

BL O-131-19

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF:

**LAURELLE LONDON LIMITED'S APPLICATION (No. 3231633)
TO REGISTER THE TRADE MARK: Chosen
AND OPPOSITION THERETO (No. 410038) BY KATHLEEN DEAYTON**

&

**LAURELLE LONDON LIMITED'S APPLICATION (No. 501760) TO REVOKE
KATHLEEN DEAYTON'S TRADE MARK REGISTRATION (No. 2428866) OF THE
TRADE MARK: CHOSEN**

Background and pleadings

1. These consolidated proceedings concern a trade mark application and a trade mark registration for the marks: **Chosen** and **CHOSEN**, both in respect of class 3 goods.

2. Laurelle London Limited (“LLL”) applied for its mark (**Chosen**) on 17 May 2017. It was published for opposition purposes on 26 May 2017. Registration is opposed by Ms Deayton. Her grounds are based on sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”) relying on an earlier mark she owns (**CHOSEN**) which was filed on 2 August 2006 and which was subsequently registered on 2 February 2007.

3. In response to the above opposition, LLL filed a counterstatement denying the grounds of opposition. Whilst it accepted that the marks were identical, it did not accept that all of the goods were similar or identical. It also put Ms Deayton to proof of use in respect of her earlier mark because it had been registered for more than five years when LLL’s mark was published (section 6A of the Act refers)¹. The relevant period in which proof of genuine use must be shown is 27 May 2012 to 26 May 2017.

4. LLL also applied to revoke Ms Deayton’s earlier registered mark on the grounds of non-use. Its application to do so was filed on 15 August 2017. LLL’s application is based on two periods of non-use:

- i) Under section 46(1)(a) of the Act, which relates to the five-year period following registration, namely 3 February 2007 to 2 February 2012.
- ii) Under section 46(1)(b) of the Act, with a specified period of 15 August 2012 to 14 August 2017.

5. Ms Deayton filed a counterstatement denying the grounds on which revocation is sought. It is stated in her notice of defence that a small amount of use had been made

¹ In Ms Deayton’s notice of opposition, a statement of use was made stating that the mark has been used in relation to perfumes.

but there had been “a variety of circumstances, including health problems, that have caused delays”.

6. Both sides filed evidence. A hearing took place before me on 28 January 2019 at which Mr Michael Brown, of Alpha & Omega, represented Ms Deayton, and at which Mr Chris Aikens, of counsel, instructed by Maucher Jenkins, represented LLL.

The opposition proceedings

7. At the hearing, Mr Aikens accepted that i) the marks were identical and, ii) certain of LLL’s goods² were identical to the goods (perfumes) relied on by Ms Deayton.

8. Mr Brown submitted that three further goods³ were also identical, which Mr Aikens accepted. Mr Brown confirmed that no issue was taken with any of the other goods the subject of LLL’s application.

9. The consequence of the above is that section 5(1) is accepted to apply in relation to the goods set out in the footer of this page, subject, of course, to Ms Deayton’s mark meeting the use conditions. Further, the section 5(2)(a) claim is no longer relevant because no issue is taken with the remaining goods of the application.

Preliminary matters

The hearing

10. I record here that the hearing caused some practical difficulties. I had earlier agreed to move the original hearing date, something which Ms Deayton was not happy with. Her dissatisfaction was due to her health problems (which are discussed later)

² Perfumes, eau de cologne, toilet water, deodorants for personal use; deodorants; scented room spray; room perfumes; scented water, scented wood; aromatics; perfumery; fumigation preparations which are emitted into the air or atmosphere in the form of smoke, vapour or gas for the purpose of perfuming.

³ Non-medicated toileted preparations; oils for perfumes and scents; essential oils

and the assistance she would need to attend. Of course, her attendance at the hearing was optional given that she was represented at the hearing by Mr Brown, her professional legal representative. Nevertheless, arrangements were made to dial Ms Deayton into the hearing via a telephone link. Mr Brown attended in person in Newport, Mr Aikens via video-link from the IPO's London office.

11. Prior to the hearing, Ms Deayton questioned how she would be able to talk to her representative, Mr Brown. She was advised that it was a matter for her to make appropriate arrangements. However, beyond being dialled in, no separate arrangements were made by Ms Deayton/Mr Brown. This resulted in Ms Deayton speaking to Mr Brown in an open setting. I advised her that this was not ideal, as Mr Aikens and myself could, of course, hear her. Whilst appreciating the difficulty, she accepted that this was all she could do. I took this as a waiving of any privilege between herself and Mr Brown.

12. It was also not helpful that Ms Deayton often moved into giving submissions. I reminded her on a number of occasions that Mr Brown was here to represent her, at which point(s) her interjections lessened. It was also not helpful that on a number of occasions Ms Deayton and Mr Brown did not appear to be "singing from the same hymn sheet". I clarified on a number of occasions with Mr Brown what the final submission was, upon which I have proceeded.

Ms Deayton's written summary

13. Along with his skeleton argument, Mr Brown provided a written submission from Ms Deayton which he explained was intended to be a summary of Ms Deayton's activities as set out in her written evidence. Mr Aikens took issue with this, primarily because there appeared to be some new factual evidence included within it. Mr Brown confirmed that he was not seeking leave to introduce any further evidence. I proceeded on the basis that whilst I may have due regard to the summary, I would not consider any new factual aspects it may contain.

14. I now turn to the revocation and proof of use issues.

Legislation and leading case-law

15. In relation to revocation, the relevant parts of section 46 of the Act read:

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

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

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

(c).....

(d).....

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

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

(4)

(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.”

16. In relation to proof of use in opposition proceedings, section 6A of the Act reads:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or

(b) the earlier trade mark has not been used, but there are proper reasons for non-use.

(4)

(5)

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

17. Section 100 is also relevant; it 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.”

18. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. summarised the case-law on genuine use:

“114. The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013]

ETMR 16, Case C-609/11 P Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], [2014] ETMR, Case C-141/13 P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089] and Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]- [51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to

encourage the sale of the latter: Silberquelle at [20]-[21]. But use by a non-profit making association can constitute genuine use: Verein at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18]; Centrotherm at [71]; Reber at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72] and [76]-[77]; Leno at [55].

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

Proper reasons for non-use

19. Mr Brown’s skeleton argument contained a submission that the revocation action should be dismissed:

“...for the proper reasons pleaded in her defence of technical issues with the manufacturing or the perfume bottle and health issues outside Kathleen Deayton’s control preventing her from using the mark earlier”.

20. There is no mention in the skeleton argument regarding whether the same applies to the use conditions for the purposes of the opposition. It is also noteworthy that in the statement of use made by Ms Deayton in her notice of opposition, no mention is made of any reasons for her not having used the mark, indeed, the appropriate box that an opponent can use to set out any proper reasons for non-use was left blank.

21. Mr Aikens took issue with the ability to rely on proper-reasons for non-use. He submitted that even in the revocation action it was not clearly pleaded. This is one of the areas where Mr Brown and Ms Deayton were not initially “singing from the same hymn sheet”. After some discussion and direct questioning from me, Mr Brown confirmed that the defence of proper reasons for non-use were not relied as part of the consolidated proceedings. The mention of manufacturing difficulties and health problems in the revocation pleadings should, therefore, be taken solely as an explanation as to why genuine use had not been made earlier, but that there had nevertheless been genuine use.

The relevance of section 46(3)

22. In his skeleton, Mr Brown refers to section 46(3) of the Act which provides that a registration should not be revoked if genuine use commenced or resumed after the expiry of the relevant period, but before the application for revocation was filed. I agree with Mr Aikens that little turns on this. This is because:

(i) section 46(3) has no relevance to proof of use in the opposition aspect of the proceedings;

(ii) in relation to the section 46(1)(b) claim, there is no gap between the end of the relevant period (14 August 2017) and the filing of the application for revocation (15 August 2017), so there is no potential for commencement or resumption of use after the end of the period and before the making of the application;

(iii) whilst there is such a gap between the end of the section 46(1)(a) period (2 February 2012) and the filing of the application for revocation, as it is accepted by Ms Deayton that there was no actual use in the 46(1)(a) period, any commencement or resumption will fall in the section 46(1)(b) period anyway;

(iv) consequently, at least in respect of the revocation proceedings, it is only really necessary to consider the section 46(1)(b) period.

23. It should be further noted that even though the proof of use period in the opposition proceedings and the relevant period under section 46(1)(b) largely overlap (the difference in the beginnings and ends of the respective period is less than three months), there is potential for differing outcomes due to the latter part of the chronology that I set out below.

The evidence

24. I begin with the witness statement filed by Ms Deayton in which she provides a detailed chronology about her efforts to bring a perfume product to market. Whilst I do not set out below every detail of her evidence, the basic chronology is thus:

- Ms Deayton came up with the idea to launch a new perfume product “at a profit and to support myself” in 2006 at which point she was a self-employed mortgage consultant.

- The idea behind the name was based on something which was “very special” and that the word had some spiritual connotations.
- Ms Deayton spent “some time” finding perfume bottle designers. This led to her meeting, in 2007, a “world-renowned” perfume bottle designer named Pierre Dinand. Technical drawings were provided (Exhibit KD1 contains some form of email communication in which they were delivered – although the drawing is not provided). Exhibit KD2 contains a cost estimate relating to this design work, issued in January 2007.
- For the next 3 years Ms Deayton attempted to get a bottle, cap, collar and actuator manufactured to Mr Dinand’s design. She established contacts with various companies, with the assistance of Mr Dinand. Various problems were encountered meaning that samples were rejected due to corners being sharp/fragile and that they were not aesthetically pleasing. Also, the collar did not fit over the actuator properly. There appears to have been a lot of toing and froing with two companies in particular, but Ms Deayton ultimately decided that she could not work with either of them, something which she describes as a major set-back. She accepts that if she had just gone with a stock perfume bottle then the whole project would have been completed.
- Ms Deayton then conducted further research with two businesses in Bristol who specialised in the production of celebrity perfumes. She says that they acted like mentors and helped her through the process. This led to establishing a contact with a bottle manufacturer in India (Pragatti Glass), who tried to produce the bottle, but, again, there was a problem with the “glass flow”. The time period in which this took place is not clear.
- Ms Deayton also continued to source the other parts she needed: the collar, the actuator and the cap. Exhibit KD2 contains an import invoice (from January 2012) from a Chinese company who produced the actuator and collar in a bespoke gold colour.
- Ms Deayton states that she attended the International Perfume Trade Show in Bologna to look for suppliers. It is not clear when this was. She identified a

further company in China to make a metal crown cap. However, when the sample was provided, she was suspicious that it contained lead (which is banned in the UK). She questioned this with the company, who confirmed that it did contain lead, so this could not be used. Although she continued to use the company, who subsequently produced the cap in zinc and metal alloy, this caused more delay.

- Ms Deayton used a further company in China to provide decorative stones for the cap – these were sent to the cap manufacturer who then sent the cap with stones to Ms Deayton. Exhibit KD3 shows that the finished caps were sent to Ms Deayton on 8 February 2012.
- Fast forwarding to November 2014, Ms Deayton found an appropriate perfume supplier and obtained the “juice” for it. Exhibit KD4 contains an email from that date connected with securing the appropriate safety tests for the perfume.
- Ms Deayton states that she now had the caps, collars, actuators and perfume compound, but still no glass bottle, carton or liner.
- In relation to the bottle, Ms Deayton records that through a contact she established in 2011, she was pointed in the direction of a further Chinese business to assist. There was, again, a lot of toing and froing because initial samples were not right, but eventually a perfected bottle was produced and in 2015 she had a bottle ready for mass-production. To overcome the problems she had previously faced, the design had to be slightly modified and produced via a fully automatic (and more expensive) process. Exhibit KD5 is an import invoice dated March 2015 for two pallets of bottles sent to Ms Deayton’s contract filling company in South Wales.
- Given the success in finally manufacturing the bottles, Ms Deayton moved on to other aspects of the packaging, including the carton and liner. In 2015, again after some more toing and froing with another Chinese company, cartons and liners were shipped to Ms Deayton’s company in March 2016 (see Exhibit KD6).

- The above company had difficulty in producing labels with matching colours, so a British company was used for this. An email about such printing is provided in Exhibit KD7 dated July 2016.
- Ms Deayton states that between 2015 and 2017 she was also liaising with other people in relation to activities such as advertising and commercial photographing. An example is given in Exhibit KD8 which contains an email chain about commercial photographing, the results of which were to be used on Facebook and other forms of advertising. The emails are from August 2015.
- “Before and up to May 2017”, Ms Deayton states that she was at the last hurdle and had been sourcing website design companies. To keep costs down she was creating some of the content herself. Around this time, she was also contacting buyers at various department stores. An example is shown in Exhibit AKD9 which is an email chain (dated 7 September 2015) with River Island asking some questions about minimum orders. CHOSEN is not mentioned in the email. No orders were made because they wished to sell the perfume at too low a price point.
- A television advert was created which was planned to air in September 2017 and photographs to be included in a Nov/Dec Christmas edition of a magazine (I assume 2017, the actual magazine is not specified nor the advertisement). It should be noted that this evidence is from after the expiry of all the relevant periods and after the date of application for revocation.
- The glass bottles had been filled and were in a warehouse ready for sale, although it is not clear exactly when this was.
- All the photography was completed before May 2017 and the first bottle of CHOSEN was sold in June 2017 from Ms Deayton’s website when it went live. Ms Deayton states that she continues to make sales.
- Ms Deayton renewed the trade mark in 2016 and she also purchased the company name CHOSEN (UK) Ltd with the intention to trade through that

company. Various domain names were also purchased – Exhibit KD9 shows invoices for domain names from May 2016.

25. Another aspect of the case relates to Ms Deayton's illness. She gives the following information:

- In February 2014 she was hospitalised having had a cerebral spinal fluid leak. This occurred after treatment for spinal curvature. She describes the severe pain and discomfort she faced.
- Unfortunately, Ms Deayton was sent home as her symptoms were put down to migraine. Ms Deayton then had a private scan and her true condition was identified. She states that she was incapacitated for five months (so I assume between February to June 2014). Subsequent to this, she has a tilted head and curved spine with chronic pain and some disfunction. She has been undergoing conservative treatments to avoid spinal fusion. She states that this has caused delay in her business dealings. She refers to Exhibit KD11 which contains letters from a surgeon discussing her condition and surgery options.
- From early 2016 Ms Deayton has been unable to drive, but has worked at home co-ordinating by telephone and email. She has continued to run the business and has secured new courier contracts. Ms Deayton states that she continues to run her business from home through her website, eBay and social media. She adds that she has taken public liability and product insurance showing that her use is not token.

26. Mr Tim Pendered, LLL's trade mark attorney, filed evidence on its behalf. He explains that he conducted web searches on an Internet archive tool for the website (Ms Deayton's) www.chosen.co.uk. Essentially, the evidence shows that on 7 June 2017 the website was "UNDER CONSTRUCTION". The next capture was on 21 September 2017 which shows the availability of Ms Deayton's CHOSEN perfume product. Mr Brown, on behalf of Ms Deayton, also provides evidence of the current website – but as this is well after all the relevant periods, it takes matters no further forward.

27. Ms Deayton filed a further witness statement. I note the following:

- On 5 May 2017 Ms Deayton received a telephone call from a person called Tom (who said he was from Westcliffe-On-Sea) asking her about the trade mark and whether she was using it. She replied saying that the product was ready for sale and she was in the process of advertising it on eBay, and on her website which was being put together, and on social media, and that she had a Christmas advertisement campaign being launched in September.
- On 19 May 2017 she received a “very threatening and intimidating” letter from Tom Frederikse of Clinton’s solicitors accusing her of trade mark infringement in relation to a mark that had been filed two days earlier. As part of the discussion with Mr Frederikse she emailed him photographs of the perfume bottle and packaging. She explains that at this point the perfume bottles had been filled for sale, boxed up, and cellophane wrapped, ready for sale, that the goods were to be imminently marketed and that the brand was to be part of a Christmas advertising campaign launching in September.
- On 11 July 2017 a purchase of Ms Deayton’s perfume was made on e-Bay and sent to a customer in Westcliffe-On-Sea (Exhibit KD2 refers). She believes that this was purchased for and on behalf of LLL.
- Ms Deayton states that whilst her website may have been under construction on 7 June 2017, it went live on 22 June 2017, as did the Facebook page and shop. She also provides an archive print from the website dated 2 October 2016 with the text “COMING SOON THE NEW BRAND CHOSEN Perfume, Watches, Jewellery, Scented Candles, Fashion t-shirts, Belts”. The page is headed CHOSEN. The only imagery on the page contains what appears to be standard website content for a under construction site – there is no imagery of the CHOSEN product. The same exhibit (KD6) also contains an eBay advertising invoice for the period 16 May to 15 June 2017, which she notes was before the contact with Tom Frederikse on 19 May.

- Exhibit KD7 contains prints showing a Facebook cover page being updated on 22 June 2017 depicting a bottle of CHOSEN perfume. There is also a review from someone on 27 June (the year is not listed).
- Evidence is then provided about the September 2017 advertisement (Exhibit KD8). However, given this was after the relevant periods and after the making of the application for revocation, this does little to assist.
- Ms Deayton makes various points about what LLL has done with its perfume product (a celebrity perfume produced for Nicole Scherzinger), however, this does not go to the question of Ms Deayton's use, so I need not record the points here.

The use conditions relating to Ms Deayton's earlier mark

28. In relation to proof of use in the opposition proceedings (the relevant period for which is 27 May 2012 to 26 May 2017), the following summary of the evidence is applicable:

- Ms Deayton experienced various problems with the manufacture and development of her product.
- Ms Deayton has, since February 2014, experienced health problems. She states that she was incapacitated between February 2014 to June 2014. Her health problems have been ongoing since then, although she has worked from home with regard to her business.
- Products were boxed up, ready for sale, sometime in May 2017.
- There was no active website or Facebook presence during the relevant period (Ms Deayton's evidence is that they went live on 22 June 2017, after the relevant period).
- Although the perfume may have been listed on eBay before the above (Ms Deayton states this was in May – see paragraph 31 of her second witness

statement) there is insufficient evidence to show exactly when this was and whether it was within the relevant period. Although there is an eBay invoice for the period 16 May 2017-15 June 2017, this does not demonstrate the exact date of the first listing. This is important because the relevant period ended on 26 May 2017.

- There is evidence of an under-construction webpage with the text “COMING SOON THE NEW BRAND CHOSEN Perfume, Watches, Jewellery, Scented Candles, Fashion t-shirts, Belts”.
- No sales had been made during the relevant period.
- Advertising had been prepared for launch in September 2017, to hit the Christmas market.

29. It is fair to say from the totality of the evidence that Ms Deayton intended to make genuine use of the mark. Indeed, she appears to have shown persistence and tenacity in her attempts at getting her product to market despite the issues which have slowed her down. That said, genuine use relates to actual use of the mark, mere preparations for use do not count. To that extent, there are no indicators that the product was on the market during the relevant period. There were clearly no sales. In terms of external use, the highpoint is the under-construction webpage with the reference “COMING SOON THE NEW BRAND CHOSEN Perfume, Watches, Jewellery, Scented Candles, Fashion t-shirts, Belts”.

30. The fact that goods have yet to be placed on the market is not always a fatal flaw. Room has to be left, as put by Arnold J in *Walton*, for circumstances to deal with goods “...which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns”. However, I very much doubt that the under-construction webpage would be viewed as an advertising campaign with the aim of securing customers. There is no reason why anyone would have found the website. It is nothing more than a holding page with an indication of what may be to come. It cannot be regarded as an act which is attempting to create a

market share at that point and is not warranted in the economic sector as real commercial exploitation.

31. My finding is that Ms Deayton's earlier mark fails the use conditions and, as such, it cannot be relied upon to oppose LLL's application for registration. The further consequence is that Ms Deayton's opposition is rejected and LLL's application for registration may, subject to appeal, proceed to registration in full.

32. Even if I am wrong to have decided that there was insufficient evidence relating to eBay use in the relevant period, the best that can be said is that a first listing may have been made on 16 May 2017 (the earliest date in the date range of the eBay invoice), however, this would represent a use of just 10 days, with no sales and no other market presence. Such use would not constitute genuine use in any event.

Should Ms Deayton's mark also be revoked?

33. Under section 46(1)(b) of the Act, for which the relevant period is 15 August 2012 to 14 August 2017, the following summary of the evidence is applicable:

- Products were boxed up, ready for sale, sometime in May 2017.
- There had been manufacturing problems and health issues as described above.
- There was at least 1 sale (on 11 July 2017) albeit it appears to have been a test purchase by LLL the via eBay. There is mention of another sale (the first sale) in June 2017 via Ms Deayton's website when it went live – but no further evidence is given in relation to this sale.
- The chosen.co.uk website was active (according to Ms Deayton) as was the Facebook page (both on 22 June 2017). The CHOSEN perfume product was also listed on eBay.

- There is a further review on the Facebook page on 27 June, but the year of review is not listed.

34. Some of the Facebook prints are clearly dated within the relevant period. In particular, those that show the cover photo of the Facebook page being updated (on 22 June 2017) to show the CHOSEN perfume product. They also show the name of the page as CHOSEN. It is also clear that the goods were available to purchase on eBay, evidenced not just from the sale that took place in July 2017, but also from the invoice that was issued by eBay. I accept that there is no print showing the eBay listing, but it would be counterintuitive to believe that they did not depict the CHOSEN goods as shown elsewhere in the evidence.

35. Mr Aikens criticised the absence of any dated website prints. However, Ms Deayton is clear in her commentary that this also went live on 22 June 2017 (indeed, she also states that the first sale was made from it in June). I note that in a witness statement provided by Mr Pendered on behalf of LLL, he provides an archive print from 7 June 2017 of the website chosen.co.uk which simply states that the site is under construction, then a further archive from 21 September 2017 which shows an active website featuring the CHOSEN perfume with an option to buy. However, this does not prove that the website was not live in the relevant period because no archive from after 22 June 2017 (but before the end of the relevant period) has been captured from the archive tool. I come to the view that the evidence as a whole paints a picture that the website was indeed live and, again, it would be counterintuitive to believe that it did not feature the CHOSEN perfume.

36. Taking all of the above into account, I come to the view that as of (at the very latest) 22 June 2017, Ms Deayton had placed her goods on the market via her website, eBay and Facebook. A point was taken in terms of timing, being shortly after the contact from Tom Frederikse of Clinton's solicitors. However, I do not regard this as indicative of token use to preserve the registration, or use sooner than would have otherwise have been made. Indeed, the evidence paints the picture that the use was simply the culmination of a long process to get the product to market. Even though the number of sales evidenced is extremely low, the nature of the use is consistent with an attempt to create a market share.

37. Mr Aikens compared the number of sales made of CHOSEN (1 or 2 sales) with the number of sales made of a perfume called TWINKLE (24 unit sales) referred to in an earlier decision of mine⁴ in which I revoked the registration. However, in that case, the other relevant factor was the nature/purpose of the use, which counted against the proprietor. Here, the nature of use is consistent with an attempt to create a market share.

38. I accept that not all commercial use of a mark is sufficient to constitute genuine use. Very low sales may, in some circumstances, present a reason for finding that no genuine use has been made. However, in this case there is good reason for very few sales having been made, that being that the goods had only just been placed on the market. Taking all the relevant factors into account, my finding is that genuine use has been made. Ms Deayton has made actual use of the mark. It is not token use. It is use consistent with the essential distinguishing function and represents, in my view, real commercial exploitation of the mark, albeit on a low level.

39. Having found that use has been made in the section 46(1)(b) period, the absence of any use in the section 46(1)(a) period is saved by the commencement of use under section 46(3) of the Act. In that respect, I note the further provision in that section of the act which specifies that commencement of use in:

“...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”

However, it is clear that preparations for use began well before any contact from LLL, so the commencement of genuine use can be relied upon.

Conclusion

40. The outcome is that Ms Deayton's mark may remain registered and, furthermore, LLL's mark may proceed to registration.

⁴ BL O/738/18

Costs

41. The proceedings represent something of a score draw. In such circumstances neither party will be favoured with an award of costs.

Dated 8 March 2019

Oliver Morris

For the Registrar,

The Comptroller-General