

O-252-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. 2115051  
IN THE NAME OF PENN FISHING TACKLE MANUFACTURING CO.  
OF THE TRADE MARK:**

**EXTREME**

**AND THE APPLICATION FOR REVOCATION THERETO  
UNDER NO. 83075  
BY FOX INTERNATIONAL GROUP LIMITED**

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by Fox International Group Limited**

### **BACKGROUND**

1. On 6 November 2007, Fox International Group Limited, which I will refer to as Fox, filed an application for the revocation of registration number 2115051. The registration is for the word EXTREME and is registered for the following goods:

*Fishing tackle, fishing rods, reels and lines.*

The above goods are in class 28 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2. Completion of the registration procedure for 2115051 took place on 16 May 1997. On 12 January 1998, the registration was assigned from Shimano (UK) Limited to Penn Fishing Tackle Manufacturing Co, which I will refer to as Penn, the current proprietor of the trade mark registration.

3. Fox seeks revocation of the registration in full under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (the Act). It claims that the mark has never been used in relation to the goods for which it is registered or that it has not been so used in the last five years. The five year period relating to section 46(1)(a), during which Fox claims there has been no genuine use of the mark for the goods as registered, is 17 May 1997 to 16 May 2002. Success for Fox would mean a date of revocation of 17 May 2002. The five year period under section 46(1)(b) ends with the date of application for revocation; the claim is therefore that there has been no genuine use of the mark for the goods as registered between 6 November 2002 and 5 November 2007. Success for Fox under section 46(1)(b) would mean a date of revocation of 6 November 2007. There is no overlap between both periods of non-use pleaded.

4. Penn filed a counterstatement, claiming the mark has been used continuously in the UK since 1999 and denying that there had been no genuine use of the mark in the UK in respect of the registered goods during the relevant five year periods.

5. Both parties filed evidence and both seek an award of costs. They were advised that they had a right to a hearing and that if one was not requested a decision would be made from the papers and any written submissions received. Neither side requested a hearing and only Penn filed written submissions via its trade mark attorney.

## Evidence

### 6. Penn's chain of ownership/consent and Fox's challenge thereto

A witness statement from David Caulfield states that he is the General Manager of Penn Trading Limited, a wholly owned subsidiary of the proprietor. Penn Trading Limited uses the EXTREME trade mark with the permission of and under the control of Penn and has done so continuously in the UK since 1999. Mr Caulfield also states that Shakespeare Company (UK) Limited began use of EXTREME with the permission of Penn Trading Limited in 2001. In early 2007, Penn was acquired by Shakespeare Company LLC, the parent company of Shakespeare Company (UK) Limited. Penn Trading Limited and Shakespeare (UK) Limited now form part of the same group of companies. In correspondence during the evidence rounds, Fox challenged this statement as being unsupported by evidence; Fox requested cross-examination of Mr Caulfield unless Penn filed satisfactory evidence to support Mr Caulfield's statement. Penn's trade mark attorney, Anne Wong of Carpmaels & Ransford, filed a witness statement; exhibit AW8 is a 'Letter of Declaration' by Mark Rosebrock, Assistant Secretary of Penn. The letter is not the subject of a witness statement, affidavit or statutory declaration. Its contents essentially are the same as the statement made by Mr Caulfield. It does not add anything, and Fox has not pursued its challenge to this aspect of the proceedings.

### 7. Evidence of use

Mr Caulfield explains that the goods are sold via distributors and retailers, rather than directly to the public by Penn or Shakespeare. The EXTREME mark is typically used on the products, in trade manuals, trade catalogues and price lists. Copies of Penn and Shakespeare invoices are exhibited at P-1. The first set of these show dates of 9 August 1999, 6 September 1999, 29 September 1999, 24 October 2001, 15 January 2003, 3 February 2003, 26 September 2003, 14 October 2003, 14 October 2003, 19 November 2003 and 16 August 2004. These dates span both periods pleaded under sections 46(1)(a) and (b) of the Act. Without listing each occurrence of the word EXTREME on the invoices, it appears, for example as, "12'6"EXTREME SURF VENOM", "12' EXTREME SURF VOYAGER", "6-8OZ EXTREME UPTIDE" and "30-50LB EXTREME BOAT PIRKER". All of these invoices were sent to 'Veals Mail Order' in Bristol. The second set of invoices shows delivery addresses to Humberside and Whitby; the invoices are dated 20 October 2004, 17 January 2005, 14 February 2005, 25 December 2005, 4 September 2006, 15 December 2006, 20 March 2007 and 15 January 2008. The last one is outside of the relevant dates. There are references to "K ELITE XTREME SUPREME ROD", "K2 TEAM EXTREME BEACHCASTER ROD" AND "K2 EXTREME TITANIUM (T6)". The items vary in price: a K2 TEAM EXTREME TITANIUM ROD has a retail price of £250, while an EXTREME SURF VENOM is £113.48 (it is not specified whether this is retail or wholesale pricing). Mr Caulfield describes XTREME as a close variant of EXTREME.

8. Mr Caulfield states that the EXTREME products are top-of-the-range goods, aimed at a niche section of the overall fishing tackle market; they are not high volume or mass market goods. Exhibit P-4 is a 2006 price list from Mullarkeys, Shakespeare's largest UK retailer. Thirteen EXTREME or XTREME items are listed;

the recommended retail prices range from £145.00 to £340.00. The prices of other brands of rods which are listed as beachcasters range from £32.00 to £88.00, revealing a price differential between EXTREME goods and other branded goods. Sales figures for EXTREME rods are provided for 2005-2007:

2005		2006		2007	
Quantity sold	Sales value (GBP £)	Quantity sold	Sales value (GBP £)	Quantity sold	Sales value (GBP £)
1,079	93,989	1,339	94,453	906	60,023

I note that the Mullarkeys price list separates various types of rods: beach rods, uptide rods and flattie/bass rods. The EXTREME/XTREME goods appear under the beach rod heading.

9. Exhibit P-3 shows close-up views of what appear to be fishing rods, showing “THE TEAM EXTREME BEACHCASTER”, “K2 Team LBC Xtreme Beachcaster” and “K2 BLUE METAL Team Xtreme”: these are undated. Exhibit P-2 provides extracts from Shakespeare’s UK and Penn’s pan-European trade manuals, price lists and catalogues from 1999-2003 and from 2005-2007. The sterling price list for 1999 lists the PENN EXTREME SERIES as comprising ‘boat’, ‘uptide’, ‘surf’ and ‘bass’ items, which I infer, from evidence elsewhere, to be rods. The second page of the price list shows PENN EXTREME REAR DRAG REELS, PENN EXTREME FRONT DRAG REELS and PENN EXTREME LEVER DRAG FIXED SPOOL REELS. The rods and reels also appear separately in the 2000 and 2001 sterling price lists. The 2000 Penn Fishing Tackle Europe catalogue states that EXTREME 2 rods are for beach anglers. Bass rods in this range are for catching saltwater sport fish (bass). The publication includes references to the EXTREME 2 downtide boat rods and boat pirkers, which appear to be rods (the pirk being the bait or lure). In relation to reels sold under the EXTREME mark, they are described as for ‘boat and surf action’. Page 46 of the 2002/3 catalogue (which includes a Worcestershire servicing address within the text, indicating it is a catalogue for the UK market) refers to the EXTREME RD reel as being “ideal for carp, pike, catfish etc plus tope and bass in saltwater”. The 2003 Shakespeare Tackle Guide shows the K2 Team Xtreme beachcaster as costing from £150; in the 2005 and 2006 guides the price is from £180. Shakespeare’s 2007 catalogue lists the K2 Xtreme Titanium and K2 Blue Metal Team Xtreme beachcasters.

10. Mr Caulfield’s final exhibit, P-5, is comprised of extracts from the November 2002, March 2003, November 2003, December 2003 and October 2004 editions of the ‘Sea Angler’ magazine, published in the UK monthly. In 2006, Sea Angler sold over 44,000 copies in the UK and Republic of Ireland; this figure is not particularised as to the UK circulation level. The magazines carry advertisements for EXTREME rods and include the exhortation “Get your Xtreme rod from one of these great

PENN Select Dealers”, listing outlets in Beccles, Dagenham, Scunthorpe, Morcambe, Glasgow, Edinburgh, Southend, Eastbourne and Bristol.

11. Penn has also filed a witness statement from Ann Wong, who is a trade mark attorney acting for Penn in these proceedings. Her witness statement is to rebut challenges made in correspondence by Fox, after the latter had examined the evidence outlined above. I have already mentioned the challenge in relation to the trading relationship between the various Penn and Shakespeare companies. Fox also raised argument regarding use of the mark EXTREME by itself, stating that it has only ever been used with other words, for example:

EXTREME V SERIES  
K2 EXTREME TITANIUM  
EXTREME VENOM  
PENN EXTREME LIGHT BEACH

David John Crouch, Fox’s trade mark attorney, has filed a witness statement to adduce two dictionary references for the word ‘extreme’. The first is from Webster’s New Collegiate Dictionary of 1970: “**a**: existing in the highest or the greatest possible degree **b**: going to great or exaggerated lengths **c**: exceeding the ordinary, usual, or expected” and the second reference is from Collins Dictionary of the English Language of 1979: “**1**. being of a high or of the highest degree of intensity **2**. exceeding what is usual or reasonable; immoderate...”. I note these two dictionaries are several decades old but if there is any significance in that, it has not been explained.

12. Ms Wong exhibits at AW9 a decision from the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) in a parallel cancellation/revocation case, filed by Fox against Penn’s Community Trade Mark for EXTREME for identical goods to the instant case. The evidence summary in that decision indicates similar evidence to that filed in this case, OHIM’s cancellation division having noted use in the UK (and other countries) in particular. It appears the evidence, as in this case, showed use of EXTREME with other matter. OHIM found that the use constituted use without altering its distinctive character. OHIM dismissed the cancellation action and maintained the registration in its entirety. I am not bound to follow OHIM’s decision. Ms Wong has not stated her purpose in filing the decision as evidence to support Penn in these UK proceedings but presumably it is to place this UK action in context: Fox has filed to revoke both Penn’s UK and Community registrations as Penn is relying on them to oppose Fox’s own Community trade mark application. However, this is extraneous to the job of this tribunal; a revocation application has been made, the registration has been defended and it falls to Penn to satisfy this tribunal that it has made genuine use of the mark in the UK (or that there are proper reasons for non-use) for the goods registered, in the relevant periods.

13. Ms Wong has filed a number of references from various sources to show that the additional terms, such as uptide, boat, and surf rod are generic. I will not list them but will refer to them, as necessary. The remainder of Ms Wong’s evidence is in fact submission based on the evidence of Mr Caulfield, whereby she has re-filed some of the exhibits to demonstrate EXTREME used alone, which I bear in mind.

## Decision

14. Section 46 of the Act reads as follows:

“(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 purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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.”

Consideration has to be taken, also, of section 100 of the Act which states:

“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.”

### **The relevant dates**

15. Consequent upon section 100, the onus is upon Penn to prove that it has made genuine use of the mark EXTREME in the UK (or that there are proper reasons for non-use) for the goods registered, in the relevant periods. For ease of reference, the relevant dates for the two five-year periods during which Fox claims there was no genuine use of the mark are:

#### Section 46(1)(a):

Completion of registration procedure	Five year period in which to commence use started	Five year period in which to use ended	Revocation date sought
16 May 1997	17 May 1997	16 May 2002	17 May 2002

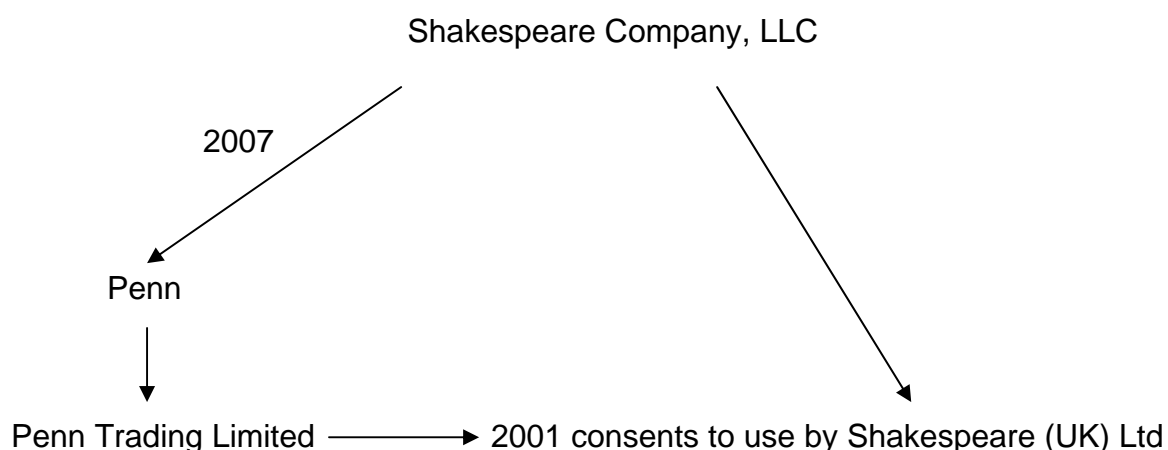
Section 46(1)(b):

Application for revocation filed	Five year period in which to use starts	Five year period in which to use ends	Revocation date sought
6 November 2007	6 November 2002	5 November 2007	6 November 2007

Fox requests revocation takes place from 17 May 2002 or, failing that, from 6 November 2007.

**Use by the proprietor or with his consent**

16. In paragraph 6, I have summarised the chain of ownership given in evidence by Mr Caulfield. This was initially challenged by Fox but, following evidence filed by Ms Wong, the challenge was not pursued. The trade mark application/registration was originally in the ownership of Shimano (UK) Ltd. Penn was assigned ownership of the registration on 12 January 1998. Penn owns Penn Trading Limited, who consented in 2001 to use of the mark by Shakespeare (UK) Ltd, owned by Shakespeare Company, LLC. The latter acquired Penn in 2007, completing the circle.



I am satisfied that evidence of use by Penn Trading Limited and Shakespeare (UK) Ltd can be considered in these proceedings as Penn has demonstrated a consensual trading relationship between it and these entities.



## Forms of use shown by Penn

17. Fox says EXTREME is laudatory and descriptive and that it has not been used on the goods by itself. It has supported the first of these contentions by filing the dictionary definitions referred to above. I think that what Fox is driving at is that even if there is use of EXTREME, it is not use as a trade mark and where it appears with other matter, it is more likely to be seen as a descriptor. Ms Wong has filed evidence to highlight instances where EXTREME has been in use by itself or with generic elements such as 'uptide' or 'surf rods'. This use appears in the invoices and in the textual descriptions of the EXTREME goods in catalogues. The evidence shows that EXTREME frequently appears on fishing rods with other elements, for example:

K2 EXTREME TITANIUM  
PENN EXTREME VENOM  
EXTREME VENDETTA  
EXTREME VILLAIN  
EXTREME VENGEANCE  
EXTREME V3.

Advertising use of EXTREME is in evidence in the extracts from the *Sea Angler* magazine:

"Building on the success of the original INXS and Extreme ranges these new and exciting V Series second generation surf rods..."

"The new Extreme range has undoubtedly scored big in the UK on three points..."

18. Section 46(2) of the act refers to use of a trade mark as "includ[ing] 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". Where it appears with wholly generic matter, such as the weight of the line for which it is suited, or the word 'boat', 'uptide' etc, such additions do not alter its distinctive character (the additions having none of their own). However, the additions of words such as 'venom', 'vendetta' and 'villain' do not fall into the same bracket. I have to consider whether the use of EXTREME with these words, as shown, constitutes an acceptable variant. Venom, vendetta and villain have distinctive character, with no meaning in relation to the goods. In *Castellblanch SA v OHIM* T-29/04 [2005] ECR II-5309, the Court of First Instance (CFI) said:

"33 In the contested decision the Board of Appeal found that there is no precept in the Community trade mark system that obliges the opponent to prove the use of his earlier mark on its own, independently of any other mark. According to the Board of Appeal, the case could arise where two or more trade marks are used jointly and autonomously, with or without the name of the manufacturer's company, as is the case particularly in the context of the automobile and wine industries.

34 That approach must be followed. The situation is not that the intervener's mark is used under a form different to the one under which it was registered,

but that several signs are used simultaneously without altering the distinctive character of the registered sign. As OHIM rightly pointed out, in the context of the labelling of wine products joint affixing of separate marks or indications on the same product, in particular the name of the winery and the name of the product, is a common commercial practice.”

19. In *REMUS Trade Mark*, O/061//08, Mr Richard Arnold QC, sitting as the Appointed Person, considered a trade mark used with an additional element. Repeating what he had said in *NIRVANA Trade Mark*, O/262/06, he posed the following questions regarding whether variant use constitutes an acceptable variant:

“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...”

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

Taking the distinctive character of EXTREME first, Fox submits that Penn cannot claim any prominence of the word EXTREME because the word is laudatory and lacks distinctiveness and has filed the dictionary definitions to demonstrate that the manner in which Penn has used the mark should be discounted as constituting genuine use since it has a laudatory/descriptive meaning. (Penn points out that Fox has itself applied for EXTREME as a Community Trade Mark for these goods, has been opposed by Penn and others, and that it is therefore inconsistent for Fox to claim in these proceedings that EXTREME is laudatory. Parties may choose their grounds in individual proceedings and so this is not relevant.) The definitions are likely to be known to all who are familiar with the English language. I consider ‘extreme’ to be allusive or suggestive of high performance, but it is not descriptive of the goods or of a characteristic of them. When put before venom, vendetta or villain, is the distinctive character altered? My view is that it is not; EXTREME is used as a ‘house mark’, denoting a range of fishing goods (I will refer to which goods later in this decision), and that the range is further sub-branded to differentiate the various technical differences between models. Such use is comparable to the examples given in *Castellblanch*. The evidence clearly demonstrates that it is EXTREME which is the housemark; there are not various venom, vendetta, or villain rods. I do not see that the use gives the impression of EXTREME being a descriptive element, either in this context or as K2 EXTREME TITANIUM or EXTREME SURF VOYAGER to name two other instances of use. I conclude that the use constitutes acceptable variation of the mark as registered and falls within the parameters of section 46(2). For reasons which will become clear, there is no need to consider the use of XTREME.

## Does the evidence establish genuine use?

20. In *Anheuser-Busch Inc v OHIM* Case T-191/07, the Court of First Instance (CFI) gave a summary of the genuine use criteria:

“99 In interpreting the concept of genuine use, account should be taken of the fact that the ratio legis of the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade mark application is to restrict the number of conflicts between two marks, in so far as there is no sound economic reason resulting from an actual function of the mark on the market (Case T-174/01 *Goulbourn v OHIM – Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 38). However, the purpose of the provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-2811, paragraph 38, and judgment of 8 November 2007 in Case T-169/06 *Charlott v OHIM – Charlott (Charlott France Entre Luxe et Tradition)*, not published in the ECR, paragraph 33).

100 There is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the registration (Case C-234/06 P II *Ponte Finanziaria v OHIM* [2007] ECR I-7333, paragraph 72; see also, by analogy, Case C-40/01 *Ansul* [2003] ECR I-2439, paragraph 43). In that regard, the condition of genuine use of the mark requires that the mark, as protected on the relevant territory, be used publicly and externally (*Silk Cocoon*, paragraph 99 above, paragraph 39; *VITAFRUIT*, paragraph 99 above, paragraph 39; *Charlott France Entre Luxe et Tradition*, paragraph 99 above, paragraph 34; see also, by analogy, *Ansul*, paragraph 37).

101 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (*VITAFRUIT*, paragraph 99 above, paragraph 40; *Charlott France Entre Luxe et Tradition*, paragraph 99, paragraph 35; see also, by analogy, *Ansul*, paragraph 100, paragraph 43).

102 As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (*VITAFRUIT*, paragraph 99 above, paragraph 41, and *Charlott France Entre Luxe et Tradition*, paragraph 99 above, paragraph 36).

103 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The characteristics of those goods and services, the frequency or regularity of the use of the trade mark, whether the mark is used for the purpose of marketing all the identical goods or services of the proprietor or merely some of them, or evidence of use which the proprietor is able to provide, are among the factors which may be taken into account (Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237, paragraph 71).

104 To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case (*VITAFRUIT*, paragraph 99 above, paragraph 42; *Charlott France Entre Luxe et Tradition*, paragraph 99 above, paragraph 37; see also, by analogy, *Ansul*, paragraph 100 above, paragraph 39).

105 Moreover, the Court of First Instance has held that genuine use of a trade mark could not be proved by means of probabilities or suppositions, but had to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM – Harrison (HIWATT)* [2002] ECR II-5233, paragraph 47).”

21. The trade mark is registered for:

*Fishing tackle, fishing rods, reels and lines.*

The first term, fishing tackle, is an umbrella term which covers a variety of fishing goods. The remainder of the specification lists individual goods: rods, reels and lines. I have to decide whether the evidence which Penn has filed shows genuine use of any of the goods covered by the specification and whether such use falls within either or both of the five year periods.

22. The two sets of invoices in P-1 span both the pleaded periods under sections 46(1)(a) and (b) and are made out to UK addresses. There are numerous references to EXTREME goods in the first set of invoices, but a lack of explanation as to what goods some of the entries represent. However, common sense and examination of the accompanying brochures and magazine advertisements lead me to conclude that an item described as “12’6” Extreme surf vendetta” is a fishing rod, owing to its length of 12 feet and 6 inches. The second set of invoices explicitly refers to rods, such as K2 TEAM EXTREME TITANIUM ROD, but not to any other EXTREME goods. Within the first set of invoices I cannot say what “2-8oz extreme uptide”, at an item cost of £17, may mean. Mr Caulfield states that the EXTREME goods are top-of-the-range, citing the Mullarkey’s price list where the rods are priced between £145 and £340. This suggests that the 2-8oz extreme uptide item is not a rod. Ms Wong states that 2-8oz “indicates the weight of the lead that the rod is designed to cast”. There is still ambiguity: does the invoice reference refer to a rod designed to cast a 2-8oz lead or to the lead itself? There are no references in the

other exhibits to leads. A similar problem exists for “30-50lb extreme boat” at an item cost of £19: Ms Wong states that 30-50lb “indicates the strength of the fishing line for which the rod is suited.” There are no references in the other exhibits to lines. My conclusion from the invoices is that they show use of the mark on rods. This is supported by the sequential price lists, catalogues and *Sea Angler* extracts. It is also supported by the Mullarkeys price list, which explicitly puts EXTREME items under the beach rod heading. There is evidence of sales of rods in the UK during both the five year periods.

23. I find that there has been genuine use of rods, but that the use has been made in respect of certain types of rods only. Mr Caulfield refers to EXTREME goods occupying a niche section of the overall fishing tackle market. The goods are frequently accompanied by descriptors such as beach, beachcaster, surf, uptide, downtide and boat. The 2000 Penn Fishing Tackle Europe catalogue states that EXTREME 2 rods are for beach anglers. The magazine extracts are from *Sea Angler*, indicating that sea fishing is a discrete type of fishing, with its own equipment and magazine publication. Sea fishing with a course fishing rod may be the piscatorial equivalent of playing cricket with a badminton racket.

24. There are no references in the evidence to lines. In fact, the only references to EXTREME fishing goods other than rods are references to reels in the price lists for 1999, 2000, 2001 and 2002 (within the section 46(1)(a) date range). Rods and reels appear separately in the 2000 and 2001 price lists. Within the section 46(1)(b) date range, there is reference on page 46 of the 2002/2003 catalogue to the EXTREME RD reel. Advertisements in *Sea Angler* show Penn promotions of EXTREME rods which come with a free PENN (not EXTREME) reel. There are descriptions of rods which are designed to accommodate the angler’s preference for either fixed spool or multiplier reels. This suggests to me that rods are not sold with reels already fitted; one chooses the rod and reel separately, ensuring compatibility. Although there are no instances in the invoices that I can see that refer to reels, they are present in successive years in the other literature which Mr Caulfield exhibits, for both date spans. I view this as demonstrating that Penn has created or preserved an outlet for EXTREME reels during the relevant periods. It does not strike me as token use. Taking a global view of the evidence, I consider it to be of a sufficiently tolerable level to resist revocation on the grounds of non-use during either period for reels.

### **A fair specification**

25. I have to decide what is a fair specification based on the evidence filed by Penn. The turnover figures for rods between 2005-7, while not vast, appear to be warranted in what is a niche sector of the sport of fishing, for top-end rods; the sales of rods are shown consistently over time. There is no use other than on rods and reels; if any other fishing goods appear on the invoices, they are not apparent<sup>1</sup>.

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<sup>1</sup> In *Laboratoire De La Mer Trade Marks* [2002] FSR 51, Jacob J said: “9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye – to ensure that use is actually proved – and for the goods or services of the mark in question. All the t’s should be crossed and all the i’s dotted.”

26. There is an established body of case law which deals with the task of framing a fair specification. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, the court advised:

“31 ... The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

In *Animal Trade Mark* [2004] FSR 19:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pedantic way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

I should therefore approach the description of the goods from the standpoint of those who take part in fishing.

27. I have found genuine use of EXTREME on rods and reels but not on fishing tackle or on lines. Fishing tackle is a very broad term and it would be contrary to the

ratio legis to allow it to remain. Fishing tackle and lines should therefore be removed from the specification. In relation to rods, my examination of the evidence has informed me about the trade and led to my conclusion that sea fishing is a discrete area of fishing, with its own particular equipment and its own sector of the magazine market. There are specific rods for saltwater/sea fishing. In *Nirvana*, Mr Arnold confirmed that:

“(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].”

It seems to me that I should consider whether the term ‘rods’ should be further defined so as to reflect the circumstances of trade. In *Reckitt Benckiser (España), SL v OHIM* Case T-126/03, the CFI stated:

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Mariefelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it

is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

Applying the above, I consider that the evidence demonstrates that 'rods' is a broad category within which it is possible to identify sub-categories, according to the type of fishing for which the rod is designed. Bearing in mind the comments of Mr Arnold at point (4) above and the CFI at paragraph 46, I conclude that it is appropriate in this case to reduce the scope of the specification in relation to rods, which have been consistently represented as for use in sea fishing, but to leave reels as the term stands because the evidence does not show that this category can be divided other than in an arbitrary manner.



## **Conclusion**

28. The application for revocation on the grounds of non-use succeeds in part. The registration for EXTREME should remain for:

**Rods for use in sea fishing and saltwater fishing; reels.**

The registration is revoked in respect of all other goods with effect from 17 May 2002.

## **Costs**

29. Each side has achieved a measure of success and so each should bear its own costs.

**Dated this 3<sup>rd</sup> day of August 2009**

**Judi Pike  
For the Registrar,  
the Comptroller-General**