

**O-171-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 500918  
BY COSMETIX PTY LIMITED  
FOR REVOCATION OF TRADE MARK No. 2242032  
STANDING IN THE NAME OF  
MISS JANE G FLETCHER**

**BACKGROUND**

1) The following trade mark is registered in the name of Miss Jane G Fletcher.

Mark	Number	Date registered	Class	Specification
CARIBBEAN TAN	2242032	25.05.01	3	Suntanning preparations, sunbed creams, self-tanning applications and after-tan.

2) By an application dated 13 July 2015 Cosmetix Pty Limited (hereinafter CPL) applied for the revocation of the registration shown above under the provisions of Section 46(1)(b) claiming there has been no use of the trade mark on the goods for which it is registered in the five year period 10 June 2010 – 9 June 2015. Revocation is sought from 10 June 2015. Notice of the intention to file a revocation action was provided.

3) On 8 September 2015 Miss Fletcher filed her counterstatement. She contends that her mark has been used during the specified period. She states that it is sold via a company that she owns, Sundome Leisure Products Ltd, and is sold only to the tanning and beauty salon industry and not to the general public.

4) Only Miss Fletcher filed evidence. Neither side wished to be heard. Both sides provided written submissions which I shall refer to as and when necessary in my decision.

**MISS FLETCHER’S EVIDENCE**

5) Miss Fletcher filed a witness statement, dated 17 October 2015. She states that she owns the mark in suit and that it is used by a company in which she is a director, Sundome Leisure Products Ltd (SLP). She states that the mark in suit has been in use since May 2001 on the goods for which it is registered. She states that she has put considerable effort into promoting the brand and in keeping it a salon product supplying tanning lotions, spray tanning and self-tanning products and salon essentials to the tanning and beauty salon industry. She states that she does not sell to the general public or via websites such as eBay. She provides the following exhibits:

- CT1-9: These are copies of nine invoices. They are dated 14 July 2010 to 8 June 2015. They are all invoices issued by SLP and cover the Midlands and North of England and Scotland. The invoices are for relatively small amounts but include goods other than those listed under the mark in suit. I have extrapolated all sales of products under the mark in suit as shown in the table below:

Exhibit	Product	Date	Invoiced cost including VAT £
CT1	Coconut breeze 50 ml	14.07.10	17.63
CT2	Tropicana 50 ml	24.08.10	17.63
CT3	Coconut breeze 50 ml	18.02.11	12.60
	Tropicana 50 ml		12.60
	Sweet Sensation 50ml		12.60
	Sunkissed Shimmering Aftertan 50ml		30.00
CT4	Coconut breeze 50 ml	24.05.11	18.00

	Tropicana 50 ml		9.00
	Sweet Sensation 50ml		10.80
	Sunkissed Shimmering Aftertan 50ml		12.00
CT5	Coconut breeze 50 ml	24.06.11	16.20
	Tropicana 50 ml		16.20
CT6	Sweet Sensation 50ml	28.08.12	17.10
CT7	Coconut breeze 50 ml	01.08.13	30.00
CT8	Coconut breeze 50 ml	27.03.14	10.26
	Tropicana 50 ml		10.26
	Sweet Sensation 50ml		10.26
	Sunkissed Shimmering Aftertan 50ml		8.56
CT9	Coconut breeze 50 ml	08.06.15	18.00
	Tropicana 50 ml		18.00
	Sweet Sensation 50ml		18.00
	Sunkissed Shimmering Aftertan 50ml		18.00
	CT Display stand		0.00
	CT self Tanning Wipes		43.80
	TOTAL		387.50

- CT10 & 11: Photographs of a number of bottles, which are said to have the mark in suit upon them. However, the photograph is so blurred that the mark is not visible.
- CT12 & 13: These are said to be photographs of posters but neither show an actual poster or indeed the mark in suit.
- CT14: A photograph of a bottle which has on the label the words “Caribbean Tan” a device of a palm tree and a leaf, then in smaller print the words “sunkissed shimmering tan extender with hemp lightly fragranced salon exclusive”.

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

## DECISION

7) The revocation action is based upon Section 46(1)(b) of the Trade Marks Act 1994, the relevant parts of which read as follows:

“Section 46(1) of the Act states that:

“The registration of a trade mark may be revoked on any of the following grounds-

- (a) ...
- (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 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 is also relevant, which reads:

“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) Revocation is sought under Section 46(1)(b) in respect of the time period 10 June 2010 – 9 June 2015. Revocation is therefore sought from 10 June 2015. The revocation action was filed on 13 July 2015.

10) In determining whether Miss Fletcher has used her trade mark I take into account the case of *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, where Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung*

*Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

11) CPL criticises the evidence of Miss Fletcher stating that it shows that sales during the five year period 2010-2015 amounted to only 207 50ml bottles, one poster, one display unit and one pack of self-tanning wipes. It states that the monetary value of these sales was £325 (excluding VAT). They point out that no evidence of turnover, advertising/ promotion spend or related activity or evidence of repeat purchases has been provided. They also contend that 50ml bottles would be regarded as samples. In her submissions Miss Fletcher comments that these were sample invoices and that she could have filed a number of other invoices. She also states “they [CPL] were well aware that the delaying tactics used would prevent me from having any further evidence accepted by the Intellectual Property Office”.

12) I am puzzled by these comments as no request to file additional evidence has been made by Miss Fletcher, and any delays would simply have provided her more time to collate any such evidence.

13) I also take into account the case of *Naazneen Investments Ltd v OHIM*, Case T-250/13, in which the General Court upheld a decision by the OHIM Board of Appeal that the sale of EUR 800 worth of non-alcoholic beverages under a mark over a 5 year period, which had been accepted was not purely to maintain the trade mark registration, was insufficient, in the economic sector concerned, for the purposes of maintaining or creating market share for the goods covered by that Community trade mark. The use was therefore not genuine use. The relevant part of the judgment of the General Court is as follows:

“46. In the fifth place, the applicant argues that, in accordance with the case-law cited in paragraph 25 above, use of a trade mark is to be regarded as token if its sole purpose is to preserve the rights conferred by the registration of the mark. It claims that the Board of Appeal contradicted itself by stating, on the one hand, in paragraph 31 of the contested decision, that the total amount of transactions over the relevant period seemed to be token, and by stating, on the other hand, in paragraph 42 of the contested decision, that it did not doubt the intention of the proprietor of the mark at issue to make real use of that mark in relation to the goods in question.

47. In this connection, suffice it to point out that the applicant’s argument is based on an incorrect reading of the contested decision. The Board of Appeal used the term ‘token’ to describe the total amount of transactions, approximately EUR 800, and not to categorise the use of the mark at issue.

48. In the sixth place, the applicant claims that the Board of Appeal, by relying solely on the insufficient use made of the mark at issue, did not comply with the case-law according to which there is no quantitative threshold, determined a priori and in the abstract, that must be chosen in order to determine whether use is genuine. The Board of Appeal also failed to comply with the case-law according to which even minimal use may be sufficient in order to be deemed genuine.

49. According to the case-law, the turnover achieved and the volume of sales of the goods under the mark at issue cannot be assessed in absolute terms but must be assessed in relation to other relevant factors, such as the volume of commercial activity,

the production or marketing capacities or the degree of diversification of the undertaking using the trade mark and the characteristics of the goods or services on the relevant market. As a result, use of the mark at issue need not always be quantitatively significant in order to be deemed genuine (see, to that effect, judgments in *VITAFRUIT*, cited in paragraph 25 above, EU:T:2004:225, paragraph 42, and *HIPOVITON*, cited in paragraph 27 above, EU:T:2004:223, paragraph 36). Even minimal use can therefore be sufficient in order to be deemed genuine, provided that it is warranted, in the economic sector concerned, to maintain or create market shares for the goods or services protected by the mark. Consequently, it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine. A de minimis rule, which would not allow OHIM or, on appeal, the General Court, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order of 27 January 2004 in *La Mer Technology*, C-259/02, ECR, EU:C:2004:50, paragraphs 25 and 27, and judgment of 11 May 2006 in *Sunrider v OHIM*, C-416/04 P, ECR, EU:C:2006:310, paragraph 72).

50. In the present case, contrary to what the applicant claims, the Board of Appeal did not determine a minimum threshold 'a priori and in the abstract' so as to determine whether the use was genuine. In accordance with the case-law, it examined the volume of sales of the goods in question in relation to other factors, namely the economic sector concerned and the nature of the goods in question.

51. The Board of Appeal accordingly took the view that the market for the goods in question was of a significant size (paragraph 28 of the contested decision). It found also that the goods in question, namely non-alcoholic beverages, were for everyday use, were sold at a very reasonable price and that they were not expensive, luxury goods sold in limited numbers on a narrow market (paragraph 29 of the contested decision). Furthermore, it took the view that the total amount of transactions over the relevant period, an amount of EUR 800, seemed to be so token as to suggest, in the absence of supporting documents or convincing explanations to demonstrate otherwise, that use of the mark at issue could not be regarded as sufficient, in the economic sector concerned, for the purposes of maintaining or creating market shares for the goods covered by that mark (paragraph 31 of the contested decision).

52. It is therefore apparent, contrary to what the applicant claims, that it was in accordance with the case-law cited in paragraph 49 above that the Board of Appeal took the view that, in the present case, minimal use was not sufficient to be deemed genuine."

14) I also look to *Awareness Limited v Plymouth City Council*, Case BL O/230/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

"22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing

Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

15) I also note that in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”



16) In considering the evidence provided by Miss Fletcher, it has obvious gaps which she could and should have filled. Given the scale of her activities I assume that she purchases the product or at least the bottles from a third party. No evidence of such activity was given even in her narrative statement. No figures or examples of advertising or promotion were provided and no explanation as to how customers were even aware of her existence was provided. No turnover figures were provided for the years in question, nor was any evidence from the trade provided. Literally all that was provided was her statement that she sells products under the mark in suit and the invoices summarised above. The specification covers “Sun-tanning preparations, sunbed creams, self-tanning applications and after-tan”. Four products were named on the invoices “Coconut breeze, Tropicana, Sweet Sensation and Sunkissed Shimmering Aftertan. With the exception of the last item it is not clear which parts of the specification are represented by the other names used on the invoices. Whilst there is no *de minimus* level of use, what has to be shown is that the use is “genuine” according to the test the Courts have laid down. That requires consideration of whether the use is warranted in the economic sector concerned as a means of maintaining or creating a market share for the goods protected by the mark, the nature of those goods, the characteristics of the market and the scale and frequency of use of the mark as per *Ansul*, paragraph 43, *Sunrider v OHIM*, paragraph 70, and the order in *La Mer Technology*, paragraph 27.

17) Taking all of the above into account, I consider the extremely small level of sales said to have taken place, coupled with the lack of advertising and promotional activity is such that the evidence does not show real commercial exploitation of the mark in the UK market for tanning products. That being the case, I find that genuine use of the mark has not been shown to have been made within the relevant period in relation to the goods for which the mark is registered. The application for revocation therefore succeeds.

## CONCLUSION

**18) The mark will be revoked with effect from 10 June 2015.**

## COSTS

19) CPL has been successful and is therefore entitled to a contribution towards its costs.

Expenses	£200
Preparing a statement and considering the other side’s statement	£200
Considering the other side’s evidence	£300
Submissions	£300
<b>TOTAL</b>	<b>£1,000</b>

20) I order Miss Jane G Fletcher to pay Cosmetix Pty Limited the sum of £1,000. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 6th day of April 2016**

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