

**TRADE MARKS ACT 1994**

**IN THE MATTER OF UK REGISTRATION No. 00002340228  
IN THE NAME OF ANNCO INC.**

**AND IN THE MATTER OF CANCELLATION No. 000501184 THEREOF  
BY HOLZER Y CIA, S.A. DE C.V.**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON  
BY THE REGISTERED PROPRIETOR  
AGAINST THE DECISION OF MRS LOUISE WHITE  
DATED 19 JUNE 2017**

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**DECISION**

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**Background**

1. UK Trade Mark Registration number 00002340228 was applied for by Annco, Inc. of 7 Times Square, New York, USA (“the Registered Proprietor”) on 11 August 2003, and entered in the register on 2 January 2004.
2. The registration was of the sign ANNTAYLOR for use as a trade mark in the UK in relation to:  
  
Class 25  
Clothing, footwear, headgear, dresses, skirts, suits, jeans, sweaters, shirts, t-shirts, tank tops, bodysuits, jumpers, vests, gloves, sleepwear, robes, swimsuits, blouses, shoes, pants, shorts, jackets, coats, socks, hosiery, hats and caps, belts, scarves and underwear
3. On 19 April 2016, Holzer Y CIA, S.A. De C.V, of Campos Eliseos, 345 Pisa 10, Colonia Chapultepec, Polanco, Mexico D.F, Mexico (“the Applicant”) filed an application to revoke the registration in its entirety on grounds of non-use under Section 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994.
4. The Registered Proprietor took issue with the grounds for revocation in a Notice of defence and counterstatement filed on 27 June 2017, and claimed use or resumed use (s. 46(3)) of its mark or a permitted variant (s. 46(2)) within the alleged non-use periods for, “without limitation and by way of example only, clothing, footwear and headgear”<sup>1</sup>.

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<sup>1</sup> A claim repeated in the Registered Proprietor’s skeleton argument for the hearing before the Hearing Officer at paragraph 25.

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5. Both sides filed evidence and the matter came to a hearing attended by the parties' professional representatives before Mrs Louise White, acting for the Registrar, on 5 April 2017.
6. The main evidence of use filed on behalf of the Registered Proprietor was contained in a first Witness Statement of Carole Klinger, Assistant Secretary of the Registered Proprietor, dated 1 September 2016, paragraphs 11 and 12 and Exhibit CK3 being subject to a Confidentiality Order made by the Registrar on 21 September 2016, which the Hearing Officer therefore reviewed in her decision (BL O/281/17) merely in general terms.
7. Subject to that limitation the Hearing Officer's description of the Registered Proprietor's evidence went as follows:
  - “9. The following relevant information is contained therein:
    - The RP is the owner of the well-known ANN TAYLOR women's speciality retail fashion brand. It originated in the USA and between 2011 to 2016, amassed some 5.5 billion (US Dollars) in sales.
    - As regards UK focussed use, Ms Klinger emphasises use that has occurred from February 2013 onwards, following the commencement of international shipping from the RP's website.
    - Exhibit CK1 are screenshots from the Wayback machine showing the homepage of the RP's website on various dates from 2011 onwards. . The screenshots show a number of clothing items available during this period.
    - Exhibit CK2 are screenshots of the RP's website. Although dated 30th August 2016 (after the relevant periods), Ms Klinger confirms that the structure and core content mirrors that which was available during the relevant periods.
    - As regards UK sales, details are provided, as is information regarding the number of items sold. Both are contained within Exhibit CK3. As already stated, these are subject to confidentiality. In any case, they can be accurately described as very modest. It is noted that a range of clothing items appear in Exhibit CK3.
    - Exhibit CK4 are examples of orders placed by customers in the UK. These are dated from 2013 onwards.
    - Exhibit CK5 are examples of labels and a sample packaging slips (dated 2013 and 2015) used to ship clothing and other goods from the RP's website. Items sold during the relevant periods would, according to Ms Klinger, have the same labels and packaging slips. In respect of this, the RP filed a further witness statement, from Ms Charlotte Roe (a solicitor employed by the RP's representatives in this matter). She describes placing an order on the RP's website in September 2016

which was delivered to her in London. At Exhibit CR1, is a copy of the order/packing slip together with a photograph of the labels that appeared on the clothing.”

**The Hearing Officer’s decision**

8. The Hearing Officer decided as follows, in brief:

- (1) The onus was on the Registered Proprietor to prove genuine use (s. 100). The relevant principles derived from the EU case law were summarised by Arnold J. in *The London Taxi Corporation v. Frazer-Nash Research Limited* [2016] EWHC 52 (Ch), paragraph 219.
- (2) The evidence showed use of ANN TAYLOR rather than ANNTAYLOR. The addition of a space in ANN TAYLOR did not alter the distinctive character of the mark in the form in which it was registered.
- (3) The use shown was (a) very modest and (b) purely Internet use. The UK was not the core market of interest and that was reflected by the level of sales achieved and the lack of advertising activity. Nevertheless (taking account of the guidance provided by the CJEU in Joined Cases C-585/08 and C-144/09, *Peter Pammer v. Reederei Karl Schlüter GmbH & Co. KG* [2010] ECR I-12527 and Case C-324/09, *L’Oréal SA v. eBay International AG* [2011] ECR I-6011):

“19. It is considered clear that from February 2013 onwards, customers from the UK were clearly targeted and catered for by the RP’s website. That metric sizing was displayed on tags and labels is, in my view, a red herring. International shipping was available from February 2013 onwards and this included to the UK. Consumers were also able to pay in pounds sterling. It is considered that these are, as stated above “clear expressions of the intention to solicit the custom of that state’s customers”. Further, the evidence clearly demonstrates that items were purchased by and dispatched and delivered to, customers in the UK. The level of sales achieved is very modest to say the least, but I conclude that it is clearly genuine.”

- (4) However, the evidence of use provided was solely in respect of women’s clothing. The law relating to partial revocation was summarised by Henry Carr J. in *Property Renaissance Ltd (t/a Titanic Spa) v. Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool)* [2016] EWHC 3103 (Ch), paragraph 47(iii) – (vii).
- (5) A fair specification in this case was “women’s clothing”:

“20. It is considered that no use at all has been shown on anything other than women’s clothing (within which a range of different items have been sold). This is considered to be a definable sub category which fairly reflects the activities of the RP. Thus, the trade mark will

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be partially revoked. This will take effect from the earliest revocation date requested, namely 3rd January 2009”.

- (6) Since around equal success had been enjoyed, the parties to bear their own costs.

### **The appeal**

9. On 17 July 2017, the Registered Proprietor filed Notice of Appeal to the Appointed Person under Section 76 of the Act against the Hearing Officer’s decision.
10. The ground of appeal was that the Hearing Officer erred in her findings that:
- (i) “the evidence of use provided is solely in respect of women’s clothing” (para. 20, lines 1-2); and
  - (ii) “no use at all had been shown on anything other than women’s clothing (within which a range of different items have been sold” (second para. 20<sup>2</sup>, lines 1-2).
11. On the contrary, the Registered Proprietor’s evidence accepted by the Hearing Officer as establishing genuine use of ANNTAYLOR in the UK in respect of women’s clothing, equally showed genuine use in respect of footwear and belts, which evidence the Hearing Officer appeared completely to have missed.
12. Accordingly, in the Registered Proprietor’s submission, a fair specification of goods in Class 25 that the Registered Proprietor was entitled to retain was: “women’s clothing, women’s footwear, belts”<sup>3</sup>.
13. There was no cross-appeal and no Respondent’s notice.
14. At the Registered Proprietor’s written request dated 27 September 2017, agreed to by the Applicant in writing on 10 October 2017, I decided the appeal based on the papers and the parties’ written submissions before me without resort to an oral hearing.
15. I received a further written communication from the Registered Proprietor dated 30 October 2017 pointing out that insofar as the Applicant’s skeleton argument appeared to challenge the Hearing Officer’s finding that genuine use of ANNTAYLOR was established for women’s clothing, there was no appeal against that finding, which I accept.

### **Merits of the appeal**

16. I have carefully looked through the Registered Proprietor’s open and confidential evidence in the light of the arguments (both below and before me) and the Decision.
17. I find that the Registered Proprietor is correct in stating that:

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<sup>2</sup> The Registered Proprietor rightly pointed out that the Decision contains 2x paras. numbered 20.

<sup>3</sup> Registered Proprietor’s skeleton argument on appeal dated 23 October 2017, para. 5.

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- (a) at Exhibit CK1 the screenshots from the Wayback Machine archive showing historic pages from the Registered Proprietor's ANN TAYLOR website displayed or referred to (in 3 out of 6 of the webpages) boots or shoes by reference to the ANN TAYLOR mark.
  - (b) the screenshots of ANN TAYLOR 2016 webpages exhibited at CK2 (which Ms. Klinger confirmed mirrored those which would have been available during the relevant periods) contained several pages advertising for sale in GBP, ANN TAYLOR shoes and belts.
  - (c) in Exhibit CK4 containing sample order details (including part-redacted billing, shipping and payment details in GBP) from customers in the UK, there were order confirmations relating to boots, shoes and belts being sold under the ANN TAYLOR mark and shipped to customers in different locations in the UK<sup>4</sup> in the years 2013 – 2015.
  - (d) the lists of website orders at confidential Exhibit CK3 confirmed the sale/shipment of ANN TAYLOR goods to the UK in the years 2013 – 2015 including some boots, shoes and belts.
18. The Hearing Officer expressed herself satisfied that the Registered Proprietor's evidence was sufficient in quality and nature to establish genuine use in the UK from 2013 onwards of the registered trade mark ANNTAYLOR (or more precisely a permitted variant within s. 46(2)) in relation to "women's clothing". Within that term, the Registered Proprietor had genuinely used the registered trade mark in connection with a range of different items.
19. Nowhere in the decision, however, did the Hearing Officer deal with the Registered Proprietor's claims to have genuinely used the mark in the UK from 2013 onwards in respect of amongst other things footwear and belts<sup>5</sup>. Nor did she mention the Registered Proprietor's evidence relating thereto, which I have described above.
20. There is no indication in the Decision as to the Hearing Officer's reasoning behind these omissions. On the one hand, she might have considered that the footwear and belts in question fell within the term "women's clothing". On the other hand, as the Registered Proprietor argued she might have missed the evidence relating to those items altogether.
21. Whatever the case, because of the lack of reasoning, I cannot be certain that the Hearing Officer arrived at her determination of a fair specification (as to which, see most recently *Merck KGaA v. Merck Sharp & Dohme Corp* [2017] EWCA Civ 1834, paras. 245 – 248) without error.

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<sup>4</sup> Although 1x sample order to Cobham, Surrey appears to be duplicated.

<sup>5</sup> See particularly Ms. Klinger's first witness statement.

**Conclusion**

22. For the above reasons, in my judgment the Registered Proprietor's complaint was justified.
23. UK Registered Trade Mark number 00002340228 ANNTAYLOR should remain on the register in Class 25 in respect of: "women's clothing, women's footwear, women's belts".
24. The appeal was successful, and the Registered Proprietor is entitled to an award of costs. The scope of the appeal was, however, limited and there was no oral hearing.
25. I will order that the Applicant pay to the Registered Proprietor the sum of £350 as a contribution towards the Registered Proprietor's costs of the appeal, to be paid within 28 days of the date of this decision.
26. I do not consider that this appeal, even though successful, called for any variation of the Hearing Officer's order that in view of the roughly equal success enjoyed by the parties in the revocation proceedings before her, each party should bear its own costs. That remains to be the case.

Professor Ruth Annand, 26 January 2018