

O-313-10

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2352701
IN THE NAME OF FOX INTERNATIONAL GROUP LTD
OF THE TRADE MARK:**

NEMESIS

**AND THE APPLICATION FOR REVOCATION THERETO
UNDER NO. 83592
BY SVENDSEN SPORTS (UK) LTD**

AND

**IN THE MATTER OF REGISTRATION NO. 2352702 IN THE NAME OF FOX
INTERNATIONAL GROUP LTD OF THE TRADE MARK:**

VIRAGE

**AND THE APPLICATION FOR REVOCATION THERETO UNDER NO. 83594 BY
SVENDSEN SPORTS (UK) LTD**

Trade Marks Act 1994

**In the matter of registration no. 2352701
in the name of Fox International Group Ltd
of the trade mark:**

NEMESIS

**and the application for revocation
thereto under no. 83592
by Svendsen Sports (UK) Ltd**

and

**In the matter of registration no. 2352702
in the name of Fox International Group Ltd
of the trade mark:**

VIRAGE

**and the application for revocation thereto
under no. 83594
by Svensen Sports (UK) Ltd**

BACKGROUND

1. On 5th October 2009, Svensen Sports (UK) Ltd, (hereafter "Svendsen"), filed two applications for the revocation of registration numbers 2352701 and 2352702. Registration 2352701 (hereafter '701) is for the word NEMESIS and is registered for the following goods:

Angling apparatus; angling accessories

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 '701 took place on 11th June 2004. It is registered in the name of Fox International Group Ltd (hereafter "Fox").

3. Registration 2352702 (hereafter '702) is for the word VIRAGE and is registered for the same list of goods as '701.

4. Completion of the registration procedure for '702 took place on 25th June 2004. It is also registered in the name of Fox.

5. Svendsen sought revocation of both registrations for all goods other than fishing rods under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (the Act). As far as '701 is concerned it claims that the mark has not been used in relation to goods other than fishing rods for which it is registered following registration, 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 Svendsen claims there has been no genuine use of '701, is 12th June 2004 to 11th June 2009. Success for Svendsen would mean a date of revocation for '701 of 12th June 2009. 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 other than fishing rods between 5th October 2004 and 4th October 2009. Success for Svendsen under section 46(1)(b) would mean a date of revocation of 5th October 2009. There is plainly substantial overlap between the two claims, and Svendsen ask that the earlier of the two dates, ie 12th June 2009, be taken to be the revocation date if they are successful.

6. As far as '702 is concerned, the five year period relating to section 46(1)(a) during which Svendsen claims there has been no genuine use is 26th June 2004 to 25th June 2009. Success for Svendsen would mean a revocation date of 26th June 2009. 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 for all goods other than fishing rods between 5th October 2004 and 4th October 2009. Success for Svendsen under section 46(1)(b) would mean date of revocation of 5th October 2009. Again there is plainly substantial overlap between the two claims and Svendsen ask that the earlier of the two revocation dates, ie 26th June 2009, be taken to be the revocation date if they are successful.

7..Fox filed counterstatements, claiming the marks have been used in respect of the goods as registered during the relevant five year periods.

8. Fox has filed evidence and submissions in both proceedings. The proceedings have not been formally consolidated, but given the commonality of the issues and identity of the parties it is most convenient if I deal with all matters in one decision. I wrote to the parties on 24th August 2010 to tell them of my intention to deal with the two cases in one decision. Svendsen has filed submissions in both proceedings. It is important to note that Svendsen's submissions in both cases take the form of a concession that the evidence from Fox shows genuine use of both marks on fishing rods and fishing lures. From this, they concede that Fox are entitled to keep the descriptions, "fishing rods and fishing lures", notwithstanding that use is shown only on one type of rod (a beachcaster) and one type of lure (an imitation fish). It is Fox's position that, given the use shown they are entitled to retain the specification as registered, namely "angling apparatus; angling accessories." Given Svendsen's concession in this case, I do not feel it necessary to undertake the usual summary of the evidence at this point but instead seek to address the strictly legal question of what may be a fair specification in this case. If, in doing so, I need to refer to the evidence at any point, for example to better understand how the trade may categorise products I shall do so in due course.

9. Both parties 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 both filed written submissions via their trade mark attorneys.

Decision

10. 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.”

A fair specification

11. As I have said this case is purely and simply about what is a ‘fair’ specification: are Fox entitled to retain the specification “Angling apparatus; angling accessories” for both marks, or should the specification, according to Svendsen read instead, “Fishing rods; fishing lures”. There is no dispute about the evidence.

12. There is an established body of English 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.”

13. 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 pernicky 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."

14. In addition, and between the conclusion of proceedings and the writing of this decision, I have become aware of the case of BL O/217/10 before the Appointed Person on appeal. Henceforth I shall refer to this case as the EXTREME case or just EXTREME. I should explain in detail the background to this dispute; its relevance to this case, both in terms of legal principle and factual matrix will become self evident.

15. The case concerned an application to revoke the mark EXTREME which was registered in class 28 for "fishing tackle, fishing rods, reels and lines". The mark was registered in the name of Penn Fishing Tackle Manufacturing Ltd ("Penn"). The applicant for revocation was Fox International Group Ltd, being the same "Fox" as in these proceedings. Before the registry, the hearing officer found that genuine use had been shown in respect of both rods and reels. There had been no genuine use for fishing tackle and lines. Fishing tackle was a broad term and "it would be contrary to the ratio legis to allow it to remain". "Rods" was also a broad term, within which it was possible to identify subcategories according to the type of fishing. On the evidence, the specification would be reduced to "rods for use in sea fishing and saltwater fishing". On the other hand, there was no indication in the evidence that reels could similarly be subcategorised. Penn's registration should remain for "Rods for use in sea fishing and saltwater fishing; reels"

16. Penn subsequently appealed to the Appointed Person. It said "Fishing tackle" was a narrowly defined category, incapable of significant sub division. As they had shown use for fishing rods and reels, this was sufficient to maintain the registration for the entire category. Although "rods for use in sea fishing and saltwater fishing" might reflect *actual* use, it was overly restrictive and not a 'fair' description (*ANIMAL trade mark* [2004] FSR 383). Fishing rods were regarded as a single category in trade with the same trade channels, target consumers and advertising methods. Their sub division into saltwater/sea fishing rods and freshwater rods was arbitrary and unjustified on the evidence. The average consumer would fairly describe the goods as fishing rods, which in turn and together with 'reels', justified the description "fishing tackle".

17. On appeal, the Appointed Person carefully reviewed the English authorities quoted above, contrasting those interpreting the equivalent provisions under the Community Trade Mark Regulation. She noted, in particular, the views expressed by

Richard Arnold QC in another 'EXTREME' case (BL O/161/07 (coincidentally not the same as the mark under consideration), as follows:

“52. I considered the principles applicable under section 46(5) at some length in *NIRVANA Trade Mark* (O/262/06) at [36]-[59]. Since then the CFI has given judgment in Case T-256/04 *Mundipharma AG v Office for Harmonisation in the Internal Market* (unreported, 13 February 2007). In that case the opponent's mark was registered in respect “pharmaceutical and sanitary preparations; plasters”. The applicant did not dispute that the mark had been used in relation to “multi-dose dry powder inhalers containing corticoids, available only on prescription” and the Board of Appeal found that the opponent had only proved use of the mark in relation to those goods. On appeal to the CFI the opponent contended inter alia that use should be taken to have been proven in relation to “therapeutic preparations for respiratory illness”. The CFI upheld this contention.

53. In its judgment, having recapitulated paragraphs [45] and [46] of its judgment in Case T-126/03 *Reckitt Benckiser (España) SL v Office for Harmonisation of the Internal Market (ALADIN)* [2005] ECR II-2861 and recorded that it was not disputed that the mark had been used in relation to “multi-dose dry powder inhalers containing corticoids, available only on prescription”, the CFI [as it then was, now the General Court] went on:

“26. Next, it should be borne in mind that the earlier mark was registered for ‘pharmaceutical and sanitary preparations; plasters’. That category of goods is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently. Consequently, the fact the earlier mark must be regarded as having been used for ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’ confers protection only on the subcategory within which those goods fall.

27. In the contested decision, the Board of Appeal held that the earlier mark was to be taken into consideration only in so far as it covered goods the genuine use of which was not contested. It thus defined a sub-category corresponding to those goods, namely ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’.

28. That definition is incompatible with Article 43(2) of Regulation No 40/94, as interpreted in the light of *ALADIN*, and applicable to earlier national marks pursuant to Article 43(3) of that regulation.

29. The Court notes in this respect that, since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product or service in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services.

30. The purpose and intended use of a therapeutic preparation are expressed in its therapeutic indication. However, the definition employed by the Board of Appeal is not based on that criterion as it does not state that the goods in question are intended for the treatment of health problems and does not specify the nature of those problems.

31. Moreover, the criteria chosen by the Board of Appeal, namely the dosage form, the active ingredient and the obligation to obtain a doctor's prescription, are, as a rule, inappropriate for defining a subcategory of goods as contemplated in *ALADIN*, as the application of those criteria does not fulfil the abovementioned criteria of purpose and intended use of the goods. In fact, a given medical condition can often be treated using a number of types of medication with different dosage forms and containing different active ingredients, some of which are available over-the-counter whilst others are available only on prescription.

32. It follows that, in failing to take into account the purpose and intended use of the goods in question, the Board of Appeal made an arbitrary choice of sub-category of goods.

33. For the reasons set out in paragraphs 29 and 30 above, the subcategory of goods covering those the genuine use of which has not been contested must be determined on the basis of the criterion of therapeutic indication.

34. The sub-category proposed by the intervener, namely 'glucocorticoids', cannot be accepted. That definition is based on the criterion of the active ingredient. As discussed in paragraph 31 above, such a criterion is not generally appropriate by itself for defining subcategories of therapeutic preparations.

35. By contrast, the definition proposed by the applicant and OHIM, namely 'therapeutic preparations for respiratory illnesses', is appropriate in two ways: first, it is based on the therapeutic indication of the goods in question and, second, it allows for the definition of a sufficiently specific sub-category, as contemplated in *ALADIN*.

36. In the light of the foregoing, the Court finds that the earlier mark must be deemed to have been registered, for the purposes of the present case, for 'therapeutic preparations for respiratory illnesses'."

.....

54. Although at first blush this suggests an approach which is somewhat different to that laid down by the English authorities considered in *NIRVANA*, I consider that the difference is smaller than might appear. The essence of the domestic approach is to consider how the average consumer would fairly describe the goods in relation to which the trade mark has been used. Likewise, paragraph [29] of *Mundipharma* indicates that the matter is to be

approached from the consumers' perspective.

55. To the extent that there is a difference between them, I remain of the view expressed in *NIRVANA* that I am bound by the English authorities interpreting section 46(5) of the 1994 Act and Article 13 of the Directive and not by the CFI's interpretation of Article 46(2) of the CTM Regulation since, as already noted above, there are differences between the two legislative contexts. Nevertheless I consider that English tribunals should endeavour to follow the latter so far as it is open to them to do so. *Mundipharma* suggests that, within the spectrum of domestic case law, the slightly more generous approach of Jacob J in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch), [2004] FSR 19 is to be preferred to the slightly less generous approach of Pumfrey J in *DaimlerChrysler AG v Alavi* [2001] RPC 42.

56. Applying these principles to the present case, counsel for the proprietor submitted that a holdall was an item of luggage and would be so described by the average consumer having regard to its purpose and intended use and that it was not appropriate to attempt to sub-divide "luggage" into narrower subcategories. With some hesitation, I have come to the conclusion that I accept these submissions".

18. The Appointed Person then commented:

"15. In *NIRVANA*, Mr. Arnold identified that the main difference between the approaches of the English courts and the General Court was that the former based a fair description of the use that had taken place on the perception of the average consumer whereas the latter provided no clear yardstick for determining when a sub-category of products cannot be further divided. To my mind, a danger with the category/subcategory approach is that invites sub-division according to the product(s) concerned. A tribunal may be seduced into equating a fair description with actual use shown."

19. Having identified the legal principles to be applied and the debate surrounding them and, noting also and in particular, the arguments based on case law to the effect that one has to be cautious about divesting a proprietor of a part of his statutory monopoly, unless one is satisfied that he ought to demonstrate confusion in fact, or at least be obliged to rely upon section 10(2), the Appointed Person proceeded then to review the evidence.

20. On reviewing the evidence, the Appointed Person noted in particular absence of distinction as between seawater and freshwater rods in trade and also that use had been shown on a variety of different rods which may have multi uses. As a result of reviewing the evidence and applying the case law the Appointed Person decided that the proprietor was entitled to use of the term fishing rods. As for "fishing tackle", Penn's use was on a variety of rods and reels. Counsel submitted that the public would refer to such items, singly and collectively, as fishing tackle. Fishing tackle was a sufficiently narrowly defined category of goods. It would not offend the non-use provisions. The purpose and intended use of fishing tackle was the same-fishing. Fishing tackle was targeted at the same consumers and marketed through the same trade channels.

21. Reference was also made by the Appointed Person to an OHIM decision issued by the Cancellation Division on 11th December 2008 under number 2533C. This concerned contemporaneous application by Fox to revoke Penn's Community trade mark. Penn was found to have made genuine use in respect of rods and reels which enabled it to retain the specification, before OHIM, of "fishing tackle". As regards this OHIM decision the Appointed Person noted that the hearing officer was right to say that she was not bound by this decision but at the same time, it could not be ignored (see ZURICH PRIVATE BANKING (BL O/201/04)).

22. Whilst they were on the wrong side of the OHIM decision, Fox rely on the same decision in this case. Svendsen urge me, in submissions I invited on the EXTREME case, to take great care when considering the persuasiveness of this decision, given especially that Fox had been on the opposite side before OHIM and had decided not to appeal. Similarly, Svendsen say that in the EXTREME case before the Appointed Person, Fox had been on the opposite side (ie as applicant for revocation) and had not appealed that decision. Accordingly, Svendsen says that Fox must have been in agreement with the hearing officer's findings in EXTREME, a position from which they cannot resile. In response Fox says that the decision not to appeal either decision is a matter for the party concerned and may have been taken for commercial reasons unrelated to the case. Furthermore, what matters is the relevance of the earlier case. If a principle of law is established and applied fairly, a tribunal cannot apply a contrary law merely because at some time in the past one of the parties put forward an argument that went counter to what has become established law. I entirely agree with Fox on this point. What was engaged in the EXTREME case before the Appointed Person case was both a principle of law and a relevant factual matrix, which is why I have gone into the case in such depth, and the particular parties involved and positions they took is not relevant for my purposes. By the same token, whilst the OHIM decision did not involve a principle of law necessarily, Fox are entitled to draw my attention to it (see ZURICH PRIVATE BANKING), whatever their own arguments may have been in that case. To say that the earlier position adopted by Fox is one from which they are incapable of resiling is plainly wrong.

23. I appreciate however, that it is one thing for me to place reliance upon the EXTREME case, in terms of its help in identifying the correct legal principle to be applied, and another to assert that its factual matrix is, if not identical, then very similar. I need also to look at the evidence in this case to see if it merits the same or similar 'conclusion' as in the EXTREME case. In this respect, as the specifications are not identical (the specifications in this case are "angling equipment and angling accessories" rather than "fishing tackle" and specific types of tackle) I need to ensure that the 'generous' approach to a fair specification advocated by EXTREME would result in the retention of Fox's full specification.

24. The evidence in this case comes from Paul Reeves, Commercial Director of Fox. He has filed two witness statements dated 11th January 2010, one for each mark. In respect of the NEMESIS mark, he says that between 13th July 2007 and 5th October 2009, 1031 products to a value of £15, 848.00 have been sold bearing that name. NEMESIS is used on two items: a sea rod (also described as a beachcaster) measuring 15', suitable for casting leads from 2-7oz and for use with fixed or

multiplier reels., and secondly, a surface lure suitable for, eg pike and sea bass. The evidence comes 'The Fox Guide to Modern Sea Angling', distributed in February 2008 and Fox's catalogue published on their website which includes administrative pages (Exhibit PR1). The webpage created for the lure is dated 9th January 2009 and the webpage for the rod was created 20th August 2007. Exhibit PR2 comprises Fox's price lists for June 2007 showing the rod, January 2008 also showing the rod, and January 2009 showing the rod and lure, together with product codes. Exhibit PR3 comprises invoices to a selection of outlets showing use of the mark, either on single item invoices or with other fishing items. Exhibit PR4 comprises extracts and articles on the product from magazines or periodicals. Mr Reeves says that £2,000 has been spent on advertising the brand between 9th November 2007 and 26th February 2009 and that it has been sold across the UK.

25. As regards the mark VIRAGE, Mr Reeves says that 87 items to the value of £5,729.00 have been sold between 13th July 2007 and 5th October 2009. The mark is used, according to the relevant web page from Fox's catalogue on a 13' beachcaster rod for use with a multiplier reel and suitable for casting between 4-7oz. The actual mark used is 'VIRAGE SURF' but Svendsen has expressly conceded that use of VIRAGE has been made on rods and lures. Given this express concession I will not undertake an analysis of this question of use of an 'acceptable variant'. Unlike the NEMESIS mark there is no evidence of use of the mark in respect also of lures and anything apart from rods. As with NEMESIS there is evidence of use in Fox's price lists (Exhibit PR2), invoices (Exhibit PR3) and articles (Exhibit PR4). Advertising spend is said to be £1,000 between 13th July 2007 and 5th October 2009. As compared with NEMESIS, use of the mark VIRAGE is somewhat less with, eg only 9 items to a value of £590.00 sold between 1st January 2009 and 5th October 2009.

26. Given my evidence summary, it is surprising to say the least (but it does not affect my overall finding below) that Svendsen has expressly accepted that VIRAGE is used on rods *and* lures (as opposed to rods only) as the exhibits do not establish this. On the other hand, NEMESIS has been used on both rods and lures. Despite this, I now have to decide whether use on rods only or rods and lures is sufficient to justify the term "angling equipment; angling accessories". In the EXTREME case, the Appointed Person decided that use on a variety of different rods and reels justified retention of the term "fishing tackle". In the earlier EXTREME case, Richard Arnold QC decided that use in respect of holdalls only justified retention of the term 'luggage', even though a holdall is but one type or category of luggage.

27. As a starting point, although it is for the sake of consistency, tempting, I do not believe it is an option for me to replace the term "angling equipment; angling apparatus" with "fishing tackle". That would be to reword the specification on the registered proprietor's behalf which I do not believe I am entitled to do, (see, eg SENSORNET BL O/136/06). The question for me is whether such limited use justifies the *existing terms* in the respective specifications. Svendsen say the existing terms are very broad and would include, eg a trawler. This is to exaggerate the case as a 'boat' would properly be classified to Class 12 rather than Class 28, which is where both identical specifications are contained. It is also worthwhile noting that the term, "angling equipment; angling accessories", is in any event narrower in scope as a starting point, and in purely linguistic terms than "fishing tackle". The dictionary definition of "angling" is as follows"

“angling”

→ **noun**

[mass noun] (*Brit.*) the sport or pastime of fishing with a rod and line.”¹

In contrast, the dictionary definition of “fishing” is as follows:

fishing

→ **noun**

[mass noun] the activity of catching fish, either for food or as a sport².

In linguistic terms then, Fox’s specification, relating as it does to ‘angling’ rather than ‘fishing’ is actually narrower than Penn’s specification in the EXTREME case.

28. That said, as the authorities tell us, the principles to be applied are those of a ‘value judgment’, based upon consumer perception and descriptions in trade, rather than from a dictionary. In this context it is clear from the evidence that, as with the EXTREME case, traders in this field invariably sell a wide range of equipment which although it may be described as having, eg use in relation only to sea fishing or beachcasting, may in fact have multiple use (the lure for example is described as being effective for both sea bass and pike (seawater and freshwater)) and would be regarded by the consumer as, individually and collectively, as ‘fishing tackle’ or, as in this case, ‘angling equipment’. It is clear that Fox follows that pattern of supplying a range of equipment to outlets (or direct from their website), which in turn supply that range to end consumers. This background pattern of trade is important in arriving at a conclusion as, in the EXTREME case, to arbitrarily sub divide the specification based only on actual use would be potentially to deprive Fox of much of their statutory monopoly, such that confusion would have to be shown in fact, in circumstances where ‘angling equipment’ is sold in the trade collectively as opposed to different outlets selling individual items.

29. It is worthwhile just pausing at this point on the question of the effect of reducing Fox’s specification to “fishing rods; fishing lures”. What this question raises is the nature of the ‘umbra’ and ‘penumbra’ of protection which may result in such a reduction. Svendsen says that Fox are only entitled to “fishing rods and lures”, as that is all they have shown *actual* use on; they are not entitled to anything broader. This would deprive their ‘umbra’ of protection significantly, such that for any other type of angling equipment, and in any infringement action, I would have to be satisfied they would have to demonstrate confusion in fact or at least to rely on section 10(2).

¹ “angling *noun*” *The Oxford Dictionary of English* (revised edition). Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2005. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 16 August 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t140.e2629>>

² “fishing *noun*” *The Oxford Dictionary of English* (revised edition). Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2005. *Oxford Reference Online*. Oxford University Press. Intellectual Property Office. 16 August 2010 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t140.e27933>>

Would it be fair for example for them to have to prove confusion in fact or rely on section 10(2) in respect of 'reels' ? After all, they have not shown actual use on reels but that said, reels and rods are inevitably complementary, they cannot exist without each other; they are sold through the same trade channels, targeted at the same consumers and used for the same purpose. As the English authorities at least make clear, the issue involves arriving at a 'fair' specification, which necessarily engages the question of what actual use has been made, but if that actual use results in being seduced into an arbitrary subdivision, which ignores eg consumer perception and the patterns of trade, it can no longer be said to be 'fair'.

30. The position adopted by Svendsen begs another question: at what point and in respect of how many different items of angling equipment does Fox become entitled to retain statutory monopoly rights in the term "angling apparatus; angling accessories" ? At one extreme, the answer would be *all* types. This is plainly wrong, given the authority of *Reckitt Benckiser*, as it would be nigh on impossible to demonstrate use on all types. The question comes down then to how many types exactly then? In the end however, it is unhelpful to reduce the matter to such a question as what is engaged (as I have said) is a 'value judgment', based upon what would a *fair* specification be, having regard to the use made and an appropriate balance to be held between the proprietor, other traders and the public.

Conclusion

31. Seeking to apply the legal principles identified in the EXTREME case, and given the evidence in this case, in the overall circumstances, I find that Fox are entitled to retain as a 'fair' specification:

"Angling equipment; angling accessories"

in respect of both marks. The term "angling accessories" would, in my view be contained within the broader term "angling equipment" and therefore there is no point in removing the term from the specification.

Costs

32. Fox has been successful in defending against the applications and is entitled to an award of costs in its favour. I take account of the fact that no hearing took place and also that Svendsen did not contest the factual evidence, but instead confined their case to the legal question of a fair specification. I also take account of the fact that the evidence and submissions in both cases are very similar, such that to 'double up' on the award may not be properly reflective of the time and effort spent on the cases. Awards of costs are governed by Tribunal Practice Notice (TPN) 4/2007 supplemented by TPN 6/2008. Using this guidance, I award costs on the following basis:

Preparing a statement and considering other side's argument (x2) - £300

Filing evidence (x2) - £ 700

Preparing written submissions and considering those of the other side- £400

Total: £1400.00

33. I order Svendsen Sports (UK) Ltd to pay Fox International Group Ltd the sum of £1400.00. 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 September 2010

**Edward Smith
For the Registrar,
the Comptroller-General**