

O-181-17


TRADE MARKS ACT 1994

**IN THE MATTER OF CONSOLIDATED APPLICATIONS
NOS 501188 AND 501190
BY ICE IP S.A.**

**FOR REVOCATION OF TRADE MARKS NOS 2447943 AND 2447390
STANDING IN THE NAME OF ISMAYIL MEHMET**

Background

1. The following marks are owned by Ismayil Mehmet:

- i) Registration no. 2447943 for the mark  **ROCKS** which was filed on 28 February 2007 and completed its registration procedure on 20 November 2009. The mark was registered in respect of the following goods and services:

Class 3: Perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants.

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computer hardware and firmware; computer software (including software downloadable from the Internet); compact discs; digital music (downloadable from the Internet); telecommunications apparatus; computer games equipment adapted for use with TV receivers; mouse mats; mobile phone accessories; contact lenses, spectacles and sunglasses; clothing for protection against accident, irradiation or fire.

Class 14: Jewellery, precious stones; horological and chronometric instruments; clocks and watches; costume jewellery.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes;

artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; disposable nappies of paper for babies; printed publications.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; handbags, rucksacks, purses; clothing for animals.

Class 25: Clothing, footwear, headgear.

Class 35: Advertising; business management; business administration; office functions. Also in this class are the organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; retail services connected with jewellery, precious stones, horological and chronometric instruments, clocks and watches, costume jewellery.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; compilation, creation and maintenance of a register of domain names.

Class 43: Catering services for providing food and drink; restaurant services, café services, hotel services; temporary accommodation.

The registration was partially surrendered by Mr Mehmet on 4 July 2016. I shall return to this shortly.

- ii) Registration no. 2447390 for the mark ICErocks which was filed on 21 February 2007 and completed its registration procedure on 20 November 2009. The mark was registered in respect of the following goods and services:

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computer hardware and firmware; computer software (including software downloadable from the internet); compact discs; digital music (downloadable from the Internet); telecommunications apparatus; computer games equipment adapted for use with TV receivers; mouse mats; mobile phone accessories; contact lenses, spectacles and sunglasses; clothing for protection against accident, irradiation or fire.

Class 14: Precious metals and their alloys; jewellery, precious stones; horological and chronometric instruments; clocks and watches; costume jewellery.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; handbags, rucksacks, purses; clothing for animals.

Class 25: Clothing, footwear, headgear.

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

The registration was partially surrendered by Mr Mehmet on 4 July 2016. I shall return to this shortly.

2. Mr Mehmet has been the registered proprietor of the marks (the proprietor) since 24 February 2016. Prior to this date the marks were registered in the name of Ice Rocks Ltd.

3. On 26 April 2016 ICE IP S.A. (the applicant) filed applications for revocation of the registrations shown above. Revocation is sought in each case under the provisions of sections 46(1)(a) and (b) of the Trade Marks Act (the Act) on the grounds that the marks have not been put to genuine use and there are no proper reasons for non-use. Under section 46(1)(a), the applicant alleges, for both registrations, non-use in the period 21 November 2009 to 20 November 2014 (the first period) seeking revocation with effect from 21 November 2014. Under section 46(1)(b) the applicant alleges, for both registrations, non-use in the period 26 April 2011 to 25 April 2016 (the second period) and requests revocation with effect from 26 April 2016.

4. Mr Mehmet filed identically worded counterstatements in both proceedings on 4 July 2016 (subsequently amended on 12 August 2017), in which he admits that no use of the two registrations have been made other than for the goods which had not been surrendered. These are as follows:

i) Registration no. 2447943

Class 14: Jewellery, precious stones, costume jewellery.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; photographs; artists' materials.

ii) Registration no. 2447390

Class 14: Precious metals and their alloys; jewellery, precious stones; costume jewellery.

5. He states:

“The Defendant has made use of the trade mark in the 5 year periods in which the Claimant alleges that it has not been used in relation to the goods set out [in paragraph i) and ii)] above. Accordingly it is denied that the trade [marks] should be revoked for those goods whether as alleged by the Claimant or at all.

The Defendant admits that no use of the trade mark has been made for the goods claimed in the trade mark as registered other than those set out [in paragraph i) and ii) above]. The Defendant received no notice of the Claimant’s complaint prior to receiving these proceedings from the UKIPO and on receipt of these proceedings has taken steps to surrender the goods for which no use has been made. Had the Claimant approached the Defendant prior to starting proceedings this would have been done voluntarily.”

6. As noted above, both registrations have been recorded as partially surrendered; the surviving goods (in relation to which use is claimed) are shown at paragraphs i) and ii). In respect of the goods that have been surrendered, they are accepted by Mr Mehmet as not having been used as no defence was made in respect of them. However, as the dates of revocation sought pre-date the date of partial surrender¹, the revocation proceedings remain to be determined. The decision will therefore include an assessment as to whether there was genuine use for the goods and services which have been surrendered and which formed part of the registered specifications when the application for revocation was filed (prior to surrender).

7. For the sake of completeness I should just say that both registrations have now expired (the renewal dates were 28 February 2017 (2447943) and 21 February 2017

¹ The applicant was notified of the surrender but has indicated that it does not wish to withdraw its actions

(2447390) respectively). However, the marks were registered at the time of the applications for revocation and are currently within the period allowed for renewal and restoration under section 43 of the Act; as the registrations could continue beyond the expiration date(s), again, the revocation proceedings remain to be determined.

8. The applications were consolidated. Mr Mehmet filed evidence. The applicant filed submissions accompanied by an annex which, again, I will refer to as appropriate. Mr Mehmet also filed written submissions (in the form of a letter) in lieu of attendance at a hearing, which will not be summarised but will be referred to as and where appropriate during this decision.

The evidence

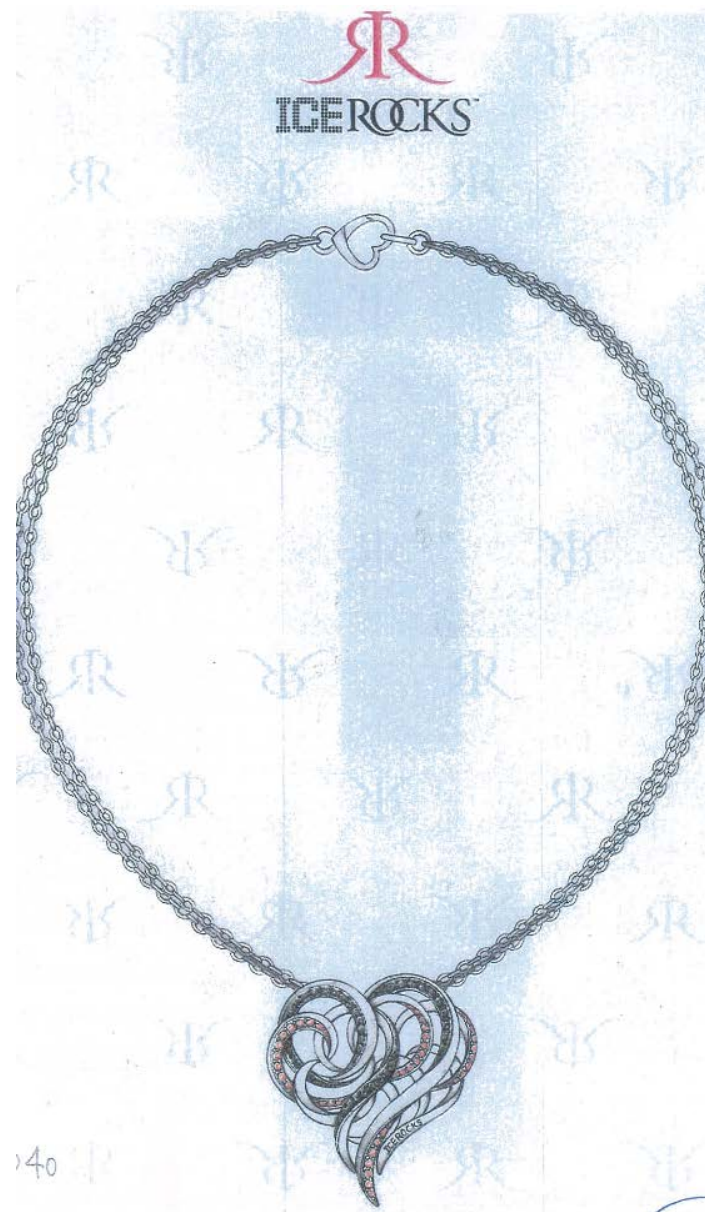
9. Mr Mehmet filed evidence in the form of a witness statement made by himself dated 14 October 2016 and a "To whom it may concern" letter from Mr Peter Stringfellow dated 6 October 2016. This evidence is aimed to establish that use of the marks had taken place during the relevant periods.



Mr Mehmet's witness statement

10. Mr Mehmet states that in the period from 21 November 2009 (and even prior to this date) until about 25 April 2016 (and to the date of the witness statement) he "has sold a range of hand-made, bespoke pieces of jewellery under the brand ICEROCKS" and that from 2012 onwards he has created "fine art installations under the name ICEROCKS" using diamonds and precious and semi-precious metals.

11. Mr Mehmet explains how he came to develop his brand, to which he refers as ICEROCKS. He says that his family owns two jewellery shops in North London which trade under the name G Mantella and that he has been working with precious and semi-precious stones since 1982 when, at the age of 15, he became involved in his family's business. Having worked for almost 30 years in the industry and having designed and created many pieces of jewellery, Mr Mehmet saw the potential for using precious stones and metal in fine art to suit a niche market. In 2007 he came

up with the brand ICEROCKS, applied to register the marks at issue and incorporated a limited company called Icerocks Limited. Mr Mehmet says that, being an entrepreneur, he considered potential expansion in areas other than “fine art and jewellery” and registered the marks in a number of classes. He also says that given his experience he “felt comfortable designing and making a jewellery collection which is why, rather than going straight into creating art [he] started by making a collection” and refers to exhibit IM-1 in support. This consists of sheets depicting designs for cufflinks, rings, bracelets, necklaces, earrings, money clips, tie pins, membership cards and cocktail sticks. Only some of the drawings feature the word ICEROCKS. This is presented in capital letters engraved on metal tags and/or charms attached to bracelets/necklaces or on their clasps. An example is reproduced below:



12. The mark  is used on each sheet in conjunction with the symbol ; the latter is also used as a distinctive ornamental feature on various pieces of jewellery and/or as a logo/mark (either on its own or in conjunction with the word ICEROCKS). Only four designs bear no mark.

13. Mr Mehmet says that he created these drawings in 2007 (before the relevant periods), as confirmed by a copyright notice which appears at the bottom of each page. Although he says that he produced the drawings for a number of pieces of jewellery which were then made either by himself or by others for him, he does not give any further information about what was actually made and when it was sold. The drawings have also been used from 2007 to the date of the witness statement to promote Mr Mehmet's work with potential customers; however there is no indication of the number of customers to whom the drawings were shown.

14. Mr Mehmet states that he had "some success with the ICEROCKS jewellery range". He explains that his target market was very niche, i.e. celebrities, and that each piece was unique and "of high value" though no details are given of the range of prices at which the jewellery was sold. Mr Mehmet says that his clients include singers, rappers, artists, actors, footballers and celebrities though, again, no details are provided of whom those clients are because, it is said, they wish to remain anonymous. The only customer named is Mr Peter Stringfellow who, is said, bought a number of pieces of ICEROCKS jewellery during the relevant periods, though no further information is provided about what was bought and when.

15. In order to keep the brand exclusive, Mr Mehmet did not advertise in the traditional sense but promoted his business by word of mouth marketing including attending networking and VIP events such as "film premiers and after-parties in the West End". Again, no details are given of when or where such events may have taken place or who may have attended. Exhibit IM-6 consists of undated photocopies of what are said to be examples of Mr Mehmet's business cards (all identical). The cards feature prominently the mark 2447943 in a reversed out version (against a black background) and bear the website address "www.icerocks.co.uk" and the email address "email@icerocks.co.uk" but give no information about the nature of the

business. There are no dates on any of the cards showing when they were in use nor are any details given of how many cards were distributed.

16. Exhibit IM-2 are undated photocopies of photographs illustrating the presentation boxes which, it is said, accompany all the ICEROCKS jewellery sold. The mark 2447943 is present on the interior of the box and on what is said to be a leather case. Exhibit IM-3 consists of undated photocopies of examples of ICEROCKS jewellery as it was sold in the branded boxes. An example is reproduced below:



17. None of the pieces of jewellery depicted in the photographs resemble any of the designs shown in Exhibit IM-1 nor do they show any ICEROCKS marks and/or

 logo.

18. Mr Mehmet gives the following details of annual turnover for what, he calls, ICEROCKS jewellery:

Year	Turnover £
2011	52,767
2012	12,086
2013	30,557
2014	20,801
2015	13,579
2016	3,000 (approx.)
March 2016 to 14 October 2016	6,000 (approx.)

19. The figures are not broken down in any way and no details are given of what has been sold.

20. Mr Mehmet says that ICEROCKS jewellery is sold through his family company because “that was an established company for tax and VAT purposes” though the ICEROCKS products are “always kept separate from G Mantella business”. Consequently, he explains, unless buyers specifically ask for an invoice showing sales of ICEROCKS jewellery, they “simply get an unbranded G Mantella till receipt”. Exhibit IM-5 provides three samples of invoices which, he states, “are very much the tip of the iceberg”. These are as follows:

- Invoice of 17 May 2011 n. 15077 addressed to “Stringfellow” (no other purchaser’s details are indicated) for “ICEROCKS 1 x 9 CT YELLOW GOLD HALLMARKED HANDMADE VIP MEMBERSHIP CARD ENGRAVED BOTH SIDES FINISHED WEIGHT 50 81 GR WITH ICEROCKS OF LONDON (illegible)” with the price charged totalling £5,626 (after VAT);
- Invoice of 8 December 2011 n. 14922 addressed to “Peter Stringfellow” (this can just about be made out) for “ICEROCKS HANDMADE 3X 9CT YELLOW GOLD (illegible) PENDANT WITH 0.12 CT DIAMOND IN EACH AND 18 DIAMOND CUT (illegible) CHAIN @ £850 EACH” with the price charged totalling £3,060 (after VAT);
- Invoice of 3 October 2013 n. 14978 for “ICEROCKS HALLMARKED HANDMADE (illegible) WITH 0.12 CT DIAMOND (illegible) CHAIN” with a price charged totalling £1,020 (after VAT). No purchaser details are indicated.

21. All the invoices exhibited are headed as being issued by Mantella Jewellers 290a Green Lanes London and details have been entered in handwriting. I note the numbers on the invoices are slightly at odds with the dates as one would expect the sequential numbers on the invoices to progress in chronological order (in line with the dates), not to go backward.

22. Mr Mehmet supports his claims with a copy of a letter dated 6 October 2016 from Mr Peter Stringfellow. The letter is written on Stringfellow's headed paper and is addressed "to whom it may concerns" although it contains a statement to the effect that the writer believes that the facts stated in the letter are true. Mr Stringfellow states that he is best known as a "celebrity nightclub owner in London" and that he has known Mr Mehmet for over 25 years. He states that between 2007 and 2016 he bought a number of pieces of jewellery from Mr Mehmet (to whom he refers as Smile); although he cannot recall exactly how many pieces he bought, he says "it would have been in excess of 20". It is impossible to extract from this statement what was bought during the relevant periods. Mr Stringfellow states that these items were "high value and handmade, one off items" which were purchased as gifts for friends and associates and that each item he purchased was labelled ICEROCKS and came in a presentation box branded ICEROCKS. He also states that he commissioned Mr Mehmet to create an ICEROCKS dessert cocktail stick, which created press interest as the most expensive dessert selling for £2,500. Five were produced, although it is not said when they were made. Mr Stringfellow concludes his statement by saying that he remembers he bought six gold membership cards for the opening of his Club, The Wardour but, again, he provides no details of when these sales might have taken place.

23. Mr Mehmet says that there was a "setback" for ICEROCKS in 2011 where both the G Mantella stores were affected by riots. He states:

"Both stores were damaged but the store in Enfield was robbed and a number of items of ICEROCKS jewellery were taken. Very regrettably these were not insured and this was a setback for the business".

24. Exhibit IM-4 is provided in support. This consists of a press article dated August 2011 which states:

“Defiant North London jeweller G Mantella is not letting the riots bring it down as it serves shoppers on the street, albeit with a red carpet reception.

During the riots the shutters of the shop were kicked in by thugs who caused a lot of damage but failed to gain access to the store on Green Lanes in Palmers Green. The jeweller reopened for business last Tuesday but is still unable to allow customers into the shop because its shutters are so badly damaged they cannot be opened.

.....

G Mantella owner Smile Mehmet told local newspaper North London Today: “I did not want the customers to think we have closed down. We still have repairs to do, orders that need collecting and people are still getting married or engaged [...]”

While the shop did not lose any stock in the attack, its sister store G Mantella in Enfield Town, which is run by Mehmet’s brother Erdal Mehmet, was not so fortunate and lost £40,000 of uninsured watches as well as sustaining damages to the shop”.

25. I emphasize this as it conflicts with Mr Mehmet’s account that items of ICEROCKS jewellery were taken during the riots.

26. Mr Mehmet states:

“While my sale of ICEROCKS jewellery continues to [the date of the witness statement], from about 2011 onwards I stopped actively promoting it and concentrated instead on the artwork [...] I still receive an appreciable number of orders because of the promotion I had already done and from returning customers, although this has tailed off slightly as I have focussed more and more on the artwork side of ICEROCKS. Today the ICEROCKS jewellery I

sell is limited to pieces which people (usually previous customers) commission me to make”.

27. Mr Mehmet says that he also registered many domain names, i.e. icerocks.biz; icerocks.cc; icerocks.info; icerocks.tv; icerocks.uk; icerocklondon.com; icerocks.london and icerockslondon.com. In particular, he says that he registered icerocks.co.uk in order to create a site on which to promote his jewellery. No further details are given of that website, or, indeed, of whether it has even been operative.

28. Under the heading “Development of ICEROCKS Brand” Mr Mehmet describes the use of the brand ICEROCKS in the art field. Mr Mehmet says that he worked in collaboration with someone called Michael Clarke in the realisation of a project called “Every man and every women is a star” which is described as “limited edition sculpture” and “a portrait of the painter Francis Bacon in black and white diamonds and set in silver”. Mr Mehmet says that he created a total of eight sculptures which are described in details as below:

“A total of eight sculptures were created (3 Artist’s proof and 5 limited edition pieces) which took over three years. Each sculpture uses 732 white round, brilliant-cut diamonds with a total weight of 2.975 carats and 4,070 black round, brilliant-cut diamonds with a total of 20.484 carats. The white diamonds range in size from 0.75 to 1.4 mm, the black diamonds from 0.7 to 1.35 mm. The weight of silver is 166.39 grams [...].”

29. Exhibit IM-8 consists of undated photocopies of photographs of the sculpture “Every man and every women is a star”. An example is reproduced below:



30. The sculpture features the mark **ICEROCKS** and, it is said, was donated to Victoria and Albert Museum (V&A) in London, where it has been on display from 2013 to the date of the witness statement. Exhibit IM-9 is provided in support. This comprises a copy of a “thank you” letter dated 18 December 2012 which was sent from V&A Museum to ICEROCKS LIMITED and in which it is stated:

“On an earlier visit, we experimented with [Michael Clark] to see whether the lighting conditions which can be provided in the Jewellery Gallery would do [Every man and every women] justice. In the gallery, Michael’s sculpture would powerfully extend the frontiers of contemporary design while being seen in a rich context of figurative work and diamond mounting and setting...”

31. The letter was signed by “Richard Edgcumbe (Metalwork Collection)”. Mr Mehmet says that the display of the sculpture in V&A Museum has created a lot of interest and that “all of this interest names ICEROCKS as the maker”. Exhibits IM-10 and 11 are extracts from the V&A Museum’s website and magazine dated 16 September 2013 and Autumn/Winter 2013 respectively. They describe “Every man and every women” as a “sculpture” and/or a “portrait” designed by Michael Clark and

executed by ICEROCKS LONDON in 2008/2009. The gallery location is indicated as Jewellery, room 91. I note that the magazine article is a commentary from Richard Edgcumbe who is qualified as “senior curator, Sculpture, Metalwork, Ceramics & Glass”. Exhibit IM-12 is a press article from “the Independent Radar” dated 3.10.2015. The article talks about the sculpture “Every man and every women” featuring in Michael Clark’s “experimental short movie *Beautiful Dreamer* [...]”. Mr Mehmet also states that he was the executive producer of that movie. Exhibit IM-15 is a photocopy of a flyer promoting a private screening which names ICEROCKS LONDON as executive producer.

32. Mr Mehmet says that the other seven sculptures are available for sale and that the asking price is in the region of £250,000. He also states that to support this new business dimension, he had a new business card made. Exhibit IM-13 provides a sample; this reproduces a picture of (the portrait created by) the sculpture “Every man and every women is a star” and contains the email address “iam@icerocks.london” and the website address “www.icerockslondon.com”. Mr Mehmet concludes his witness statement by stating:

“I have lots of other exciting plans for ICEROCKS which I intend to continue to use in relation to precious and semiprecious metals and stones and to build on the sales of ICEROCKS jewellery and on the ongoing publicity created by the V&A exhibition. As I have already said in this witness statement the quality, cost and audience for my work will necessarily mean that sales will never be huge but what we are creating is a very high end, exclusive brand which is associated with the creative and artistic use of precious and semi-precious metal and stones whether on jewellery or as part of art installation with the kudos of being in the Victoria and Albert Museum in Kensington”.

34. No further details are given of Mr Mehmet’s plans.

The applicant's submissions in reply

35. The applicant did not file evidence in these proceedings. It did, though, file written submissions in which it highlighted what it considered to be gaps and/or contradictions in the evidence. The main points from these submissions are:

- i) That the evidence filed does not demonstrate use of the marks within the relevant periods;
- ii) That most of the evidence is undated or pre-dates the relevant periods and that there is nothing to support Mr Mehmet's claim that the drawings were used as a marketing aid during the relevant periods;
- iii) That none of the pieces of jewellery shown in the evidence "corresponded in appearance or style" to any of the designs shown in the drawings. This, the applicant states, gives rise to the suspicion that they were "random items placed on packaging for the purpose of the photographs";
- iv) That the sales figures are totally unsupported in the evidence and that their accuracy is questionable given the evidence that the goods were sold "under the G Mantella name and were not even invoiced as ICEROCKS products";
- v) Mr Sringfellow's statement is not independent because he is a long standing acquaintance of Mr Mehmet; in any event, the invoice relating to the sale of a membership card is irrelevant as it is outside the scope of the goods covered by registration since it is neither a piece of jewellery nor precious metal (as raw material); further, the remaining two invoices are insufficient to demonstrate genuine use;
- vi) That the evidence relating to the sculpture "Every man and Every women is a star" is irrelevant as, similar to what it is argued at point v), the item is neither a piece of jewellery nor precious metal or alloy per se;

- vii) With the exception of the website “icerocklondon.com”, which is said to be a “parking page” and “icerocks.london”, which is not associated with any website, all the domain names listed in the evidence are merely addresses through which the website “icerockslondon.com” can be reached; this refers to the sculpture “Every man and every women is a star” and makes no mention of ICEROCKS jewellery; finally there is no provision for customers to order jewellery from that website. Copies are provided in support. Some of this seems like an attempt to give evidence, however, as it has been filed as submission, it has no weight.

Mr Mehmet’s submissions in reply

36. Mr Mehmet’s representatives filed brief written submissions in which they reiterated that the evidence provided demonstrates genuine use of both marks during the relevant periods. They also filed a letter from Mr Mehmet to a Tribunal’s caseworker which is aimed at addressing the applicant’s criticisms and contains a number of submissions. It states:

“It seems in hindsight that I was given wrong advice from the beginning from various lawyers and on reflection I feel this could have been dealt with much more efficiently had I had the correct supervisors. Therefore, for my final statement I will be writing it from myself, and I would also like to state that the fact that I hold other national trademark registrations in the UK is not irrelevant for the purpose of the present proceedings, as it only provides more evidence as to why I have not been using ICEROCKS as much as the opposition would have liked me too, as I have several other brands I have been working on”

37. Mr Mehmet admits that the jewellery produced between 2009 and 2014 was minimal. He states:

“The picture evidence I supplied of jewellery that I made for several clients in the earlier stages of this brand was at the time where originally I had planned on making it solely a jewellery brand. However, as time went on I decided I wanted to expand in a more niche market of combining jewellery and art. This

can explain the 5 year period between 2009 and 2014 where the jewellery produced was minimal, as I was focused on 'Every Man and every women is a star'. Although the jewellery produced was minimal, jewellery was still produced and all of it was sold –whilst I have provided evidence for jewellery that I made during that time, the Opposition feels it is 'irrelevant' for several reasons which cannot be proven [...]"

38. In relation to the criticism that only three invoices were supplied, Mr Mehmet offered the following explanations (reproduced as written):

"The press reports of Exhibit IM-4 is there to give reason of why many of the invoices are missing due to being stolen as well as several ICEROCKS jeweller pieces having stolen as well" (point 3)"

"[...] whilst [the applicant] keep reiterating that the invoices supplied is for 'only 3 items' - I have explained the reasoning for this in point 8 on this page. If you require further evidence G Mantella trading account can be made available." (Point 11). In point 8 he states:

"Whilst the Opposition feel that the evidence in regards to the sculpture "Every man and every women is a star is not relevant, I feel it is as the materials used can be argued that the sculpture is in fact a piece of jewellery. However, if one strongly felt it had no relevance to trade mark Class 14, it does prove where my attention was during the years aforementioned and gives an explanation as to why jewellery was not being produced in abundance".

39. Point 8 is intended to justify the lack of invoices on the basis that the jewellery was not produced in abundance. I emphasize this because it conflicts with Mr Mehmet's statement that the three invoices submitted were only the tip of an iceberg and the reason why more could not be provided was that customers purchasing ICEROCKS jewellery would normally be issued with a till receipt from G Mantella.

40. Mr Mehmet also submits that:

- i) The applicant's suggestion at iii) that the photographs of jewellery were fabricated is "trivial". In this connection, Mr Mehmet says that "the design process is a long and arduous one that is altered at every stage and not always documented, especially when working by appointment to individual customers [...]";
- ii) In response to the criticism at iv), Mr Mehmet essentially says that as ICEROCKS jewellery was stocked and sold by G Mantella, the sales were also invoiced by G Mantella, similarly to what would happen in the retail of other third party brands;
- iii) In response to criticism at v), the invoice relating to the sale of a golden membership card is relevant because this item "can be adorned in the jacket breast pocket" and it is "made from pure gold", which is a precious metal and, as such, it is within the scope of the specification covered by the marks;
- iv) In response to the criticism at vi) it can be argued that the sculpture is a piece of jewellery given the material used;
- v) In response to the criticism at vii) Mr Mehmet accepts that his website is not used in relation to jewellery however, he reiterates that this reflects the fact that the brand is exclusive and that the jewellery is designed, made and sold to private clients. He also accepts that the domain name "icerocklondon.com" was bought merely to prevent others to buy it due to the similarity with his brand.

Decision

41. 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;

.....

(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.”

42. 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.”

43. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. 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 Bunderversammlung 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].”

44. 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.”

45. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

Revocation in relation to specifications which has been surrendered

46. Mr Mehmet accepts that no use of the two registrations have been made other than for the goods which had not been surrendered. Accordingly, the applications for revocation under s. 46(1)(a) succeed in relation to the surrendered goods and services and the marks 2447943 and 2447390 are revoked to this extent with effect from the earliest date sought, namely 21 November 2014.

Genuine use in relation to the non-surrendered specification

47. I will now go through the goods which have not been surrendered and for which Mr Mehmet has claimed use.

Class 16

48. The only reference to the goods in class 16 is in Mr Mehmet's counterstatement where he claims that he has used the mark 2447943 in relation to *paper, cardboard and goods made from these materials, not included in other classes; photographs; artists' materials*. However, there is no evidence of use for such goods. Accordingly, mark 2447943 is revoked in relation to the non-surrendered specification in class 16 with effect from the earliest date sought, namely 21 November 2014.

Class 14

Use in relation to the goods of the specification?

The sculpture "Every men and every woman is a star"

49. Given my findings, I only need to assess whether there has been use of the marks in relation to the non-surrendered specifications in class 14. The applicant raised a fundamental point, namely that the use (genuine or otherwise) shown in relation to the sculpture "Every men and every women is a star" does not amount to use in relation to "jewellery". Mr Mehmet replies that the sculpture is, in fact, a piece

of jewellery and that, consequently, use of the marks in relation to it counts towards genuine use².

50. The Oxford English dictionary defines “jewellery” as meaning “personal ornaments, such as necklaces, rings, or bracelets that are typically made from or contain jewels and precious metal”. It also defines “sculpture” as meaning “the art of making two- or three-dimensional representative or abstract forms, especially by carving stone or wood or by casting metal or plaster”. A sculpture is, by definition, a work of art which is not meant to be worn as personal adornment; the fact that a sculpture might contain components made of precious metal and stones does erode the distinction between sculpture and jewellery. To consider otherwise, would broaden the definition of jewellery to include virtually all objects to which precious metal and precious stones have been applied. Whilst Mr Mehmet’s sculpture might have been displayed in the Jewellery Gallery³, this was done because of lighting conditions and in order to present the work in “a rich context of figurative work and diamond mounting and setting”; as opulent as Mr Mehmet’s sculpture might be, it is not a piece of jewellery. That this is correct is shown by Mr Mehmet’s own description of “Every men and every women is a star” as “a limited edition sculpture” and “a portrait”; the same terminology is also used in the press articles and on the V&A website. It follows that Mr Mehmet’s use in relation to the sculpture “Every men and every women is a star” does not amount to use in relation to jewellery (costume or otherwise) listed in the non-surrendered class 14 specification. Nor does it amount to use in relation to precious stone and/or precious metals and their alloys (which are also listed in the same specification); these goods are raw materials, may be sold loose and/or in ingot or bar form and are bought either for investment purposes or by manufacturers, in which case they will require some sort of processing to enable them to be made into or used as part of something else. In contrast, Mr Mehmet’s piece is a finished product.

² To be genuine use, the exploitation of a trade mark must be aimed at maintaining or creating an outlet for the goods or services for which the mark is registered, or a share in the market for such goods or services.

³ Exhibit 10 confirms the Gallery location as Jewellery room 91

Membership cards

51. Similar criticisms can be made to the evidence relating to the sale of gold membership cards. Again, Mr Mehmet's submission suffers from the problem that he seeks to equate the items he has created to jewellery on the basis that they incorporate precious metal, i.e. gold. The fact that something is made of (or incorporates) precious metal and it is sold in a jeweller's shop, does not make it jewellery, e.g. silver frames, gift pens. It is true that some pieces of jewellery are worn on clothes, e.g. brooches, however, even if a membership card is worn in a jacket's breast pocket as Mr Mehmet claims, it does not fall within that category.

Use in relation to jewellery?

52. Before assessing the evidence in detail, it is appropriate that I should make two observations. First, what is striking about the evidence is the contrast between the level of evidence relating to use of the marks in connection to jewellery, which is far from specific, and the evidence relating to the sculpture "Every women and every man is a star", which is reasonably comprehensive (though, I have already found, it does not assist Mr Mehmet).

53. Second, Mehmet filed a response to the applicant's criticisms in the form of a letter. The letter was signed by Mr Mehmet and approved by his representative who forwarded it to the Tribunal. In his letter Mr Mehmet admitted that, essentially, the jewellery produced between 2009 and 2014 was minimal because his attention was focused on his sculptural work. This may explain why Mr Mehmet's narrative evidence about the sale and promotion of jewellery is mostly unsupported by documentary evidence and appears, in some parts, deliberately vague. For example, Mr Mehmet stated, in his witness statement (paragraph 17), that he registered "icerocks.co.uk in order to create a site on which to promote [his] jewellery"; however, he admitted that the website "does not showcase any jewellery" only after the applicant challenged his statement (point 10 of the letter). Further, Mr Mehmet stated, in his evidence, that the invoices produced were "very much the tip of an iceberg", which suggests that there were many more invoices although they were not exhibited in the proceedings; however, in his submissions (which I accept is not

evidence per se) Mr Mehmet appears to provide a different version of the events and attempted to justify the paucity of the invoices on the basis that some were stolen in 2011 and, most significantly, the “jewellery was not produced in abundance”.

54. With this in mind, I proceed to assess what can be taken from the evidence.


Turnover figures

55. The sales figures provided show that Mr Mehmet has sold a total of £ 121,211 worth of goods during the first relevant period and a total of £ 137,790 during the second relevant period. However, Mr Mehmet has provided no indication of what goods were sold and it is impossible to say how many transactions were undertaken per year. Although from the two invoices exhibited the cost of the goods seems to be approximately £850 (before VAT), there is nothing to suggest that this was representative of the average value of each item sold and I see no reason why I should make such an assumption. The letter from Mr Stringfellow is hearsay evidence. Whilst I attribute it some weight, it is no conclusive anyway. Suffice to say that whilst Mr Stringfellow claims that he must have bought in excess of 20 pieces of ICEROCKS jewellery between 2007 and 2016 (although he cannot exactly remember) he does not specifically tie them to the relevant periods and it is impossible to say when they were purchased. There is only one invoice which unequivocally demonstrates that Mr Stringfellow bought three pieces of jewellery during the relevant period.

56. Though Mr Mehmet states that several pieces of jewellery were sold during the relevant period, his statement is mostly unsupported; insofar as the undated photographs are concerned, he submits that the pictures of jewellery he has supplied were items made for clients in the earlier stages of this brand (paragraph 1 of the letter), i.e. before he started working on the sculpture; as the evidence shows that the sculpture was made in 2008-2009 this means that the photos must have been taken before the relevant periods. Further, Mr Mehmet has included in his evidence items that he equates to jewellery but which, I have already found, do not fall within the scope of jewellery, i.e. sculpture(s) and gold membership card(s). Likewise, Mr Stringfellow refers to the purchase of six membership cards; he also refers to the

sale of five gold cocktail sticks which, for the same reasons outlined in relation to the sale of membership cards, I do not consider would fall within the scope of jewellery either. In the circumstances, I don't know exactly how many pieces of jewellery were sold and when. For what I know, the turnover figures provided could include the value of items that I would not necessarily consider to be pieces of jewellery and Mr Mehmet could have sold one piece (of jewellery or otherwise) per year given that, as he states, his jewellery (or what he describes as such) is very high value and unique. The most that the evidence establishes is that Mr Mehmet has sold four pieces of jewellery during the relevant periods for a total value of £4,080. The rest of the evidence is inconclusive as, despite the turnover figures, it lacks any objective details from which to establish the volume of jewellery sold within the relevant periods.

Promotion

57. Whilst Mr Mehmet asserted that the business cards bearing the mark  (registration no. 2447943) have been used in relation to jewellery, he gives no further details and admits that from 2011 he stopped actively promoting ICEROCKS jewellery (paragraph 15 of the witness statement). This means that during the second relevant period there was no marketing activity. Whilst, in the beginning of the first relevant period, i.e. 2009-2010, there may have been some promotion, this essentially consisted in Mr Mehmet attending VIP events, but it is impossible to say to what extent such activity was undertaken, or its nature, and there is no indication of any promotion and/or advertising expenses.

Website

58. Whilst there is evidence that Mr Mehmet has registered domain names which contain the words ICEROCKS, he accepts (paragraph 10 of the letter) that he does not advertise his jewellery on the website. As to the use of ICEROCKS LONDON as a company name, again, it is used in the evidence to designate the company who produced artwork not jewellery.

What can be taken from the evidence?

59. The most that there is by way of evidence is that:

- There have been two transactions during the relevant periods. A total of four items were sold. The items sold were i) three pendants (which were sold in 2011 to Mr Stringfellow) and ii) one chain (which was sold in 2013 to an unnamed customer); insofar as the latter is concerned, the price is shown in pounds so it can safely be assumed that it was purchased in the UK;
- The total value of the sales is £4,080;
- All the jewellery was sold from one shop in London;
- Although the evidence is undated, I accept that the jewellery sold was presented in branded boxes bearing the mark  (2447943);
- The jewellery sold was identified on the invoices as ICEROCKS jewellery;
- There is no real promotion of the mark through, for example, brochures or advertisements. Mr Mehmet admitted that he stopped promoting the brand from 2011 onwards and there is no evidence of promotion before 2011;
- There is nothing to support Mr Mehmet's statement that the drawings were ever used as a marketing aid and it is impossible to understand the impact of any promotion which may have taken place through word of mouth;
- There has been no use on the Internet.

60. If there has been more use than this, it is not established by the evidence filed.

61. Whilst the use shown does not strike me as sham or token, in the sense that the sales were not carried out in order to merely preserve the registration, it does not

always follow that any commercial use constitutes genuine use. In Case C-141/13 *P Reber Holding GmbH & Co. KG v OHIM, Wedl & Hofmann GmbH* the CJEU stated:

“31 As a first stage, in paragraphs 33 and 37 of the judgment under appeal, the General Court held – having regard to the evidence produced by the appellant – that the actual commercial use of the earlier trade mark ‘Walzertraum’ was undisputed and that there was a certain degree of continuity in its use.

32 However, contrary to the view taken by the appellant, the assessment of the genuine use of an earlier trade mark cannot be limited to the mere finding of a use of the trade mark in the course of trade, since it must also be a genuine use within the meaning of the wording of Article 43(2) of Regulation No 40/94. Furthermore, classification of the use of a trade mark as ‘genuine’ likewise depends on the characteristics of the goods or service concerned on the corresponding market (*Ansul*, EU:C:2003:145, paragraph 39). Accordingly, not every proven commercial use may automatically be deemed to constitute genuine use of the trademark in question.”

62. The case-law in *Reber* was recently reviewed in an appeal from a Hearing Officer’s decision to revoke a UK trade mark registration for non-use (*STRADA*, BL-528/15) where Prof. Ruth Anna, sitting as the Appointed Person, stated:

“34. Mr. Hill argued that *Reber* neither changed the law nor (as suggested by the Hearing Officer) clarified it. It was always the case that “commercial use” in the sense of use in the course of trade might not qualify as genuine use. The “dichotomy” between genuine use on the one hand, and token use on the other hand, established in Case C40/01, *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 C416/04 P, *The Sunrider Corp. v. OHIM* [2006] ECR I-4237 had been retained.

35. I am with Mr. Hill in that: (1) *Reber* does not in my view mark a departure from prior CJEU law (c.f., *100% CAPRI Trade Mark*, BL O/357/14, para. 19,

Case T-398/13, *TVR Automotive Ltd v. OHIM*, 15 July 2015, para. 44); and (2) there have been prior cases where commercial uses were held insufficient to constitute “genuine use” for the purposes of EU law (e.g., Case T-131/06, *Sonia Rykiel création et diffusion de modèles v. OHIM* [2008] ECR II-0067).

36. Moreover, I accept Mr. Hill’s further points that: (a) neither the commercial success of use, nor the economic strategy of an undertaking is necessarily telling (*TVR*, paras. 45 and 58); and (b) there is no quantitative threshold for genuine use, and even small uses can suffice for genuine use (*La Mer*, para. 21).

37. However, I would add to Mr. Hill’s last point (b) that the CJEU has made consistently clear that genuine use depends on whether the use is warranted in the economic sector concerned to maintain or create a share in the market for the registered goods or services (*Ansul*, para. 38, *La Mer*, para. 21, *Sunrider*, para. 70, *Reber*, para. 29).

38. That involves the tribunal making a consideration of all the relevant facts and circumstances in any particular case including the nature of the goods or services in question, the characteristics of the market concerned and the scale, geographical scope and frequency of the proprietor’s use of the mark for those goods or services (*Ansul*, para. 39, *La Mer*, paras. 22 – 23, *Sunrider*, paras. 71 and 76, *Reber*, paras. 32 and 33, Case C-149/11, *Leno Merken BV v. Hagelkruis Beheer BV*, 19 December 2012, paras. 30 and 36).

39. Since those factors are interdependent, tribunals deciding different cases may assess differently the genuineness of any alleged uses even where such uses have produced comparable sales volumes (*Sunrider*, para. 77).

40. Thus, whilst the *La Mer* case, on the one hand, confirmed that slight use could amount to genuine use, the *Reber* case, on the other hand, showed that use in a particular locality might not qualify as genuine use; the outcome depends on the facts in each case.

“Dichotomy”

41. As for the “dichotomy” so said by Mr. Hill to have been established by the CJEU in *Ansul* and *La Mer*, if by this Mr. Hill meant that where use was not token use merely to preserve the value of the trade mark it must be genuine use, I do not agree.

42. Although that is one way in which paragraph 36 of *Ansul* might be read, it is clear from paragraph 43 that this was not what the CJEU intended. The CJEU ruling at paragraph 43 in *Ansul* (consistently followed in subsequent CJEU judgments on use) was that genuine use did not “*include* token use for the sole purpose of preserving the rights conferred by the mark” (emphasis added) and not that all other uses must be genuine use

43. In any event, as previously mentioned, the view that: “it is necessary only to verify whether the trade mark in question has been put to use in order to create or preserve an outlet for the [products] concerned, or whether its use served merely to preserve the rights conferred by it, with the result that that use amounted merely to artificial use” was expressly rejected by the CJEU in *Reber* (para. 32; and see Case C-609/11, *Centrotherm Systemtechnik GmbH v. centrotherm Clean Solutions GmbH & Co. KG*, 26 September 2013, paras. 67 – 74).

44. If on the other hand – given that Mr. Hill conceded that certain actual commercial use might not constitute genuine use – Mr. Hill was contending that “token use” included more than use merely to preserve registered rights, I cannot see where that gets him. This is just a question of semantics.

45. To conclude at this point, I was not persuaded that the Hearing Officer’s below comment indicated that he about to fall into error in his assessment of genuine use:

“*Reber* has not really changed the law with regard to genuine use, but it is nevertheless a very good example of commercial use that was

neither sham nor token, but nevertheless was not genuine; it is therefore a clarification of the earlier case-law” (para. 30)”

63. In that case the evidence showed that the mark had been used in relation to spectacle glasses which had been sold in 3 opticians shops in the Salisbury area. Sales of around 41 pairs of glasses per year were shown and use had been continuous throughout the relevant 5-year periods but given the overall size of the UK market for spectacles and optician services, the lack of advertising, the small volume of sale and their limited geographical spread, Prof Annand upheld the Hearing Officer’s finding there had been no genuine use of the mark. The context of use in these proceedings is much smaller than the context of use in *STRADA*. Here there is no continuity of use, as the evidence is limited to two transactions during the relevant five-year periods. The amount of jewellery sold is very small both in terms of numbers (a total of four items were sold) and value (the total value of those sales was £4,080). The goods were sold by Mr Mehmet through his shop in London so the geographical scope is very limited. The market in question is jewellery in the UK (bespoke or otherwise) which is manifestly huge; considering the expensive nature of the goods, the quantum of sale is manifestly minuscule when compared to the size of the relevant market. Although I accept that a jeweller who supplies high-end bespoke products will have lower sales than a standard jeweller, I still think that the sale of only four items for a combined total value of £4,080 over a five year period represents a tiny part of the overall market for the goods. There is no evidence of promotional activity and Mr Mehmet’s statement that the brand was promoted by word of mouth is totally unsupported.

64. Taking the evidence on the round, I conclude that the use shown in relation to jewellery is insufficient to constitute real commercial exploitation of the mark in the UK market and therefore, this is not genuine use in any of the relevant periods.

65. There is no evidence of use in relation to any other goods in class 14.

Proper reasons for non-use?

66. Whilst in his counterstatement Mr Mehmet states that he has used the marks in relation to jewellery, in his letter, he invites me to consider the issue of “proper reasons for non-use” although this was not pleaded from the outset. He states:

“Whilst I am aware that one does have to use a trade mark once it is theirs, I feel I have supplied enough evidence for genuine use and reasons for non-use and ask for you to consider the nature of the business I am running in conjunction with my statement”.

67. The factor to which Mr Mehmet refers are:

- i) That he owns several brands he has been working on (no further details are provided);
- ii) That he focused on his art work;
- iii) The nature of his business, i.e. that it combines art and jewellery and suits a niche market;
- iv) That he is currently working on several projects “which take time and cannot currently be shared due to classified material” (no further details are provided);

68. Section 46 of the Act provides that if there were in the relevant period “proper reasons for non-use” of a registered trade mark, an application for revocation may be defeated. In *Armin Häupl v Lidl Stiftung & Co KG* Case C-246/05 the CJEU considered the issue of proper reasons for non-use. It held:

“54 It follows that only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as ‘proper reasons for non-use’ of that mark. It must be assessed on a case-by-

case basis whether a change in the strategy of the undertaking to circumvent the obstacle under consideration would make the use of that mark unreasonable. It is the task of the national court or tribunal, before which the dispute in the main proceedings is brought and which alone is in a position to establish the relevant facts, to apply that assessment in the context of the present action.”

69. It is clear that none of the reasons Mr Mehmet is relying on are independent of the will of the proprietor and, thus are not proper reasons for non-use.

Outcome

70. The consequence of my decision is that the applications for revocation on the grounds of non-use succeed in their entirety. Mr Mehmet’s registrations are hereby revoked with effect from 21 November 2014.

Costs

71. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice (TPN) 4 of 2007. Accordingly, I award costs to the applicant on the following basis:

Official fees (x2):	£400
Filing the applications and statement of grounds:	£300
Considering evidence and preparing and filing written submissions	£400
Considering the other party’s submissions:	£100
Total	£1,200

72. I hereby order Mr Ismayil Mehmet to pay ICE IP S.A. the sum of £1,200 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 11TH day of April2017

Teresa Perks

For the Registrar

The Comptroller – General