

**O-434-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. 1146532  
IN THE NAME OF COLIN STEWART ROBERTSON  
AND NICOLA MARGARET ROBERTSON**

**FOR THE FOLLOWING TRADE MARK:**

**EQUUS**

**IN CLASS 12**

**AND**

**AN APPLICATION FOR REVOCATION  
UNDER NO. 500967 BY EQUUS AUTOMOTIVE, INC.**

## Background and pleadings

1. The trade mark **EQUUS** (registration number 1146532) was filed by Colin Stewart Robertson and Nicola Margaret Robertson (“the proprietors”) on 6 January 1981. It was published for opposition purposes on 10 March 1982 and the registration procedure was completed on 7 July 1982. It stands registered for the following goods:

Class 12      Motor Cars

2. Revocation of the mark in full is sought by Equus Automotive, Inc. (“the applicant”) on the grounds of non-use. Under section 46(1)(a) of the Trade Marks Act 1994 (“the Act”), the applicant claims non-use in the five-year period following the date on which the mark was registered, i.e. 8 July 1982 to 7 July 1987, and seeks an effective revocation date of 8 July 1987. It also alleges, under section 46(1)(b), non-use in three separate periods: between 8 July 1982 and 7 July 1987, seeking an effective revocation date of 8 July 1987; between 8 July 1987 and 7 July 1992, seeking an effective revocation date of 8 July 1992; and between 17 August 2010 and 16 August 2015, seeking an effective revocation date of 17 August 2015.

3. The proprietors filed a counterstatement defending their registration. The defence is based on a claim that the “mark has been used in all three periods stated in cancellation application” and that it has been used for “motor cars and all goods/services associated with use of mark”. No claim is made in the counterstatement to there being any proper reasons for non-use.

4. The proprietors are not professionally represented; the applicant is represented by Lane IP Limited. Only the proprietors filed evidence; the applicant did not file evidence but filed written submissions during the evidence rounds. Neither side asked to be heard but both parties filed written submissions in lieu. The proprietors’ submissions contain factual information which should have been presented in evidential format. As the proprietors chose not to file evidence in reply and have not made a request for leave

to file further evidence, I disregard the evidence contained within the submissions. This decision is made following a careful reading of the papers. I do not intend to recount the parties' submissions here but will refer to them as appropriate. I will summarise the evidence only to the extent that I consider necessary.

## **The evidence**

5. The proprietors' evidence consists of the witness statement of Colin Robertson, with 40 exhibits. Attached to Mr Robertson's witness statement there is also a document headed "Trade Mark Holders' Defence Document" ("the Defence Document"). Mr Robertson states that he is the "joint owner" of Equus Cars and that he has held this position since 1981. Mr Robertson indicates that the trade mark was first used in the United Kingdom in 1981 for "[m]otor cars (and parts thereof)".

6. The evidence is not easy to follow. Very little information is contained in Mr Robertson's witness statement itself, with many of the important matters of evidence being contained in the Defence Document. Mr Robertson does not say whether this Defence Document is in his own words, although presumably that is the case. Consisting, as it does, of key information about the history of trading under the mark, it would have been preferable for this evidence to have been provided in the body of a witness statement, so that it is clear that the evidence is provided from the witness's own knowledge, is in his own words and is verified by his statement of truth. However, I have come to the view that it is appropriate to treat the Defence Document in the same way as the exhibits (which are introduced without comment in the witness statement), i.e. as verified by the statement of truth in the witness statement to which it is attached.

7. In the Defence Document, Mr Robertson states that:

"1.2 [...] all accounting/sales/invoicing documents cannot be kept forever and as such the vast majority of such documents dated before 2002 have been

destroyed to make room for further storage. We therefore have no remaining accounting records of sales, purchases or turnover before 2002.

1.3 Additionally, the Holders were subjected to a fire in March 1998 that resulted in the loss of some irreplaceable record photos, drawings, product details and literature, particularly for the period 1988-98. Fortunately, the equivalent information before 1988 was kept in a separate location”.

8. A number of amended certificates of registration for VAT are exhibited at CSR1, CSR4, CSR5, CSR10, CSR11, CSR13 and CSR14. The effective date for all of these is 10 September 1981. Exhibit CSR1 is in the names of the proprietors, who are indicated also to be trading as “EQUUS DESIGN”, with a date of issue of 3 February 1984. Exhibit CSR4 is in the names of the proprietors and was issued on 29 August 1987. Exhibits CSR5, CSR10, CSR11, CSR13 and CSR14 are in the names of the proprietors. Part of the address has been redacted but “EQUUS CARS” follows the redaction. The amended certificates were issued on 24 July 1991, 4 August 1993, 21 March 1997, 26 September 2003 and 30 December 2004, respectively. Only the first of these dates falls within one of the claimed periods of non-use.

9. Exhibits CSR2, CSR3, CSR6 to CSR9, CSR15 and CSR16 are the front pages of VAT returns. CSR2 and CSR3 are in the names of the proprietors also trading as “EQUUS DESIGN”, for the periods 1 May 1984 to 31 July 1984 and 1 May 1987 to 31 July 1987, respectively. Exhibits CSR6 to CSR9, CSR15 and CSR16 are in the names of the proprietors. EQUUS CARS is also listed in the name and address box, although again part of the address has been redacted so it is not clear how the personal names relate to the name “EQUUS CARS”. They show returns for the following periods, respectively:

- 1 August 1991 to 31 October 1991
- 1 May 1992 to 31 July 1992
- 1 June 2010 to 31 August 2010

- 1 December 2011 to 29 February 2012
- 1 September 2007 to 30 November 2007
- 1 June 2009 to 31 August 2009

10. The dates in 2007 and 2009 are not within a non-use period claimed by the applicant. All of the figures have been redacted, so it is impossible to know what, if any, VAT was paid or payable. I note, however, that there is a box on the forms to be ticked if a payment is also being sent and that this box is ticked in exhibits CSR6, CSR7 and CSR15.

11. None of these documents assists the proprietors, since they only demonstrate that the proprietors, as far as the tax authorities were concerned, were also trading as "EQUUS CARS". They do not establish that the trade mark was being used to market or sell motor cars. The same can be said of the "Certificate of status of taxable person" at exhibit CSR12.

12. Exhibit CSR19A is a copy of an article from the *Daily Express* dated 27 June 1983. The copy is of poor quality and I cannot make out any reference to "EQUUS".

13. Exhibit CSR20 shows images said to be from a motor show held at Earls Court in London from 20 to 30 October 1983. The trade mark is not visible.

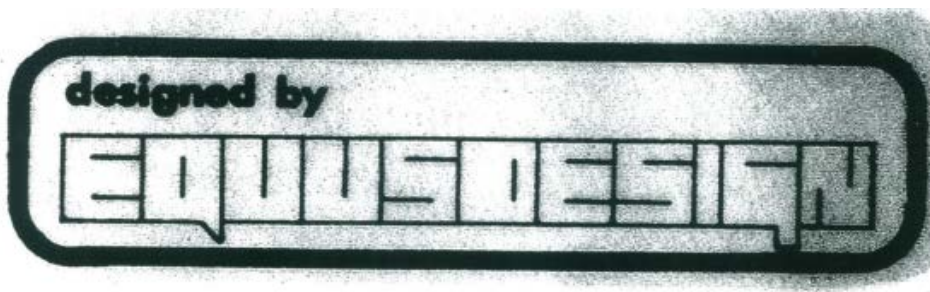
14. Exhibit CSR21 is said to show an "Equus Cavallo sign/promotional board". The first of the images is shown below (the second image appears to be of the same sign but taken from a different angle):



It would appear that this sign was used at the Earls Court motor show in 1983 (paragraph 2.0 of the Defence Document).

15. Exhibit CSR22 is said to be an image of the Equus Cavallo factory sign. The earlier mark is not visible.

16. Exhibit CSR23 shows the following image, which is said to be an “Equus Design body decal” (Defence Document, 3.10):



17. Exhibits CSR24, CSR25A, CSR25B and CSR25C show images of the exterior and interior of cars. The trade mark is not visible on any of these (it may be that it is on the number plate of the vehicle at CSR24, in the stylised format shown on the promotional sign at CSR21 but the image is not clear). None of the images is dated.

18. Exhibit CSR26 is entitled "EQUUS DESIGN STYLING KIT FOR B.L. MINI RANGE". The exhibit is not explained and it is not clear whether the parts described (e.g. bumpers) are added to a vehicle provided by the customer or whether the vehicle in its entirety is supplied by the proprietors: reference is made to trimming which may require "localised re-shaping to suit the particular vehicle" and fitting time which "depends on condition of vehicle, damaged or repaired panels etc.". There are references to "Equus Design", "Equus Cars" and "Equus" at the bottom of the page. The exhibit is not dated.

19. Exhibit CSR27 consists of three sample invoices. They are dated 19 June 2011, 3 August 2012 and 4 May 2014. The goods listed are a "sound barrier mat" at £18.00, an "Equus Design' side decal" at £10.00 and a "rear boot lid decal set" at £15.00. The customer addresses are not provided but all are indicated to be cash sales.

20. Exhibits CSR28A and CSR28B are said to be a brochure used for promotion at the 1983 motor show, though the exhibit itself is not dated. CSR28B refers, at the bottom of the page, to "Equus" and "Equus Design" being trade marks, and "Equus Cars Ltd".

21. Exhibit CSR30 is a letter dated 16 June 1983 which says that a press release and leaflet for the "Cavallo Estivo" car is attached and asks the recipient to consider including publicity information in their publication. The letterhead features a logo containing the word "EQUUS" and the words "EQUUS CARS LIMITED" but there is no indication of how many of these letters were sent or to whom. The same logo appears at exhibit CSR38, which is an example of the company stationery, and at CSR31B, attached to a fax (exhibit CSR31A, dated 19 July 1991) which asks for approval of the copy. The logo is shown below:



22. Exhibit CSR33 is a renewal notice from Namesco Limited regarding the domain name equuscars.com. It indicates that the domain name will expire on 11 October 2010.

23. Exhibit CSR34 is a “preliminary price breakdown” for the “EQUUS MINI” dated June 1990. Two options are given, priced £16,780.55 and £16,780.52. These include the cost of UK delivery.

24. Exhibit CSR37 is said to be an “Equus 160i price sheet, 1986/7”. The exhibit is headed “The new EQUUS 160i for 1988”.

25. Exhibit CSR40 is said to be a “[p]rint from CC website front page 2015”. It shows a picture of a car, under the heading “CAVALLO ESTIVO”. The earlier mark is only present insofar as there is, at the bottom of the page, the following statement: “Estivo and Equus are registered trademarks: copyright 1981-2015”.

## **Decision**

26. Section 46(1) of the Act states that:

“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 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”.

27. 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”.

28. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, 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 Bunderversvereinigung 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]”.

29. In *Reber*, the Court of Justice of the European Union (“CJEU”) said, at paragraph 34, that:

“the General Court conducted an overall assessment of that trade mark, taking into account the volume of sales of the goods protected by the trade mark, the nature and characteristics of those goods, the geographical coverage of the use of the trade mark, the advertising on the website of Paul Reber GmbH & Co. KG and the continuity of the trade mark’s use. It thus established a certain degree of interdependence between the factors capable of proving genuine use. The General Court therefore correctly applied the concept of ‘genuine use’ and did not err in law in its assessment of that use”.

30. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

31. The burden of proof in revocation proceedings is on the proprietor(s), who must show that there has been genuine use of the mark. In *Awareness Limited v Plymouth City Council*, Case BL O/230/13, 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”.

32. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/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”.

33. Mr Robertson has stated that he is “the joint owner of Equus Cars” and he ought, therefore, to be in a position to give reasonably detailed evidence regarding the use which has been made of the mark. I accept the difficulties in gathering evidence of use going back over thirty years and am mindful of Mr Robertson’s evidence that all pre-2002 sales records /invoices have been destroyed. While I have no reason to question whether Mr Robertson is telling the truth (the applicant having filed no evidence to challenge Mr Robertson’s evidence), the authorities cited above tell me that I must nevertheless consider whether the evidence filed by the proprietors is sufficient to show that the trade mark at issue has been put to genuine use in the relevant periods. Mr Robertson has indicated at paragraph 1.5 of his Defence Document that it is “our understanding that it is not a requirement to consider the success or otherwise of the use of the mark but to prove that it was used and as a necessary and genuine part of our business”. That is correct to a point. However, I hope it is clear from the authorities cited that, although minimal use *may* be enough to constitute genuine use, the assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”. For a mark which has been registered for over thirty years, and for which there has been no formal pleading of proper reasons for non-use, volume of sales will necessarily play a part.

34. Not every use of “EQUUS”/”Equus” in the proprietors’ evidence can be considered trade mark use. While it is clear that “Equus Cars” has been used as a trading name, the appearance of “EQUUS CARS” in the company name “Equus Cars Ltd” (e.g. exhibit CSR28B) does not establish that the trade mark was being used to sell motor vehicles. The same principle applies to indications at the bottom of pages or at the end of brochures (such as exhibit CSR26) that “Equus Design is a trademark of Equus Cars”. This is not trade mark use: informing readers that the company owns a trade mark is not the same as using the mark on, or in relation to, the goods for which it is registered, so that the mark functions as an indication of the origin of the goods

35. Nonetheless, it is apparent from elsewhere in the evidence that there is trade mark use of the contested mark (I will come to whether these instances constitute genuine use shortly). Some examples of trade mark use are at exhibits CSR26, CSR34 and CSR37. Other examples of trade mark use are on the invoices at exhibit CSR27 and on the letterhead at exhibit CSR30. The mark is also used alongside other matter and in a stylised form, as shown below:



36. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period



following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1) [my emphasis].

37. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under s.46(2) of the Act as follows:

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

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

38. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

39. The mark at (i), above, where the word “EQUUS” appears in a roundel device is, in my view, use of the mark as part of a composite mark, as described in *Colloseum*. This constitutes use of the mark as registered. It is less straightforward with the mark at (ii), above, where the word “EQUUS” appears in a fairly heavily stylised typeface. However, for reasons which will become apparent, I intend to assume, without deciding, that this is use of the mark in a form which does not alter the distinctive character of the registered mark and I proceed on that basis.

40. I will consider each of the relevant periods in turn, starting with the most recent relevant period.

17 August 2010 – 16 August 2015

41. This period postdates both the routine destruction of records and the fire to which Mr Robertson has referred. There is, however, scant evidence of use of the mark shown in this period. I have already explained why the tax documents do not assist the proprietors. The ownership of a domain name (exhibit CSR33) cannot, of itself, create or maintain a market for goods or services and, on that basis, cannot constitute genuine use of a trade mark. Mr Robertson says that the company sold parts, souvenirs and materials through its two websites.<sup>1</sup> There is, however, no documentary evidence to show which goods were marketed, the use of the trade mark in marketing those goods or the level of sales. Mr Robertson also states that:

“The Holders acknowledge that Equus Cars’ scale of turnover at [16 August 2015] was a fraction of that in the 1980s/90s, but state that is not owing to lack of promotion but the recognition that it is now impossible to compete, in the longer term, with high volume manufacturers. Despite this, Equus/Cavallo Cars continues to trade and submit annual accounts with a much reduced but profitable business based upon the goodwill of the brands...”.

42. That may well be the case. However, nowhere in the evidence is there even a global figure for the turnover of the business in any period, let alone a figure for the volume of sales of motor cars under the mark at issue in this—or any other—relevant period. The image at exhibit CSR40 is said to be from the “CC website” but does not feature “EQUUS” in trade mark use. The sample invoices at CSR27 fall within the latest relevant period but total just £43 and are for accessories for cars (rather than motor cars themselves). I come to the clear view that the evidence does not demonstrate genuine use of the mark in this period.

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<sup>1</sup> Defence Document, 2.0.

8 July 1987 – 7 July 1992

43. Mr Robertson states that “Equus Design brand body kits” were produced between 1986 and 1988. This is supported by exhibits CSR24 and CSR26. There is also shown in evidence an “EQUUS MINI PRELIMINARY PRICE BREAKDOWN” dated June 1990 (exhibit CSR34). The difficulty for the proprietors is that no information has been provided to explain how, when or where these goods were advertised or sold. Nor is there any information about how many were sold or to whom.

44. I recognise the challenges in finding evidence of use from many years ago, especially given Mr Robertson’s stated reasons for not providing documentary evidence of, for example, invoices. However, given his position in the company, Mr Robertson is ideally placed to account for any inadequacies in the documents available. Unfortunately, he has not done so. He states that:

“Production of both models was sporadic with the final version completed in 1988 although replacement body parts/components continued to be sold in the late-1990s and again between 2009 and 2013.

During the whole development/production periods all prototype and production Cavallo and Equus models carried the ‘Equus Design’ badge” (Defence Document, 2.0).

45. However, no details have been provided regarding actual or potential sales, or of the advertising efforts made in respect of goods sold under the mark. Exhibit CSR37 shows what is described as a “price sheet” for the 1988 Equus model but, again, there is no information to explain, for example, whether this was used with customers in the trade, previous customers or whether the vehicle was advertised in local or national publications. There is an indication that there was co-operation with third parties, which included production of vehicles and that, in the relevant period, “Equus Cars produced

bespoke one-off luxury versions of customers' cars".<sup>2</sup> However, it is unclear whether, or how, the mark was used in relation to these vehicles. It is my view that the evidence provided does not show real commercial exploitation of the mark, and therefore genuine use, in the period 8 July 1987 – 7 July 1992.

#### 8 July 1982 – 7 July 1987

46. The evidence of use in this period is largely beset by the same problems as for the other two periods. There are, for example, no details of sales of cars, whether estimated or specific, and no turnover figures. However, there is somewhat more persuasive evidence that advertising was carried out and that preparations were under way to secure customers in this period. This is important because activities such as provisional orders and advertising may, in certain circumstances, qualify as genuine use of the mark.<sup>3</sup> Mr Robertson states that "the use of the 'Equus' name by the Holders, had started in 1980 in correspondence with potential suppliers, etc. under the business name of 'Equus Design'" (Defence Document, 2.0). It is not clear from this statement, and it is not clarified with documentary evidence, whether "potential suppliers, etc." also includes potential distributors or other intermediaries who would sell the cars to the ultimate consumer.

47. Mr Robertson also describes a promotional exercise for the "modified Equus". He states that the promotion was effected through "motoring magazines, national newspapers, etc". This is supported by an article from the *Daily Express*, which is largely illegible but in which the words "Cavallo" and "Estivo" are visible. I cannot make out the word "EQUUS".<sup>4</sup> There is also a letter from Mr Robertson, dated 16 June 1983, to an unidentified recipient, in which he states that he is attaching a leaflet for the Cavallo Estivo and in which he asks for any publicity that the recipient could offer.<sup>5</sup> The use is likely to have been external but, as no details are given about how many of these

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<sup>2</sup> Defence Document, 2.0

<sup>3</sup> *Ansul* at [36] to [38]

<sup>4</sup> Exhibit CSR19A

<sup>5</sup> Exhibit CSR30

letters were issued, to which publications they were sent, over what period or whether the advertisements resulted in any sales, this exhibit is of limited assistance to the proprietors. There is also in evidence a brochure which Mr Robertson indicates was used “for promotion in 1983 and at London Motor Show in October 1983” (Defence Document, 3.12) but none of the uses of “EQUUS” in this document constitutes trade mark use.<sup>6</sup>

48. In relation to the motor show, Mr Robertson indicates that the mark was used, in stylised form, on a display board and that the “stand literature also promoted the Equus brand and the coming 160i model. Six months [sic] worth of order deposits were taken at the show and production of the Estivo began in December 1983”.<sup>7</sup> However, no examples of the use of the mark in the stand literature are provided (the fire which destroyed many documents is said not to have affected pre-1988 literature (Defence Document, 1.3), although this is contradicted in the proprietors’ written submissions). There is no indication of how many deposits were taken and there is some ambiguity as to whether the deposits were in respect of Estivo or Equus cars.

49. I have no evidence as to the particular characteristics of the market in motor vehicles but I can imagine that it is the type of market where development and production of a new vehicle runs to years, rather than months. However, even if that is the case, I am not satisfied, on the evidence provided, that there was an “advertising campaign” which would constitute genuine use of the trade mark. I have no evidence before me of the scope of the letter campaign or of the way in which the mark was used on promotional literature. It appears that the word “EQUUS” in its stylised typeface was used on a promotional sign at the 1983 London Motor Show. However, there is nothing in evidence to show in what form the mark was presented on literature or how many, if any, deposits were taken for the car promoted under the “EQUUS” mark. Moreover, this is only one example of such a motor show in the whole period. The lack of evidence of promotion of the mark at other shows of the same nature, evidence which Mr

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<sup>6</sup> Exhibits CSR28A and CSR28B

<sup>7</sup> Defence Document 2.0.

Robertson's position in the company ought to have enabled him to give, suggests that there were no other instances of such promotion. In my view, the use shown is insufficient to constitute genuine use of the mark in this period.

#### Proper reasons for non-use

50. Mr Robertson raises, in his Defence Document, matters which may be directed at supporting a pleading that there were genuine reasons for non-use, i.e. the delayed implementation of a favourable approval regime (Single Vehicle Approval, or "SVA") with the Department of Transport. Strictly speaking, there is no need for me to consider this issue as it was not formally pleaded and there has been no application to amend the pleadings. However, lest it be considered unfair for the unrepresented proprietors to lose a case they have floated but not pleaded, I record here that I would have rejected the case that there were proper reasons for non-use. In *Armin Häupl v Lidl Stiftung & Co. KG*, Case C-246/05, the CJEU held that:

" 54. [...] only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as "proper reasons for non-use" of that mark. It must be assessed on a case-by-case basis whether a change in the strategy of the undertaking to circumvent the obstacle under consideration would make the use of that mark unreasonable".

51. Mr Robertson's evidence is that the SVA was intended for "small manufacturers to avoid the costly National Type Approval and produce cars fully built". He states that, by January 1983, the proprietors had invested over £30,000 and that:

"As the SVA procedure still hadn't been introduced a decision was made to market the Equus 160i as a completed car with the engine/transmission removed again, for the customer to re-install, in what became known as

'component' form. This DoT concession was meant to be temporary. In practice, the SVA procedure didn't appear until the 1990s. Production of the Equus began at the end of 1984/start 1985. By this time development costs had exceeded £45k and the failure of the SVA procedure to start meant that it was uneconomic to further update the Equus 160i beyond its production run".<sup>8</sup>

52. Mr Robertson does not explain further the advantages of the SVA or what, precisely, it entailed. However, it appears from what he says that the SVA was not a total bar to production but that, without it, car manufacture of the type carried out by his company was more expensive. In circumstances where a business decision was made to proceed to registration of the trade mark and development of the product before the SVA was implemented, the delay in implementation of the procedure may have been inconvenient but it is not, in my view, a proper reason for non-use. Moreover, Mr Robertson has given evidence that the proprietors did market the Equus 160i before the SVA was implemented, albeit in modified form, and that the SVA procedure came into force in the 1990s.<sup>9</sup> Whilst I might accept that the delay in implementing the SVA procedure could adversely affect commercial activity for a limited period of time, this cannot be a proper reason for non-use in the (at least) fifteen years since the procedure came into effect.

## **Conclusion**

53. There has been no genuine use of registration number 1146532 during any of the periods of non-use claimed and there are no proper reasons for non-use. The mark is revoked from 8 July 1987.

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<sup>8</sup> Defence Document 2.0.

<sup>9</sup> *Ibid.*



## **Costs**

54. As the applicant has been successful it is entitled to a contribution towards its costs. Only the proprietors filed evidence; the applicant filed written submissions during the evidence rounds and only very brief submissions in lieu. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Official fees: £200

Preparing a statement and  
considering the other side's statement: £200

Considering the other party's evidence  
and filing written submissions: £500

Total: £900

55. I order Colin Stewart Robertson and Nicola Margaret Robertson to pay Equus Automotive, Inc. the sum of **£900**. This sum is 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 14th day of September 2016**

**Heather Harrison  
For the Registrar  
The Comptroller-General**