

O-070-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 82859
BY DAIMLER AG
FOR REVOCATION OF TRADE MARK No. 314710
STANDING IN THE NAME OF
WILHELM HAMM GMBH & CO KG**

BACKGROUND

1) The following trade mark is registered in the name of Wilhelm Hamm GmbH & Co KG. (hereinafter the proprietor).

Mark	Number	Registered Date	Class	Specification
MERCEDES	314710	09.03.09	25	Boots, shoes, footwear; leggings and gaiters.

2) By an application dated 30 April 2007, Daimler AG (formerly DaimlerChrysler AG) applied for the revocation of the registration under the provision of Section 46(1)(b) claiming there had been no use of the trade mark in suit in the five years period 26 June 2001 to 25 June 2006, and seeking revocation with effect from 26 June 2006.

3) On 4 September 2007 the proprietor filed a counterstatement denying the allegation of non-use.

4) Both sides filed evidence. Both sides ask for an award of costs. The matter came to be heard on 28 January 2009 when the proprietor was represented by Ms Mensah of Counsel instructed by Messrs D Young & Co. and the applicant was represented by Mr Brandreth of Counsel instructed by Messrs Jensen & Son.

REGISTERED PROPRIETOR'S EVIDENCE

5) The registered proprietor filed a witness statement, dated 31 August 2007 by Peter Toltz the Chief Executive Officer of Manz-Fortuna Schuhfabrik GmbH and also Schuhfabrik Manz GmbH positions he has held since 18 March 1991. The latter company was the proprietor of UK trade mark registration 314710 until it was assigned to Wilhelm Hamm GmbH & Co KG on 24 February 2006. He states that:

“Schuhfabrik Manz GmbH is the mother company, Manz-Fortuna Schuhfabrik GmbH is the production company.”

6) Mr Toltz states that his company was the proprietor of the trade mark registration for the majority of the relevant period. He provides a number of exhibits which are summarised below. In all cases the mark has been used with a capital letter “M” with the remainder of the mark in lower case and with the mark inside an ellipse device.

Exhibit PT-02: Pages from a shoe catalogue dated Winter 2001 which although in German shows a UK agent, Mr Michael Thomas. It shows use of the mark in suit on the front cover and on the last page with the details of its agents.

Exhibit PT-06: As per PT02 but dated Winter 2002.

Exhibit PT-21: As per PT02 but dated Summer 2005.

Exhibit PT-03: As per PT02 but dated Summer 2001. This also shows the mark at the top of each page in the catalogue above the pictures of various types of shoes.

Exhibit PT-07: As per PT03 but dated Summer 2002. This catalogue also shows the mark used alongside socks.

Exhibit PT-09: As per PT03 but dated Winter 2003.

Exhibit PT-10: As per PT02 but dated Winter 2003.

Exhibit PT-15: As per PT03 but dated Winter 2004.

Exhibit PT-16: As per PT03 but dated Summer 2004.

Exhibit PT-20: As per PT03 but dated Winter 2005, the front cover appears to have been torn and so the mark in suit appears only on the inside page.

Exhibit PT-04: A copy of an invoice dated 20 September 2001 to Magnus of Northampton, 2 High St, Harpole, Northampton relating to 59 pairs of shoes at a total cost of 4417.35 Euros. It also shows the agent's name. The invoice has the mark in suit prominently shown in the top right hand corner.

Exhibit PT-05: As per PT04 but dated 20 October 2001 for one pair of shoes valued 60.32 Euros.

Exhibit PT-08: As per PT04 but dated 20 November 2002 for forty-two pairs of shoes valued 2476.76 Euros.

Exhibit PT-11: A copy of an invoice dated 20 May 2003 to David Roberts Ltd in Llandudno for sixteen pairs of shoes valued 1169.90 Euros. The invoice has the mark in suit at the top right hand corner.

Exhibit PT-12: As per PT11 but this time dated 30 July 2003 for three pairs of shoes valued 217.44 Euros

Exhibit PT-17: As per PT11 but dated 20 May 2004 for three pairs of shoes valued 217.44 Euros.

Exhibit PT-18: As per PT11 but dated 30 April 2004 for six pairs of shoes valued 395.28 Euros.

Exhibit PT-23: As per PT11 but dated 20 December 2005 for five pairs of shoes valued 362.40 Euros. In addition to the ellipse containing the mark in suit the word "MERCEDES" is printed across the top of the invoice.

Exhibit PT-13: A copy of a credit note dated 10 December 2003 to Brian Forbes Menswear in Glasgow for 1 pair of shoes valued 45.02 Euros.

Exhibit PT-22: A copy of an invoice dated 20 October 2005 to Brian Forbes Menswear, Glasgow for 1 pair of shoes valued 57.07 Euros. This also has the word "MERCEDES" printed across the top in addition to the device mark with the mark in suit inside.

Exhibit PT-25: A copy of an invoice to Davies Footwear, Llanelli dated 10 April 2006 for two pairs of shoes valued 131.22 Euros. This does not have the ellipse version of the mark but merely the word “MERCEDES” printed across the top of the invoice.

Exhibit PT-14: A copy of an order from the UK agent Michael Thomas, dated 8 October 2003. This are said to be for shoes bearing the trade mark Mercedes but the document does not show the mark in suit.

Exhibit PT-19: A copy of a letter from Manz-Fortuna to Mr Thomas dated 9 October 2003 relating to the sale of 29 pairs of samples shoes at a cost of 798 Euros.

Exhibit PT-24: As per PT19 but dated 10 November 2005. This refers to three pairs of “Mercedes” shoes being supplied valued at 108 Euros. The letter also mentions “Manz” and “Fortuna” shoes being supplied.

APPLICANT’S EVIDENCE

7) The applicant filed a witness statement, dated 25 March 2008, by Patricia Santander, the applicant’s trade mark attorney. She points out that much of the proprietor’s evidence consists of German language catalogues. She also states that she has investigated the commercial activities of the proprietor’s agent Michael Thomas and she states that although he is listed in the online PCDS trade directory he is listed as an agent for a number of shoe brands but not for Mercedes. At exhibit PVS1 she provides a print-out of the directory which is undated, although it does state that it was last updated on 27 November 2006. She continues:

“3. On February 14th 2008, I called the customer services number of Magnus Shoes in Harpole, which is also the company’s head office and asked if they sold or had sold Mercedes branded shoes. I was advised that Magnus used to sell a Mercedes shoe, which was a ladies’ moccasin manufactured by a British company, DB Shoes of Rushden, but that this has been discontinued. I also looked at Magnus shoes website but this does not list any Mercedes shoes.

4. I then contacted Brian Forbes Menswear in Glasgow and asked if they sold Mercedes shoes. Initially, the customer services representative said that they did not stock Mercedes shoes but was then informed me [sic] that they might have a couple of pairs in stock and that they were expecting to obtain a new catalogue in a few weeks.

5. On 25th February 2008, I contacted Davies Footwear in Llanelli and asked if they had Mercedes shoes in stock. The customer advisor apologised and said that they did not have Mercedes shoes.

6. There is no company called Roberts David Ltd listed at Companies House and I attach as exhibit PVS2 extracts from the Companies House website showing both current and former names of companies. I was unable to find any companies at the invoice address under the name Roberts David.

7. Finally, I attach as Exhibit PVS3, the abstract of a report produced by Market Research into the U.K. footwear market, which states that the U.K. footwear market has a value of £5.6 billion pounds. It appears that the total sales claimed by Mr Toltz amount to less than £6000 over a five year period.”

REGISTERED PROPRIETOR’S FURTHER EVIDENCE

8) The registered proprietor filed a witness statement, dated 23 June 2008, by Michael Thomas the UK agent for Manz-Fortuna Schuhfabrik since 1992. He states that he distributed goods under the trade mark MERCEDES to various retailers in the UK. He then provides a number of exhibits which are summarised below. When the mark in suit is mentioned it is in the form of a capital letter “M” with the rest of the mark in lower case and all within an ellipse device unless otherwise stated.

Exhibit MT1: A computer printout said to date from March 1997 which is said to show the retail distribution list for MERCEDES branded goods in the UK. The list shows names and addresses throughout the UK.

Exhibit MT2: A list of what Mr Thomas refers to as “my own customer profile list”. This shows names, addresses, phone numbers and VAT numbers throughout the whole of the UK. He states that this list was compiled in 1996.

Exhibits MT3 & 4: Photocopies of Winter 2004 and Winter 2005 catalogues which Mr Thomas states were sent to UK retail outlets even though they are in German.

Exhibit MT5: A copy of an order from Mr Thomas to Manz-Fortuna dated 1 October 2002. Mr Thomas states that the 15 pairs of shoes were his own order.

Exhibit MT6: A copy of an order form in the name of Magnus of Northampton, dated 8 May 2003. The mark in suit is at the bottom of the order form. The order form has at its foot, the word “MERCEDES” with all the letters being in capitals, with the letters “M” and “S” being slightly larger than the other letters with the letters “ERCEDE” being underlined. The whole word is in an ellipse which has a “hole” at either side of the word suggestive of it being a plaque or nameplate.

Exhibit MT7: A copy of an order form in the name of Davis Footwear in Llanelli, dated 12 May 2004. The mark in suit is at the bottom of the invoice as per MT6.

Exhibit MT8: A copy of an order form from Manz-Schuhfabrik to Mr Thomas showing the name and address of Tim King of Sole Fashion Ltd located in Leicester, dated 21 September 2004. There is a message to the effect that Mr King visited Manz and had requested a catalogue. The mark in suit is shown at the bottom of the invoice.

Exhibit MT9: A copy of an order form for shoes ordered by Mr Thomas, dated 4 November 2004. The paper does not show the mark in suit. The shoes are Manz and also Fortuna branded.

Exhibit MT10: A copy of an order form in the name of David Roberts of Llandudno, dated 15 November 2004. Also attached is an order confirmation form dated 23 November 2004. The order confirmation form bears the mark in suit in the usual manner, whereas the first order form has it in the style of MT6.

Exhibit MT11: A copy of an order form in the name of Magnus of Northampton dated 18 November 2004. The invoice has the mark in the style of MT6.

Exhibits MT12 & 13: Copies of order confirmation forms in the name of Magnus of Northampton dated 23 November 2004. The mark in suit appears at the bottom of the order forms. The orders appear to be for 108 and 63 pairs of shoes, respectively valued at 4,335.24 and 3,224.34 Euros.

Exhibit MT14: A copy of an invoice from Manz-Fortuna to Mr Thomas dated 11 April 2005 for thirteen pairs of shoes. There is no mention of the mark in suit in this exhibit, the goods all appear to be Manz and Fortuna shoes.

Exhibit MT15: A copy of an invoice in the name of Tissimans of Bishop Stortford dated 30 January 2006. This paperwork only has the mark in suit as part of the name "Bereich MANZ/MERCEDES" at the bottom of each exhibit sheet. The order is for ten pairs of shoes valued at 376.70 Euros.

Exhibit MT16: A copy of an order confirmation to Davies Footwear of Llanelli, dated 20 February 2006. The mark in suit is shown as per MT15. The order is for six pairs of shoes valued at 214.80 Euros.

Exhibit MT17: A copy of an invoice to Elizabeth Johnston in Troon, dated 20 February 2006. The mark in suit is shown as per MT15. The order is for nineteen pairs of shoes valued at 1000.35 Euros.

Exhibits MT18 & 19: Two copies of an invoice to Magnus of Northampton, dated 28 February 2006. The mark in suit is shown as per MT15. The order is for two pairs of shoes valued at 103.82 Euros.

Exhibit MT20: A copy of an invoice to Magnus of Northampton, dated 30 March 2006. The mark in suit is shown as per MT15. The order is for 54 pairs of shoes valued at 1926.72 Euros.

Exhibit MT21: A copy of an invoice to Brian Forbes Menswear in Glasgow, dated 30 March 2006. The mark in suit is shown as per MT15. It relates to eighteen pairs of shoes valued at 862.15 Euros.

Exhibits MT22 & 23: Two copies of an invoice to Davies Footwear of Llanelli, dated 10 April 2006. The mark in suit is shown as per MT15. It relates to three pairs of shoes valued at 111.60 Euros.

Exhibits MT24 & 25: A copy of the two pages of a single invoice to Davies Footwear of Llanelli, dated 10 April 2006. The mark in suit is shown as per MT15. It relates to six pairs of shoes valued at 311.46 Euros.

Exhibits MT 26 & 27: Two copies of an invoice to Davies Footwear of Llanelli, dated 10 April 2006. The mark in suit is shown as per MT15. It relates to two pairs of shoes valued at 131.22 Euros.

9) In his witness statement Mr Thomas states that the goods shown in the paperwork at exhibits MT5, 6, 7, 10, 11, 12, 13, 14, 15, 16, 18, 19, 20, 21, 23, 24, 26, & 27 all relate to goods which have the MERCEDES mark upon them and are for sale in the UK. Exhibits 17, 22 & 25 are said to have been sold under the mark in suit. He also states that whilst a number of shoes also have a sub brand, the mark MERCEDES is used with all the shoes. He also states that the majority of the invoices for the relevant period have been destroyed and that those provided are only part of the picture.

CROSS EXAMINATION

10) The following witnesses were examined under oath during the hearing. Mr Toltz and Mr Thomas both appeared to me to be credible, truthful witnesses who did their best to answer the questions put to them in a straightforward and helpful manner. The following is a summary of the main points of their evidence.

Mr TOLTZ

11) Mr Toltz was punctilious in his answers. He made it clear that although he employed agents with a local knowledge of their area, ultimately, he and his company, set targets for sales and determined what styles would be sold in each area. He confirmed that he wrote the statement and then had it translated. He explained that his factory in Germany had moved on three occasions and during these moves they mislaid or simply got rid of promotional materials and other paperwork. He explained that it was clear from the invoices that the items were shoes because of the sizes stated, which could not relate to anything else. His company sells shoes etc under three marks, Mercedes, Manz and Fortuna. He stated that under the MERCEDES brand they produce ladies and gentlemen's shoes, a kind of moccasin, clogs and slippers. He also confirmed that the catalogues also had terms, conditions and prices in English. It also transpired that in a number of the catalogues the word "Mercedes" could just be made out on the buckle of some of the shoes depending on the angle of the photograph and the quality of the reproduction.

Mr THOMAS

12) Mr Thomas was equally clear and precise in his answers which equated with his written evidence. He initially wrote his statement which was then submitted to the Trade Mark Attorney who added "legal" type wording but did not alter the crux of his evidence. He confirmed that the orders he places are initially used as samples but he is actually charged for them and so has to sell the shoes at the end of the season. He also confirmed that it is common in the industry for shops to place orders for single pairs of shoes, as they are unable or unwilling to carry the levels of stock in all available

sizes. He confirmed that he was the sole representative of the registered proprietor in the UK during the relevant period. He also confirmed that he only sold men's shoes.

38) That concludes my review of the evidence. I now turn to the decision.

DECISION

39) The revocation action is based upon Section 46 (1)(b) of the Trade marks Act 1994, the relevant parts of which read 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)
- (d)

(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.

(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.”

40) The applicant alleges that the mark has not been used in the five years period 26 June 2001 to 25 June 2006

41) Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act make it clear that the onus of showing use rests with him. It 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.”

42) I take into account the judgement in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* where the European Court of Justice, on 11 March 2003, stated at paragraphs 35-42:

“35. Next, as Ansul argued, the eighth recital in the preamble to the Directive states that trade marks ‘must actually be used, or, if not used, be subject to revocation’. ‘Genuine use’ therefore means actual use of the mark. That approach is confirmed, *inter alia*, by the Dutch version of the Directive, which uses in the eighth recital the words ‘werkelijk wordt gebruikt’, and by other language versions such as the Spanish (‘uso efectivo’), Italian (‘uso effettivo’) and English (‘genuine use’).

36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of origin of goods or services to the consumer or the end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability *viv-a-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’etre*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations for by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular 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.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or services at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market.

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 paras [35] to [39] of this judgement. 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.

42. The same may be true where the trade mark proprietor makes actual use of the mark, under the same conditions, for goods and services, which, though not integral to the make-up or structure of the goods previously sold, are directly related to those goods and intended to meet the needs of customers of those goods. That may apply to after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services."

43) I was also referred to the CFI case T-334/01, *MFE Marienfelde GmbH v OHIM* (HIPOVITON) where at paragraph 37 they stated:

"37. However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness."

44) This seems to be a rewording of the views of Mr Justice Wilberforce in *NODOZ* [1962] RPC 1, albeit he was referring to onus.

45) The applicant contended that the registered proprietor had not discharged the onus that section 100 lays upon it. However, in considering what constitutes evidence of use I take into account the comments of Mr Arnold QC acting as the Appointed Person in *Pan World Brands Ltd v Tripp Ltd (Extreme)* [2008] RPC 2 where he said:

"31. Basing himself upon the first three sentences of the passage I have quoted from Moo Juice, counsel for the applicant submitted (1) that a mere assertion of use of a trade mark by a witness did not constitute evidence of use sufficient to defeat an application [for revocation] for non-use, and (2) it followed that mere testimony from a representative of the proprietor was not enough and such testimony had to be supported either by documentary records or corroborated by an external witness. I accept submission (1) but not submission (2). Kitchen J.'s statement that "bare assertion" would not suffice must be read in its context, which was, that it had been submitted to him that it was sufficient for the proprietor to give evidence stating "I have made genuine use of the trade mark". A statement by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark has been used would not in my view constitute bare assertion. As counsel for the applicant accepted, it might not be possible for a trade mark proprietor to produce documentary evidence: for example all the records might

have been destroyed in a fire. In such circumstances I do not see anything in either the Directive, the 1994 Act or the 2000 Rules which would require the proprietor to adduce evidence from an external witness (which is not to say that it might not be advisable for the proprietor to do so).”

46) In this decision the Appointed Person went onto consider the position regarding unchallenged evidence. He took into account *Phipson on Evidence* (16th ed), the House of Lords in *Brown v Dunn* (1894) 6 R.67, Hunt J. in *Allied Pastoral Holdings v Federal Commissioner of Taxation* [1983] 44 ALR 607 and The Court of Appeal in *Markem Corp v Zipher Ltd* [2005] RPC 31. He summed up these cases in the following terms:

“35. In my judgement the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell L.C. in *Brown v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] R.P.C. 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness’s evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness’s evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness’s evidence.”

47) In the instant case the evidence has been challenged and the witnesses cross examined. The registered proprietor has provided catalogues for the whole of the relevant period. I accept that those submitted were in the German language, however, the registered proprietor explained that the factory in Germany had moved several times and the only ones kept were those in German. It was confirmed that the English language ones would have been identical other than the German being translated into English. The layout of the brochures is such that it would have been perfectly possible to see the customer face to face, as Mr Thomas did, and leave them the catalogue for them to place orders. The picture shows the shoe, the style names are easily pronounceable, and the reference number is very simple. The proprietor also provided invoices and credit notes to various clients covering the whole of the UK for the entire relevant period. Most, but by no means all, showed the mark in suit and a number also had the mark in suit referred to in the body of the invoice. I accept that the firm also sold shoes under two other marks during the same period and indeed could be seen on some of the invoices. However, the invoices submitted were said to be examples, again many were destroyed in the factory moves, and Mr Thomas only retained some invoices as he no longer represents the registered proprietor. In addition Mr Thomas provided his customer list which shows names and addresses throughout the UK to whom he sold MERCEDES shoes.

48) The applicant tried to undermine the registered proprietor's evidence, by making their own enquiries. However, the work was carried out in a very sloppy manner which raised more questions than it answered and to a degree reinforced the registered proprietor's evidence.

49) Mr Brandreth contended that the evidence showed only token sales which were made simply to maintain the registered mark. I do not accept this. To my mind the picture painted by the evidence shows that whilst the UK was undoubtedly not the registered proprietor's main market it was doing a reasonable amount of business in the UK. Whilst each individual aspect of the evidence can be criticised and questioned I have to consider the evidence as a whole. The registered proprietor's turnover maybe somewhat small in relation to the market for shoes in the UK, but under section 46 there is no deminimis test.

50) In my opinion the registered proprietor has provided a narrative which is not "obviously incredible". On the contrary, the evidence filed as exhibits backs up the narrative. Whilst it is not the most convincing evidence that I have seen it is more than adequate. The witnesses were wholly credible when being cross examined. The use shown is within the relevant periods and is genuine use. The only issue is precisely what has the mark in suit been used on in terms of the specification for which it is registered.

51) In considering this issue I was referred to *Thompson Holidays Ltd v Norwegian Cruise Ltd* [2003] RPC 32, *West v Fuller Smith & Turner* [2003] FSR 44, *Animal Trade Mark* [2004] FSR 19, *WISI Trade Mark* [2006] RPC 17, and *Croom's Trade Mark* [2005] RPC 2. The correct approach to reducing a specification has been considered in a number of cases, other than those listed above, 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].

52) The mark in suit is registered for, “Boots, shoes, footwear; leggings and gaiters”. It was accepted at the hearing that no use had been shown on leggings and gaiters. Ms Mensah claimed that the mark had been used on a number of varieties of footwear. I allowed her to provide a complete list of items that were shown in the evidence following the hearing to be certain that the registered proprietor’s best case was before me. This list referred me to various exhibits. Regarding exhibit PT3 it was contended that this shows use on a “sandal”, a “mule/clog” and a “pump”. I shall not deal with the issue of whether these are simply varieties of shoes. These all appear on two pages clearly marked “Damen”. In his cross examination Mr Thomas, the proprietor’s sole representative in the UK, stated categorically that he only sold men’s shoes. Whilst I accept that the registered proprietor manufactures and sells ladies shoes in Europe, there is no evidence that they sell them in the UK. Simply appearing in a German language catalogue is not enough. There was also a reference on exhibit MT7. This shows an order for 17 pairs of size nine shoes. The marks, Manz, Fortuna and Mercedes all appear on the invoice. In addition there is what appears to be a plea for a particular awkward customer, it reads “(Any size 14 sandal)”. I doubt that there is a great deal of demand for sandals in this size, it is not clear if the request was met, or if the sandal bore the Mercedes mark instead of one of the companies other marks. To my mind, this is not credible evidence that the registered proprietor has sold sandals, mule/clog or pumps in the UK.

53) The list provided by the registered proprietor also lists under the heading “shoes” various different styles such as “Moccasin”, “Brogue”, “Oxford”, “Derby”, “Monk”, “Budapester” and “Loafer”. Whilst I am willing to be guided on the names of styles of shoes, they are still all men’s shoes. Ms Mensah contended that the authorities listed above require me to determine a “fair specification”, which can mean completely rewording the original specification. Her view was that the registered proprietor should retain a specification of “boots, footwear and shoes”. Whilst I agree with the premise I do not agree with the conclusion. In my view, the instant case is a prime example of where the “blue pencil” approach advocated by Neuberger J in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 can be used. The terms used in the specification are not so wide that I need to consider the approach preferred by Laddie J in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850 or indeed by Aldous LJ in *Thompson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828 [2003]RPC 32.

54) The registered proprietor has only shown use on Mens shoes. The words "boots and footwear" encompass a variety of other types of coverings for the feet, which are noticeably absent from the evidence. A fair specification would therefore be "Shoes". The balance of the specification comprising "Boots, Footwear, leggings and gaiters" are revoked with effect from 26 June 2006.

55) As the applicant has been, for the most part, successful it is entitled to a contribution towards its costs. The registered proprietor contented that a decision could have been made from the papers had the applicant being willing to amend its request for revocation following the evidence rounds. I note however, that even at the hearing the registered proprietor was seeking to defend the bulk of its specification only offering up at the hearing those parts where absolutely no use had been shown. The cross examination did assist me in my determination in that it made it easier to following the comments of Mr Thomas as to what he actually sold. Taking all the above into account I order the registered proprietor to pay the applicant the sum of £1,200. This sum 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 12th day of March 2009

**George W Salthouse
For the Registrar,
the Comptroller-General**