

O-557-18

TRADE MARKS ACT 1994

IN THE MATTER OF:

**STATUS INTERNATIONAL (UK) LIMITED'S APPLICATION (NO. 501710)
TO REVOKE ON THE GROUNDS OF NON-USE
REGISTRATION No. 2396652
IN RESPECT OF THE MARK:**

MAXIM

OWNED BY DHARMESH MEHTA

Background and pleadings

1. These proceedings concern a trade mark registration which is shown on the register as being owned by Mr Dharmesh Mehta (“the proprietor”). The registration is for the trade mark **MAXIM**. It was filed on 12 July 2005 and registered on 15 February 2008. It stands registered for the following goods:

Class 7: Vacuum cleaners.

Class 8: Hand tools and implements; curling and hair waving tongs; electric razors; curling and hair waving tongs, electric razors, hand tools, hammers; all included in Class 8; but not including clamps or any goods of the same description as clamps.

Class 9: Apparatus and instruments for the recording, transmission or reproduction of sound and images; video tapes; radio transmitting apparatus; radios; car radios; electric cables and wires and assemblies therefor; audio and video connecting leads; plugs, amplifiers and speakers; headphones and microphones; telephones; photographic apparatus and instruments; vacuum cleaners for domestic use and for cars; door bells; binoculars; electrically heated hair curlers and curling tongs; parts and fittings for all the aforesaid goods; but not including electronic gauges or integrated circuits or any goods similar to electronic gauges or integrated circuits and not including computer software or any goods similar to computer software; binoculars; calculating machines; cameras; electric door bells; electric hair curlers; plugs, radios; telephone apparatus; record players; television apparatus; vacuum cleaners; video tapes; all included in Class 9. Radio receiving sets.

Class 11: Electrical and battery operated fans; motorised fans for air conditioning and ventilation; radial air fans; room air fans; table fans.

Class 28: Toys, games and playthings; Christmas tree decorations.

2. Status International (UK) Limited (“the applicant”) seeks revocation of the mark on the grounds of non-use. The claim is made against all of the goods covered by the registration. The applicant relies on section 46(1)(b), based on two separate five-year periods, namely: 30 June 2009 to 29 June 2014 and 8 January 2012 to 7 January 2017. The applicant states in its counterstatement that despite investigations being made, it has been unable to locate any use of the mark during the relevant periods.

3. The proprietor filed a counterstatement denying the grounds of revocation and claiming that the mark has been used during the relevant periods for all of the goods covered by the registration.

4. Both sides filed evidence, which I will summarise, to the extent necessary, later in this decision. A hearing took place before me on 21 June 2018 at which Mr Alan Fiddes of Urquhart-Dykes & Lord LLP, represented the applicant, and at which Ms Laura West, of Mathys & Squire, represented the proprietor.

Legislation and leading case-law relating to revocation

5. The pertinent legislation is contained in section 46 of the Act, the relevant parts of which read:

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

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c).....

(d).....

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

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4)

(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.”

6. Section 100 is also relevant; it 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.”

7. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. summarised the case law on genuine use of trade marks:

“114. The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 *P Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; Leno at [29]; Centrotherm at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: Gözze at [43]- [51].

(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] and [22]. 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]; Reber at [29].

(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]; Leno at [29]-[30], [56]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34].

(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] and [76]-[77]; *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].”

The proprietorship issue

8. Section 46(1) of the Act stipulates that genuine use must be made “by the proprietor or with his consent”. At the hearing, Mr Fiddes’ primary line of argument was that Mr Mehta was not the proprietor of the mark, despite the fact that he is recorded on the register as such. The historical data on the register shows the following:

- The mark was filed by a company called Sherwood Agencies Limited (“Sherwood”).
- On 9 July 2014 a Form TM16 was filed to record a change of ownership from the above, to Mr Mehta. The effective date of the transfer of ownership was entered as 30 June 2014. Mr Mehta signed the form in his capacity as the new owner. It was signed by a Bhupatrai Mehta on behalf of Sherwood.

9. The applicant’s evidence consists of a witness statement from Mr Gareth Price (a partner and trade mark attorney in Urquhart-Dykes & Lord LLP) in which further information is provided, namely:

- A print from the website of Companies House showing that Sherwood was incorporated in May 1974 (Exhibit GIP1).

- A copy of Sherwood's annual return submitted to Companies House in September 2013. Both the proprietor and Mr Bhupatrai Mehta are, amongst other people, identified as directors and shareholders of the company. The former had 10% of the shares, the later 23.34% (Exhibit GIP2).
- A copy of a Notice of Administrator's Appointment which shows that administrators were appointed in respect of Sherwood on 30 June 2015, with the form being signed on 1 July 2014 (GIP3).
- A copy of the official file relating to the assignment (GIP4). Mr Price notes that on the TM16 the date of transfer of the mark has been corrected (by over-writing) from 8 July 2014 to 30 June 2014. Mr Price also notes that the form was filed 9 days after the appointment of administrators.

10. In accompanying written submissions, the applicant argues that there has been no valid assignment to the proprietor because there was no deed of assignment (the form TM16 simply being a request to record an assignment on the register) and, in any event, Mr Bhupatrai Mehta was not authorised to sign and file the TM16 because administrators had been appointed by then; this is argued even if the transfer had taken place before the appointment – with both the transfer and the appointment, on the basis of the TM16 and the Notice and Appointment respectively, taking place on 30 June 2014. It is submitted that the registration should still be in the name of Sherwood and that the proprietor should not be a party to the proceedings and his evidence struck out.

11. The proprietor filed a number of witness statements, including one from himself, which primarily relates to the use that has been made of the mark, most of which (but, as I come on to explain, not all) was made by Sherwood prior to it entering administration. In his witness statement, Mr Mehta does not deal with the assignment issue, although I do note his statement that he was a director of Sherwood up until an administrator was appointed on 7 July 2014 (a date which is inconsistent with the date shown in the Notice of Administrator's Appointment). However, I note that there is a witness statement from a Kayur Mehta, director of a company called SK7 Limited ("SK7"). He explains that SK7 have, with the authority of the proprietor, been using the

mark MAXIM since Sherwood went into administration. He explains that SK7 purchased Sherwood's outstanding stock when it went into administration. At Exhibit KM3 there is a letter from the administrators, which, on the face of it, may have been solicited for these proceedings, which states that the company (Sherwood's) assets were sold on 29 September 2014 to "D Mehta and SK7 Limited" and which included the company's interests in trade marks; also provided is a "PROFORMA INVOICE" dated 29 September 2014 which lists "company intellectual property including brands, trade marks, web domains and telephone numbers" as part of the sale.

12. The Tribunal noted the applicant's request to strike out Mr Mehta as a party to the proceedings and to also strike out his evidence. On 14 February 2018 the Tribunal informed the applicant that its proposed course of action was not to be followed and that the registration of Mr Mehta as the proprietor was to be regarded as prima facie valid. The Tribunal added that there was no mechanism to challenge the chain of title in the context of the revocation proceedings and that any challenge should be made via an application to rectify the register. Fourteen days were given to request a hearing if an objection on this matter was to be pursued. No request to be heard was forthcoming and no application to rectify the register was made.

13. Despite not requesting to be heard when the applicant received the Tribunal's letter dated 14 February 2018, Mr Fiddes still argued at the substantive hearing on 21 June 2018 that the standing of a person as the proprietor on the register was a rebuttable presumption, and that the assumption that Mr Mehta was the proprietor had been put in issue by Mr Price. He submitted that the question of use by the proprietor (or with his consent) was central to the whole revocation issue and must be considered in the subject proceedings. Ms West submitted that this was not the appropriate forum for such arguments to be advanced.

14. It is, in my view, not open to the applicant to make the arguments it did at the hearing. The Tribunal had already indicated that Mr Mehta would, absent any request to rectify the register, be treated as the proprietor of the registration. The applicant did not challenge this view. It would be wholly inappropriate to now countenance the possibility of striking Mr Mehta (and his evidence) from the proceedings. Clearly, if something was not in issue, there would have been no reason for the proprietor to file

evidence in response to the proprietorship issue, therefore the absence of a written deed of assignment has no bearing on the matter. I accept that the letter from the administrators in KM3 of Kayur Mehta's witness statement casts doubt on the timing of any assignment, but, again, this is not sufficient for me to reopen the matter.

15. Having rejected the argument that Mr Mehta should be struck from the proceedings, he is consequently left as a party to the proceedings in the capacity of proprietor of the registration. I am then left with the fundamental point, as per section 72 of the Act, that "(i)n all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it." Any submission made by Mr Fiddes at the hearing about not being able to rely on Mr Mehta's evidence is consequently misplaced.

The use made of the registered mark

16. It is useful to record that whilst in its written submissions the applicant made some points about the evidence of use provided (which I bear in mind), Mr Fiddes said very little at the hearing, suggesting that it was down to me to consider the evidence filed and decide whether genuine use had been established and, if so, in relation to what.

17. A number of witness statements were provided by the proprietor, as follows:

Witness statement of Dharmesh Mehta

18. Mr Mehta provides a long list of goods (mainly consumer electronic goods) on which he says the MAXIM mark was used by Sherwood during the relevant periods. He states that the majority of such goods were sourced from a company called Nabra Limited in Hong Kong. Exhibit DM1 contains a large number of invoices from Sherwood's suppliers, mainly Nabra, but also others. They range in date from early 2012 to early 2014. Some, but not all, specifically identify MAXIM as the brand being supplied.

19. Exhibit DM2 contains a large number of invoices to customers. These cover dates between 2011 and 2015. They are mainly customers in the UK, but also some customers in Germany, Ireland and the Netherlands. Some of the invoices are highlighted to show the MAXIM goods, although not all use the word MAXIM in the description of the product.

20. Exhibit DM3 contains product packaging for various goods which clearly make use of the MAXIM name. The name is most often used in a slightly stylised manner which I am prepared to accept is a form of use acceptable under the provisions of section 46(5) of the Act (no submission to the contrary has been made)¹. Mr Mehta states that they were used during the relevant period.

21. Exhibit DM4 contain extracts from the Waybackmachine Internet Archive Tool for sherwoodagencies.com. They are dated between 2011 and 2013 and show various products identified as MAXIM (plain word) brands. There is also use on the home page of MAXIM used in the stylised manner.

22. Mr Mehta concludes his evidence by referring to the sales revenue for Sherwood, 50% of which he says was attributable to the sale of MAXIM branded products. The figures are substantial, in the millions, but are not broken down by product type.

Witness statement of Surinder Singh

23. Mr Singh is a director of a company called Clyde Importers (Scotland) Ltd. It was a purchaser of MAXIM branded products from Sherwood. Mr Singh lists a range of goods which he says were purchased from Sherwood between January 2012 and June 2014. A sample invoice from March 2014 is provided showing the purchase of some of them.

¹ Even if this is incorrect, there is plain word use on invoices and the website.

Witness statement of Kayur Mehta

24. As described above, Mr Mehta is a director of SK7. He states that between 2014 and 2016, roughly £300k - £400k worth of goods (he lists a number) have been sold. He provides two example invoices, but these are from Sherwood not SK7. However, he does provide in Exhibit KM2 what he describes as the stock valuation list calculated by the administrators. The goods highlighted in this very long list are said to be MAXIM goods which he states were all subsequently sold in the UK.

Witness statement of Rizwan Aktar

25. Mr Aktar is a director of Sash Time Ltd, another customer of Sherwood. He gives similar evidence to that of Mr Singh.

Witness statement of Devshi Chothani

26. Mr Chothani is the proprietor of DBF Associates. He audited the accounts of Sherwood during the years up to May 2012. He viewed inventory as part of the audit process and lists a long list of MAXIM branded goods the existence of which he witnessed.

Witness statement of Andrew Edward Kew

27. Mr Kew worked for a company called Sit Up Merchandising between 2006 and 2014. He provides a long list of MAXIM branded goods which he says were purchased from Sherwood between 2012 and 2014.

Does this amount to genuine use?

28. There is clear evidence that prior to entering into administration, Sherwood operated a business selling a variety of goods under the brand name MAXIM. This is not only supported by invoices showing the sale of goods, but also invoices for the purchase of goods from suppliers. There is also evidence in the form of packaging (with the witness attesting that the packaging was used during the relevant periods),

use on Sherwood's website, and evidence from customers. There is nothing whatsoever to suggest that this is sham or token evidence. There is nothing to suggest that the use is of a commercial yet non genuine type illustrated in the *Reber* case. The evidence as a whole paints a compelling picture of actual use that is significant enough from a commercial perspective to be regarded as genuine. In respect of the second relevant period, the use made by Sherwood covers only the first half of the relevant period. Nevertheless, in my view, this is still more than sufficient to constitute genuine use. In any event, the use by SK7 will have supplemented this.

The goods on which use has been shown and a fair specification to reflect such use

29. In general terms, and as stated above, the nature of the use made constitutes genuine use. However, the question arises as to whether such a finding can extend to all of the goods claimed to have been used. On this, I note the observations of Mr Daniel Alexander QC, sitting as the Appointed Person, in *Plymouth Life Centre* (BL O/236/13):

19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. Use should be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (to use the words of Anheuser-Busch – see above).

30. In terms of a fair specification to reflect any genuine use that has been shown, I note that in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, summed up the law as being:

“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.”

In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed

independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46”.

31. At the hearing, Ms West made a number of submissions with the aid of a table she had prepared, explaining where the use on particular goods had been shown, with cross-references to the evidence. I requested sight of that table in order to inform my decision, which was duly provided after the hearing; I accept, though, that this is just a working document. Mr Fiddes took no issue with the provision of this document. Bearing all this in mind, I identify below, broken down by class, what goods have been the subject of genuine use, and what a fair specification should be:

Class 7

32. The only goods in class 7 covered by the registration are vacuum cleaners. I note that this term also appears in the class 9 specification of the registration, however, as of 1 January 1997 the Nice Classification (from the 7th Edition onward) classified such goods in class 7 only as opposed to the previous classification of class 9. Consequently, I will not determine the class 9 term as it does not fall in that class.

33. Ms West’s table identifies a number of pages of the evidence which contain invoices for the goods (particularly window vacuum cleaners) together with examples of packaging. I am satisfied that this amounts to genuine use. Given that this is the only term in the class, “vacuum cleaners” represents the fair specification.

Class 8

34. The specification in this class reads:

Class 8: Hand tools and implements; curling and hair waving tongs; ~~electric razors~~; curling and hair waving tongs, ~~electric razors~~, hand tools, ~~hammers~~; all included in Class 8; but not including clamps or any goods of the same description as clamps.

35. The items I have struck through are either items which Ms West accepts (in her skeleton argument) that no use has been made, or are items which were voluntarily surrendered but for which the IPO has yet to remove. I will start with the actual use. Ms West's table refers to:

"Drill driver" – the description of which (for example in an invoice at page 40 of the evidence) demonstrates that this is some form of tool that comes with bits and driver attachments. The item appears in two further invoices.

Lift & Move (the packaging shows that this is some form of lifting device with the item lifted then being capable of easy moving), with the item listed on a number of invoices. However, I do not consider that such an item falls within any of the terms as registered, as it would be unnatural to describe such an item as a hand tool or implement.

"Lint shaver", the packaging shows that this is a tool for removing "fuzz" (lint) from clothing, blankets, carpet etc. The item is included in 5 invoices.

"Lopper", with the item appearing on 3 invoices, described as a telescopic lopper.

"Curler", with the packaging showing a hand-held hair curling device, with the item appearing on just one invoice, albeit one for 8k units.

36. I accept that all of the above represents genuine use in relation to these goods. The lint shaver, loppers and drill drivers represent three distinct types of hand tool, all for very different purposes. I consider that the use across these products is sufficient to maintain a fair specification of hand tools. Similarly, although the hair curler is just one item, the registered term is curling and hair waving tongs, which, in reality, is no

wider given that curling and waving are virtually the same process. Given all this, the fair specification in class 8 should read:

Class 8: Hand tools and implements; curling and hair waving tongs; curling and hair waving tongs, hand tools; all included in Class 8; but not including clamps or any goods of the same description as clamps.

Class 9

37. The table for the goods in class 9 follows a similar pattern to that described above. I am satisfied that genuine use has been shown for the following identified goods:

DVD player

Cassette player & USB cassette player

Card reader (which it is fair to assume is a memory card reader)

TV/DVD recorder – the item is a TV with a DVD recorder built in

Twin screen DVD player

Blank CDs and video tapes

Radios and car radios

HDMI cables

Socket adapter, to plug additional plugs in and to prevent electrical surges

Scart adapter

USB turntable (with speakers)

Earphones

Digital photo viewer

Binoculars

Curlers (class)

Digital money jar and coin counters

Television signal boosters and antennas

Wireless/cordless doorbell

Remote control

38. Of the remaining goods listed by Ms West, I comment below:

- The table includes reference to an alarm clock, however, as no picture is provided of the product itself it is not possible to know if this is an alarm clock in class 9 or 14, so the absence of evidence should not go in favour of the proprietor. This use cannot, therefore, qualify.
- Window/car vacuums cleaners – as noted above, such goods fall in class 7 so should not appear in the class 9 specification.
- Curlers – Ms West’s table relies on the same evidence as was relied upon for the similar terms in class 7. Whilst it is possible for a composite product to potentially fall in more than one class, this is not an example of such. In my view the product for which genuine use has been shown falls in class 7 not class 9. The term cannot therefore remain in the class 9 specification.

39. I now turn to the terms as registered and whether any genuinely used goods fall within them and, if so, what a fair specification should be to reflect such use. I do not need to consider cameras and the term that lists parts and fittings for the bulk of the specification because the proprietor accepts no use has been made. I go through the rest below:

Apparatus and instruments for the recording, transmission or reproduction of sound and images

The proprietor relies on its use of DVD players, cassette players, card readers and a TV/DVD recorder. The breadth of the registered terms is substantial whereas the actual use is limited to just a handful of products. I doubt whether a card reader even falls within it.

I consider a fair specification to be “Apparatus and instruments in the form of video and audio players for the reproduction of sound and images; apparatus and instruments in the form of a television DVD recorder for the recording and reproduction of sound and images”

Video tapes

The goods have been used and the registered term matches the use made. This represents the fair specification.

Radio transmitting apparatus

The goods relied upon are radios. However, such goods receive radio signals they do not transmit them. As such, no use has been shown and the term is to be deleted.

Radios; car radios

The goods have been used and the registered term matches the use made. This represents the fair specification.

Electric cables and wires and assemblies therefor

The goods relied upon are HDMI cables which transmit video/audio not electric. As such, no use has been shown and the term is to be deleted.

Audio and video connecting leads

The goods relied upon are HDMI cables which clearly are used to connect audio/video components. Even though only one form of lead has been used, I consider the term as registered to reflect a fair specification.

Plugs, amplifiers and speakers

The goods relied upon are sockets used to plug multiple devices into one electrical plug, a scart adapter and a USB turntable with speakers. That the USB turntable may have speakers built into it does not equate to genuine use of speakers per se. Speakers must therefore be removed from the specification. None of the goods relied upon are amplifiers, which must also be removed. In

relation to plugs, I do not regard a scart adapter as a plug, so this does not assist. That leaves sockets but the only use is of socket expanders/adapters, often described as extension leads. This would not in my view be described as a plug. It has a plug, but its primary purpose is to receive plugs so as to extend the number of sockets a person can make use of. The goods used do not fall within the registered term so, again, must be deleted.

Headphones and microphones

There is use on earphones and headphones, the latter of which are described as incorporating a microphone. I consider a fair specification to read: headphones, including headphones incorporating a microphone.

Photographic apparatus and instruments;

The use relied upon is a digital photo viewer. This would not in my view be regarded as a piece of photographic apparatus or photographic instrument. It is simply a display. The goods must be deleted from the specification.

Door bells

The goods are used and the term above is one which represents a fair specification.

Binoculars

The goods are used and the term above is one which represents a fair specification.

Calculating machines

The goods relied upon are digital money jars and a coin counter. I do not consider either of these items would be termed a calculating machine. The term is to be deleted.

Electric door bells

The goods are used and the term above is one which represents a fair specification.

Plugs, radios

The assessment here follows those made above. Plugs are to be deleted, radios may remain.

Record players

The goods relied upon are USB turntables. I consider "record players" a fair specification to reflect such use.

Television apparatus

The goods relied upon are televisions with an inbuilt DVD recorder. I consider the above term to be a fair specification.

Video tapes

The goods have been used and the registered term matches the use made. This represents the fair specification.

Radio receiving sets

The goods relied upon are radios and car radios. I consider the above term to be a fair specification.

40. In view of the above, the fair specification for the whole of class 9 reads:

Class 9: Apparatus and instruments in the form of video and audio players for the reproduction of sound and images; apparatus and instruments in the form of a television DVD recorder for the recording and reproduction of sound and images; video tapes; radios; car radios; audio and video connecting leads; headphones, including headphones incorporating a microphone; door bells; binoculars; but not including electronic gauges or integrated circuits or any goods similar to electronic gauges or integrated circuits and not including computer software or any goods similar to computer software; binoculars; electric door bells; radios; record players; television apparatus; video tapes; all included in Class 9. Radio receiving sets.

Class 11

41. Ms West's table shows various table fans and pedestal fans. There are also references to other items for ventilation. I consider the specification as registered to be a fair specification to reflect such use, focused, as it is, on fans. The fair specification will, therefore, read:

Class 11: Electrical and battery operated fans; motorised fans for air conditioning and ventilation; radial air fans; room air fans; table fans.

Class 28

42. The final class is class 28, the specification of which reads:

Class 28: Toys, games and playthings; Christmas tree decorations.

43. The goods relied upon are skateboards, a pool table, a mini football table, a bowling game, mini table tennis and a number of gaming type games (poker, Texas holdem, drinking roulette). There are also various forms of tablet, an LED snowman, LED Santa and a snowflake tree topper. Looking firstly at the toys, games and playthings, I consider that the use shown is not enough to support the term as a whole. I consider a fair specification to be toys, games and playthings in the nature of skateboards, sports games and gaming games. Tablets are not included as they are

class 9 goods. In terms of the Christmas tree decorations, the LED Santa/snowman may not necessarily be for a Christmas tree, but the tree topper clearly is. Although just one item, I consider Christmas tree decorations to be a fair specification. As a whole, the specification is to read:

Class 28: Toys, games and playthings in the nature of skateboards, sports games and gaming games; Christmas tree decorations.

Conclusion

44. Registration 2369652 is revoked with effect from 30 June 2014, save in relation to the following goods:

Class 7: Vacuum cleaners.

Class 8: Hand tools and implements; curling and hair waving tongs; electric razors; curling and hair waving tongs, electric razors, hand tools, hammers; all included in Class 8; but not including clamps or any goods of the same description as clamps.

Class 9: Apparatus and instruments in the form of video and audio players for the reproduction of sound and images; apparatus and instruments in the form of a television DVD recorder for the recording and reproduction of sound and images; video tapes; radios; car radios; audio and video connecting leads; headphones, including headphones incorporating a microphone; door bells; binoculars; but not including electronic gauges or integrated circuits or any goods similar to electronic gauges or integrated circuits and not including computer software or any goods similar to computer software; binoculars; electric door bells; radios; record players; television apparatus; video tapes; all included in Class 9. Radio receiving sets.

Class 11: Electrical and battery operated fans; motorised fans for air conditioning and ventilation; radial air fans; room air fans; table fans.

Class 28: Toys, games and playthings in the nature of skateboards, sports games and gaming games; Christmas tree decorations.

Costs

45. The proprietor has won significantly more than it has lost. I therefore consider that it is entitled to an award of costs from the standard published scale. My assessment is as follows:

Statements of case and considering the counterstatements - £300

Filing evidence - £1000

Attending the hearing - £600

Total - £1900

46. I order Status International (UK) Limited to pay Mr Dharmesh Mehta the sum of £1900 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 7th day of September 2018

Oliver Morris

For the Registrar,

The Comptroller-General