

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO 2000259  
FOR THE TRADE MARK**



**IN THE NAME OF FORMULA ONE CAR CARE LIMITED  
AND THE APPLICATION FOR REVOCATION THERETO  
UNDER NO 83872  
BY FORMULA ONE LICENSING B.V.**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF registration no. 2000259  
for the trade mark**



**In the name of Formula One Car Care Limited**

**and**

**the application for revocation thereto under no. 83872  
by Formula One Licensing B.V.**

### **BACKGROUND**

1) On 23 September 2010, Formula One Licensing B.V. ("the applicant"), filed an application for the revocation of registration number 2000259.

2) The registration is in respect of the above shown mark and for the following list of goods in Class 3:

*Cleaning, polishing, scouring, waxing and abrading preparations, all for use in connection with vehicles; leather creams; but not including any such goods for use in relation to racing cars.*

3) Completion of the registration procedure for 2000259 took place on 23 August 1996.

4) The applicant seeks complete revocation of the registration under Section 46(1)(a) and Section 46(1)(b) of the Trade Marks Act 1994 ("the Act"). It claims that the mark has not been put to genuine use in the UK by the proprietor or with its consent between 24 August 1996 and 23 August 2001 and also 23 September 2005 and 22 September 2010. Success for the applicant would mean revocation taking effect on either 24 August 2001 or 23 September 2010.

5) The proprietor, Formula One Car Care Limited, filed a counterstatement, claiming that its mark has been put to genuine use in the UK by the registered proprietor, or with its consent, in connection with the goods for which it has been registered and that such use continued, uninterrupted, until at least 2008.

Further, it has been making genuine preparations to recommence use of the mark since the beginning of 2010.

6) Both sides filed evidence and written submissions. I will not detail the latter, but I will bear them in mind. Both parties also seek an award of costs. The matter came to be heard on 3 November 2011 when the applicant was represented by Mr Chris McLeod of Squire, Sanders & Dempsey (UK) LLP. The proprietor did not attend the hearing.

## **EVIDENCE**

### **Proprietor's Evidence**

7) This consists of three witness statements. The first of these is by Tracy Anne Craik, Director and Company Secretary of the proprietor. She states that she was also Company Secretary of Liberty Cosmetics Limited ("Liberty"), a company in liquidation and the previous proprietors of the contested mark. Ms Craik was employed by Liberty from September 2005 to December 2008 when it went into liquidation. She states that only towards the end of her time with Liberty did she become Company Secretary and that for most of her time at the company she held the position of Director of Design and Marketing.

8) Ms Craik recalls that Liberty had a range of products in several different markets. One of these products was a kit of car care products that was sold under the mark the subject of these proceedings. This kit "basically consisted" of shampoos, waxes, tyre cleaners, polishes as well as cloths for application and was aimed at the Christmas gift market and therefore had a very seasonal turnover.

9) Whilst she is unable to provide precise figures, Mr Craik recalls that the kit historically had good sales, but the figures began to fall away in 2006 after one of the main stockists decided to drop the line. In 2007, development began on a revamped line that included individual car care and car cleaning products with the remaining kits being sold off during 2007 and 2008. The re-launch of the revamped line, bearing the same mark, had begun before Liberty went into liquidation in 2008.

10) The second witness statement is by Bernard Wright, a director of Liberty from February 2006 to October 2008. He had overall responsibility for the sales and development of the range of car care products that the contested mark was used in respect of. He also states that these products were in a car care kit with essentially the same contents as referred to by Ms Craik. He states that the mark was applied to the external packaging of the kits, the kit bag itself and also to the labels on the individual items within the kit. Following the re-launch in 2008, the individual items continued to be labelled with the mark.

11) Prior to Mr Wright's resignation, he held sales meetings with leading retail groups, including *Tesco*, *Asda* and *IMO Car Wash* who were interested in stocking the re-launched range. He was aware that there was a continued trade in the kits during 2008 as the old stock was sold off.

12) The third witness statement is by John Scott, founder of Liberty and Managing Director of the proprietor. He states that Liberty launched a range of car care kits in 1994. These kits contained various products such as shampoos, polishes, waxes, screen washes, and tyre cleaners. They were sold to "relatively large" national retail companies such as *Poundstretcher* and *Wilkinsons*, who consistently bought the line of products every year. As with the other two witnesses, he states that because of the liquidation of the company, he is unable to access precise figures. Nevertheless, he recollects that, despite the kit only being a seasonal product, sales were in the region of £100,000 to £200,000 in 2005 and that following the decline in sales, he estimates sales of about £20,000 in 2007 and £12,000 in 2008.

13) Mr Scott explains that the main form of promotion undertaken was attendance at a Spring fair in Birmingham that Liberty "attended for many years" and where products featuring the mark were promoted. He states that the fair is one of the largest gift buying trade exhibitions in the UK. Liberty last attended in 2005.

14) The retailer *Poundstretcher* ceased to stock the product in about 2005 and *Wilkinsons* ceased to stock it from 2006 and in 2007, Liberty ceased production of the kit. In mid-2008, Liberty produced prototypes of the new individual range and had begun negotiations with some major outlets, but the new range was never bought to market as a result of Liberty going into liquidation. He states that the current proprietor wishes to re-launch the product and that preparations are ongoing.

### **Applicant's Evidence**

15) This takes the form of a witness statement by Christopher James McLeod, Director of Trade Marks for Squire, Sanders & Dempsey (UK) LLP, the applicant's representatives in these proceedings. He states that in July 2010, an investigation firm called Amsel & Co ("Amsel") were instructed to conduct an investigation into the use of the contested mark. Amsel's report is provided at Exhibit CJM1. This report confirms that Amsel was unable to locate any use of the contested mark when conducting Internet searches, contacting Telephone Directory Enquiries, searches of media and advertising databases, and corporate enquiries about the proprietor.

16) At Exhibit CJM2, Mr McLeod provides an extract from the ICC companies database recording that the proprietor is a non-trading, dormant company. An extract from the same database and relating to Liberty is provided at CJM5. Its

principle activities are recorded as “The manufacture and distribution of cosmetics and toiletries.”

17) Exhibit CJM7 consists of a print of a page from Liberty’s website [www.libertycosmetics.co.uk](http://www.libertycosmetics.co.uk) obtained from the Wayback Machine website and is from the year 2001. The following statement appears on the page:

“Liberty Cosmetics Limited is a well-known British manufacturer and supplier of cosmetics, perfumes and toiletry gift sets. ...”

### **Proprietor’s Evidence in Reply**

18) This takes the form of a second and third witness statement by Mr Scott, a second witness statement by Ms Craik and a witness statement by Edmund Stephen Harrison, registered trade mark attorney at Mewburn Ellis LLP, the proprietor’s representative in these proceedings.

19) In his second witness statement, Mr Scott states that he has contacted Liberty’s liquidators, Christopher Haworth & Co in an attempt to obtain historical information. He states they are reluctant to release such information as their duty is to best protect the creditors. Consequently, Mr Scott states there is “a real and insurmountable reason why documentary evidence is very hard to provide”.

20) At Exhibit JS2, Mr Scott provides a “full stock valuation list” from around June 2008. On page 34 of this list is an entry for “assorted car care kit” having a recorded total “selling price” of “£966.04”. Mr Scott conforms that these goods would have been bearing the mark.

21) In response to Mr McLeod’s evidence he states that:

“the car care product was not a significant product for the company, but I can categorically state that Liberty Cosmetics Limited did indeed produce car care kits bearing the trade mark during a period of five years up to the date on which the application to revoke the trade mark was filed.”

22) In his third witness statement, Mr Scott states that Liberty’s principle activity was the manufacture and distribution of cosmetics and toiletries, but that it was also involved in the manufacture of car care kits. He explains that these kits were then marketed and distributed by a wholly owned subsidiary of Liberty, called Homefresh (Laboratories) Limited.

23) Mr Scott extrapolates from data provided in earlier exhibits that around 7000 kits bearing the mark were sold between June 2008 and 5 December 2008.

24) In her second witness statement, Ms Craik provides a copy of a stock list and covering email dated 4 July 2008. The email is from

[joanne@libertycosmetics.co.uk](mailto:joanne@libertycosmetics.co.uk) and Ms Craik explains that “Joanne” is Joanne Carden, and was one of the stock controllers at Liberty. It begins “Hi John” and Ms Craik explains that this is a reference to John Scott who must have requested the stock list at that time. The stock list contains the entries “care care kit white wadded cap” and “car care kit 150ml rectangular bottle”. It records nearly 15,000 of the latter items.

25) Ms Craik makes a number of submissions that I will not detail here, but I will keep them in mind.

26) Mr Harrison, in his witness statement, provides evidence in response to Mr McLeod’s witness statement and accompanying Exhibit CJM7 where evidence obtained from “WayBack Machine” is provided. At his own Exhibit ESH1, Mr Harrison provides a printout of “frequently asked questions” from the website of the company responsible for “WayBack Machine”. This states that “Some sites may not be included because the automated crawlers were unaware of their existence at the time of the crawl. It is also possible that some sites were not archived because they were password protected, blocked [...] or otherwise inaccessible to our automated systems” as well as providing instructions for people wishing to have websites found by WayBack Machine, suggesting that its record is not complete.

27) At Exhibit ESH2, Mr Harrison exhibits a letter marked for his attention, dated 6 May 2011, from C G T Haworth of Chris Haworth & Co. Mr Haworth advises that he was appointed liquidator for Liberty and that he is able to confirm that, at the date of liquidation, there were no car care products bearing the mark in stock “because they has previously been sold or cleared by the company.”

## **DECISION**

28) 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.”

29) 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.”

Consequent upon section 100 the onus is upon the registered proprietor to prove that it has made use of the trade mark in suit, or that there are proper reasons for non-use.

30) The application for revocation is based on Section 46(1)(a) and Section 46(1)(b). In *Philosophy di Alberta Ferretti Trade Mark* [2003] RPC 15, the Court of Appeal held that an application for revocation on the grounds of non-use may be made only after the five years following completion of the registration procedure has ended. The date for revocation is the date that the application for revocation was made, and cannot be less than five years from the date the registration procedure was completed. In *WIS/ Trade Mark* [2006] RPC 22, Geoffrey Hobbs QC, sitting as the Appointed Person said:

“...This permits revocation with effect from the day following the fifth anniversary of completion of the registration procedure in the case of an application which succeeds under s.46(1)(a) and with effect from any subsequent date at which there has been suspension of use for an uninterrupted period of five years in the case of an application which succeeds under s.46(1)(b).”

31) Therefore, I have to consider whether there was genuine use in the UK of the proprietor’s mark, for all or any of the goods for which it is registered, by the proprietor itself or with its consent between 24 August 1996 and 23 August 2001 and between 23 September 2005 and 22 September 2010.

32) The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40, *La Mer Technology Inc v Laboratoires Goemar SA*, Case C-259/02 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Anna Carboni, sitting as the Appointed Person in O-371-09 SANT AMBROEUS:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to



summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine

commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].

33) Taking account of this guidance from the courts it is clear that genuine use does not need to be quantitatively significant and that, when asking if the use is genuine, it is necessary to assess all surrounding circumstances.

34) At the hearing, Mr McLeod reminded of the onus upon the proprietor pursuant to Section 100 of the Act. In this respect, Mr McLeod made a number of criticisms of the proprietor's evidence. These can be summarised as:

- Despite submitting numerous witness statements, not one witness was able to furnish the proceedings with one exhibit illustrating use of the mark;
- The probative value of the witness statements is questionable because, in the absence of collaborative records, they rely upon recollections relating to a number of years ago and that such recollections may not be correct;
- The letter from the liquidator is hearsay and therefore carries little weight and, anyway, it does no more than demonstrate that as of December 2008, Liberty had no stock of car care kits.

35) Therefore, Mr McLeod is urging me to reach a conclusion that, in the absence of any exhibits illustrating use of the mark, I am compelled to find that there is no genuine use. This is not necessarily so. I must consider all the evidence before me and assess what weight to give to this and whether or not it satisfies the requirement of demonstrating genuine use taking account of all the relevant factors. Further, where there are deficiencies, I will consider what the reasons are for these and what impact this may have upon my considerations.

36) With this in mind, from the evidence, I note the following:

- Three different individuals (Mr Scott, Ms Craik and Mr Wright), all involved with Liberty during the relevant period, state that the mark, as registered, was the mark that appeared upon the goods. They all exhibit the mark with their witness statements;
- The same three individuals all corroborate that car care kits were sold under the mark in question. Liberty sold such kits from 1994 to 2008, but it is unclear when the trade mark was first used. Ms Craik states that it was used during her time with Liberty, namely between September 2005 and December 2008, when Liberty went into liquidation;

- Both Mr Wright and Ms Craik recall that the kit included shampoos, waxes, tyre cleaners and polishes. Mr Scott recalls a list of contents that match this, but also included screen wash;
- Mr Scott recalls that the kits were sold to retailers such as *Poundstretcher* and *Wilkinsons*;
- Ms Craik cannot recall the level of sales of the kit, but can recall that it historically had good sales, but that sales began to fall away in 2006 after the loss of a main stockist. Mr Scott's recollection is somewhat better, stating that sales were in the region of £100,000 to £200,000 in 2005 before declining to about £20,000 in 2007 (after *Poundstretcher* and *Wilkinsons* had ceased to stock the product) and £12,000 in 2008;
- Mr Scott and Ms Craik exhibit a stock valuation list and a stock lists respectively. Both are from the Summer of 2008. The former records that the selling price of the stock held for "assorted car care kit" was £966.04. The latter records that nearly 15,000 bottles and caps for such kits were held. Mr Scott confirms that these goods would have borne the mark;
- Mr Scott explains that the reason that more detailed evidence cannot be provided is because the liquidator is reluctant to release information about the mark and sales relating to it, despite being approached.

37) Richard Arnold Q.C. (as he then was) sitting as the Appointed Person in *EXTREME Trade Mark* BL O/161/07 commented:

"Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence."

38) Mr McLeod was at pains to point out that he was not challenging the evidence *per se*, but rather, he was challenging the probative value of it. As such, I am not being invited to disbelieve the evidence. With that in mind, even taking account of the negative impact upon the probative value created by the complete lack of exhibits showing the mark in use, the evidence when viewed in its entirety provides a compelling case that there was genuine use of the mark between

2005 and 2008. Even if, as Mr McLeod submitted, some of the recollections of the witnesses are inaccurate, they nevertheless paint a near identical picture of a car care kit containing shampoos, waxes, tyre cleaners, polishes, with one witness recalling that they also contained screen wash. They all state that these kits carried the mark in question.

39) It is unlikely that Mr Scott, as founder of Liberty, would have mis-recalled the primary retailers of the product, namely *Wilkinsons* and *Poundstretcher*, even if he was unable to recall the precise sale figures. That said, his recollection of there being sales in the region of £100,000 to £200,000 (in 2005) are consistent with Ms Craik's comments that the product has historically good sales. The two witnesses are also consistent in recalling that sales dropped off markedly after 2005 because of the loss of the primary retailer, but that stock was sold off up to 2008.

40) On the face of it, the provision of such information but without any collaborative exhibits showing use during the relevant period will raise serious and fair questions as to the probative value of the statements. However, in this case, a reason has been provided, namely that any corroborative evidence is in the possession of the liquidator of Liberty and, as such, it is not accessible to the proprietor despite making efforts to do so. This reason appears to me to be plausible and is consistent with the statements of the witnesses. Taking this into account, together with the consistent message that can be drawn from the different witnesses' statements, I find that the evidence is sufficient to demonstrate that genuine use of the mark was made in respect of car care kits. Such use relates to both of the relevant periods, even though, with *Poundstretcher* ceasing to stock the product from about 2005 and *Wilkinsons* ceasing to stock it from 2006, the sales were significantly reduced during the first two years of the second relevant period and ceased altogether after 2008. A finding of genuine use is further supported by Mr Scott's statement that the product bearing the mark was manufactured up to 2007, over a year after the start of the second relevant period.

41) I should say that this finding is not disturbed by the lack of success that the investigation firm, Amsel, had in locating evidence of use of the mark. Its investigations did not extend to speaking to any employee of Liberty or any of the retailers of the products. As such, in light of the lack of promotion of the product, as explained by Mr Scott in his first witness statement, Amsel's investigation is not persuasive.

### **Fair specification**

42) Having established that the proprietor has demonstrated genuine use in respect of car care kits, I must consider whether such use justifies it retaining the slightly limited specification as proposed unconditionally by the proprietor in its written submissions, namely:

*Cleaning, polishing, waxing preparations, all for use in connection with vehicles; but not including any such goods for use in relation to racing cars.*

43) In considering this, I keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“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.”

44) The 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 picky 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.”

45) I am also mindful of the guidance provided by the General Court in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) (ALADIN) Case T-126/03:

“43 [...], 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.

[...]

45 [...], 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 subcategories 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 subcategory or subcategories 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 subdivisions 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) Finally, I also take account of the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

“... 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.”

47) Taking all of the above into account, it is likely that the “average, reasonably informed consumer” would, when asked to describe the proprietors goods present in its *car care kits*, describe them as “vehicle cleaning, polishing and waxing preparations” or similar . These are categories of goods that do not lend themselves to further subdivision and, as such, I find that it is appropriate for the proprietor to retain the specification of goods as suggested in its written submissions, namely:

*Cleaning, polishing, waxing preparations, all for use in connection with vehicles; but not including any such goods for use in relation to racing cars.*

48) In summary, taking account of all the surrounding circumstances, I find that there has been genuine use of the goods identified in paragraph 47 above, within the relevant time period. The registration shall be revoked in respect of the remaining terms in the specification, namely *scouring and abrading preparations* and as conceded in the proprietor’s written submissions.

## **COSTS**

49) The proprietor, being largely successful, is entitled to a contribution towards its costs. At the hearing, Mr McLeod argued that, if successful, the applicant should be entitled to an uplift within the published scale because the proceedings were “dragged out” by the proprietor who required two extensions of time before

filing its evidence in reply, and that a large amount of this evidence had no impact. The corollary of this submission is that if the proprietor is successful, as here, then its award of costs should be reduced for the same reasons. However, the proprietor's evidence was not without impact and was delayed for reasons that the Registry considered justified allowing the extensions. For these reasons, I find that this should have no bearing on the costs award.

50) Therefore, I award costs on the following basis:

Consideration of statement of case and preparation of counterstatement	£300
Preparing evidence and considering other side's evidence	£900
Written submissions in lieu of attending hearing	£400
<b>TOTAL</b>	<b>£1600</b>

51) I order Formula One Licensing B.V. to pay Formula One Car Care Limited the sum of £1600. 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<sup>st</sup> day of December 2011**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**