

O-180-11

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 2348052
IN THE NAME OF FOX INTERNATIONAL GROUP LIMITED

AND
AN APPLICATION FOR REVOCATION OF THAT REGISTRATION
UNDER NO 83639 BY SENSAS

TRADE MARKS ACT 1994

In the matter of registration No 2348052 in the name of Fox International Group Limited and an application for revocation of that registration under No 83639 by Sensas

Background

1. Registration No. 2348052 is for the trade mark CHALLENGER and stands registered for *Angling apparatus; angling accessories*. It has a registration date of 23 April 2004 and stands in the name of Fox International Group Limited (“Fox”).
2. On 13 January 2010, an application to revoke the registration was made by Sensas. The application is made on grounds under sections 46(1)(a) and (b) of the Act. Sensas alleges the registration has not been put to genuine use by Fox and that there are no proper reasons for non-use. Sensas seeks revocation from 24 April 2009 (under section 46(1)(a)) or from 7 September 2009 (under section 46(1)(b)).
3. Fox filed a counterstatement in which it denied the claims made.
4. Both parties filed evidence which I will refer to as necessary in this decision. Fox also filed written submissions. The matter came before me for hearing on 22 March 2011, when Fox was represented by Mr David Crouch of Bromhead Johnson, its trade mark attorneys in these proceedings. Sensas was represented by Mr Simon Malynicz of Counsel, instructed by Elkington and Fife LLP, its trade mark attorneys.
5. Whilst the application, as filed, sought complete revocation of the registration, Mr Malynicz indicated at the hearing that Sensas accepted that Fox has shown genuine use of the mark in relation to ‘angling rods’ and ‘landing nets’ but maintained its position that no use had been shown on any other goods. For its part, Fox accepts this to be an accurate position. But whilst the parties are in agreement as to the use made of the mark, they disagree as to whether or not the use made of the mark is sufficient to justify retention of the full specification of goods as registered. The dispute therefore comes down to a decision on what is a fair specification of goods in view of the use made of the mark.
6. In this regard, Mr Malynicz submitted that both ‘angling rods’ and ‘landing nets’ were accepted commercial sub-categories of goods and that, accordingly, the registration should be partially revoked with the specification being limited so as to reflect the actual use made. For its part, Fox submitted that use made in relation to angling rods and landing nets was sufficient to justify retention of the full specification as registered.

Decision

7. Sections 46(1)(a) & 46(1)(b) of the Act read:

“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)

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

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

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

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

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

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

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

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

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

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

8. Section 100 of the Act is also relevant, this 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.”

9. The question of what constitutes a fair specification has been the subject of a number of judgments. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, the Court said:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s. 10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for “motor vehicles” only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s. 10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s. 10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to “dig deeper”. But the crucial question is—how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox’s Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox’s Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. 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.”

10. The following comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant:

“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.”

11. Both parties referred to the decision of the Court of First Instance in *Reckitt Benckiser (España) SL v OHIM*, Case T-126/03. In this case, it was stated:

“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 to which the goods or services for which the trade mark has actually been used 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 'parts 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."

12. In this regard, I bear in mind the following comments of Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

13. Both parties also referred to the decision of Professor Ruth Annand sitting as an Appointed Person in *Extreme* BL O/217/10. Fox submits:

"In paragraph 30 of [her] decision, Professor Ruth Annand considered that the average consumer would have referred to the goods in respect of which fair use of the mark EXTREME had been demonstrated as "fishing rods". Paragraph 33 shows that fair use was also considered to have been made in relation to fishing reels. Nonetheless, Professor Ruth Annand, in the light of existing case law at that time, stated that the full specification "fishing tackle, fishing rods, reels and lines" should remain on the register.

Whilst the present mark is directed to "angling apparatus; angling accessories" and not "fishing tackle", it is respectfully submitted that this if anything is a narrower term than fishing tackle at least insofar as the latter would fairly describe heavy nets and machinery on the backs of trawlers, whereas "angling apparatus" would not, ignoring for the moment whether such heavy tackle would properly fall within class 28. It follows therefore that retention of this specification is justified on the basis of genuine use of the mark CHALLENGER by the proprietor in relation to angling rods and landing nets".

14. For its part Sensas seeks to distinguish Professor Annand's decision from the present case. It submits:

“In that case the specification was different to the present. It was for “fishing tackle, fishing rods, reels and lines”.

Prof Annand found that there had been use on rods and that qualifying it to sea and saltwater rods was not fair because, in effect it was being too picky: see §30. That issue does not arise in the current case because the applicant is not seeking to “dig deeper” within “rods”.

The next issue concerned “fishing tackle”. The Appointed Person considered that there had been use shown in relation to rods and reels which she held to be sufficient to maintain fishing tackle: see paragraph §39. That issue does not arise in the current case either as the specification is not for “fishing tackle” but for “angling apparatus; angling accessories” which is wider.

Finally of course, the evidence was different to that produced in the current case.”

15. Sensas has filed evidence from Mitchell Smith who is its UK Carp Fishing Manager, a position he has held for five years having been employed in the fishing industry for over 25 years and with experience as an angler for 32 years.

16. Mr Smith states that the term “angling apparatus” is not generally used because it covers an extremely broad range of goods. Somewhat contradictorily, he himself uses the term when he states that pages taken from the Fox website exhibited at MS2 show that company to provide a broad range of fishing and angling apparatus. He goes on to state that angling and fishing shops use the term “angling accessories” to refer to “minor items (sic) of fishing and angling equipment that are not central to fishing including items (sic) such as swivels (sic), baiting tools, lead shot, bait boxes, feeders, bait riddles, line markers and catapults” though he gives no details to explain how he reaches this conclusion. He states his belief that rods and landing nets will not be referred to as angling apparatus and accessories by the average consumer and that they are likely to be sold in separate parts of a store.

17. Stuart James Angel is the Manager of Davies Angling, a fishing and angling equipment shop located in Staines. He states he has held this position for some 21 years and has been a fishing and angling enthusiast for more than 30 years. Mr Angel states that anglers and fishing enthusiasts:

“generally do not use the term “angling apparatus” because of the breadth of this term which would cover an extremely broad range of goods, including fishing rods, reels, seat boxes and lines, all of which could be used directly in relation to angling and fishing.”

He goes on to say that he:

“believe[s] that angling and fishing shops use the term “Angling accessories” but this refers to less important items of fishing and angling equipment which

are not vital to fishing including items such as swivels, baiting tools, lead shot, bait boxes, feeders, bait riddles, line markers and catapults etc.”.

He says that:

“Fishing rods and landing nets are clearly central to the activity of fishing and most anglers will own or have access to these items, I believe therefore that fishing rods and landing nets form their own clearly identical (sic?) group of items. Angling and fishing customers purchase fishing rods and landing nets by reference to these names. In addition, I believe that customers will refer to these items by the terms “fishing rods and landing nets” when purchasing such items in fishing and angling outlets.”

He concludes by stating his belief that:

“fishing rods and landing nets are ordinarily sold in specific sections of angling and fishing shops where the customer can easily view and locate these items”.

18. There are a further seven witness statements. These have been filed by:

Nigel Newport, Manager of Tackle Up, a fishing and angling equipment shop in Fleet;

Mark Barnet, proprietor of Mark II angling, of Crayford;

Timothy Nicholas Johns, Director of Burgess Hill Angling Centre Ltd, a fishing and angling equipment shop in Sussex;

Sean Manning, proprietor of Mannings Fishing Tackle, a fishing and angling equipment shop in Waterlooville;

Ricci Connolly, proprietor of Fishon-Online, an online fishing and angling store;

Lewis Read, Marketing and Product Development Manager of Gardner Tackle Ltd of Guildford which produces and sells a range of carp and coarse fishing equipment; and

Mark Haywood, Commercial Director of W B Clarke Ltd of Evesham.

19. The witness statements filed by each of these gentlemen are largely identical, both in form and content, to that of Mr Angel, including, in some instances, mistakes in spelling.

20. In *Re Christiansen's TM* [1885] 3 RPC 54 at 60 Lord Esher MR stated:

“Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same

stereotyped affidavit, if I am called upon to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has drawn the whole lot of the affidavits, and they adopt that view as a whole and say 'I think that affidavit right' and they put their names at the bottom."

21. I do not consider, however, that anything turns on this evidence which is, in essence, somewhat vague evidence of opinion. What is of more significance is Exhibit MS3 of Mr Smith's evidence, which consists of some 1300+ photocopies pages which together form several catalogues and product guides from a range of suppliers which show how they categorise various goods. The catalogues are as follows:

1. Preston Innovations 2008/2009 Product Guide. The index of this catalogue is broken down into two parts. The first part has no heading but lists various items such as 'X Box Seatboxes', 'Off Box', 'Carp Poles', 'Margin Poles & Whips', 'Sentient Float Rods', 'Super Sentient/Sentient Feeder Rods', 'Dutch Master Rods' and 'Pole Elastic Elastication'. The second part is headed 'Accessories' and lists various items including 'Pole Floats', 'Ready-made Rigs', 'Pole Accessories Pole Protection Preston Winders', 'Landing Nets and Handles', 'Hardcase luggage', 'Competition luggage', 'Essential luggage' and 'Fleeces, Shirts and Headgear';
2. Sensas' own 'Starbaits' Catalogue 2009. The index page separates the goods within the catalogue into eight product headings including 'rods and nets', 'luggage', 'accessories' and 'clothing'. Under the 'rods and nets' section, the listing includes 'rod accessories' as well as various rods and nets listed by sub brand. Under the 'accessories' section are listed 'feeding', 'rod pods' and 'banksticks';
3. Wychwood 2008 catalogue. The contents page is split into two sections i.e. 'stuff' and 'things'. Under 'stuff' are separate listings for such items as 'rods', 'reels', 'chairs', 'landing nets', 'banksticks', 'rigs' and 'clothing'. Under 'things' are listed 'alarming stuff', 'advanced bags' and 'clothing to see you through';
4. Sensas 2010 catalogue. The contents page has separate entries for 'poles', 'rods', 'baits', 'accessories', 'luggage', 'landing/keepnets', 'seatboxes & accessories' and 'clothing'. Under the 'accessories' pages are included such items as hooks, hook length boxes and hook wallets, elastic, line, connectors, disgorgers, bristle markers and worm scissors. The 'Seat box accessories' page shows such items as bait weighters, side trays, support bars and umbrella arms;
5. Korum product catalogue 2009. The contents page lists, separately, 'luggage', 'rod holdalls', 'rods', 'chair/chair accessories', 'landing nets', 'hooks & rigs', 'rig accessories', 'accessories and tools', 'rod support and bite alarm' and 'clothing';
6. The Garbolino Fishing Collection 2009. The index page lists separately 'competition poles', 'competition/multi purpose poles', competition

accessories', feeder rods', 'float rods', pole accessories', landing net handles', 'keepnets', 'seatbox accessories', 'luggage' and 'clothing and accessories';

7. Preston Innovations 2010 Product guide. The contents page has sections for 'seatboxes', 'box accessories', 'poles', 'rods' 'accessories', 'luggage' and 'clothing'. Under the 'accessories' heading are listed 'general accessories', 'landing nets' and 'keepnets'. The 'general accessories' pages shows such goods as olivettes, silicone tubing, scissors, swivels, float stops, disgorgers and pole end protectors;
8. Fox 2008 catalogue. The contents page lists, separately 'rods', 'luggage', 'sleeping bags', 'hooks', 'ready made rigs', 'accessories', 'sunglasses' and 'clothing'. The accessories pages shows goods such as bait pots, boilie stops, tension bars, baiting needles, glue pens, tubing, leads, weights and swivels;
9. Maver 2010 Trade catalogue. The contents page lists, separately, 'poles', 'rods', 'nets & handles' 'luggage' 'clothing' and 'accessories'. Under the accessory pages are shown reel line, line floats, hooks, bait bands, worm scissors, weed cutters, flasks, pole cleaner, swivels, pole feeders, rod stands and pellet wagglers;
10. Waterline 2005 Trade catalogue. The extensive index at the back of the catalogue has no entry for 'accessories' but includes entries for such items as 'bank sticks', carryalls', 'chopped worm scissors', 'clothing', 'eyed barbless hooks', 'float accessories', 'fly fishing accessories', 'handles, net', 'holdalls', 'luggage', 'poles', 'rods', 'rod kits', 'swivels', 'thermal clothing', 'vision poles' and 'whale spit'.

22. Whilst some of these catalogues date from after the relevant period, there has been no challenge to them and I have no reason to doubt that they reflect a position which has existed for many years. The catalogues are those of a range of suppliers and show how the various companies categorise their goods. In its own 2009 Starbaits catalogue, for example, Sensas has a separate listing for 'clothing' and another for 'accessories' with 'accessories' said to include e.g. banksticks. The Wychwood 2008 catalogue categorises both 'clothing' and 'banksticks' as 'stuff' (though it also categorises 'clothing' under 'things'). The Preston Innovations 2008/2009 catalogue includes entries for various types of luggage and clothing under the heading 'accessories' whereas the Garbolino 2009 catalogues lists 'luggage and clothing' together as a separate category. Turning to the goods at issue in these proceedings, the Waterline 2005 catalogue has no entry for 'accessories' but does include an entry for 'fly fishing accessories', the relevant pages showing a range of items such as seats, bags, scissors and nets. The Preston Innovation 2010 catalogue lists 'landing nets' and 'keepnets' separately under 'accessories' whereas in its 2008 catalogue under 'accessories' it lists 'landing nets & handles' and 'keepnets brollies' with 'rods' listed as a separate category. Sensas' Starbaits 2009 catalogue lists 'rods and nets' together as one category but its 2010 catalogue lists them as separate categories. Some of the catalogues refer to 'rods' and 'poles' separately or categorise them by their method of operation (e.g. feeder rods, sentient float rods), whilst others categorise them by their intended use (e.g. carp poles,

competition poles), by brand name or include them within the category of 'ready made rigs'.

23. From the evidence, it is clear that whilst there is a high degree of commonality of the types of goods supplied by various companies, those companies have their own ways of categorising those goods. As exemplified in the Sensas catalogues, the same company may change its categorisation from one catalogue to the next.

24. As far as I can tell, none of the catalogues provided show use of the term 'apparatus' in relation to goods for use in angling. Apparatus may or may not be the most common word to use when describing goods for use in angling however its meaning is clear and will be well understood by anglers as meaning equipment or tackle. As noted above, Mr Smith himself uses the word to describe the goods offered for sale via the Fox website. Furthermore, the Collins dictionary 3rd Ed. defines apparatus as "a collection of instruments, machines, tools, parts or other equipment used for a particular purpose" whereas 'equipment' is defined as "a set of tools, devices, kit, etc., assembled for a specific purpose" whilst 'tackle' is defined as "the equipment required for a particular occupation, etc.: *fishing tackle*". The argument that the word apparatus has a different meaning is a purely semantic one. Whether the word used is apparatus, equipment or tackle, each is used in common parlance and all are synonymic.

25. Sensas submits that the use shown in respect of *angling rods* is insufficient to justify retention of the term *angling apparatus* as rods are a separate sub-category of goods. I accept that some of the catalogues within the evidence have separate index listings for 'rods', but others do not. And what one company refers to as a rod, appears to be described by others as a pole or a rig which further blurs the categorisation. The same evidence shows that the term *angling accessories* is equally widely interpreted by the various companies who are represented in that evidence. As can be seen above, whilst some companies list landing nets separately, others list them with limited other goods (e.g. landing nets and keepnets), others list the net separately from the handle and still others include landing nets within the term 'accessories'. Again, the word 'accessory' is a well-known one and can be defined as a supplementary part or object. A landing net is an accessory for use in angling.

26. Whilst I accept the mark has been used on a limited range of goods, taking the evidence as a whole, I am not persuaded that it supports Sensas' submissions that *angling rods* and *landing nets* are each separate sub-categories of goods such that the specification of goods as registered should be subject to a limitation. *Angling rods* and *landing nets* are both articles of angling apparatus. I consider the registration should remain on the register for the specification of *angling apparatus*; *angling accessories* as this represents a fair description of the use made of the mark.

Costs

27. Fox has been successful and is entitled to an award of costs in its favour. I make that award on the following basis:

Preparing a statement and considering other side's statement:	£300
Preparing own and commenting on other side's evidence:	£700
Preparing for and attending a hearing:	£500
Total:	£1500

28. I order Sensas to pay Fox International Group Limited the sum of £1500. 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 1 day of June 2011

Ann Corbett

**For the Registrar
The Comptroller-General**