

O-456-15

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2158980A
OF THE TRADE MARK**

The Shed

THE SHED

(A SERIES OF TWO MARKS)

IN THE NAME OF SIMON THACKRAY TRADING AS THE SHED

**AND THE APPLICATION FOR REVOCATION THERETO
UNDER NO. 500639**

BY THE SHED BAR LIMITED

Background, pleadings and surrender

1. On 3 October 2014, The Shed Bar Limited (“the applicant”) filed an application for the revocation, on the grounds of non-use, of trade mark registration number 2158980A owned by Simon Thackray, trading as The Shed. The registration is for a series of two marks, which I shall refer to in the singular:

The Shed
THE SHED

2. The registration procedure was completed on 12 March 1999. The applicant seeks revocation of the registration in full under sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (“the Act”). Under section 46(1)(a), it claims that no genuine use was made between 13 March 1999 and 12 March 2004, seeking an effective revocation date of 13 March 2004. Under section 46(1)(b), the applicant claims that no genuine use was made of the mark between 3 October 2009 and 2 October 2014, seeking an effective revocation date of 3 October 2014; and between 1 March 2008 and 28 February 2013, seeking an effective revocation date of 1 March 2013.

3. Mr Thackray filed an amended form TM8N and counterstatement on 7 January 2015. He states:

“9. The Registrant denies and disputes the Revocation under Section 46(1)(a) & (b), of the Form TM26 (N) in its entirety, save where the Registrant will decide not [sic] support the registration.

10. Each and every other allegation made by the Applicant for Revocation on the Form TM26(N), is expressly denied.

11. The Registrant contends, and will, show that his trade mark has been used on a wide variety of Goods and/or Services and should therefore remain on the Register, for a broad range of Goods and/or Services, and the request made by the Applicant in the Form TM26 (N) should be denied.

12. Prior to the Application for Revocation being filed by the newly appointed attorney for the Applicant for Revocation the Registrant made it clear to the Applicant, and moreover, the newly appointed attorney would have been aware that, upon a brief review of the UKIPO records, of two Licences namely:

Licence number RC000008431

Geographical Limitation: The venue, located at Upper Ground, London SE1 9PX. Classes 41 and 42 Entertainment services to include the staging of art, drama, theatre & music; information in relation thereto; and bar services.

Start date 01 March 2013 End date 30 April 2014

Licence holder Royal National Theatre Enterprises Limited of Upper Ground, London, SE1 9PX.

Licence number RC000008432

Geographical Limitation: Venue, located at Upper Ground, London, SE1 9PX.

Classes 41 and 43 Entertainment services to include the staging of art, drama, theatre and music; information in relation thereto; and bar services.

Start date 01 March 2013 End date 30 April 2014

Licence holder The Royal National Theatre of Upper Ground, London, SE1 9PX.

13. Evidence will also be brought forward covering 'non-licenced' use.

4. Mr Thackray filed a Form TM23 on 20 March 2015 to surrender partially the following goods from his registration:

Class 9: software for entertainment.

5. Section 45 of the Act provides:

“45.—(1) A registered trade mark may be surrendered by the proprietor in respect of some or all of the goods or services for which it is registered/

(2) Provision may be made by the rules—

(a) as to the manner and effect of a surrender, and

(b) for protecting the interests of other persons having a rights in the registered trade mark.”

6. Rule 33 of the Trade Marks Rules 2008 provides:

Surrender of registered trade mark; section 45 (Forms TM22 & TM23)

33.—(1) Subject to paragraph (2), the proprietor may surrender a registered trade mark, by sending notice to the registrar—

(a) on Form TM22 in respect of all the goods or services for which it is registered; or

(b) on Form TM23, in respect only of those goods or services specified by the proprietor in the notice.

(2) A notice under paragraph (1) shall be of no effect unless the proprietor in that notice—

(a) gives the name and address of any person having a registered interest in the mark; and

(b) certifies that any such person—

(i) has been sent not less than three months' notice of the proprietor's intention to surrender the mark, or

(ii) is not affected or if affected consents to the surrender.

(3) The registrar shall, upon the surrender taking effect, make the appropriate entry in the register and publish the date of surrender on the Office website."

7. The trade mark registration case history details on the Intellectual Property Office website state:

"26 March 2015

Event	Recordal Registration	Recordal Type: Partial Surrender
Text	Part of the G&S have been surrendered due to recordal RC000035386 received on date 2015/03/20."	

A letter from the Registry to Mr Thackray's professional representatives, Joshi & Welch Limited, also dated 26 March 2015, states:

"Dear Sir/Madam,

Confirmation of the Recordal of a Partial Surrender of a Registration

Trade Mark Number: 2158980A

Registered Owner: Simon Thackray trading as The Shed

I refer to form TM23 'Notice to partially surrender a registration'.

Your request to partially surrender the above trade mark has been recorded.

You can view the recordal on the IPO website at www.ipo.gov.uk/tmcase

Yours faithfully,

Darrel Hendy

Recordals Team
Trade Marks Registry"

8. Rule 33(3) does not stipulate that the publishing of the date of surrender on the website must be in the Trade Marks Journal; the rule simply provides that the date of surrender must be published on the website. The website entry shown above gives the date of 26 March 2015 as the recordal of the surrender (the 'event'), which is the same date as the letter was sent to the owner of the trade mark. The date on which surrender took place was therefore 26 March 2015. There has been no suggestion that the partial surrender in any way affects the revocation proceedings; nor has the

partial surrender had any effect¹ on the proceedings. The decision will therefore include an assessment as to whether there was genuine use for software for entertainment (class 9), which formed part of the list of registered goods and services when the application for revocation was filed and when the defence was filed, prior to surrender. The other goods and services for which the trade mark is registered are:

Class 25: Articles of sport and leisure clothing; coats, jackets, T-shirts, sweatshirts, sweaters, jumpers, cardigans, neck ties, footwear; headgear.

Class 32: Beer, ale, lager, stout, port, shandy, mineral water, aerated waters, non alcoholic drinks, fruit flavoured drinks, fruit juices, vegetable flavoured drinks, vegetable flavoured juices, cordials, mixtures containing any of the aforesaid goods; preparations for making the aforesaid.

Class 33: Wines, spirits, liqueurs, cocktails, alcoholic extracts, alcoholic essences, alcoholic carbonates, alco-pops, alcoholic beverages containing fruit, mixtures containing any of the aforesaid goods; preparations for making any of the aforesaid goods.

Class 41: Recreations; recreational information; entertainment; entertainment information; arranging and/or conducting entertainment and/or cultural activities of all sorts; music concert services; poetry performances; booking agent services for performing artists; publications of books, journals, magazines and other text (but not publicity text); video productions; film production; cabaret services; production of radio and/or television programmes; club entertainment services; organising of dancing displays; provision of dancing facilities; production and distribution of audio and/or video tape; laser show services; booking of seats for shows and concerts; entertainment club services; discotheque and nightclub services; presentation of live performances; entertainment party planning.

Class 43: Peripatetic and/or static restaurant, bar, café, brasserie, public house services, bar and catering services, hotel services; providing facilities for exhibitions.

10. Both parties are professionally represented; the applicant by Appleyard Lees, and Mr Thackray by Icen Intellectual Property (IP) Limited (previously called Joshi & Welch Limited). Both sides filed written submissions during the evidence rounds, but only Mr Thackray filed evidence. Both sides elected for a decision to be made from the papers (neither filed written submissions in lieu of a hearing). I make this decision after a careful reading of all the papers filed.

Mr Thackray's evidence

11. Mr Thackray has filed a witness statement and exhibits, and Duncan Welch, his trade mark attorney, has also filed two witness statements and exhibits.

¹ See the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Rapier Trade Mark*, BL O/170/07, paragraph 29.

12. Mr Thackray states that THE SHED is now part of a national and international touring network for both specialist and mainstream named performing artists. Appendix ST1 consists of a list of national and local press, magazine, radio, TV and independent films which carried material at various dates, from 1995 to 2011, which Mr Thackray states referred to THE SHED. There are samples of some of the material; more so for the years which fall under the section 46(1)(a) period than for the two section 46(1)(b) periods. A sizeable proportion of the material is so poorly reproduced that it is illegible. Samples within the relevant pleaded periods which I can read include:

- A flyer for a double bill advertised for 4 April 1999 “The Shed Kevin Coyne David Thomas & the two pale boys” at the Halifax Theatre. The same duo, located at The Shed, was billed to perform at the Royal Festival Hall four days later. The performance flyer is headed “The Shed in association with SBC”.
- An Arts Council update dated March 2000 refers to a grant being given to The Shed.
- An advertisement dated 9 June 2001 in the Yorkshire Advertiser headed THE SHED for a band, a Yorkshire Pudding boat race and celebrity bowls, with a phone number for tickets.
- An article in the Independent, dated 9 March 2002, about the 50 best jazz venues in Britain includes (at number 11) The Shed, Brawby. The article says that it is famed for its eccentric acts as well as mainstream poetry and jazz.
- An article in the Guardian, dated 12 November 2003, refers to The Shed as being a miniscule concert hall in Brawby where cramped audiences of up to 70 attend concerts regularly broadcast on national radio.
- An article dated 6 June 2003, showing a picture of Mr Thackray wearing a t-shirt which says The Shed. The article reports that The Shed is moving for two nights to a bigger venue to put on a show to a bigger audience, but that it is not a permanent move.
- The 2004 Official Tourist Map of Yorkshire has The Shed marked on the map at Brawby, with an icon similar to that of a theatre mask, commonly used to denote performing arts.
- An article dated 31 January 2004 in the Yorkshire Post magazine in which all but the headline is illegible. The headline says “From Labi Siffre singing live to a celebratory festival of knitting, it’s all happening at The Shed, a village hall venue in the middle of nowhere”. The same picture of Mr Thackray wearing a t-shirt which says The Shed appears in the article.
- A page from the October 2009 Belfast Festival brochure: “Mrs Boyes’ Bingo featuring Mark Sanders, is a bog standard game of prize bingo with simultaneous drumming and percussion disruption. Conceived and produced

by Simon Thackray, the event was premiered at The Shed in North Yorkshire in 1999.”

- An article in the 20 March 2010 edition of The Guardian about international local music venues: “The Shed North Yorkshire. I first played at this blink-and-you’ll-miss-it shed in the tiny village of Brawby back in 1998. It only held 64 people and we scraped our legs on the front row’s knees. It has since moved to Hovingham village hall, though it retains its name. The man behind The Shed, Simon Thackray, has presented events from the Fish and Chip Shop Van Tour with a trombonist, to mixed media knitting installations – saxophonist Lol Coxhill playing free jazz in a skip to coach trips for folks in knitted Elvis wigs touring sites of Elvisian interest in Ryedale. My own band, Hank Wangford and the Lost Cowboys, started a tradition of Christmas gigs at The Shed, where we play morose songs and have a riotously miserable time. The Shed was the inspiration for my village hall tour around Britain, which I am currently writing up as a book. And, after 235 villages, The Shed is still the loony best.”
- Several brochures, and front pages of brochures, for The Shed gigs, all of which are undated as to the year.
- Lists of The Shed gigs during 2010.
- A print from the internet archive (the Wayback Machine) from the National Theatre’s website, as at August 2013, which lists, amongst other food venues at the National Theatre, “The Shed Bar”, which is described as: “A lively atmosphere host to an eclectic crowd of theatregoers, artists and locals. Enjoy Meantime draught, Sipsmith spirits or our delicious homemade smoothies”.

13. Mr Thackray quotes from his website, but as the content appears to be dated 6 April 2015 (although Mr Thackray’s statement was signed on 16 March 2015), this does not help to show genuine use within the relevant periods, the latest of which ended on 2 October 2014. This is with one exception – a review from the Guardian which is quoted on the website: “For the past 20 years, The Shed, near the market town of Malton, has been responsible for some of the smallest and most inspired arts events in the country”.

14. Referring to his surrender of the class 9 goods, Mr Thackray states that he puts forward no evidence in relation to these goods.

15. Mr Thackray states that ‘The Shed’ has printed and sold THE SHED t-shirts since 1995 at gigs and online. ‘The Shed’ sponsored football shirts for Pickering under 13s football team in the 2003-2004 season. Mr Thackray states that the t-shirts have been “a powerful publicity vehicle” in newspaper articles and seen on TV programmes on mainstream channels. Appendix 3 contains two photographs (undated) of a t-shirt and a long-sleeved top which show the words The Shed on the front (together with a rough line drawing of a shed). There is an undated advertisement in an unspecified publication for The Shed t-shirts. This appendix

also shows proof of sale receipts for online purchase of The Shed t-shirts (£14.00) to customers in Devizes, Abingdon, Bradford and West Drayton, in December 2011, February 2012, July 2012 and December 2012. The invoices are for a total of five t-shirts.

16. Mr Thackray states that he has operated a bar at THE SHED for over 20 years. He holds a personal licence to sell alcohol. A copy of the licence is included in Appendix 4 (valid from 2005 to 2015). Also in this exhibit are documents relating to an event which The Shed held in a municipal park in Leeds on 24 September 2010. I note that the documents show that the event ran for 20 minutes from 9am to 9.20am, with The Shed vacating the site by 9.30. (The event was the Lol Coxhill performance from a skip referred to above).

17. Appendix 3 includes ten invoices to The Shed from local breweries and a wholesaler of beer. The invoices are all for quantities of drink which suggest rather more than personal consumption, although they are not on enough of a scale as to suggest regular trade from a busy bar. The goods are either unspecified or are clearly beer carrying a third party trade mark (Firkin). The invoices are dated from June 2009 to April 2013. A page giving general venue information says "The Shed door (and bar) opens 7:00pm". The base of the page says "We have a licensed bar serving *hand pulled* SHED BITTER!" The page is undated, but includes a copyright notice for 1992-2010. Mr Thackray states that, since 2008, SHED BITTER has been brewed for him by Cropton Brewery and the beer then sold under the mark SHED BITTER. Some of the Cropton Brewery invoices are for unspecified goods, rather than for Firkin-branded goods. The invoices for unspecified goods are dated in June 2009, March 2010 and February 2011. Mr Thackray states that in relation to THE SHED bar he has also sold other drinks, including wines, bottled beers and soft drinks. He states that THE SHED bar has made a small, but genuine and significant contribution towards the overall income of THE SHED. Mr Thackray states that he has "as would be customary within such an environment supplied casual food items".

18. Appendix 5 comprises copies of THE SHED trading accounts for the years ending 5 April 1999, 2000, 2001, 2002, 2003, 2009, 2010 and 2014. There are bar 'staging costs' figures of between £2000 and £4000 for each year. Apart from one year (2014), there is no mention of t-shirts as a source of income (or expenditure).

19. Mr Thackray states that to support the various cultural and entertainment events at THE SHED/put on by THE SHED, he has published journals, magazines, pamphlets, programmes and runs a box office, both for THE SHED and to third party venues. He states that THE SHED has been the subject of Arts Council reports and videos, and that THE SHED is periodically studied by students on university Film and TV courses, and on Arts Programming and Marketing Masters degree courses.

20. Mr Thackray exhibits pages from his website theshed.co.uk, which has been maintained since 1998. As these pages were printed to accompany his witness statement, they post-date the relevant periods and are largely unhelpful, especially as the print is so faint and small it is mostly illegible. I note, however, that the first page says: "News: The Shed's 23rd birthday 2015." Some of the content has been described elsewhere in this evidence summary.

21. Appendix 7 comprises typed lists of events which have taken place at The Shed. Some were cultural and some were private events. Not all have been dated in the list. Some say they included the provision of a temporary The Shed bar, Shed Bitter and food such as sandwiches, mince pies and cheese. In 2010, The Shed went on tour to other village and community halls across the north of England and to London. Other tour events have been described earlier in the evidence summary (such as the Mrs Boyes' Bingo, 2004; the North Yorkshire Elvis Bus Tour, 2003 and 2012; and Lol Coxhill in a skip, 2006). Between 2009 and 2001, The Shed was involved in the production of four films. Under 'National Awards', the following are listed, but not explained:

London– 2004: Arts and Business Awards, London
The Shed and Sirdar Spinning Limited (shortlisted)

Various cultural works have been commissioned by The Shed, including poetry, songs, monologues and knitting patterns (for Elvis wigs).

22. Mr Welch's first witness statement is aimed at demonstrating the policing of Mr Thackray's trade marks and communications with the present applicant. The burden is on Mr Thackray to prove genuine use on all the goods and services for which he maintains there has been use. The matters referred to by Mr Welch do not prove genuine use of the trade mark the subject of these proceedings and so I say no more about the contents of his first witness statement, except to note that it includes an exhibit which appears to be without prejudice, although not marked as such. I have taken no notice of it. There is one small section of Mr Welch's statement which refers to the National Theatre licences, but this issue is dealt with in Mr Welch's second statement, to which I now turn.

23. Appendix 1 to Mr Welch's second witness statement comprises a copy of a non-exclusive licence dated 28 June 2013, effective from 1 March 2013 until 30 April 2014. The agreement is between Mr Thackray, trading as The Shed, and The Royal National Theatre and The Royal National Theatre Enterprises Limited, for the use of the trade mark the subject of these proceedings as the name of the venue², in respect of entertainment services in classes 41 and 43, to include the staging of art, drama, theatre, music, information relating thereto, and bar services. The licence provides that the National Theatre may use the trade mark in various images, and that adaptation and alterations may be made.

24. Mr Welch states that the National Theatre adopted the name THE SHED, for a temporary venue at the South Bank, in London. The venue was a temporary replacement for the Cottesloe Theatre. Appendix 2 includes the National Theatre company report and financial statements for the financial year 2013 to 2014. The report refers to National Theatre productions in The Shed on 12 April 2013 ("Table"), on 21 May 2013 ("Bullet Catch"), on 5 June 2013 ("Mission Drift"), on 9 July 2013 ("The Grandfathers"), on 22 July 2013 ("The Hush"), on 24 July 2013 ("Romeo and Juliet"), on 25 July 2013 ("Sea Wall"), on 9 August 2013 ("Home", revived 26 March

² Specified in the agreement as a temporary venue outside the the National Theatre on the South Bank, in London.

2014), various plays between 9 and 21 September 2013, on 30 September 2013 (“The Word of Extreme Happiness”), on 5 November 2013 (“nut”), on 13 December 2013 (“The Elephantom”), on 19 December 2013 (“Protest Song”), on 22 January 2014 (“Blurred Lines”), on 12 March 2014 (“Riverrun”), and on 17 March 2014 (“Chewing Gum Dreams”). There were 75,000 paid attendances at The Shed, and it won four awards during the year it operated under this name. Due to a particular marketing strategy, The Shed attracted almost double the percentage of ticket-bookers under the age of 35, compared to the National Theatre’s Lyttleton and Olivier theatres in the same period. The BBC’s news website carried a report dated 9 May 2014, which said that The Shed name was dropped at the end of April after the expiry of a licence agreement: “The NT had been allowed to use the name by Simon Thackray, of The Shed in Ryedale – a small music and poetry venue on the edge of the North York moors.”

25. Mr Welch has highlighted a reference in the National Theatre document to a temporary cafe-bar, but this appears to have been called Propstore, not The Shed. There are two photographs provided in Appendix 5 which Mr Welch states were taken in The Shed bar at the South bank venue. One has a word which looks like ‘tshed’ in the background, which does not prove use of The Shed. The other shows bar staff behind hand pumps, serving beer, underneath the words Box Office. The staff in the photograph are wearing t-shirts and jackets bearing a logo which includes the word The Shed:



26. The same logo is identified in an appendix to the licence agreement and it also appears on a cocktail listing. The device represents the shape of the temporary building. A sheet shows that the 'Shed' bar takings on Friday 28 March 2014 were £941.12 and that 'Home' was showing in The Shed.

Decision

27. Section 46 of the Act states:

“(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.”

28. 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 Laboratories 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].

(6) 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]"

29. The onus is on the proprietor to show use when a challenge arises because 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."

Pursuant to section 46(3), if the evidence does not establish use during the first of the periods pleaded, that is to say the Section 46(1)(a) period, Mr Thackray will still have a defence if he can show commencement or resumption of use in the later, section 46(1)(b), periods³.

30. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

³ *Philosophy Inc v Ferretti Studio Srl* [2003] RPC 15, paragraph 7.

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within this description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that 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 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. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

32. I will go through the goods and services for which Mr Thackray has claimed use, class by class.

33. There has been no use shown on the goods in Class 9 which have an effective surrender date of 26 March 2015. The mark is therefore revoked in respect of *software for entertainment* from 13 March 2004, the earliest revocation date claimed, which follows the section 46(1)(a) period.

34. Mr Thackray claims to have used the mark on *articles of sport and leisure clothing; coats, jackets, T-shirts, sweatshirts, sweaters, jumpers, cardigans, neck ties, footwear; headgear*. It has not been claimed, and certainly it was not mentioned by Mr Welch in his evidence, that the photograph shown above is evidence of use of the mark on clothing. One photograph of staff wearing corporate uniforms is not evidence of exploitation that is aimed at maintaining or creating an outlet for goods in the clothing market.

35. In relation to the football shirts worn by Pickering under 13s football team in the 2003 to 2004 season, this is purely sponsorship and does not show use as a trade mark aimed at maintaining or creating an outlet for shirts; or that the trade mark guarantees the identity of the origin of the goods, which is the essential function of a trade mark. Mr Thackray’s statement that The Shed t-shirts are a powerful publicity vehicle goes nowhere near showing genuine use; if anything, it suggests that they are promotional items to encourage sales of performances (*Silberquelle*). The photographs of the short and long-sleeved t-shirts are undated, as is the advertisement in an unspecified publication. There is no way of telling how widely the advertisement was seen, or when it was seen.

36. The invoices for t-shirts represent the high point of the defence in relation to class 25 goods. They are dated within the two section 46(1)(b) periods. However, there is no evidence as to how many, apart from the five t-shirts specified in the four invoices, were sold. The accounts exhibited by Mr Thackray make no mention of t-shirts apart from the 2014 accounts in which t-shirts are listed under ‘staging costs’, rather than income; it is notable that other income is listed throughout the accounts, such as grants, advertising, ticket sales and fees, but not t-shirts. In Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, the General Court (“GC”)

observed that it may be possible to gain a sense of genuine use from the overall picture of the evidence, notwithstanding that individual pieces may not, of themselves, be compelling. Here, I do not find that a picture emerges of genuine use on any goods within class 25. Only five sales have been shown as being made, and the other evidence either adds nothing, is telling in its silence (the lack of mention in all but one of the accounts) or points in the direction of t-shirts being promotional items. Mr Thackray appears in photographs wearing the t-shirts, but wearing one's own goods for press article photographs about an arts venue is not use aimed at securing an outlet for the goods in a vast market.

37. Mr Thackray claims to have used the mark on *beer, ale, lager, stout, port, shandy, mineral water, aerated waters, non alcoholic drinks, fruit flavoured drinks, fruit juices, vegetable flavoured drinks, vegetable flavoured juices, cordials, mixtures containing any of the aforesaid goods; preparations for making the aforesaid* (all class 32) and on *wines, spirits, liqueurs, cocktails, alcoholic extracts, alcoholic essences, alcoholic carbonates, alco-pops, alcoholic beverages containing fruit, mixtures containing any of the aforesaid goods; preparations for making any of the aforesaid goods* (all class 33). The evidence does not show use of the mark on these goods. Mr Thackray states that he has sold a beer called The Shed, brewed by Cropton Brewery since 2008. There is no evidence to show this. The invoices from Cropton Brewery list unspecified items. In *Awareness Limited v Plymouth City Council*, Case BL O/230/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

38. It should not, therefore, have been difficult to have provided evidence over and above invoices which do not, without further corroborative exhibits showing the mark, show genuine use on beer. The other invoices are for third party branded beer, so do not show use of The Shed on beer (as goods, rather than the provision of beer which is a bar service).

39. Mr Thackray claims to have used the mark on *peripatetic and/or static restaurant, bar, café, brasserie, public house services, bar and catering services, hotel services; providing facilities for exhibitions* (all class 43). The exhibited personal licence to sell alcohol does not, of itself, prove that the mark has been used

on bar services. Neither does exhibiting proof of permission for an event held at 9am on a weekday morning which was over by 9.20am, with The Shed vacating the site ten minutes later.

40. However, I do not need to take a view as to whether Mr Thackray and the Yorkshire premises used the mark on bar services because the mark was licensed to the National Theatre, which did use the mark on bar services during the later relevant periods, from 1 March 2013 until 30 April 2014. This is clear from the evidence showing bar takings, the photograph shown above, and the print from the internet archive from the National Theatre's website in August 2013, which describes "The Shed Bar" as "A lively atmosphere host to an eclectic crowd of theatregoers, artists and locals. Enjoy Meantime draught, Sipsmith spirits or our delicious homemade smoothies". That the bar was part of the venue does not mean that the use in relation to the serving of drinks was not genuine use. In case BL O/472/11 *The Light Aparthotel LLP v. Aegon UK Property Fund Limited* ("THE LIGHT") it was claimed that use of third party branded cafes and restaurants within a shopping centre called THE LIGHT was use of that mark in relation to the provision of food and drink, cafes and restaurants. Mr Daniel Alexander QC, sitting as the Appointed Person, said:

"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*.”

41. Mr Alexander went on to observe that:

24 ...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.

42. The opposite situation occurred during the National Theatre period of use. Theatregoers at performances at The Shed, availing themselves of the services of the bar at The Shed, and served by members of staff wearing corporate clothing bearing The Shed trade mark, would see The Shed as denoting the provider of the bar services. There was no separate signage for the bar. During the period 1 March 2013 to 30 April 2014, there was The Shed signage for both the temporary performing arts venue and its bar, a single day’s taking amounting to some £900.

43. The applicant submits that the evidence of use from the National Theatre “was obtained solely for the purposes of defeating the revocation action; it was not genuine use”. I think, from other points raised by the applicant elsewhere in its submissions, that the applicant takes the view that Mr Thackray no longer uses The

Shed mark and is licensing it to others as a result of his attorneys' 'policing' of the market, and this is sham use, not genuine use. Licensed use is not sham use if the licensee uses the mark in accordance with the essential function of a trade mark. It is use with the consent of the proprietor, which qualifies as genuine use (all other things being equal).

44. There is no evidence of use on any services in class 43 other than on *bar services*.

45. The use of the mark is of the words over the device shown on the t-shirts in the photograph (paragraph 25 of this decision), provided for in the licence:



46. In Case C-252/12, *Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd, Specsavers Optical Superstores Ltd v Asda Stores Ltd*, the CJEU stated⁴:

“22. For a trade mark to possess distinctive character for the purposes of Regulation No 207/2009, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (see, to that effect, Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble v OHIM* [2004] ECR I-5141, paragraph 32; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-311/11 P *Smart Technologies v OHIM* [2012] ECR I-0000, paragraph 23).

23. That distinctive character of a registered trade mark may be the result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases, it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service at issue as originating from a given undertaking (see, by analogy, Case C-353/03 *Nestlé* [2005] ECR I-6135, paragraph 30).”

Apart from the slight 'roughness' to the letters, the registered mark itself is unaltered and would clearly signify to the relevant class of persons that it originates from the

⁴ See also the CJEU's ruling in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12.

same undertaking as for the registered mark(s). The mark used by the National Theatre qualifies as genuine use of the trade mark in relation to *bar services*.

47. This leaves the class 41 services for which Mr Thackray claims genuine use. The National Theatre licence was for the “staging of art, drama, theatre, music, information relating thereto” (and bar services). I find that the use of THE SHED under licence by the National Theatre qualifies as genuine use in relation to these services. The registered specification is shown here:

Recreations; recreational information; entertainment; entertainment information; arranging and/or conducting entertainment and/or cultural activities of all sorts; music concert services; poetry performances; booking agent services for performing artists; publications of books, journals, magazines and other text (but not publicity text); video productions; film production; cabaret services; production of radio and/or television programmes; club entertainment services; organising of dancing displays; provision of dancing facilities; production and distribution of audio and/or video tape; laser show services; booking of seats for shows and concerts; entertainment club services; discotheque and nightclub services; presentation of live performances; entertainment party planning.

48. There has been no use shown during any of the three pleaded periods of non-use for the following:

Publications of books, journals, magazines and other text (but not publicity text); video productions; film production; production of radio and/or television programmes; club entertainment services; organising of dancing displays; provision of dancing facilities; production and distribution of audio and/or video tape; laser show services; entertainment club services; discotheque and nightclub services; entertainment party planning.

Mere mention in a list of having been involved in the production of four films, without any explanation or corroborative evidence, does not prove genuine use in respect of video productions or film productions. Being mentioned or interviewed is not genuine use of the mark on production of radio and/or television programmes. Any literature that was produced appears to have been publicity material, which is excluded from protection. There is no evidence in relation to dancing or nightclubs, or any kind of club entertainment.

49. There is also no evidence of independent provision of *booking agency services for performing artists*, as opposed to Mr Thackray booking people to perform at The Shed, which is internal use. This service did not form part of the licence. Running a box office is not a booking agency service. In relation to *booking of seats for shows and concerts*, the use has all been for the proprietor’s venue, whether Mr Thackray’s venue or the National Theatre, not a service provided on behalf of other venues. It was also not in the terms of the licence.

50. The remainder of the services are in the nature of the entertainment and the performing arts:

Recreations; recreational information; entertainment; entertainment information; arranging and/or conducting entertainment and/or cultural activities of all sorts; music concert services; poetry performances; presentation of live performances; cabaret services.

Although the earlier use of The Shed shows the performances to have been eclectic, 'recreations' and 'entertainment' are extremely wide terms which allow for the identification within them of several subcategories capable of being viewed independently. In my view, the National Theatre licence terms ('staging of art, drama, theatre, music, information relating thereto') accord with the use of the mark during the year in which the mark was licensed. They also match the use shown in the 'Yorkshire period'. The use shown does not warrant retaining the broad terms recreations and entertainment (or the information relating thereto) as these cover categories such as festivals, TV, radio and films. A fair specification which reflects the use shown but which is not unduly restrictive is:

Arranging and/or conducting cultural activities of all sorts; music concert services; poetry performances; presentation of live performances; cabaret services; information relating thereto.

Outcome

51. The series of marks may remain registered for the following:

Class 41: Arranging and/or conducting cultural activities of all sorts; music concert services; poetry performances; presentation of live performances; cabaret services; information relating thereto.

Class 43: Bar services.

52. The registration is revoked for all other goods and services, including the surrendered class 9 goods *software for entertainment*, from 13 March 2004.

Costs

53. The applicant has been successful in revoking a great deal of the registered goods and services, which I would put at 90% success. Ordinarily, I would reduce the award to the applicant by 10% to reflect the portion of the specification for which the revocation application was unsuccessful. However, in this instance, I intend also to award the applicant the 10%. This is because of the voluminous, rambling and illegible nature of much of Mr Thackray's evidence; and because of the entirely irrelevant content of his trade mark attorney's first witness statement which included without prejudice material, unfairly filed. This witness statement and the without prejudice communication should not have been filed. The applicant was put to more trouble than it should have been considering the issues, and its costs were increased unnecessarily. These unnecessary costs included a counterstatement which requested a case management conference at which the applicant would request summary judgment. Both requests were refused. Further, owing to the content of

the counterstatement and the nature of the evidence, the award is at the top of the scale for these two items.

54. The award breakdown is as follows:

Filing the application and considering the counterstatement	£600
Considering the evidence	£2000
Filing written submissions	£400
Total	£3000

55. I order Simon Thackray, trading as The Shed, to pay The Shed Bar Limited the sum of £3000 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 1st day of October 2015

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