invitations to disbelieve a witness’s evidence arise in the context of factual statements such as “the mark was used in this form by placing it in the window of shop A in relation to goods B at location C between the dates D and E.” However, statements of fact can take other forms. For example, in the context of an allegation of bad faith, what one witness says he told another is a statement of fact. If the evidence consists, as it should, of fact, then the party wishing to have it disbelieved must raise the issue in a way that permits the witness to answer the criticism that his or her evidence is untrue. This can be done by filing written submissions stating why the witness should not be believed in a time frame which gives the witness an opportunity to supplement his or her evidence (if he wishes) before the matter falls to be decided. 3. Normally, this will mean the opposing party making written observations within the period allowed for the filing of its evidence in response to the witness’s evidence explaining why the witness should not be believed. Alternatively, the opposing party can file factual evidence in reply of its own which shows why the evidence in question should not be believed. In the further alternative, the opposing party can ask to cross-examine the witness in question at a hearing.

4. However, requesting cross-examination may be disproportionate and unnecessarily costly and burdensome, since in trade mark proceedings the evidence stages are sequential, providing opportunities to deal with points during the proceedings (see the comments of Richard Arnold QC, as the Appointed Person, in *BRUTT Trade Marks* [2007] RPC 19). Indeed, cross-examination may not be permitted if the truth or otherwise of the challenged statement manifestly has no bearing on the outcome of the case. Written submissions, or evidence which contradicts the witness’s evidence, are therefore likely to be the most satisfactory ways to dispute the factual evidence of the other side in the majority of cases.

**Where prior notice or cross-examination is not a pre-requisite for an invitation to a Hearing Officer to treat a witness’s evidence as untrue**

5. Factual evidence which is obviously incredible can be challenged on the basis that it is untrue whether or not the witness has been cross examined or given prior notice of the challenge to the truth of his or her evidence.

**Costs Implications**

6. The cost incurred as a result of making written submissions, filing further evidence or cross examination of witnesses will be factored into any overall cost award made by the Hearing Officer at the conclusion of the proceedings. Each case will be assessed on its own facts.”

57. By challenging the registered proprietor’s evidence during the evidence rounds, Mr Sheikh had the opportunity to respond to the challenge, as per the practice notice. I am not therefore obliged to accept Mr Sheikh’s narrative evidence at face

value simply because he has not been cross examined on it<sup>4</sup>. Even where evidence has not been challenged, it is still necessary to assess its weight and to determine what it shows, as part of the body of evidence as a whole. If there are doubts as to reliability of evidence, this affects weight. Additionally, where hearsay evidence has been filed, as is the case with the letters, weight is an issue. Hearsay evidence is admissible under rule 64(1)(b) of the Trade Mark Rules 2008, but its weight has to be assessed according to the various factors set out in section 4 of the Civil Evidence Act 1995:

**“4.— Considerations relevant to weighing of hearsay evidence.**

(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following—

- (a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;
- (b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;
- (c) whether the evidence involves multiple hearsay;
- (d) whether any person involved had any motive to conceal or misrepresent matters;
- (e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;
- (f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight."

58. The filing of a hearsay statement inherently comes with the risk that the tribunal may assess its weight at a lower level than that which the party considers it should carry (depending on the factors set out in section 4 of the Civil Evidence Act 1995). The letters filed as an exhibit by Mr Sheikh are hearsay and are not contemporaneous. They have been solicited for the proceedings as a set of recollections. The writers of the letters are not witnesses because their recollections are not in the form of witness statements. Since the writers are not witnesses, the applicant cannot test their recollections (by cross-examination). The applicant would clearly have liked to test them because Mr Garnsworthy states that he has contacted

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<sup>4</sup> To the extent that it is mere assertion, I would not have been obliged to accept it anyway: see the comments of Mr Geoffrey Hobbs QC as The Appointed Person in *Williams and Williams v. Canaries Seaschool SLU (CLUB SAIL)* [2010] RPC 32 at paragraph 38.

the writers. In addition, there is doubt as to their veracity. Even without Mr Garnsworthy's contact with Mrs Tulsiani and his enquiry to the Arya Samaj Vedic Mission, it is not credible that the same letter from Mr and Mrs More can have two completely different signatures. This puts in doubt the probity of the evidence. I do not set any store by the letters.

59. I also have doubts regarding the insertion of the VAT rate of 20% in invoices several years prior to 2011, when the 20% VAT rate was introduced for the first ever time. To state that it was a data entry error from 17.5%, which needs very different keying actions, is a strange explanation. It would also be strange to explain the error by the wrong insertion of pre-set codes: why would there be a code for a 20% rate when that rate had never existed? Furthermore, the invoices where the rogue entries occur are the Penney Corporation Limited invoices from 2003 to 2008 (the company went into liquidation in December 2008). Mr Sheikh obtained an extension of time to file these invoices because he had to apply to a firm of accountants to get them, several years after the liquidators were appointed; it was difficult, according to the information he gave at the interlocutory hearing<sup>5</sup>, because the password had been lost. When the invoices were filed (presumably the software access problems having been resolved), the invoices which were filed were historical documents. An entry of 20% VAT would be a complete anachronism, in the sense that I have described above.

60. A significant amount of the parties' evidence has been directed at the Balu Bear evidence. The brochure referred to in the evidence summary is made up of stapled photocopied pages of poor quality, is undated and clearly is not a real brochure. In any case, whatever the probity of the Balu Bear evidence, designing promotional literature does not prove, without corroboration, that the mark was put to genuine use.

61. Another cause for concern is the content of the assignment documents. As described in paragraph 17 of this decision, the wording is very unusual, as though it has been tailored to meet the challenges made regarding use on goods rather than services. This a point raised by Mr Garnsworthy. The documents, although dated in 2001 and 2008, give details in the past tense about how the assignee wanted to use the mark and that the assignee "wanted Unique styled name to be put in the tub and to fill different generic based ice cream like Vanilla, Strawberry, Banana, Bubblegum and many other to provide service to their caterers' and parlours". This is not a credible way to word an assignment document which was supposedly dated at the start of the two companies' lives in 2001 and 2008. In any event, Mr Sheikh states that he never intended to transfer ownership of the mark. So, the assignment documents are not assignments. Section 46(1)(a) states that the mark must be used by the registered proprietor or with his consent. I consider that if use is shown on the facts of this case, the consent of Mr Sheikh to the use of the trade mark by Penney Corporation Limited and AMZ (UK) Ltd can be inferred from all the evidence which he has filed. Consent is not an issue in this case (the registered proprietor does not have to control the use<sup>6</sup>). However, probity of evidence is an issue. The assignment documents raise a further question as to probity.

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<sup>5</sup> Before another hearing officer.

<sup>6</sup> *EINSTEIN*, Geoffrey Hobbs Q.C. sitting as the appointed person, [2007] R.P.C. 23.

62. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

(2) 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].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) 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].

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

(b) 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].

(5) 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]; *Sunrider*, [70]-[71].

(4) 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]; *Sunrider*, [72]"

63. An assessment as to whether there has been use which amounts to real commercial exploitation of the mark on the market for the services means that there must have been exploitation that is aimed at maintaining or creating an outlet for the services or a share in that market. That assessment must include consideration as to the nature of Mr Sheikh's services and the characteristics of the market concerned. One of the applicant's grounds for attack is that if there is use it is on goods, i.e. ice cream, and not on the services for which the mark is registered. This is the main reason why the applicant requested summary judgment. However, the matter is not as straightforward as Mr Garnsworthy submits. The Act refers to a mark having been put to genuine use in relation to the goods or services for which it is registered. The words "in relation to" are important because whilst a trade mark may not actually have been affixed to goods or services, it may nevertheless have been genuinely used in relation to them. Where services are concerned, trade marks cannot be affixed to them because they are not tangible objects. An issue which arises from the evidence is whether the mark has been used in relation to goods or a service, or both. Depending on case-specific facts, use on a tub of ice cream could indicate use in relation to goods, use in relation to the service of retail of goods and/or use in relation to the service of providing the ice cream as food.

64. In *The Light*, BL O/472/11, Daniel Alexander QC, sitting as the appointed person, considered whether a shopping centre called The Light could sustain its claim to have made genuine use of the mark (The Light) in relation to the provision of food and drink when third parties, under their own prominent signage, such as Starbucks, Browns, Café Rouge and Nandos, were the providers of these services within the shopping centre. He said (footnotes omitted):

"18. In *Céline SARL v. Céline SA*, Case C-17/06 (*Céline*), the Court of Justice gave guidance as to the meaning of "use in relation to" goods for the purpose of the infringement provisions in Article 5(1) of the Directive. Considering a situation where the mark is not physically affixed to the goods, the court said at [23]:

"...even where the sign is not affixed, there is use "in relation to goods or services" within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party."

19. The General Court has, on more than one occasion, proceeded on the basis that a similar approach applies to the non-use provisions in Article 43 of

the Community Trade Mark Regulation. For example, in *Strategi Group*, Case T-92/091, the General Court said:

23. In that regard, the Court of Justice has stated, with regard to Article 5(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989, L 40, p. 1), that the purpose of a company, trade or shop name is not, of itself, to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being 'in relation to goods or services' (*Céline*, paragraph 21).

24 Conversely, there is use 'in relation to goods' where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets. In addition, even where the sign is not affixed, there is use 'in relation to goods or services' within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party (see *Céline*, paragraphs 22 and 23).

20. Those passages must be read together with the general requirements of proof of use in *Ansul* at [43] that there is genuine use of a trade mark where the mark is used in accordance with its essential function namely to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services.

21. The approach which requires the tribunal to consider whether there is a link, having regard to the essential function of a trade mark, is consistent with English authorities prior to *Céline*.

22. In *Premier Brands UK Ltd. v Typhoon Europe Ltd & Anor* [2000] EWHC 1557 (Ch) [2000] FSR 767, Neuberger J (as he then was) said:

In my judgment, when considering whether the mark has been used "in relation to" goods within the meaning of Section 46(1), it is right to go back to the nature and purpose of a trade mark, and in this connection the observations of the ECJ in *Canon* are of assistance, as indeed, is the guidance given by the Court of Appeal in *Bach Flower Remedies* in the passages which I quoted. Although Mr Arnold took issue with this, contending that what mattered was not how members of the public perceive the usage, but "whether the mark is in fact acting as an indication of quality control", it appears to me that the difference between the two approaches is more apparent than real. In a sense, the two ways of looking at the matter can be conflated: does the use of the TY.PHOO mark on the Goods convey to members of the public that the source of the well known TY.PHOO mark or tea is responsible for, and in some way guarantees, the quality of the Goods?

23. In *Euromarket Designs Incorporated v. Peters & Anor* [2000] EWHC 453 (Ch), [2001] FSR 20 Jacob J, as he then was, drew attention to the range of factors relevant to whether there was use in relation to given goods or services, including public perception of what the marks denoted. He said:

[57] In this connection it should be borne in mind that the Directive does not include an all-embracing definition of "use", still less of "use in relation to goods." There is a list of what may inter alia be specified as infringement (Art.5(3), corresponding to s.10(4)) and a different list of what may, inter alia, constitute use of a trade mark for the purpose of defeating a non-use attack (Art.10(2), equivalent to s.46(2)). It may well be that the concept of "use in relation to goods" is different for different purposes. Much may turn on the public conception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled "Boots", only a trade mark lawyer might say that that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign "in relation to" the goods. Perception matters too. That is yet another reason why, in this case, the fact that some goods were sent from the Crate & Barrel US shops to the UK in Crate & Barrel packaging is at least arguably not use of the mark in relation to the goods inside the packaging. And all the more so if, as I expect, the actual goods bear their own trade mark. The perception as to the effect of use in this sort of ambiguous case may well call for evidence.

24. Both these cases demonstrate that in considering whether use is in relation to given goods or services, the tribunal may take into account a number of factors, including whether the goods were in fact obtained from the proprietor, the presence or absence of other branding on the goods, how the goods were sold and so on. An approach which entitles the tribunal to make an overall assessment of this aspect of use is similar to that of *Ansul*, which requires regard to all the facts and circumstances in evaluating whether use was genuine.

25. The effect of these authorities, both at EU and at national level, is therefore that this aspect of the non-use provisions requires the tribunal to consider whether, having regard to all the facts and circumstances, the mark been used to identify to the average consumer the proprietor as the origin of, including, having responsibility for, the particular goods or services in question."

65. This is a very case-specific point. For example, there are a number of famous high street fast food chains where the provision of food and drink as a service is very closely linked to the goods served; and there is a close, integral relationship between a greengrocer's service of retailing loose fruit and vegetables and his goods. Mr Sheikh states, in his first witness statement:



“1. The trade mark Hokey Pokey in unique stylish manner was first used in the United Kingdom in the year 2000 by penney Corporation Ltd for our ice cream products and thereafter AMX (UK) Limited.”

2. The goods and services on which the mark has been used and the date of first use, are as follows:

Name of the Product: Ice Cream.

year of First Use: 2001.”

This is not conclusively use on either goods or a service, although the language leans more towards goods. There is, however, no other evidence, within the first set of evidence, which supports use on a service; the use is on goods. There is the Birmingham Evening Mail article showing the launch of Hokey Pokey ice cream in seven new flavours. The invoices, those that are before the date of application for revocation, are all for ice cream flavours. The photograph of women in saris carrying trays of ice cream tubs, which Mr Sheikh states was taken at a wedding, is undated and there are no details about the wedding. I agree with the applicant that the first set of evidence filed by Mr Sheikh is directed at use of the mark in relation to goods, i.e. ice cream and that it does not demonstrate any link with the registered service(s).

66. Following the summary judgment challenge, the basis of Mr Sheikh’s evidence altered significantly. His other three witness statements place much emphasis on demonstrating that the service of serving ice cream, and transportation and delivery, was totally separate to the sale of ice cream and would be seen as separate. For example, in Mr Sheikh’s witness statement of 15 November 2011, he states:

“6. I had realised that there was a gap in the United Kingdom market for a branded service supplying food and drink to end users in a way that went beyond merely delivering it, distinct from the product itself. This meant the brand had to identify with the service rather than just a product. I spent an immense amount of time researching and developing a concept based upon a brand which related to a service.

7. I believe the Trade Mark is not defined to a concrete product but relates to the provision of a service. It identifies and distinguishes the source of a service rather than a product.”

This means that a potential close, integral, relationship between goods and service, discussed above, cannot be relied upon because the opposite claim is being made by the registered proprietor. Use of the mark on ice cream will, therefore, not suffice because Mr Sheikh has stated that there is no integral relationship between the ice cream and the service of serving it.

67. The applicant has also disputed the scope of the services for which the mark is registered, which are “providing food and drink ice cream parlour”. Mr Garnsworthy submits that the inclusion of the term “ice cream parlour” has a restrictive effect upon the preceding words and that the meaning of the specification is “providing food and drink [in an] ice cream parlour”. The specification recorded on the electronic register

of trade marks, *providing food and drink ice cream parlour*, is ungrammatical. I have looked at the original application form<sup>7</sup> which Mr Sheikh filed on 24 February 2001 to see how the specification was entered on that form. It is handwritten, as follows:

Class number

42

Providing of food & drink  
ICE CREAM PARLOUR

It is important for legal certainty that trade marks are registered for goods and services which are identified clearly and precisely<sup>8</sup>. This specification is not clear or precise because there is (i) a lack of punctuation and (ii) the different letter casing implies some (unknown) significance. I must take the specification as I find it. The application form instructs that goods and services are to be listed. There are separate services listed, one above the other. I find that the specification is a list of services, the interpretation of which is not providing of food and drink [in an] ice cream parlour, but which is, instead, providing of *food and drink; ice cream parlour*.

68. In proceedings before the registrar, although criticisms can be made of individual items of evidence, the tribunal must stand back and take a collective view of the evidence. It is a matter of viewing the picture as a collective whole; the approach is not a forensic one of proof beyond reasonable doubt. In taking a collective view of the evidence in these proceedings, I bear in mind that there have many criticisms of individual statements, parts of statements and a detailed audit of the invoices. I will weigh all these as to relevance and effect on the collective picture. I also bear in mind that some parts of the evidence are not credible, as I have described already, and some parts have no weight, as also described.

69. An ice cream parlour is an establishment serving ice cream. There is no use shown of such a place. Mr Sheikh's later evidence is focussed towards the serving of ice cream at parties and events. Apart from the undated wedding photograph described above, the only other photographs are of people at a trade exhibition (Mr Sheikh's witness statement of 15 November 2011), also undated. Mr Sheikh states that these photographs show a service consisting of serving the product using waiters/waitresses. However, these photographs (which look as though they were all taken at the same occasion, owing to the backgrounds) were clearly at a trade show. A nearby stand has Braun signage and there are people milling around carrying carrier bags. A woman in the foreground of one of the photographs is trying a sample of ice cream on a spoon. She is not eating a tub of ice cream because she has a large carrier bag in the other hand. It is disingenuous of Mr Sheikh to describe this as the service of a product using waiters and waitresses. This is promotion of ice cream at a trade show, not providing food and drink.

<sup>7</sup> Statutory Form TM3.

<sup>8</sup> See the judgment of the CJEU in *Chartered Institute of Patent Attorneys v. Registrar of Trade Marks* C-307/10.

70. Mr Garnsworthy submits that there has been fabrication of the later evidence to show services, following his summary judgement challenge. Mr Sheikh has answered some of the challenges; for example he states that the product activity sheets always show the latest price charged and therefore do not match the invoice charges. He states that this is normal accounting practice using SAGE accounting software. The Garnsworthys dispute this. I do not know whether this is normal for SAGE or not and I do not have independent evidence from an accountant either way (the Garnsworthys, although retired accountants, are the parents of the brothers who make up Greyleg Investment Ltd and so cannot be said to be independent experts). Mrs Garnsworthy disputes the probity of the thank you card sent to Penney Corporation Ltd dated 24 August 2010, when Penney Corporation Ltd went into liquidation in December 2008. Mr Sheikh has not explained the anomaly. From my own analysis of the financial aspect of the evidence, I note that the AMZ (UK) Ltd product activity reports from 2009-2010, attached to Mr Sheikh's first witness statement, are all in respect of goods. The word 'goods' is used throughout. There are no instances of services being listed. However, in the AMZ (UK) Ltd invoices attached to Mr Sheikh's third witness statement, services are listed. These invoices are from the same period as covered by the product activity reports attached to the first witness statement. There is no explanation as to why services did not appear in the product activity reports filed in March 2011 but then appeared in the financial exhibits filed in November 2011.

71. Where services are listed in the invoices, it is not possible to say how much or how little of the service charge relates to the services which are registered. Mr Sheikh states in his third witness statement:

"33. The service offered would be tailored to the needs of PCL's (Penney Corporation Ltd's) individual clients.

34. For example, PCL clients may only want to purchase for the delivery of, (e.g. ice cream) to their guests in a stylish manner. Whereas other end users may want their product served by a group of waiters at a formal function. Accordingly, the end user was aware of the service provided by the Trade Mark."

Earlier in the witness statement, Mr Sheikh states that the services for which the trade mark is used can be summarised as:

"12.1 The transportation supply of items of food and drinks, including ice cream in a stylish manner (i.e. Packaging, which identifies with a particular business as the source of services not the product);

12.2 The transportation/delivery of items of food and drink;

12.3 Services consisting of serving the product using waiters/waitresses, who are dressed in a uniform bearing the Trade Mark;

12.4 Providing facilities for the storage of food and drinks (e.g. refrigerators and freezer cabinets);

## 12.5 The use of expertise and experience in delivering the service.”

72. So, some (or all) of the service charges (the probity of which is in dispute) may relate to services such as transportation and delivery, rather than the services which are registered. In his third witness statement, Mr Sheikh states that customers for the waiter/waitress service ranged from shops to restaurants to caterers. It is difficult to envisage how a shop would use such as service, and a restaurant usually employs its own waiting staff. Mr Khan has stated that he purchased the service annually about fifteen times between 2003 and 2008 and an unknown amount of times since then; but, as already described, there is a complete lack of reference to this service in the first set of evidence. Mr Patel states that he bought the service five or six times a year. Mrs Sheikh involvement was sporadic and Mr Shabir provided transportation, as well as being a waiter, about eight to twelve times a year, but without specifying on how many of those occasions he was a waiter. Ms Rasool also provided the service eight to twelve times a year, the same number as Mr Shabir, which could indicate the same occasion. On the evidence of these individuals, the scale of activity is not large. Although the genuine use provision is not there to assess economic success or large-scale commercial use, and 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, the use must have been 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. It must have been appropriate in the economic sector concerned. The provision of food and drink is a vast sector. The scale of use described by Messrs Khan, Patel and Shabir, Mrs Sheikh and Ms Rasool is minute in that sector.

73. If there was good corroborative evidence elsewhere, the very small scale attested to by these individuals might not, of itself, be detrimental to the proprietor's case. The problem for Mr Sheikh is that when I stand back to take a collective view of the evidence to see what the overall picture is, the numerous problems with his evidence which I have described throughout this decision cause the picture to blur. The pieces do not come together in such a way as to enable me to decide that there has been genuine use on any of the registered services.

74. There is one final issue; that of the mark itself. I will comment upon this briefly. The early evidence shows the additional word 'parlour' in the mark. The applicant challenged this and asked for summary judgement because the mark differed in elements which altered the distinctive character of the mark in the form in which it was registered (section 46(2) of the Act). A parlour is a place. There is no reference to a place in the registered mark:



Mr Sheikh's later evidence includes pictures of ice cream tubs without the word parlour, and sometimes with the words ice cream service. However, there is no dating of these tubs and the pictures have been filed after Mr Garnsworthy pointed out the relevance of section 46(1)(2). The presence of the word parlour is a conceptual alteration and is an element which alters the distinctive character of the mark in the form in which it was registered because it is a reference to a place rather than a type of good. In relation to the later representations on tubs, they too suffer from the deficiencies and anomalies in evidence, described above. There is no corroboration and no explanation as to the change from Mr Sheikh's first statement where he states:

"The Trade Mark 'Hokey Pokey Ice Cream Parlour' has been used in the whole of UK".

## **Outcome**

**75. The application for revocation on the grounds of non-use succeeds under both sections 46(1)(a) and 46(1)(b). Consequently the mark is revoked under section 46(6)(b), the effective date of revocation being 24 November 2006.**

## **Costs**

76. It is usual for the registrar to award costs from the scale published in Tribunal Practice Notice 4/2007. The scale envisages professional representation; i.e. representation from a legal professional such as a trade mark attorney or a solicitor. In the case of a party who has not been professionally represented during proceedings, an award made from the published scale might be larger than its actual expenditure. No agent details were recorded on the application form for revocation (Form TM26(N)) and none have been recorded by way of a Form TM33. Mr Garnsworthy states that he is the applicant's legal advisor, but gives his background as a retired accountant. Mrs Garnsworthy is a retired auditor and does not state what her commercial relationship is to the applicant. The applicant therefore appears to have been represented but has not recorded any representation. It falls somewhere between being represented and being a self-represented party. Mr Garnsworthy, in correspondence, has asked for off-scale costs because of the time and effort which he says both he and his wife have had to spend analysing Mr Sheikh's evidence. As I said at the start of this decision, their analysis has been forensic and in great detail. Not all of it has been relevant to this decision; e.g. the emphasis on spelling mistakes and a very lengthy, detailed challenge to Mr Badil's evidence/the Balu Bear evidence. However, it can be seen from this decision that

some of the applicant's challenges to Mr Sheikh's evidence were not without justification. I have found that some of his evidence is just not credible and elsewhere challenges have gone unanswered or unsatisfactory explanations given.

77. Both sides have had to put their evidence in order because of formatting errors and omissions. The applicant complains that it has been put to a great deal of trouble in examining the various versions of Mr Sheikh's evidence; however, some of the variations can be explained by Mr Sheikh's confusion as to what he was being asked to rectify, and the change of representation (from no representation, to Murria Solicitors, then back to no representation). The applicant has filed a substantial amount of correspondence and continued requests for summary judgment, even after it was refused. Weighing all this, I do not think costs above the scale are justified. On the contrary, a reduction is appropriate owing to the half-way house in relation to whether the applicant is represented or not. Applying a broad brush, I award costs to the applicant as follows:

Preparing a statement and considering the counterstatement	£100
Application fee	£200
Considering the registered proprietor's evidence; filing evidence and submissions	£1000
<b>Total:</b>	<b>£1300</b>

78. I order Phiroz Sheikh to pay Greyleg Investment Ltd the sum of £1300. This sum is 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 2nd day of October 2013**

**Judi Pike  
For the Registrar,  
the Comptroller-General**