

O-155-16

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 2491444  
FOR THE TRADE MARK



**BorgRollsWerner**

IN THE NAME OF VELIYIL KOYAKUTTY NAZEER  
AND THE APPLICATION FOR REVOCATION THERETO  
UNDER NO 500245  
BY BORGWARNER INC.

## Background and pleadings

1) Veliyil Koyakutty Nazeer (“the proprietor”) is the registered proprietor of trade mark registration No. 2491444 in respect of the following mark:



**BorgRollsWernar**

2) The trade mark was filed on 30 June 2008 and completed its registration procedure on 28 November 2008. It was registered in respect of the following list of goods in Class 12:

*Vehicles, apparatus for locomotion by land, air or water*

3) Borgwarner Inc. (“the applicant”) seeks revocation of the trade mark registration on the grounds of non-use based upon Section 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”). The application for revocation was filed on 19 December 2013.

4) The proprietor filed a counterstatement and claimed that he “has made full use of the trade mark in the United Kingdom within the last 5 years sufficient to overcome the current proceedings under Section 46(1)(a) and (b)”. He refers to full use being made within the proprietor’s brochures, flyers and website and states “[w]hilst we cannot show any use of the mark on vehicles, it can be seen clearly that the proprietor has sold spare parts for such vehicles” and argues that the judgment of the Court of Justice of the European Union (“the CJEU”) in *Minimax*, C-40/01 supports such a finding.

5) Revocation has been sought under Section 46(1)(a) in respect of the 5 year time period following the date of completion of the registration procedure, namely 29 November 2008 to 28 November 2013. Revocation is therefore sought from 29 November 2013. Revocation is also sought under Section 46(1)(b) in respect of the time period 19 December 2008 and 18 December 2013. Revocation is therefore sought from 19 December 2013.

6) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary. The proprietor also filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. A hearing took place before me where the applicant was represented by Mr Edmund Harrison for Mewburn Ellis LLP. The proprietor did not attend, nor was he represented.

## The proprietor's evidence

7) This includes a witness statement by Ilyas Ibrahim Manjara, managing partner at Horwath Mak, trademark and patent attorneys based in Dubai. He states that, in June 2008, his firm instructed ip21 Limited to register the proprietor's mark in the UK and that following the filing of the applicant's action against the registration Mr Nazeer belatedly confirmed that he wished to defend the action and that he had used the mark. The delay was as a result of Mr Nazeer not receiving communications from Horwath Mak because he was out of the country.

8) The proprietor, Mr Nazeer, also filed two witness statements. In his first statement he states that he is director of Redington International Trading Fzc, a company operating in the United Arab Emirates. His first statement is an amended statement where, following a case management conference, he was offered the chance to amend the statement that his mark had been used in respect of both vehicles and parts and fittings therefore. The amended statement no longer makes a claim to use in respect of vehicles. This amended statement was received after the applicant had filed its evidence.

9) He states that his company has been using the mark since at least 3 December 2008 when it also registered the domain name www.brwengland.com. Exhibit VKN1 consists of a copy of the "Whols" data for this domain name that confirms the date of registration but does not contain the owner's name.

10) Mr Nazeer states that his company operates a business advertising its services on the website. At Exhibit VKN2 he provides a printout from the website from 19 June 2012 where a variant form of the registered mark is shown. The following statement appears:

"BorgRollsWarner (BRW) has established itself as a leading name in Europe, Middle East and Africa with rich experience in the Manufacturing and Distribution of spare parts for commercial vehicle industry ... [and] ... is well equipped to supply the most demanding parts for a wide range of commercial vehicles..."

11) Mr Nazeer also states that his company also incorporated the company Borgrollswarner (UK) Limited in the UK on 16 February 2013 and that his company sells parts and fittings in the UK through this company.

12) He states that his company advertises its products via its catalogues, excerpts of which are provided at Exhibit VKN4 and which Mr Nazeer states, relate to the last 5 years. The same variant mark as referred to in paragraph 10, above appears and the extracts show "bearings" and refers to "Truck-Trailer Spare Parts" for Mercedes, Volvo, Man, Scania (and others) alongside a representation of a heavy goods lorry. Exhibit VKN5 consists of a copy of an undated flyer relating to the same goods as shown in the catalogue extracts and carries a further variation of the mark. Both documents contain the business' address in Sunderland.

13) Mr Nazeer states that his company is well known in the UK as a leading supplier of parts and fittings for vehicles and has customers across the UK and lists 38

towns/cities where customers are located. This list includes locations in Cornwall, the South East, Midlands and north of England as well as South Wales.

14) Mr Nazeer's second witness statement is signed on his behalf by ip21 Limited and it includes a statement that Mr Nazeer has authorised ip21 Limited to do so, but provides no explanation as to why he was unable to sign the statement himself.

15) Exhibited with the statement are the following five photographs provided as Exhibits VKN1 to VKN5:

- Boxes on warehouse shelves. On two boxes in the foreground the letters "BOR RNER" are visible, but the middle section is obscured behind a support post for the shelving. There is also an indication on the cover of these boxes that they contain spare parts. Mr Nazeer confirms that the boxes contain spare parts for public service vehicles;
- A similar photograph to that above. Again the mark appearing on some of the boxes is partially obscured, but what is visible is consistent with the mark mentioned in paragraph 13 above;
- The final three photographs also show boxes stacked up on warehouse shelves. Despite the mark not being discernable, Mr Nazeer states that each box is clearly marked with the letters and word "BRW ENGLAND".

16) Exhibit VKN6 consists of three photographs of what Mr Nazeer states show enlarged views of the boxes shown in the final three photographs referred to above. Typical of what is shown is reproduced below:



## **The applicant's evidence**

17) This consists of a witness statement by Taurean Weber-Laurencio, Vice President of Bishop Group Investigations of New York since mid-2014. Prior to this, Mr Weber-Laurencio was employed by, and then subsequently provided contracted investigations to, Farncombe International Ltd based in West Sussex. Both companies are members of the same group of companies. Farncombe International Ltd specialises in investigations relating to intellectual property, including trade marks. He was instructed by the applicant's representative, Mewburn Ellis LLP to investigate the extent of use of the proprietor's mark.

18) The report produced by Mr Weber-Laurencio is provided at Exhibit TWL1. He was unable to find any use in the UK and only in respect of variant marks being used on spare parts outside the UK. He was unable to find any use at all in respect of the goods for which the contested mark is registered, namely vehicles.

19) Mr Weber-Laurencio found that, as a result of talking to a receptionist contacted on the UK telephone number provided for the proprietor's UK office, the proprietor's presence in the UK consisted of an answering service. He also states that records from Companies House show that the proprietor's UK company is dormant.

## **The proprietor's evidence-in-reply**

20) This consists of a further witness statement by Mr Nazeer. He repeats his comments regarding Exhibits VKN1 to VKN6 to his previous statement and re-files the exhibits. Mr Nazeer disputes Mr Weber-Laurencio's finding that his UK company is dormant and at Exhibit VKN7 he provides a one page extract from the website [www.enterpriseslist.co.uk](http://www.enterpriseslist.co.uk) that records that the company's "...current trading status is active" and that accounts were filed on 28 February 2013.

## **Further evidence from the applicant**

21) This consists of a witness statement by Edmund Stephen Harrison, trade mark attorney with Mewburn Ellis LLP, the applicant's representative in these proceedings.

22) To counter Mr Nazeer's evidence that his company is active, Mr Harrison provides his UK company's annual accounts dated 28 February 2014 and 28 February 2013 (Exhibits ESH1 and ESH2, respectively). Both exhibits contain an entry from the directors of the company indicating that it has been dormant for the whole of each period.

23) At Exhibits ESH3 to ESH5, Mr Harrison provides copies of the company's annual returns to Companies House dated 16 February for each of the years 2013, 2014 and 2015. These confirm Mr Nazeer as director and that the capital held is £2. On the front of each return the "SIC code" is recorded as "99999". Mr Harrison states that "SIC" stands for Standard Industrial Classification" used by Companies House to classify activities of business establishments and that the code "99999" refers to a dormant company (Exhibit ESH7 refers).

24) Mr Harrison notes that at Mr Nazeer’s Exhibit VKN7 only page 1 of 2 is exhibited. At Exhibit ESH6, Mr Harrison provides both pages and at the bottom of the first page (missing from Mr Nazeer’s copy) is the following entry:

“SIC/NACE:  
√ 99999 – Dormant Company”

### Legislation

25) Section 46(1) of the Act states that:

“The registration of a trade mark may be revoked on any of the following grounds-

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

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

(c).....  
.....

(d).....

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

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

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

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

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

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

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

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

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

26) Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

## Decision

27) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. recently summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice:

*Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

28) The relevant dates are identified in paragraph 5 above. Use in the later period will be sufficient to save the registration by virtue of the provision at Section 46(3) of the Act. The proprietor must show genuine use of its mark for the following five year periods:

29 November 2008 to 28 November 2013

and

19 December 2008 to 18 December 2013

29) In his counterstatement, Mr Nazeer submitted that as he has sold spare parts for vehicles he is entitled to retain “vehicles” *per se* in the specification. He relied upon the CJEU’s guidance in *Minimax*, C-40/01. The relevant passage reads:



“43. [...] The fact that a mark is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”

30) The circumstances discussed in *Minimax* are different to the current case. It was considering circumstances where a trader had previously sold fire extinguishers but more latterly had only sold component parts of those fire extinguishers. The court was considering whether the sale of the component parts was sufficient to qualify as genuine use in respect of the previously sold goods. In the current case, there is no evidence, or even a claim to have previously traded in vehicles *per se*. As the CJEU noted at paragraph 43, use must be such as to “... maintain or create a share in the market for the goods or services protected by the mark ...” In the current case there is no evidence that the proprietor is maintaining a market in respect of vehicles or is trying to create a market for such goods nor has it ever created or maintained such a market. The evidence only illustrates that the proprietor has a business in spare parts for commercial vehicles. Therefore, I dismiss the argument alluded to by the proprietor in his counterstatement.

31) This effectively concludes proceedings. However, if I am wrong and Mr Nazeer is entitled to rely on use in respect of spare parts in order to maintain his registration, I will consider the evidence in respect of those goods.

32) Even when considering the evidence in respect of spare parts for vehicles, there is no use shown in the UK, either during the relevant periods or at any other time. The evidence provided by the applicant has demonstrated that the proprietor's company in the UK is dormant (Exhibit ESH6). Further, whether intentional or otherwise, Mr Nazeer's Exhibit VKN7 provides only the first page of an Internet extract purported to show that his company is active in the UK. As Mr Harrison illustrated in his Exhibit ESH6, if the whole extract had been provided it would have clearly shown that the company is actually dormant.

33) In the written submissions provided on behalf of Mr Nazeer it is claimed that the applicant's evidence has not established any connection between Mr Nazeer and the company and, therefore, the applicant has failed to prove that Mr Nazeer has not been using the mark in the UK. I find this argument somewhat disingenuous because it is Mr Nazeer himself who relies on the existence of the company to support his claim to genuine use (as seen by his comments in paragraphs 7 and 8 of his reply evidence and his Exhibit VKN7). Further, I remind Mr Nazeer that the onus is upon him to demonstrate genuine use in the UK, not for the other side to disprove it. In this respect, he has provided no evidence of turnover in the UK, nor any invoices to support his claim. Neither has he identified any customers in the UK. Whilst he provides a list of 38 locations in the UK where he has apparently sold his goods, he has not supported this statement with any corroborative evidence. At the hearing, Mr Harrison submitted that the unusually uniform distribution of these locations suggested that Mr Nazeer had merely chosen the locations from looking at a map of the UK. I make no finding on this submission. Such a challenge was only made at

the hearing and Mr Nazeer had not had the opportunity to respond to such a claim and neither had the applicant requested cross-examination on this issue. Nevertheless, in the absence of any corroborative evidence, I am unable to find that providing a list of 38 locations around the UK is sufficient evidence for me to conclude that there has been genuine use.

34) The high point of Mr Nazeer's case is that he exhibits a catalogue and a flyer that both include a business address in Sunderland (Exhibits VKN4 and VKN5 to his first witness statement). These are both undated. In his report provided at his Exhibit TWL1, Mr Weber-Laurencio states that the contact number on these documents was for another company. When calling the contact number, the person stated that he had reached a company called "WBE". It was explained to Mr Weber-Laurencio that if any orders are received for Mr Nazeer's company they are passed on. This is insufficient evidence that Mr Nazeer is trading in the UK, particularly bearing in mind that his UK company is also recorded as being dormant and with no turnover.

35) Whilst Mr Nazeer's evidence does illustrate that he undertakes some trade under the mark or similar marks, the evidence falls well short of demonstrating that any of that trade is in the UK. In fact, the evidence points towards the fact that he is not trading in the UK and certainly that he is not made any real and commercial exploitation of the mark for any of the goods listed in his registration. There is no evidence that he has or is maintaining or creating an outlet for the goods in the UK.

36) The proprietors offer to limit his specification to spare parts for vehicles does not assist. This is for two reasons. Firstly, the specification in only respect of *vehicles, apparatus for locomotion by land, air or water* and, therefore, does not include spare parts. It is not permissible to broaden the scope of a registration. Secondly, even if it was permissible to broaden the scope of a registration, I have found that there has been no genuine use in respect of the goods listed OR the goods to which Mr Nazeer has offered to limit. I dismiss Mr Nazeer's offer to amend the specification.

## **Conclusion**

37) Taking all of the above into account, I conclude that there has been no use of the contested mark during either of the relevant periods within the meaning of Section 46(1)(a) and 46(1)(b) of the Act. The application for revocation is successful in its entirety from the earliest date sought, namely 29 November 2013.

## **COSTS**

38) The applicant for revocation has been successful and is entitled to a contribution towards its costs. At the hearing, Mr Harrison requested costs on the normal scale in respect of the proceeding to the point that the proprietor filed his evidence. After that time and until the proprietor focused its case by relying on claimed use in respect of spare parts (rather than vehicles) he requests off-scale costs. Additionally, Mr Harrison cited problems and delays resulting from missed deadlines and evidence being filed in the wrong format. I accept that the proceedings were delayed by Mr Nazeem missing deadlines and because of, what I have found, a mistaken reliance upon the principle set out in *Minimax*. However, I do not see anything unreasonable in the proprietor's actions. Whilst the proceedings may have been accelerated if the

deadlines were not missed, I do not believe it is justified to go off the scale. I find that additional costs of £200 are appropriate in respect of the case management conference regarding evidential issues and to resolve tension between what was stated in the counterstatement and what was stated by the proprietor in his evidence. I also enhance the award to the applicant by £200 in respect of the part of its evidence addressing the lack of use in respect of vehicles. With these comments in mind, I award the applicant for revocation the sum of £2400 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing and filing a statement & considering other side's statement (including official fee)	£500
Filing evidence & considering other side's evidence	£1000
Case management conference	£200
Preparation for, and attending hearing	£700
<b>TOTAL</b>	<b>£2400</b>

39) I therefore order Veliyil Koyakutty Nazeer to pay Borgwarner Inc. the sum of £2400. The above sum should be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24th day of March 2016**

**Mark Bryant  
For the Registrar,  
The Comptroller-General**