

O-003-08

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NOS 82347, 82357 & 82358
BY ARCANDOR AG (PREVIOUSLY KARSTADT QUELLE AG) FOR
REVOCATION OF
REGISTRATION NOS 2170818A, 2170818B & 2208079 STANDING IN THE
NAME OF PRO ACE INTERNATIONAL CORPORATION

TRADE MARKS ACT 1994



**IN THE MATTER OF Application Nos 82347, 82357 & 82358
By Arcandor AG (previously Karstadt Quelle AG)
For Revocation of Registrations 2170818A, 2170818B & 2208079
Standing in the name of Pro Ace International Corporation**

BACKGROUND

1. The three registrations the subject of this action all stand in the name of Pro Ace International Corporation and are all registered for identical goods, namely:

“Class 28 - Sporting articles; racquets; strings and grips, all for racquets; articles for playing golf; golfing apparatus; golf clubs; golf heads; golf shafts; golf grips; golf bags; wheeled golf bags; golf trolleys; golfing accessories; golf gloves; golf tees and markers; fitted covers for golf bags and/or clubs; balls for games and/or sports; shuttlecocks.”

2. The three marks are reproduced below:

2170818A	PRO ACE
2208079	
2170818B	

3. On 7 December 2005 Arcandor AG (previously Karstadt Quelle AG) applied for revocation of the three registrations under Section 46(1)(b) of the Trade Marks Act 1994 (“the Act”). The five year period in which non-use is claimed is the five year period preceding the filing of the application for revocation. Although not expressly stated, I have taken the claim to relate to all the goods covered by the registrations.

4. The registered proprietor filed counterstatements in which it denied the claim to non-use. The registered proprietor asks for the revocations to be dismissed and for awards of costs to be made in its favour. Both parties filed evidence in the proceedings; this is summarised below.

5. The matter came to be heard before me on 13th December 2007. The applicant was represented by Mr M Edenborough of Counsel instructed by Lovells LLP and the registered proprietor by Mr M Stacey of Baron & Warren.

6. Prior to the hearing taking place the Registrar wrote to the parties to suggest that the three cases be consolidated. No objections have been raised. I confirm, therefore, that the cases have now been consolidated.

7. I should also say at this point that the grounds for revocation, the counterstatement and both sides' evidence deal in part with issues relating to the use of the applicant's mark in the German market and the relationship between the applicant and the registered proprietor therein. This does not appear germane to the issue here which is whether the registered proprietor has used its marks in the UK market. I will say nothing about these other issues in this decision.

EVIDENCE

8. It should be noted that since the filing of both sides' evidence the three registrations were assigned from ACE SPORTS SUPPLY LTD ("ASSL") to PRO ACE INTERNATIONAL CORP. The evidence therefore focuses on the use made by ASSL. Nothing turns on this

Registered proprietor's evidence (Rule 31(3))

Witness statement of Irena Maria Kantor & Exhibits IMK1-8

9. As the evidence is in substance the same in each case I will treat it as a single body of evidence. Ms Kantor works for Baron & Warren, the registered proprietor's representative in this matter. She states that her firm has represented ASSL since at least as early as 1999 and that the contents of her witness statement come from her own research, her firm's files or from evidence of use provided by a Mr Peter T.H. Chang, the Managing Director of ASSL.

10. Ms Kantor states that ASSL is a manufacturer of sports equipment including tennis, badminton and squash racquets and also golf equipment. She exhibits at IMK1 an extract from ASSL's website (found at www.proace.com.tw) which provides an overview of the company. Highlighted is a reference to the sale of PRO ACE products through the purchasing groups of chain stores like JJB SPORTS in the UK. The rest of the extract features some of the products that are sold under the PRO ACE sign – all three versions of the mark are included in this material. Two extracts are provided, the fuller extract containing the product information is dated 6 February 2006 (outside the period of alleged non-use), however, a further extract is provided of the front page only which is dated 27 May 2004 (within the relevant period); both extracts contain the reference to JJB on the front page

11. Exhibit IMK2 is then referred to. This consists of a series of orders, invoices, packing lists, landing document etc relating to an order that JJB Sports (the delivery address is in Wigan) placed with ASSL in relation to the purchase of tennis racquets (8000), badminton racquets (4,600) and squash racquets (4,000). Many of these documents refer to the PRO ACE brand of racquet. On the ASSL invoice all three versions of the mark are shown as part of the corporate branding. They are dated in the first half of 2001. Similar documents are also annexed in Exhibit IMK3 relating to orders from JJB Sports in 2001 and in Exhibit IMK4 relating to orders from JJB in 2000.

12. Exhibits IMK5, 6 & 7 focus on JJB Sports whom Ms Kantor describes as ASSL's major UK customer. IMK5 is an extract from JJB's corporate web-site – although the extract is from after the relevant period, Ms Kantor highlights that the extract refers to the fact that in 1994 JJB had 120 stores and at the time of the extract (March 2006) this had increased to 430. The PRO ACE brand is not mentioned at all in this material. IMK6 consists of an extract from JJB's Annual Report (year ending 31 January 2001) and that at this point JJB had 433 stores. This information is provided to show that the orders by JJB referred to above would have been distributed UK wide (given the size of the orders) from its distribution centre in Wigan. IMK6 provides similar information to IMK5 save that this is from the annual report for the year ending 31 January 2002 and at this point JJB had 435 stores.

13. The final exhibit is IMK8 which consists of a copy of a Taiwan registration certificate (and notarised translation) dating from 1983. This is provided to show that the applicant's assertion in paragraph 1 of its statement of reasons (relating to who first used the mark) are false.

Applicant's evidence (Rule 31A(1))

Witness statement of Mr David Allan Latham

14. Mr Latham is from the firm Lovells, the applicant's solicitor in this matter. This witness statement does not contain any evidence of fact relating to the issue of non-use. It is more a critique of the registered proprietor's rule 31(3) evidence. In summary, Mr Latham suggests that the evidence relating to ASSL's web-site should be disregarded as it is not aimed at the UK consumer and that, furthermore, it is not possible to buy goods from it and in any event it is after the relevant date (strictly most of the material is after the date, but an earlier front page has been provided which bears a date that is within the relevant period). The various documents between ASSL and JJB are criticised because they do not cover the full specification as registered, the year 2000 documents are additionally from before the relevant period and that, in any event, they do not amount to genuine use as they do not make reference to the trade marks and there is no evidence that they were distributed throughout the UK or even in the UK at all.

Witness statement of Mr David Allan Latham & Exhibit DAL1

15. Mr Latham's second witness statement is given purely for the introduction into the proceedings (under Exhibit DAL1) of evidence from a Mr Siegfried Despineux, the Unit Manager Golf of Karstadt Warenhaus GmbH a company owned by Karstadt Quelle AG ("Karstadt") the applicant for revocation. Mr Latham explains that Mr Despineux's evidence was sent to the Registrar but it never arrived. I summarise Mr Despineux's evidence below:

Witness statement of Mr Siegfried Despineux and Exhibits SD1-4

16. The first part of Mr Despineux's evidence details the use that Karstadt have made of their PRO ACE mark in the German market. As mentioned in paragraph 7 above, this has no relevance.

17. Of relevance to the proceedings are exhibits SD3 & SD4. These are referred to as "in use" reports conducted by Thompson Compu-mark on behalf of Karstadt. The first report (dated 6 October 2005) concludes that no UK use could be established. The report details various pieces of information. It states that various umbrella organisations in the field of sporting articles were contacted none of whom had heard of PRO ACE or ASSL. A number of companies (presumably specialising in sale of sporting articles) were also contacted. Again, they had no knowledge of ASSL or the trade marks. Reference was made to the ASSL web-site; it states that the web-site refers to products for tennis, badminton and golf but that no information on possible availability in the UK is given. Reference is made to the identification of the trade mark "Epsilon Pro Ace" being sold by a company at "www.sunrisesports.net" but that no link with ASSL could be established. Attempts to contact Sunrise Sports for further information appear to have been fruitless.

18. The second report (SD4) is dated 11 October 2005. It states again that the ASSL web-site refers to the PRO ACE trade mark in relation to tennis, badminton and golf equipment, but now the report identifies that the web-site also has a reference to the distribution in the UK by JJB Sports. The report states that the JJB Sports website has no reference to the trade mark. The report further details that calls were made to some JJB employees. A female customer services employee (who did not give her name) indicated that PRO ACE products are available at some JJB stores and that they are not available elsewhere. An employee at JJB Birkenhead stated that he knew of the PRO ACE tennis and badminton racket but they were not currently in stock. Employees at JJB London New Cross and Reading stated that they did not know of the PRO ACE products. The search report then alters its conclusion to use of the trade mark PRO ACE in the UK can be confirmed.

19. The rest of Mr Despineux evidence is a critique of the registered proprietor's evidence under Rule 31(3) in almost identical terms to the critique given by Mr Latham in his witness statement. I shall not summarise this further.

Registered proprietor's evidence (Rule 31A(3))

Witness statement of Irena Maria Kantor & Exhibits PRO ACE 1 – 6

20. Ms Kantor's second witness statement begins by criticising the evidence of Mr Despineux for much of it being irrelevant to the proceedings but then provides evidence on a similar theme – this is equally irrelevant and I will not summarise this further. Invoices, some of which are for UK destinations, are provided at Exhibit PRO ACE 4, however, these are all from before the relevant period.

21. Some submissions in relation to the "in use" reports are then made. As this is not evidence of fact I shall not summarise this here but will refer to the submissions later in this decision.

22. To counter the lack of knowledge of the PRO ACE brand by the various umbrella organisations, Ms Kantor refers to exhibit PRO ACE 5 which consists of an Equipment Approval Certificate from the International Badminton Federation showing that ASSL's PRO ACE shuttlecock has been approved for international play. Also provided in this exhibit is further information on this organisation which Ms Kantor describes as a prestigious one.

23. Finally, Ms Kantor refers to Exhibit PRO ACE 6 which is in response to the "in use" report focusing on lack of knowledge of the sign in the golf equipment sector. The exhibit consists of an extract from the Ryder Cup Programme 1991 which features an advert for ASSL's Jumbo Driver bearing the PRO ACE mark. It should be noted that the mark is incorporated into a composite sign with other distinctive logo elements. It should also be noted that this is from a period well before the relevant period.

Applicant's evidence (Rule 13A(5))

Witness statement of Mr David Allan Latham & Exhibit DAL2 & 3

24. Much of Mr Latham's final witness statement is, again, submission rather than evidence of fact. The Exhibits he provides are DAL2 which consists of a list of 158 countries that belong to the Badminton World Federation (formerly The International Badminton Federation). Mr Latham points out that the fact that an approval certificate has been issued by the organisation for international play (presumably in any of the 158 countries) does not equate to use in the UK.

25. Exhibit DAL3 is an extract from www.kiawahisland.org which indicates that this location is in South Carolina USA. The relevance of this is that the Ryder Cup programme previously exhibited by Ms Kantor containing the PRO ACE golf club advertisement indicated that the competition was held in Kiawah Island and, as such, is not only outside the UK, but is, in any event, outside the relevant date.

The Law

26. Section 46 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;

(c) that, in consequence of acts or inactivity of the proprietor, it has

become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

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

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

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

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

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

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

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

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

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

27. Section 100 of the Act is also relevant and reads:

“100. 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.”

Relevant five year period

28. The applications for revocation are based on Section 46(1)(b). The five year period is said to be the five year period preceding the date of application for revocation. This makes the relevant period 7 December 2000 to 6 December 2005.

The authorities on genuine use

29. The two leading authorities on the guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);

- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

DECISION

30. In his skeleton argument Mr Stacey indicated that no further defence was to be made in respect of:

“Articles for playing golf; golfing apparatus; golf clubs; golf heads; golf shafts; golf grips; golf bags; wheeled golf bags; golf trolleys; golfing accessories; golf gloves; golf tees and markers; fitted covers for golf bags and/or clubs; balls for games and/or sports.

31. The balance of the specification that the proprietor seeks to retain, and for which it is said use has been shown, covers:

“Sporting articles; racquets; strings and grips, all for racquets; shuttlecocks”.

32. Mr Edenborough, for the applicant for revocation, submitted that the device mark registrations should in any case be revoked totally as should the word mark. In the alternative the word mark registration should be partially revoked to leave a specification of ‘stringed racquets’ to reflect the category of goods sold by the proprietor and so as to exclude items that are not stringed but solid (‘table tennis racquets’ being the example given). In support of those opposing positions the representatives, not surprisingly, invited me to place different constructions on the evidence. I, therefore, turn to the detail of the evidence and the main issues to which it gives rise between the parties.

Genuine Use

33. Exhibits IMK 2 and 3 are central to the proprietor’s case. They consist of a collection of orders, invoices and other documentation relating to orders placed by JJB Sports. There is no question that the orders fall within the relevant period and relate to goods branded PRO ACE (I will return to the precise marks used below). The goods are badminton, tennis and squash racquets. Various invoices have been supplied, some are described as proforma invoices, others as commercial invoices. The latter show goods to the value of US \$63,300, US \$11,300 and US \$162,284 (IMK2) and US \$31,970 (IMK3). These are by no means insignificant sums. That is not altogether surprising given that the customer, JJB Sports, is a major UK retailer with many hundreds of stores in the UK (upwards of 400 during the relevant period).

If further context is required, IMK4 contains similar invoice and related material from just before the relevant period involving goods to the value of in excess of US \$170,000.

34. In *Ansul* terms this evidence is not token use, it is not internal to the undertaking and was with a view to creating or preserving an outlet for the goods. Furthermore *Laboratoire de la Mer* establishes that an act of importation could constitute putting the goods on the market. That case involved orders placed over a six month period with goods amounting to £800 in all. There was no evidence of sales of the goods to the public. The proprietor here is prima facie in a much stronger position than the proprietor in *Laboratoire de la Mer* given the more substantial size of the transactions and the prominent trading position of the customer.

35. However, Mr Edenborough made a number of criticisms of the evidence. Firstly, he said the documentation emanated from the Taiwanese supplier. There was no indication as to what happened at the UK end and JJB Sports had not filed evidence that could have put the matter beyond doubt. He asked rhetorically why a JJB Sports catalogue or such like had not been filed in evidence.

36. It is rare for evidence to be above criticism and it may well have been of advantage to the proprietor to have adduced evidence of that kind. But the material at IMK 2 and 3 is credible evidence of a significant trade with a major UK supplier. It is not entirely surprising that a proprietor will rely primarily on material that it is able to generate internally rather than having to rely on third parties particularly where historical records are required. Furthermore, as Mr Stacey pointed out, both Exhibits IMK 2 and IMK 3 contain bill of lading papers from third party sources that provide an independent reference point on the transactions and identify the UK handling agents.

37. The applicant commissioned an ‘in use’ search report for the UK. Two brief reports were produced on 6 October 2005 and 11 October 2005 both, therefore, the result of enquiries made during the relevant period. The first report failed to establish use in the UK. The second records that a female employee at JJB Sports in Wigan said that “the proprietor’s trade mark PRO ACE is available at some JJB Sports stores in the UK”. Also, “a male employee at JJB Sports, Birkenhead said that he knows the proprietor’s trade mark PRO ACE for tennis and badminton racquets” though they were not in stock at that point in time.

38. Mr Edenborough sought to downplay the significance of these statements on the basis that one of the individuals refused to state her name (not altogether surprising if she got wind of the context in which the enquiry arose) and the other is not named. Having sought and obtained information the applicant is now effectively trying to distance itself from the results of those enquiries when they are not altogether helpful to it. I do not accept that this evidence should be discounted in this way. However, the proprietor’s case on genuine use is not in my view dependent on these statements. There is enough primary evidence to establish its position.

39. A further point that was the subject of submissions relates to whether, on the material before me, it can be said that there has been use in relation to the goods. The issue spills over into the question of the actual marks used that I consider below. For

present purposes the point arises because there are no examples of the goods or their packaging in the form in which they were placed on the market in the UK. The closest one gets is IMK1 which contains extracts from the proprietor's Taiwanese website. This does illustrate the goods but, of course, is open to the criticism that the site is not obviously directed at a UK audience and is in large part taken from a date that is two months outside the relevant timeframe.

40. The Act (and the equivalent provision in the Directive on which the Act is based) does not require a mark to be used on goods (or services), merely 'in relation to' those goods (or services). That wording was no doubt driven in part by the need to cater for services but also allows for the fact that not all goods carry a mark. Nevertheless, a mark may be used 'in relation to' those goods and services.

41. The proprietor here is a supplier of various items of sports equipment. PRO ACE is, in essence, a manufacturer's mark. The invoices and other evidence establish that the words PRO ACE are unquestionably used in relation to the goods. Thus, to take numbered pages 32 and 33 of Exhibit IMK2 as an example, the body of the documents refer to "PRO ACE Brand of Badminton Racquets" and, likewise, tennis and squash racquets. I am satisfied that, even without actual examples of the products, this constitutes use in relation to those goods. I now turn to the more difficult issue of whether the evidence establishes use of the three forms of the basic PRO ACE mark.

The marks used

42. As recorded at the start of this decision there are three forms of the PRO ACE mark. The plain block capitals version that has clearly been used and the two logo versions. Mr Edenborough submitted that the evidence did not establish genuine use of these logo versions bringing the consequence that registration Nos 2208079 and 2170818B should be revoked in their entirety.

43. Evidence as to the marks used on or in relation to the goods can be found in IMK1 which clearly shows both logo versions in use - 'on and in relation to' the goods for No 2208079 (see; for instance numbered pages 22 and 23) and 'in relation to' (but not 'on') No 2170818B (see numbered pages 19 and 21). However, the exhibit is taken from the proprietor's Taiwanese website and is (mainly) dated two months after the end of the relevant period. This latter criticism is partly mitigated by the fact that both logo marks feature prominently on the May 2004 pages that are at the front of the exhibit though this usage is not on the goods themselves. A further point to be taken from IMK1 is that the mark of No 2170818B appears in the heading of the exhibit with the words "Golf and Rackets" beneath it. I note that the same mark is used in relation to the golf club shown in Exhibit PRO ACE 6. The golf club shown on page 12 of Exhibit IMK1 shows the mark of No 2208079. The nature of the use suggests that the marks are used across the range of goods offered. Nevertheless, without further information that this Taiwanese website was also directed at the UK market Exhibit IMK1 cannot in itself satisfy the requirement to show genuine use of the marks in this country.

44. The principal evidence in support of the proprietor's case for retention of the logo marks is again Exhibits IMK2 and 3. In addition to showing clear references to the

words PRO ACE (plain block capital form) in relation to the goods in the body of the documents, the shipping advice letters from Ace Sports Supply Ltd and pro forma invoices show both logo marks in the headings of the document. The same is true of IMK4 but as this is outside the relevant period it is not directly relevant to the proprietor's claim but does go to confirming consistency and stability of the marks used over time.

45. Mr Edenborough submitted that the IMK2 and 3 material merely showed that the logo marks were used generically in relation to the range of products supplied and that it was stretching the natural meaning of the words to say that this was "in relation to the goods". Mr Stacey reminded me that I needed to consider the evidence as a whole and not adopt a piecemeal approach. In the absence of examples of the goods, point of sale material, advertising matter and such like I must make the best I can of the material available to me. I am entitled to draw reasonable inferences from that material but not to indulge in conjecture (see the observations of the Appointed Person in *Corgi Trade Mark*, [1999] R.P.C. 549 referring to *Jones v Great Western Railway Co*, [1930] 144 LT 194).

46. The following seem to me to be the material considerations:

- (i) there is a strong evidence that the proprietor's use of the logo marks is long standing and consistent over time. The Taiwanese website refers to use of PRO ACE since 1978. The UK trade mark applications for the marks in question were made in 1998/9. The invoices etc dealt with above and dating from 2000 and 2001 show the same marks. The 2004 and 2006 Taiwanese website material continues to show the same marks in unchanged format. I do not rely on the latter in isolation but regard it as being supportive of the view that there has been a consistent and stable use of the logo marks in these forms over a lengthy period of time including during the relevant period.
- (ii) IMK1 is also indicative of how the marks are used on and in relation to relevant goods even though it cannot be relied on in itself to establish use in the UK. I bear in mind that PRO ACE (and the logo forms) is in the nature of a manufacturer's house mark and, therefore, likely to be applied in its various forms to the range of goods sold.
- (iii) although there is no direct correlation between the goods shown in IMK1 and the goods that are the subject of the well documented trades in IMK2 and 3, there is good reason to suppose that they are from the same series of goods with similar characteristics in terms of how they are marked. Thus, both IMK1 and IMK2 and 3 show racquets from the T1, Speed and SP series.
- (iv) viewed in the context of the evidence as a whole, the use of the logo marks on the material sent to JJB Sports contained in IMK2 and 3 can, in my view, be said to be in relation to the goods.

47. Taking the evidence in the round I have come to the view that it does establish genuine use of the logo marks as well as the plain words PRO ACE.

What is a fair specification of goods?

48. It is common ground that the proprietor must lose part of its specification in each case. The correct approach to reducing a specification has been considered in a number of cases that have been before the High Court and Court of Appeal. Richard Arnold QC, sitting as the Appointed Person, considered the accumulated authorities in *Nirvana Trade Marks*, BL O/262/06. I gratefully adopt the following propositions that he derived from his consideration of the case law:

- (1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].
- (2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].
- (3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].
- (4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].
- (5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].
- (6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].
- (7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].
- (8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].

49. The golfing goods aside, the items in the specifications that call for consideration are "Sporting articles; racquets; strings and grips, all for racquets; shuttlecocks." The principal submissions related to the specification that was appropriate in the light of use on tennis, badminton and squash racquets. Mr Stacey's initial submission was

that racquets would be known as sporting articles and that this term thus represented a fair specification. I indicated at the hearing that I considered that was far too wide to constitute a fair specification within the terms of the established test and also suffered from the drawback that the term would include the very goods (the golfing items) that it was accepted the proprietor is bound to lose.

50. Mr Stacey's fall-back position was that the specification should be "Sporting articles relating to racquet sports". Mr Edenborough, for the applicant, submitted that it should be "stringed racquets" so as to exclude table tennis racquets and the like. In his submission if the term racquet meant a stringed racquet then there was no unfairness in making explicit what was already implicit. I do not consider either of these opposing positions to be attractive or appropriate. Mr Stacey's proposal would result in a specification that exceeds the interests of the proprietor and would cover, for instance, nets, balls and other paraphernalia of the various racquets sports. It is not how consumers would describe the goods on which use has been shown.

51. At the other end of the spectrum Mr Edenborough's proposal is unduly restrictive and, again, not how the average consumer would describe the goods - cf the Court of First Instance's judgment in *Reckitt Benckiser (España), SL v OHIM, Case T-126/03 (Aladin)* where it was held, in the context of proof of use in an opposition that an appropriate specification was 'polish for metals' rather than a 'product for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton)'. The average consumer faced with use on badminton, squash and tennis racquets would in my view simply refer to them as racquets. I regard this as a natural sub-category of sporting articles and achieves the balance that has to be struck according to criterion (4) above. Mr Edenborough's concern at the risk of unwarranted coverage being given to table tennis racquets seems to me to be flawed as I have always understood the term to be a table tennis bat. A table tennis bat would not fall within the normal meaning of the term racquet which, it appears to be accepted, refers to a stringed item.

52. The next category to consider is 'strings and grips, all for racquets'. I have not been pointed to any use on these goods. Mr Stacey argued for retention on what might be described as a reverse-*Ansul* principle. In that case the ECJ held that:

- “40. Use of the mark may also in certain circumstances be genuine for goods in respect of which it is registered that were sold at one time but are no longer available.
41. That applies, *inter alia*, where the proprietor of the trade mark under which such goods were put on the market sells parts which are integral to the make-up or structure of the goods previously sold, and for which he makes actual use of the same mark under the conditions described in paragraphs 35 to 39 of this judgment. Since the parts are integral to those goods and are sold under the same mark, genuine use of the mark for those parts must be considered to relate to the goods previously sold and to serve to preserve the proprietor's rights in respect of those goods.”

53. The goods being defended were fire extinguishers. The proprietor had ceased selling these goods but maintained a trade in components and repair and maintenance services.

54. There is no evidence of a trade in the ancillary goods here or any indication that such a trade would be a necessary corollary of the sale of racquets. It seems more likely that strings and grips would be a separate area of trade though I have no evidence on the point one way or the other. On the basis of absence of use on these items the proprietor has no compelling case for retention of 'strings and grips, all for racquets' and I do not read *Ansul* as supporting the proposition that a proprietor is necessarily entitled to retain coverage for ancillary goods based on sale of a main product, particularly in circumstances where those ancillary goods have not been shown to form part of a natural follow-on trade.

55. That leaves "shuttlecocks". The case for retention of this item rests entirely on Exhibit PRO ACE 5, this being an equipment approval certificate for a PRO ACE shuttlecock from the International Badminton Federation, a body that has been shown to be active in a large number of countries. There is no evidence of any sale of shuttlecocks under the PRO ACE mark(s) in the UK. There is no basis for defending this item in the specification.

56. In summary, under the terms of Section 46(5) the proprietor will retain each of its registrations but only in respect of 'racquets'. Pursuant to Section 46(6)(a) the registrations will be revoked in respect of all other goods with effect from 7 December 2005.

COSTS

57. The proprietor has had some limited success but the applicant for revocation has succeeded in large measure. I will make an award to cover the three consolidated cases to take account of the fact that separate actions had to be launched; that the evidence was in substance the same in each case; and that the applicant has succeeded to a substantial extent. I order the registered proprietor to pay the applicant the sum of **£2000** by way of a combined award covering the three cases. 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 7th day of January 2008

**M Reynolds
For the Registrar
The Comptroller-General**

