

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for the revocation of the registration of Trade Mark No. 244516 and in the matter of the registered Proprietor's opposition thereto.

STRATHROY DAIRY (ROI)

Applicant for Revocation

GLANBIA IRELAND DESIGNATED ACTIVITY COMPANY

Proprietor

The registered trade mark

1. Glanbia Ireland Designated Activity Company (hereinafter "the Proprietor") of Ballyconra, Ballyragget, Co. Kilkenny, Ireland is the registered Proprietor of the Trade Mark no. 244516 in respect of "*Milk and milk products*" in Class 29.
2. The mark is recorded on the Trade Mark Register as "*The Mark in use will be in the colour RED corresponding with cyan 0, magenta 91, yellow 100, black 23, as applied to the packaging of milk and dairy products*". This description represents the following colour:
 (hereinafter "the Red Mark").
3. The application was filed 15 September 2010 and the publication of the registration of the mark appeared in Journal No. 2170 on 20 July 2011.
4. On 20 April 2020 Strathroy Dairy (ROI) of 6 Bath Avenue Gardens, Sandymount, Dublin 4, Ireland (hereinafter "the Applicant"), made an application for the revocation of the registration pursuant to the provisions of Section 51 of the Trade Marks Act, 1996 ("the Act").
5. The Proprietor filed a Notice of Opposition dated 9 November 2020, an accompanying Statutory Declaration of even date, of Mr Eoin Doyle, Head of

Marketing and Product Management of the Proprietor and six exhibits, labelled “Exhibit 1” to “Exhibit 6”. The Applicant elected to file written submissions in lieu of attending the Hearing. The Proprietor attended the Hearing on 7 July 2021.

6. Acting for the Controller, I decided to revoke the registration in respect of “*milk products*” and to alter the registration in respect of “*milk*” to “*fortified milk, milk enriched with vitamins and minerals*”. In so deciding, I considered carefully all the materials and arguments advanced by both parties and relevant caselaw and precedents. I will refer to these materials as and when appropriate and necessary below.
7. The parties were informed of my decision by way of letter dated 14 July 2021. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Applicant filed on 6 August 2021.

The Application for Revocation

8. The Applicant grounds its application for revocation on the following:
 - i. That within the period of five years following the date of publication of the Registration, the said trade mark was not put to genuine use in the State, by or with the consent of the proprietor in relation to milk products for which the Trade Mark is registered and that there are no proper reasons for non-use. For the purpose of clarity the term 'milk products' include such goods as whey, cream, butter, buttermilk, butteroil, caseins, anhydrous milk fat (AMF), cheese, yogurt, kephir, etc.
 - ii. That use of the Trade Mark in connection with 'milk products' has been suspended for an uninterrupted period of five years prior to the date of the current application and that there are no proper reasons for such non-use.
 - iii. That in consequence of the activity or inactivity by the proprietor, the trade mark has become a common indicator within the trade to designate a kind (type) of milk, goods which are covered by the registration and therefor no longer capable of distinguishing milk originating from the Proprietor from milk originating from other undertakings.

9. The Applicant then claims that the average consumer, who is deemed to be reasonably well informed, reasonably circumspect and observant, identifies types of milk by reference to the colour of its packaging or labels, e.g. dark blue denoting whole milk, light blue denoting, low fat or semi-skimmed milk, pink denoting skimmed milk, etc.

10. The Applicant also claims that the average consumer, identifies types of milk by reference to the colour of bottle caps, and that a red cap on a milk bottle indicates a particular type of milk. In support of this the Applicant attached at Annex 1 a copy of a webpage¹, which lists the following in respect of milk bottle tops:

Republic of Ireland
Blue top - whole milk
Red top - 2% milk
Green top - 1% milk
Pink top - Skim Milk
White top - creamer

11. The Applicant states numerous undertakings use shades of red to indicate their product as being vitamin enriched milk. In support of this it attached at Annex 2, images showing packaging from a number of undertakings² wherein the colour red predominates and indicates the type of milk being offered.

12. In the alternative, and in accordance with Section 51(5) of the Act the Applicant sought partial revocation of the mark by the removal from the specification any goods for which the mark has not been used, and for any goods for which, by virtue of the actions or inactivity of the Proprietor, the mark has become a common indicator in the trade to specify type.

Notice of Opposition

13. In its Notice of Opposition the Proprietor defends its registration on the following grounds:

¹ https://milk.fandom.com/wiki/Milk_Bottle_Top

² TESCO Enriched Low Fat Milk, SPAR Mega Milk, LIDL Xtra Low Fat Milk and Connacht Gold Low Fat Enriched Milk

- i. The Red Mark has been continuously used in Ireland in association with the word marks "Super Milk" and "Avonmore" on milk, particularly vitamin and mineral enriched milk for in excess of 20 years (since as early as the year 1998).
- ii. "Super Milk" enriched milk has been the top selling enriched milk brand in Ireland. According to the most recent market research (AC Nielsen Scan Track September 2020), the "Super Milk" market share of the enriched milk market in Ireland stands at 94%. Therefore, since the Red Mark was registered, it has been continuously used in relation to Ireland's top selling enriched milk, and as a consequence, the Red Mark is exclusively associated with the enriched milk marketed by the Proprietor.
- iii. The Red Mark is exclusively associated with the Proprietor's enriched milk and has not become a common indicator within the trade to designate a kind of milk as a consequence of the activity or inactivity of the Proprietor.
- iv. The Red Mark has been genuinely used in Ireland by the Proprietor within the period of five years prior to the filing of the application for revocation and the grounds for revocation of the Red Mark, as set out in the Statement of Grounds filed by the Applicant on April 20, 2020, have no basis and are incorrect.

14. In his Statutory Declaration Mr Doyle states the Proprietor's best known milk is 'Super Milk' vitamin and mineral enriched milk (with added vitamins B, D, E, folic acid and calcium), which was launched in 1998. Since then it has been sold extensively throughout the State in distinctively designed and coloured packaging, incorporating the Red Mark. It is sold under the house brand 'Avonmore', which is the number one milk brand in Ireland. He attaches at "Exhibit 1" samples of 'Super Milk' packaging and information on the 'Super Milk' product.

15. Mr Doyle states the total sales value of the goods sold / number of units sold in the State under the Red Mark for the past six years is xxxxxx and xxxxxx Litres, with annual turnover as follows:

YEAR	AMOUNT (€ / Litres sold)
2020 [Year to Date]	xxxx
2019	xxxx
2018	xxxx
2017	xxxx
2016	xxxx
2015	xxxx

16. In support of these statements he attaches at "Exhibit 2" samples of invoices evidencing sales of 'Super Milk' in the State for the years 2019 and 2020, and at "Exhibit 3" extracts from the Proprietor's SAP accounting system in respect of four major buyers of 'Super Milk', namely BWG, Dunnes Stores, Musgraves and Tesco.

17. Mr Doyle states that the amount spent on advertising and promotion to make the Red Mark known in the State between 2015 and 2020 is estimated at xxxx, broken down as follows:

YEAR	AMOUNT
2020 (to date)	xxxx
2019	xxxx
2018	xxxx
2017	xxxx
2016	xxxx
2015	xxxx

18. He says the Red Mark has been used on all 'Super Milk' packaging and promotional campaigns and has featured extensively in promotional campaigns, bus and tram advertising, national press, television advertisements, trade publications and in-store demonstrations. The Red Mark has received significant recognition as evidenced by the awards "Super Milk" has won. He attaches at "Exhibit 4" the following material to support these claims:

- Bord Bia Food & Drink winner best brand campaign 2015.

- All Ireland Marketing Awards Advertising campaign award Winner 2018.
- In-store demonstrations held nationwide in Dunnes Stores, Tesco, SuperValu, Mace for the years 2015 – 2020.
- Large in-store space and shelf presence for the years 2015 – 2020.
- Luas advertising 2018 and 2019.
- SuperValu trolley advertisements.
- TV advertisements 2014 -2019 featured on RTE1, RTE2 & Virgin Media stations. Sponsorship of the weather on RTE Television.
- Dublin Bus advertising - 2018 & 2019.
- National press coverage including The Irish Times Magazine, The Irish Daily Star, She Mazing, Irish Independent, Irish Examiner.
- Trade Publications and websites — Shelflife (Irish retail news magazines), Checkout, Adworld.

19. Mr Doyle says he reviewed the milk packs included in "Annex 2" of the Application for Revocation. In his opinion, the colours of the exhibited packs are not the same as the Red Mark, though he concedes there is some similarity between the colours. He says he is not surprised by this because some (but by no means all) milk producers have designed their enriched milk packs to bring to mind the market leading Super Milk product, thereby obtaining advantage from the overwhelming goodwill and reputation that the Super Milk enriched milk enjoys.

20. He states 'Super Milk' is the top selling enriched milk in Ireland and, according to recent market research by AC Nielsen, enjoys an overall approximate market share in enriched milk sales of 94 %. He compared this to an approximate 0.3% market share in the enriched milk market enjoyed by Connacht Gold, for which packaging was exhibited at Annex 2. The adoption of similar "lookalike" packaging by competitors to the market leading brand is a phenomenon that marketers are well aware of, and it is a feature of the Irish and UK retail market for many grocery products, including milk.

21. He contends the reason that the packs at Annex 2 have employed somewhat similar colours to the Red Mark is not so as to denote or designate a particular

kind or type of milk, which the colours do not, but to evoke an association with the Proprietor's 'Super Milk' in the minds of customers. Mr speculates that if use of the Red Mark by the Proprietor were to cease and a different colour brand were to be adopted for Super Milk enriched milk, then those competitors employing similar packaging would most likely follow suit. He claims many businesses do not have budgets for advertising and promotion and therefore follow the market-leader's branding as closely as possible without infringing their trade marks, with the aim of taking advantage of the market-leader's investment in marketing.

22. He attaches at "Exhibit 5" examples of packaging of various vitamin and/or mineral enriched milks sold in Irish retail stores by businesses not using predominantly or substantially red milk packs. The enriched milks include Moovers (with added Vitamin D), Lee Strand (enriched with vitamins D, B, E), Dawn (with added Omega 3), Clonbawn (with added vitamins C, D, B12 and folic acid), Tesco Enriched Whole Milk (with added Vitamin E, Vitamin B2, Folic Acid, Vitamin D), Tesco Enriched Skimmed Milk (enriched with essential vitamins), Avonmore Slimline milk (enriched with iron, folic acid and vitamins C & D).

23. He says these branded milks are sold by major retailers including SuperValu, Centra, Lonsis, Tesco, Dunnes Stores, Lidl and Aldi. The packaging is in various colours such as blue, brown, green, pink and yellow, but not the colour red or showing the Red mark. He says it is noteworthy that the Dawn enriched milk has a market share of 0.3 % (roughly the same as Connacht Gold) but Dawn does not employ packaging that is substantially or predominantly red.

24. He attaches at "Exhibit 6" packaging for "Dawn Fresh Milk" and "Organic For Us" low fat milk. The packaging features the colour red prominently. He says neither of these milks is enriched with added vitamins or minerals. So, if the colour red had become a common indicator of milk type (which he does not accept) then the colour red would not be in use by other businesses to denote non-enriched milk.

25. Mr Doyle states he is not aware of the Red Mark having become a common indicator in the trade to designate a kind or type of milk namely vitamin enriched milk, nor has there been any act or activity by the Proprietor of the Red Mark, which would have led to the Red Mark becoming an indicator of vitamin enriched milk. The Red Mark is exclusive to the Proprietor and is not in use by other producers or sellers of enriched milk. He says the only "act" of the proprietor that may have encouraged some (but by no means all) competitors to introduce somewhat similar colours for their enriched milk is the "act" of being the market leading brand.

26. He then goes on to state the Proprietor has been active in policing use of the Red Mark in relation to packaging used for enriched milk sold by competitors and has objected to use of the Red Mark over the years. The Proprietor's Trade Mark Agents and in-house lawyers have written Cease and Desist letters to Tesco, Lidl and Applegreen amongst others in this regard. The present revocation action was filed in response to a Cease and Desist letter sent to Strathroy containing an objection to its use of the Red Mark on packaging for enriched milk and requesting that it adopt alternative packaging not containing the Red Mark for its vitamin enriched milk.

27. Mr Doyle concludes his Declaration by stating the evidence submitted establishes genuine use in relation to the goods of the registration which are the subject of this revocation action and disproves the Applicant's claim that in consequence of acts or inactivity of the proprietor the Red Mark has become a common indicator in the trade for the registered goods and is no longer capable of distinguishing milk originating from the Proprietor from milk originating from other undertakings.

Written Submissions

28. MacLachlan & Donaldson, acting on behalf of the Applicant, filed written submissions in lieu of attending the Hearing.

29. They say the Proprietor admits the Red Mark is used "... *in association with the word marks 'Super Milk' and 'Avonmore'*" and, as such, consumers are not reliant upon the Red Mark itself to identify the origin of the product. Therefore,

there is a question as to whether consumers would identify the Proprietor as the origin of the product without these additional word marks; or would they simply identify a type of milk?

30. They submit that no claim is made by the Proprietor to use of the mark in relation to "*milk and milk products*", other than use in respect of enriched milk. In this regard they note that Mr Doyle, in paragraph 4 of his Statutory Declaration, admits that the colour is used on a specific type of milk stating, "*The Mark is used on milk, specifically vitamin enriched milk with added vitamins B, D, E, folic acid and calcium*". Further, in the Notice of Opposition the Proprietor states that "*the Mark has been continuously used in relation to Ireland's top selling enriched milk, and as a consequence, the Mark is exclusively associated with the enriched milk marketed by the Proprietor*". Therefore, no evidence of use in respect of the goods covered by the subject registration, i.e. "milk and milk products", other than in respect of enriched milk has been submitted to defend the registration.

31. The Applicant submits that in Paragraph 12 of the Statutory Declaration, Mr Doyle states that "*after examining the colours of the exhibited packs, it is my opinion that the colour shades exhibited are not the same as the Mark*"; then later admits that "*there is some similarity between the colours of the exhibited packs and the Mark*".

32. The Applicant points to the Court of Justice of the European Union (CJEU) decision in *Libertel*³ that colours are normally a simple property of things and that colours and combinations of colours are generally used for their attractive or decorative powers, and do not convey any meaning.

33. The Applicant argues that, in relation to milk, colours are perceived by the relevant public as designating certain characteristics of the goods, not as an indication of origin of such goods. While there is no standardized system among dairies in the State that calls for a certain type of milk to use a specific colour

³ Case C-104/01, *Libertel Groep BV and Benelux-Merkenbureau*

and no compulsion for dairies to use said colours, there is long-established use of colour to indicate a type of milk or to indicate particular characteristics of milk.

34. The Applicant submits that consumers are accustomed to identifying types of milk by colour indicators. It says that, in the State, it is commonly understood by consumers that the colours blue, green, pink, white and red indicate milk with certain characteristics and points to the Proprietor's own use of colours to denote different types of milk, as indicated below:



35. The Applicant submits that the Proprietor's own evidence shows the Red Mark being used on the Proprietor's products, but also shows identical, or similar, marks on the products of its competitors, on the same shelves.

36. The Applicant contends that the Red Mark is used to identify and distinguish the characteristics of one product from products with differing characteristics and does not fulfil the essential function of a trade mark which, according to the CJEU in *Minimax*⁴, "*... is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin*". It argues that since use of the Red Mark does not fulfil the essential function of a trade mark, relevant use of the trade mark has not been made.

The Hearing

37. At the Hearing the Proprietor was represented by Ms Mary Bleahene, Trade Mark Attorney of FRKelly.

⁴ Case C-40/01 *Ansul BV and Ajax Brandbeveiliging BV*

38. Ms Bleahene opened her submission by noting the proceedings at hand are not an invalidity action and that the Red Mark is validly registered for over 10 years.

39. She accepted the Red Mark had not been used on all milk products, or even all types of milk, but it has been used extensively and continuously on packaging for milk with fortifications and/or added vitamins.

40. Ms Bleahene argued that use of the Red Mark in conjunction with other registered marks of the Proprietor (Avonmore, Super Milk) does not diminish the mark.

41. As regards the grounds of the application based on Section 51(1)(c), Ms Bleahene noted it concerns circumstances where the mark “... *in consequence of acts or inactivity of the proprietor, has become the common name in the trade for a product or service for which it is registered.*” She accepted the colour red can act as an indicator but argued it is not a name. She maintained no evidence whatsoever was advanced to suggest that consumers use “Red” instead of the word milk when purchasing that product or that “Red” is an accepted substitute for milk in any setting. Furthermore, the Applicant did not identify any “*acts or inactivity*” the consequences of which resulted in the claimed genericisation of the Proprietor’s Red Mark.

42. Ms Bleahene argued there is no universal or widespread use of the colour red on milk. She contended the mention, on a single website, of red as being an indicator of enriched milk in Ireland is not enough, as this is more than outweighed by the many enriched milk products on sale in Ireland that do not feature the colour red.

43. Ms Bleahene also submitted that the European Union Intellectual Property Office removed 24 colour marks from its register on invalidity basis but has not removed a single colour mark for reasons of it having become generic.

The law

44. The relevant provisions are in Section 51 of the Act, and are written in the following terms:

“(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 publication of the registration, the trade mark has not been put to genuine use in the State, by or with the consent of the proprietor, 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 purposes of subsection (1), use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor and use in the State includes affixing the trade mark to goods or to the packaging of goods in the State solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in paragraph (a) or (b) of subsection (1) 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; but, for this purpose, any such commencement or resumption of use occurring after the expiry of the five year period and 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 Controller or the Court is satisfied that the grounds for revocation existed at an earlier date, that date.

Relevant Period

45. In these proceedings, in light of the publication of the registration of the contested mark on 20 July 2011 and the application for its revocation having been made on 20 April 2020, the period in which the mark must have been put to genuine use is from 20 April 2015 to 19 April 2020, with the period between 20 January 2020 and 19 April 2020 being disregarded if use of the mark had been suspended and resumed during that three-month period.

Issues

46. The questions to be decided are (i) was the mark put to use in the State by the Proprietor or with its consent between 20 April 2015 and 19 April 2020; (ii) if so, was it used in respect of all the goods for which it is registered; (iii) if it was used for some or all of the goods, was it genuine use; and (iv) has the mark become generic in the trade?

Decision

47. I am satisfied the evidence shows that milk bearing the Red Mark was sold to consumers in Ireland within the relevant period. Adequate proof by way of sales invoices, turnover figures, advertising and promotion expenditure was furnished to demonstrate this. So, the first question has been answered in the affirmative.

48. Turning to the second question. The mark is registered in respect of two distinct kinds of goods in Class 29, namely, “*milk*” and “*milk products*”. It could be argued that the former is a subset of the latter and therefore that once use was shown for the latter, it should be deemed to show use for the former. However, the Proprietor in making its application for registration and in listing the goods to be covered by its application in the manner it did, deliberately intended to distinguish one from the other. Accordingly, I must determine whether there was use in none, one, both or a subset of either categories of goods for which the mark is registered.

49. I have already found the contested mark was used during the relevant period in respect of milk. No evidence whatsoever was adduced to prove or even suggest the mark was used in “*milk products* [other than milk]”. In fact, the Proprietor conceded its mark was only used on fortified milk. Accordingly, under Section 51(5) I must revoke the registration in respect of all goods, with the exception or fortified or enriched milk. The effective date of the partial revocation to be the date the Applicant made its application, namely, 20 April 2020.

50. Turning now to the third question of whether the use shown constitutes “genuine use”. The Act does not define the term words “genuine use” of a trade mark for

the purposes of Section 51 but the words have been considered by the Court of Justice of the European Union (CJEU) in *ANSUL*⁵, wherein the Court stated that:

“... there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.”

51. There is ample other judgments emanating from the CJEU to assist me in answering this question. The CJEU has set out what is required in order to establish genuine use of a trade mark insofar as revocation proceedings are concerned. These include *Ansul*⁶, *La Mer*⁷, *Silberquelle*⁸ and *Sunrider*⁹ in which the following factors were identified as the criteria to be assessed by competent authorities:

- i. Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark. (*Ansul* at paragraph 35)
- ii. The use must be more than merely token; which means in this context that it must not serve solely to preserve the rights conferred by the registration. (*Ansul* at paragraph 36)
- iii. The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of

⁵ *Ansul BV v. Ajax Brandbeveiliging BV* (Case No. C-40/01)

⁶ *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439

⁷ *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159

⁸ *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759

⁹ *Sunrider v Office for Harmonisation in the Internal Market* (C-416/04 P) [2006] E.C.R. I-4237

confusion, to distinguish the goods or services from others which have another origin. (Ansul at paragraph 36; Sunrider at paragraph 70; Silberquelle at paragraph 17)

- iv. The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market. (Ansul at paragraphs 37-38; Silberquelle at paragraph 18)
- v. Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. (Ansul at paragraph 39; La Mer at paragraphs 18 and 24-25; Sunrider at paragraph 72)
- vi. All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide. (Ansul at paragraphs 38-39; La Mer at paragraphs 22-23; Sunrider at paragraphs 70-71)

52. It is clear from the foregoing that “genuine use” may be equated with actual use, provided that such use has been more than mere token use and that the use in question has brought the mark to the notice of the relevant class of consumers of the goods for which it is registered. It is not necessary for the purpose of proving genuine use of a mark to establish that the use in question has been continuous or extensive or that it has resulted in the mark becoming well-known to the relevant consumers. It is sufficient to show that the mark has been used as a trade mark for the goods within the relevant period and that it has, as a result, come to the notice of consumers of those goods.

53. I am satisfied the evidence of use submitted in support of maintaining the registration is sufficient to allow me to tick all the boxes identified by the Court. I am satisfied the use made of the mark is consistent with the essential function of

a trade mark and has guaranteed the identity of the origin of the goods as being the Proprietor. Accordingly, it has performed the essential function of a trade mark by serving to distinguish the Proprietor's fortified milk from other fortified milk which has a different origin.

54. Finally, I turn to the question of whether the Red Mark has become generic. The Applicant claims the mark has become a common indicator in trade to designate fortified milk, and that as a result of acts or inactivity by the Proprietor that the mark has become generic. The evidence does not support these claims for a number of reasons.

55. Firstly, there does not appear to be a standard for the use of colour on different types of milk in Ireland. The parties submitted evidence to support their opposing positions on this, which simply proves the point. Secondly, the Proprietor claims to have been the first to use the colour red on enriched milk – a claim not disputed by the Applicant, and I have no reason to doubt it. Thirdly, it is common for competitors to imitate the features of market-leading products (sometimes blurring the line between healthy competition and trade mark / copyright infringement), and I am satisfied that, due to the Proprietor's stature in the market, it is likely to be mimicked in the trade.

56. Fourthly, unchallenged mimicry is not considered grounds for revocation under Section 51(1)(c) if there is a question of infringement. The CJEU was clear on this when in *Levi Strauss*¹⁰ it had this to say:

“Article 12(2)(a) of Directive 89/104 provides that a trade mark is liable to revocation if, after the date on which it was registered, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered. Thus, by balancing the interests of the proprietor against those of his competitors in the availability of signs, the legislator considered, in adopting this provision, that the loss of that mark's distinctive character can be relied on against the proprietor thereof only where that loss is due to his action or inaction. Therefore, as long as this is not the case, and particularly when the loss of the distinctive character is linked to the activity of a third party using a sign which infringes the mark, the proprietor must continue to enjoy protection.”
(my emphasis)

¹⁰ *Levi Strauss & Co. v Casucci SpA*, Case C-145/05

57. But the Proprietor does not have to rely on this ruling as Mr Doyle made it clear in his Statutory Declaration that the Proprietor polices the use of its Red Mark and had issued a number of “cease and desist” letters to its competitors (Tesco, Lidl, Applegreen and unnamed others). Furthermore, he says this revocation action was filed in direct response to the Proprietor’s attempt to get the Applicant to cease using the Proprietor’s Red Mark on the Applicant’s enriched milk. The Applicant did not dispute this. In any event, I am satisfied the Proprietor did take action to protect its registration and did not allow its mark to be used by competitors or behave in a manner that would bring the provisions of Section 51(1)(c) into play.

58. Lastly, there is no evidence to suggest consumers substitute “red” for “milk” when purchasing or referring to milk. Therefore, I am satisfied the Proprietor’s Red Mark has not become the common name for the goods.

59. Accordingly, I have decided to reject the application for revocation and to allow the registration to remain on the Register in respect of the goods for which use has been proven, namely, fortified and enriched milk.

60. In summary, I have decided to revoke the registration in respect of “*milk products*” and to restrict the registration in respect of “*milk*” by altering it to read “*fortified milk, milk enriched with vitamins and minerals*”.

Dermot Doyle

Acting for the Controller

8 September, 2021