

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION No 1006509
IN THE NAME OF PAISANO PUBLICATIONS INC**

AND

**IN THE MATTER OF AN APPLICATION FOR REVOCATION
THERE TO UNDER No 9624 BY THE H.D. LEE COMPANY INC**

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BACKGROUND

1. On 16 June 1997, The H.D. Lee Company Inc of Wilmington, Delaware, United States of America applied to revoke registration No 1006509 standing in the name of Paisano Publications Inc. The registration is in respect of the trade mark **EASY RIDERS** and is registered for a specification of goods which reads:

“Articles of outer clothing, shirts and blouses, none being for cyclists, motor cyclists or for horse riders; and not including boots, shoes, slippers or sandals, or any goods of the same description as any of these excluded goods”.

2. The registration was filed on 13 February 1973 and the registration procedure completed on 4 March 1974.

3. The applicants for revocation express the basis of their attack in the following terms:

“The applicant has conducted thorough investigations of the trade, sales outlets and professional bodies in an effort to establish whether the subject mark is known or in use. As a result of such investigations, the applicant can find no evidence of any genuine use having been made by the proprietor or with his consent in the United Kingdom in relation to the goods for which the subject mark is registered. This is for the period during the last five years prior to three months before the date of this application under the provisions of Section 46(1)(a) of the Act”.

4. On 26 September 1997 the registered proprietors filed Form TM8 and counterstatement together with evidence of use of the mark.

5. Both sides ask for the Registrar to award costs in their favour. Both sides filed evidence. The matter came to be heard on 11 June 2001. The applicants for revocation were represented by Ms Anna Carboni of Linklaters, Solicitors. The registered proprietors were represented by Mr Hornby of Clifford Chance, Solicitors.

REGISTERED PROPRIETORS' EVIDENCE

6. This consists of an affidavit dated 24 September 1997 by Robert Davis. Mr Davis explains that he is the Treasurer and Vice President of Finance at Paisano Publications Inc a position he

has held since 1992. He confirms that he is authorised to make his declaration on the registered proprietors behalf adding that the information comes from either his own personal knowledge or from the records of his company to which he has full access.

7. The following relevant points emerge from Mr Davis' affidavit:

- that the registered proprietors have used the trade mark in the United Kingdom since at least 1988 and that the trade mark has been used continuously since that time;
- that the trade mark has been used in respect of the following goods:

Coats, jackets, shirts, blouses, sweatshirts, T-shirts, vests, tank tops, jumpers, ladies underwear, gents underwear, trousers, nightshirts, baseball caps, bandannas, hats, headbands, scarves, bikinis, leg warmers, boots and shoes, socks, thermal shirts, thermal underwear. Exhibit RD1 consists of a T-shirt and baseball cap on which the EASYRIDERS mark appears;
- exhibit RD2 is said to consist of copies of catalogues showing the EASYRIDERS mark used on the goods the subject of the registration;
- that the registered proprietors approximate turnover of goods sold under the trade mark in the period 1992-1997 was \$32m. Of which, sales in the United Kingdom constituted approximately 5% i.e. \$1.6m;
- that goods sold under the trade mark in the United Kingdom are promoted by placing advertisements in its EASYRIDERS magazine and by producing catalogues illustrating the range of goods available. The mark is also promoted on the registered proprietors' web site from which customers in the United Kingdom can order goods sold under the trade mark directly from the registered proprietors. Exhibit RD3 consists of examples of pages from the registered proprietors' web site and advertisements from the EASYRIDERS magazine.

APPLICANTS' EVIDENCE

8. This consists of two statutory declarations. The first dated 10 March 1998 is by Sharon Beard. Ms Beard explains that she is the Company Secretary of The H.D. Lee Company Inc a position she has held since 1993. She adds that she is authorised to speak on the applicants behalf. The information in her declaration comes either from her personal knowledge or from the records of the applicants to which she has full access. Ms Beard states that she is familiar with the methods used by clothing manufacturers and traders to market, advertise and promote their merchandise.

9. The following relevant points emerge from Ms Beard's declaration:

- that having reviewed the evidence provided by Mr Davis of the registered proprietors, it does not, in Ms Beard's view, provide any evidence that the mark EASYRIDERS has been put to genuine use in the United Kingdom in relation to clothing;

- that the sales figures that have been provided are for EASYRIDERS products in general. In Ms Beard's view the registered proprietors trade mainly in motorcycles, motorcycle accessories, magazines and other goods as well as clothing. There is, in her view, no evidence to indicate whether any of the claimed sales under the EASYRIDERS mark in the United Kingdom are in respect of clothing, adding that not one order or invoice evidencing a single sale of clothing bearing the EASYRIDERS mark to a customer in the United Kingdom has been provided;
- that in Ms Beard's view there is no evidence of any intention on the registered proprietors part to make available actual items of clothing bearing the EASYRIDERS mark to customers in the United Kingdom. She comments that in this respect she can find nothing more specific or deliberate than the setting up of an Internet web site in the United States which can also be accessed from other countries and the distribution of a United States motorcycle publication which contains advertisements for clothing which can be purchased in the United States.

10. The second declaration dated 6 March 1998 is by Jacqueline Lake. Ms Lake explains that she is a Director of Farncombe International Ltd who are a firm of commercial investigators based in Worthing, West Sussex. Ms Lake explains that in May 1997 she was instructed by Linklaters & Paines to conduct an investigation into use of the trade mark EASYRIDERS by the registered proprietors in the United Kingdom. If the mark was found to be in use, Ms Lake explains that she was instructed to determine the range of products to which it was applied and if it was not in use, she was instructed to establish whether any use had been made of the mark during the past five years.

11. The following relevant points emerge from Ms Lake's declaration:

- the registered proprietors' offices in the United States was contacted by telephone. The female receptionist and another female colleague (the latter of which worked in the registered proprietors' EASYRIDERS department) when asked whether the company operated outside of the United States, said that they did not think so;
- that an employee in the Franchise Development Department called Alison told Ms Lake that there were currently twenty six EASYRIDERS stores operating in the United States. That the only EASYRIDERS store outside the United States was in Canada;
- when asked whether the company published any EASYRIDERS books or magazines, Alison told Ms Lake that the company published the EASYRIDERS magazine, which was the world's largest selling motorcycle magazine. Ms Lake was told that the magazine was published in five languages and distributed worldwide;
- that Ms Lake purchased a copy of the June 1997 edition of the EASYRIDERS magazine from a local newsagent. A copy of the magazine is provided as exhibit JML1;

- Ms Lake comments on a number of the entries in the magazine, essentially drawing the conclusion that both the magazine and the supplement were published in the United States and that all references in the publications are to American or Canadian places, people and events. She adds that in all the advertisements, the contact details provided relate to the United States or Canada;
- that on page 116 of the publication there is a list of names and addresses of EASYRIDERS international sales representatives. In so far as the United Kingdom is concerned, Mr David Kitchener of David Kitchener Associates of Brentwood, Essex is named as the Advertising Sales Representatives and Mr John Williams of Innovations Licensing of London is named in the context of Licensing and Franchise Stores;
- Ms Lake explains that contact was subsequently made with Ms Jenny Smith of Innovation Licensing. Ms Smith confirmed, says Ms Lake, that EASYRIDERS merchandising was not as yet available in the United Kingdom, nor was it possible to obtain the goods by mail order;
- Ms Lake concludes her declaration in the following terms:

“I can confirm that I could find no evidence whatsoever that clothing bearing the registered proprietors’ EASYRIDERS mark is available for purchase in the UK”.

REGISTERED PROPRIETORS’ FURTHER EVIDENCE

12. This consists of a further affidavit dated 14 December 1998 by the same Robert Davis mentioned above. Mr Davis makes the following points:

- that for the avoidance of doubt, Mr Davis confirms that his company has used the trade mark in the United Kingdom in relation to the goods falling within the specification of the registration in suit during the period of five years prior to the filing of the application for revocation;
- Mr Davis confirms that the annual turnover of his company in relation to the goods in the United Kingdom under the trade mark in the period 1992-1998 amounted to some \$700k. Exhibit RD1 says Mr Davis consists of copies of invoices and shipping documents, (together with a copy catalogue which identifies the style numbers referred to in the invoices) which relate to the sales of the goods under the trade mark exported by his company from the United States to customers in the United Kingdom during the five year period prior to the date of the filing of the application for revocation;
- that the company’s web site can also be accessed by potential customers in the United Kingdom and that its web site has been accessed by approximately 50 customers from the United Kingdom in the period since June 1997;
- that the company produced catalogues illustrating the range of goods for sale under the trade mark for each of the years from 1990 to 1998 and that these catalogues have been circulated in the United Kingdom during the five year period prior to the date of

the filing of the application for revocation. Copies of these catalogues are provided as exhibit RD2;

- that his company produces a special edition of its magazine sold under the trade mark designed for circulation in the United Kingdom. That exhibit RD3 consists of advertisements that were placed by his company in the United Kingdom edition of its magazine advertising for sale by mail order the goods under the trade mark;
- that his company uses the trade mark by placing it on name tags, neck and woven labels to be attached to goods sold under the trade mark. Exhibit RD4 consists of photocopies of such labels.

APPLICANTS' EVIDENCE IN REPLY

13. This consists of a statutory declaration dated 15 June 1999 by Mary Wotring. Ms Wotring explains that she is the Secretary of The H.D.Lee Company Inc for whom she has worked since 1979. She states that she is authorised to speak for the applicants in these proceedings adding that the information in her declaration comes either from her own knowledge or from the records of her company to which she has full access.

14. Having read Mr Davis' second affidavit, Ms Wotring makes the following points:

- that in so far as exhibit RD1 is concerned, there is no indication that all the items listed bore the mark EASYRIDERS. That in so far as the invoices relate to goods sold under the EASYRIDERS mark, these are only in relation to videotapes, calendars and wallets;
- that the evidence relating to the registered proprietors' website is not relevant as it is after the material date in these proceedings;
- that in so far as exhibits RD2 and RD3 are concerned, Ms Wotring comments that she does not see any evidence in these exhibits that goods bearing the trade mark the subject of the registration have been available to customers in the United Kingdom. In Ms Wotring's view the documents in the exhibit seem only to refer to goods offered for sale to customers in the United States.

15. That concludes my review of the evidence in so far as I think it necessary.

DECISION

16. In her skeleton arguments, Ms Carboni noted that the only remaining ground of objection should have referred to Section 46(1)(b) of the Act and not Section 46(1)(a) as indicated. At the Hearing Mr Hornby confirmed that he did not intend to object to this clarification.

Section 46(1)(b) of the Act reads as follows:

“46. —(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;”

17. Where the registered proprietor claims that there has been use of the trade mark, the Act makes it clear that the onus of showing use rests with them. Section 100 of the Act reads as follows:

“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 these proceedings the relevant period has been explicitly specified and is the five year period ending three months prior to the date of the application for revocation ie. 17 March 1992 to 16 March 1997. In considering the matter, I rely upon the comments of Jacob J in *Euromarket Designs Incorporated v Peters and another* [2000] All ER (D) 1050 (the *Crate & Barrel* case) where he said:

“It seems to me that "genuine use" must involve that which a trader or consumer would regard as a real or genuine trade in this country. This involves quantity as well as the nature of the use. In part it is a question of degree and there may be cases on the borderline. If that were not so, if Miss Vitoria were right, a single advertisement intended for local consumption in just one US city in a journal which happened to have a tiny UK distribution would be enough to save a trade mark monopoly in this country. Yet the advertisement would not be "sham." This to my mind shows that Miss Vitoria's gloss on the meaning of "genuine" is not enough. And the only stopping place after that is real trade in this country”.

19. Mr Hornby contended that there had been use of the mark in the context of both offers for sale and actual sales of the goods the subject of the registration within the relevant period.

20. In so far as the offers for sale were concerned, Mr Hornby took me to exhibit RD2 of Mr Davis's second affidavit (dated December 1998) and drew my attention to the range of goods

offered for sale in a number of the registered proprietors' publications. These were the 1992 and 1993 publications entitled EASYRIDERS COLLECTION and EASYRIDERS CATALOGUE and the EASYRIDERS ROADWEAR catalogue. In the course of his analysis, Mr Hornby identified the following goods as being offered for sale: "T-Shirts, baby dolls, caps, berets, bandanas, tube tops, scarves, sweatshirts, snap tops, nightshirts, denim jackets, shirts". Mr Hornby asked me to note that each of these publications mentioned contained a reference to overseas orders and specific telephone/facsimile numbers in the United States were provided for this purpose. Thus in Mr Hornby's view, customers in the United Kingdom could order goods from the catalogues using either of these numbers.

21. In relation to the actual sales of goods, Mr Hornby took me to exhibit RD1 to Mr Davis's affidavit of 1998 and the customer listing and invoices attached thereto. He then sought to reconcile various catalogue numbers appearing in the invoices against the goods to which they related by reference to the publications mentioned above. I do not propose to summarise Mr Hornby's submissions here, but it would I think be fair to say that Ms Carboni accepted that there had been some use of the mark within the relevant period. At the Hearing she said:

".....I think I have to concede that these invoices are evidence of some clothing items being sold to dealers in the UK and one assumes that at least some of them were onwardly sold to people who came into those shops. I do not think there is any point in my fighting about that. However I would say they all fall within the carve-out of the specification".

22. I will return to what Ms Carboni describes as the "carve out" of the specification later in this decision.

23. In relation to the actual sales of goods Mr Hornby commented as follows:

"Sir, of course, these are invoices to shops. Those are not the only sales that were being made. You have seen from the catalogues that people were being invited to purchase directly. You have also seen the evidence that there is a website through which you can order goods as well. There are additional sales and we have not got invoices for all those different transactions. We have the ones for the stores that I have shown you".

24. For the applicants, Ms Carboni observed that in relation to the offers for sale, the registered proprietors were relying on use of their trade mark in three different publications, namely: the EASYRIDERS magazine; the EASYRIDERS catalogue (which includes a wide range of goods); and the ROADWEAR catalogue. While Ms Carboni conceded that it was possible to purchase the registered proprietors' EASYRIDERS magazine in the United Kingdom, this was in her view quite clearly a magazine dedicated to motorcycling. Any reference to the sale of clothing in the magazine was she felt insignificant. Ms Carboni added that in so far as the registered proprietors have filed copies of the EASYRIDERS magazine in

these proceedings (and in so far as they fall within the relevant period), the same comments would apply.

25. In respect of the circulation of the two other publications mentioned, this was, in Ms Carboni's view, less easy to determine. In her opinion the registered proprietors' EASYRIDERS catalogue was, probably, only distributed to a small number of motorcycle dealers in the United Kingdom. She found support for this contention by reference to two of the invoices exhibited by Mr Davis at RD1. Ms Carboni noted that the invoices dated 12 May 1993 and 26 October 1993 both to Surrey Harley Davidson contained references to respectively: "30 93/SP C-Counter Copy - No Charge Catalogs" and "50 Catalog Winter 94 Counter", the latter at a cost of £0.50p each. While Ms Carboni accepted that catalogues may have been made available to other motorcycle dealers, it was in her view most unlikely that the circulation of the publication was more widespread. In relation to the ROADWEAR catalogue, Ms Carboni noted that there was no specific information as to how this publication was circulated (although I note from the declaration of Ms Lake that the ROADWEAR catalogue appears to be provided as a supplement to the EASYRIDERS magazine).

26. In relation to the actual sale of goods mentioned by Mr Hornby, Ms Carboni commented that in her view it would appear that the goods that had been sold and for which invoices have been provided, had been sold almost exclusively through motorcycle dealers. Ms Carboni reached this conclusion on the basis of the names which appeared in the invoices to whom the registered proprietors had sent goods bearing the trade mark, for example, Surrey Harley Davidson, Ago's Harleys, Harley Trading Post, Pendragon Motor Group etc. Ms Carboni also noted that a significant number of the invoices provided were either before or after the relevant period in these proceedings. In connection with the turnover figures provided by the registered proprietors, Ms Carboni questioned the figure of "not less than \$100,000" appearing as it does for each year. In her view it seemed to be "a sort of a guess" and was not supported by the invoices provided. In response to this criticism, Mr Hornby explained that the registered proprietors had provided a conservative estimate. At the Hearing he said:

"He has chosen a conservative figure and said "I'm greater than that".

27. In so far as the registered proprietors claim to have used their mark in connection with their web site, Ms Carboni correctly pointed out that this use (dated as it is July 1997) was after the relevant period in these proceedings. Ms Carboni also correctly noted that the reference by Mr Davis to 50 customers visiting the website from June 1997 was not only outside the relevant period but was not evidence that anything was actually bought as a result of these visits. In the circumstances, I do not think the registered proprietors use of their mark on their website can in the circumstances of this case assist them.

28. In summary Ms Carboni concluded that even if the registered proprietors were considered to have used their mark EASYRIDERS within the relevant period, any use they may have made of the mark was in relation to articles of clothing for motorcyclists and as such was not

use sufficient to preserve the registration on any basis, as such goods were specifically excluded from the registration by the inclusion in the specification of the words “none being for cyclists, for motor cyclists or for horse riders”.

29. At the Hearing I asked both Ms Carboni and Mr Hornby how in their view the exclusion appearing in the specification of goods should be interpreted. Not surprisingly they took different views. Ms Carboni said:

“One has to take a common sense reading of it and I would say it means excluded from the specification are items which are primarily aimed at the motorcyclist, cyclist or horse rider consumer. I would say that those are items that one would normally expect to buy in a biker shop or through a biker magazine or through a biker website”.

30. Whilst Mr Hornby said:

“.....When it says “none being for cyclists, motorcyclists or horse riders”, one has to give that a purposive construction. It cannot possibly mean that because I go out and ride a horse that any items of clothing that I buy are thereby excluded. That would be perverse, in my submission. What you have got to say is: are these of the types of goods which are used for the cycling, motor cycling or horse riding purpose”.

31. Having considered the respective parties submissions in the light of the evidence filed, it appears to me that I need to answer three questions in order to come to the correct conclusion in these proceedings. These three questions are:

are the offers for sale alone sufficient to maintain the registration and if so for what range of goods? If not,

what actual use have the registered proprietors made of the trade mark EASYRIDERS within the relevant period and is this use sufficient to maintain the registration on any basis?

how should the phrase “none being for cyclists, motor cyclists or for horse riders” included in the specification be construed?

32. The following is an extract from the headnotes of the ELLE trade mark case [1997] FSR 529.

“(3). The offer for sale of cosmetics branded ELLE in the United Kingdom through foreign editions of the plaintiff’s magazine would not fail to qualify for the purposes of

section 46 by reason of the fact that there was no evidence of actual sales during the relevant period. Although it was fairly near the borderline, it could constitute genuine use within the United Kingdom of the mark in relation to a trade in goods within the relevant class”.

33. In the MINERVA trade mark case (2000 FSR at page 734) Mr Justice Jacob made the following comments:

“Neuberger J.’s attention was not drawn to the decision of Laddie J. in the Mercury Communications Ltd v Mercury Interactive (UK) LtdLaddie J. was concerned with a very wide specification of goods: “computer programs”. In rejecting an application for summary judgement, he took the view that the wide specification could be cut down by a non use attack. In other words, that “computer programs” could be limited to computer programs of a particular part.

I have no doubt that what Laddie J. assumed was right and in this respect I differ from Neuberger J. The problem is that some of the language for specifications of goods is apt to be extremely wide. Indeed, “printed matter” in this case is extremely wide. I think it inevitable that at times one would have to “dig deeper”. Even taking the specification considered by Neuberger J. for a “domestic container”, one can think of quite different sorts of domestic container: a hat box, a snuff box, a jewellery box, a plastic thing you put inside the fridge. Wide words can cover what are commercially quite different sorts of articles. So if one were to show use for just one of that sort, it would be commercially nonsense to maintain the registration for all goods caused by the wide words.

That is not to say the court will cut the registration right down to things like red tea caddies. But if non use in respect of a significant subset of a wide general description is established, then I see no reason why the court should not eliminate that subset from the registration. Thus here I think that, although use in relation to printed stationery is established, stationery is a quite different sort of material from literary publications of the kind put out by Reed and the specification can be cut down.”

34. Mr Justice Jacob’s views were supported by Mr Justice Pumfrey in DECON LABORATORIES v FRED BAKER SCIENTIFIC LTD [2001] RPC 293. From the ELLE trade mark case, it would appear that the offering of goods for sale in a publication even where there is no evidence of actual sales may be considered sufficient to constitute genuine use of a mark in relation to a trade in goods. Clearly the registered proprietors here are in a better position. There is evidence that during the relevant period they actually sold goods under the mark in the United Kingdom. That being the case, why then do they also seek to rely on offers for sale? In my view it may be because the evidence of sales provided in the various invoices only demonstrates actual use of the mark in relation to a more limited range of goods than were actually offered for sale.

35. Regardless, as mentioned above, the evidence establishes that during the relevant period the registered proprietors offered for sale a range of goods in their EASYRIDERS and ROADWEAR catalogues and in addition made actual sales of goods bearing the EASYRIDERS mark. Ms Carboni argued that there was no clear indication of the circulation of these catalogues and speculated that in so far as the EASYRIDERS catalogue was concerned that this was (at best) only sent to a small number of specialist motorcycle dealers. That may be true. Nevertheless, in view of the guidance provided in the ELLE trade mark case, it is my view that these offers for sale ought to be considered sufficient to allow the registered proprietors to maintain their registration on some basis (subject of course to the comments in the EUROMARKET DESIGNS INCORPORATED and MINERVA trade mark case).

36. In so far as actual sales of the goods are concerned Ms Carboni's comments mentioned above are relevant. Of the invoices provided, it would appear that a number are either before or after the relevant period in these proceedings. Of the remaining invoices which do relate to the relevant period, a significant number of the individual items listed in the invoices refer to goods which are not proper to Class 25. That said, there are still a substantial number of invoices which remain which refer to goods covered by the registration.

37. Ms Carboni contended that even if I was to determine that the registered proprietors had made use of their EASYRIDERS mark within the relevant period, none of this use could assist them as it all fell within the exclusion "none being for cyclists, for motor cyclists or for horse riders".

38. This brings me to my third question. It seems to me that the sort of clothing a motorcyclist would wear would be to protect themselves against accident or injury and would therefore be protective clothing proper to Class 9 and not Class 25. However, there may still be goods proper to Class 25 which whilst not for protection against accident or injury may still be particularly suitable for use by a motorcyclist. At the Hearing Mr Hornby suggested, leather jackets as an example. Another example might be a waterproof suit which a motorcyclist could wear to keep themselves dry. In the light of this and bearing in mind the comments of the parties reproduced above as to how the exclusion appearing in the specification should be construed, it is Mr Hornby's interpretation, namely: "are these of the types of goods which are used for the cycling, motor cycling or horse riding purpose" that I think is correct.

39. In reaching this conclusion, it seems to me that simply targeting an article of clothing at a particular market (in this case motorcyclists) does not of itself mean that that article of clothing is to be used for the purposes of motorcycling. A T-shirt for example is a T-shirt regardless of the imagery it may carry or the audience to which it is directed. The clothing on which the registered proprietors have used their mark are what one might loosely call "lifestyle" goods. While they may clearly be aimed at the motorcycling fraternity, it is quite likely that they would also appeal to a cross-section of the public. I do not accept Ms Carboni's comments that simply because goods are "..... primarily aimed at the motorcyclist,

cyclist or horse rider consumer” means that they fall within the exclusion indicated. In my view to fall within this exclusion, the goods would need to be especially suited or adapted for use whilst motorcycling. In my opinion the goods on which the registered proprietors have used their EASYRIDERS mark do not fall into this category.

40. In summary, given the existence of the various publications mentioned together with the actual sales of goods during the relevant period, I am satisfied that the registered proprietors have used their EASYRIDERS trade mark for goods albeit only in respect of “T-Shirts, tops for women, caps, berets, bandanas, scarves, sweatshirts, nightshirts, denim jackets, shirts”. As a consequence the specification for which the mark is registered must be limited accordingly. I therefore find that the application for revocation is successful, in part, and under the provisions of Section 46(5) order that the registration be revoked accordingly. The specification for which the mark should remain registered is shown below:

“T-Shirts, tops for women, caps, berets, bandanas, scarves, sweatshirts, nightshirts, denim jackets, shirts, none being for cyclists, motor cyclists or for horse riders; and not including boots, shoes, slippers or sandals, or any goods of the same description as any of these excluded goods”.

41. Such amendment to take effect (under the provisions of Section 46(6)(a)) from the date of the application for revocation ie. 16 June 1997. In determining that specification I have taken no view on whether the second exclusion is still relevant. Boots, shoes, slippers or sandals are not now in the specification of goods and it is likely that goods of the same description are not there either.

42. The application for revocation has been successful and the applicants are therefore entitled to a contribution towards their costs. At the Hearing Ms Carboni asked me to consider the nature of the registered proprietors’ evidence, a significant proportion of which, was in her view either repetitive or outside the relevant period in these proceedings. In response, Mr Hornby pointed out that the brochures and catalogues had featured in the Hearing and asked me to bear this in mind when making any award. Ms Carboni is of course correct that some of the exhibits to Mr Davis’s affidavits were duplicated and it is also true that a number of the invoices provided were not relevant. However as already mentioned in decisions in respect of associated proceedings between the parties, these proceedings began some time ago. I would hope that in this post Woolf era, evidence filed in proceedings such as these will in future be more focussed and attention paid to its relevance to the proceedings.

However, in the circumstances of this case, I do not propose to make an award of costs outwith the scale and order the registered proprietors to pay to the applicants the sum of **£850** as a contribution towards their costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13 day of November 2001

M KNIGHT

For the Registrar

The Comptroller General