

O/740/18

TRADE MARKS ACT 1994

APPLICATION NO 501888 BY LINDA CERMINARA
TO REVOKE TRADE MARK
REGISTRATION NO 2522513



OWNED BY
RACHAEL WOOLSTON

Background and Pleadings

1. RACHAEL WOOLSTON is the registered proprietor of trade mark registration No UK 2522513 consisting of the trade mark as shown on the front cover page. The trade mark was filed on the 30 July 2009 and completed its registration procedure on the 22 January 2010. It is registered in respect of the following goods and services:

CLASS 25: Clothing, sweat bands, caps.

CLASS 41: Fitness boot camp classes

2. LINDA CERMINARA seeks revocation of the trade mark registration in respect of all the Proprietor's goods in Class 25 on the grounds of non-use, based upon section 46(1)(a) and (b) of the Trade Marks Act 1994("the Act"). She submits in her application that:

"...Usage for class 25 has been merely "token"

"There has been no genuine or serious usage of the mark."

"There is no real commercial exploitation of the mark"

" The proprietor has simply been placing her logo on two styles of promotional goods to encourage participation in her class 41 fitness classes or serve as reward for doing so."

"The proprietor registered her mark to cover "clothing, sweat bands, caps" which is not being utilised in a way to justify monopolising the full scope of "clothing"."

"The mark covers "clothing, sweatbands, caps" which is not being utilised adequately for the purpose of creating or preserving a market share for the relevant goods."

“Awareness of the proprietor’s class 25 goods does not extend to the whole of the UK or beyond her fitness class clients which are very localised to the Brighton and Hove area”

3. Rachael Woolston filed a counterstatement denying the claim. She opposes the application for revocation on the grounds that she is still using the mark to sell merchandise and that there has been no suspension of use within Class 25.

4. Revocation is sought under Section 46(1)(a) that there was no genuine use of the mark in the first five years following the date of completion of the registration period, namely from 23 January 2010 to 22 January 2015. Revocation is therefore sought from 23 January 2015. Revocation is also sought under section 46(1)(b) that there was no genuine use made of the mark between 16 November 2012 and 15 November 2017. Revocation is therefore sought from 16 November 2017.

5. Neither party is represented. Only Ms Woolston filed evidence in these proceedings by way of a witness statement and exhibits dated the 24 June 2018. This will be summarised to the extent that it is considered appropriate. Neither party requested a hearing or filed written submissions in lieu of hearing. This decision is taken therefore following a careful perusal of the papers.

Ms Woolston’s evidence

6. Ms Woolston states that she is the owner and CEO of Fitbitch Boot Camp a position she has held since March 2009. She states that the mark Fitbitch Boot Camp was first used in the United Kingdom in 2009, specifically in relation to hoodies, t-shirts and vest tops in Class 25 since March 2009.

7. Ms Woolston provides the annual sales figures for the goods and services between 2010 and 2016, totalling £1,831.21, as set out below:

2010 - 2012	£157.19
2012 - 2014	£1614.66
2014 – 2016	£59.36

8. The annual expenditure for promoting the goods/services total £6,142.50 between 2010 and 2016, broken down as follows:

2010 - 12	£726.81
2012 - 14	£3,704.34
2014 - 16	£1,711.35

9. Neither of the figures provided by Ms Woolston are broken down further to particularise the income derived from sales of merchandise in class 25 and the sales from the fitness camp services in class 41 nor the expenditure incurred for promoting each division of the business.

10. Ms Woolston states that the trademark has been put to genuine use with no suspension or interruption between January 2010 and January 2015. Also, that she/her company has worked hard to gain national media coverage from 2009 to date in order to build the Fitbitch brand. She adds that publicity to the website includes sales channels to merchandise which continues to be sold to a world-wide market.

11. In conclusion Ms Woolston states that Fitbitch is a unique brand name in fitness and the fitness merchandise market within the UK. Not only does the business have a London database but also a national presence. She states that it is her/the business' intention to commercially exploit this opportunity in 2019 with a relaunch.

12. Ms Woolston's describes Exhibit RW1 as a link to the website fitbitchbootcamp.com and a screen shot showing the sales channel for merchandise


(reproduced below). The webpage is undated but Ms Woolston states it has been active since August 2011. The extract gives information about booking camps and gives an option to purchase t-shirts, hoodies or race vests by clicking merchandise. The screen shot shows a picture of a hoodie with the trademark displayed on the front, a description of the item and a buy button for purchasing. T shirts described as “Camp T shirts” are displayed for sale in sizes Small to XLarge underneath but with no supporting pictures. There is no information regarding the number of visits made to the website.

(<http://www.fitbitchbootcamp.com/bookingpage/>)

event information & early bird codes

You can book our small group fitness and healthy eating camps, Boxing Belles, Body Athletic and HiIT SQUAD sessi below. For all things running, please visit Girls Run the Wo by clicking [here](#).

If you would like to purchase our t-shirts, hoodies or race vests click Merchandise.

<p>Hoodie - Large (14)</p>  <p>Have you been FitBitched? Now, get the style (in your new dress size!) with our hoodies (50% cotton/50% polyester mix) in trademark purple Please note additional postage and packing may apply.</p>	Buy
Camp T-Shirts - Small (8-10)	Buy
Camp T-Shirts - Medium (12)	Buy
Camp T-Shirts - Large (14)	Buy
Camp T-Shirts - XLarge (16/18)	Buy

[Edit this entry.](#)

13. Exhibit RW2 is described by Ms Woolston as links to editorial features in national magazines between 2010-2012 showing evidence of the promotion of the Fitbitch brand, and merchandising, by way of a website link to a sales channel to a national audience. In particular Exhibit RW2(i) is a copy of an undated article in the Weight Watchers magazine which Ms Woolston dates as February 2010. There is reference within this article to Rachael Woolston running FitBitch Boot Camp and a reference to fitbitchbootcamp.blogspot.com for further information. There is no link however relating to the sale of goods/merchandise. The clothing offered for sale in the article is

credited to Marks and Spencer and Nike respectively. There are no images of clothing carrying the contested trade mark.

14. Exhibit RW2(ii) is an extract of an event review for Sportsister magazine dated 11 December 2012 written by Rachael Woolston. In the article it describes a team of “14 women from my running club” participating in the Spartan beast race and they are described as “Fitbitches”. There are several pictures included in the article showing ladies wearing purple vest tops but I am unable to decipher the logo. The images however do not appear to show the contested trademark. At the end of the article the following endorsement is shown

“Rachael Woolston is the founder of www.fitbitchbootcamp.com. They have a new performance team training corporates and individuals for events including obstacles races and more.”

There is no reference within the article to merchandise or the purchase of the same.

15. Exhibit RW2(iii) is described as Fitbitch in Top Sante magazine dated March 2012. The extract (reproduced below) seems to be a screen shot of a blog from the fitbitchbootcamp website. Apart from the heading “Getting muddy cured my depression” the copy of the article is illegible. There is reference to Rachael Woolston being in Woman’s Own and Reveal magazines but no copies have been provided. The bottom of the page has the following statement *“And if you want to try the camp yourself, then don’t miss our next start dates.”*

(iii) Top Sante, March 2012 (<http://www.fitbitchbootcamp.com/blog/fitbitch-in-top-sante-magazine/>)

Fitbitch in Top Sante magazine



Fitbitch Boot Camp, featured in Top Sante, March 2012

This month, Fitbitch Boot Camp was featured in Top Sante magazine. It featured our client, Pip Henderson and talked about the effect that our camps can have not just on your figure and fitness but in your outlook on life in general.

Fitbitch founder, Rachael Woolston, was also in Woman's Own this month talking about how you can work out in half the time and still get fantastic results. Look out for future features in Reveal magazine, Woman's Own, and Sportsister.com.

And if you want to try the camp for yourself, then don't miss our next start dates. It could change your life.

16. Exhibit RW3 is a copy invoice to Janet Gordon of Blue Starfish Consulting dated 9th August 2013 for the sale of seven FitBitch hoodies at £35 each, described as merchandise purchased by a corporate client for attendees.

17. RW4(i) and RW6 are described as transaction records showing the sale of t shirts. RW4(i) also includes a photograph and email correspondence. Ms Woolston describes the documents as showing the transaction history of the sale of merchandise to the US in 2015 and email supporting location of sales and a photograph of customers wearing our designs in Texas, USA. These are described as demonstrating that the website is accessible globally and sales are global. The first page of the exhibit is a copy screen shot dated 21 June 2015 and shows the payment details for the purchase of three Fitbitch t-shirts by Mary Sullivan at a cost of £45. Payment is to be sent to "fbfitness@aim.com". The photograph shows a rear-view picture of three people wearing vests which include the words "FitBitch Be inspired. Be inspiring." The email correspondence is dated 9 July 2015 with the subject heading Texas Thanks You. Included in this email exchange is confirmation of the shipping costs and estimated delivery time. RW6 shows the purchase of one Camp t-shirt by Florence Theberge for £15 dated 22 September 2017; payment being sent to info@fitbitchbootcamp.com.

18. RW5 is described as a copy of a business plan document for franchising the business in 2016 and purports to shows "a large scale increase of merchandise sales". Ms Woolston also states that the franchising plans were shelved, but are being revisited for 2019. The entry below is the only one which makes reference to clothing, however, there is no further explanation given of what the document represents.

Clothing 2 Run vests or t shirts plus two hoodies	244.152	65
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19. RW7 is described by Ms Woolston as some invoices for the cost of merchandise and printing, between February 2011 and March 2016. There are only two invoices produced, however, both from 2013. RW7(i) is a copy invoice from polo-shirts.co.uk

dated 8th July 2013 for an order of 11 Gildan Adult hoodies totalling £121.84 addressed to Body Balance Fitness, Rachel Woolston, at Flat 4, 4 St Aubyns, Hove, BN3 2TB. I note that there is no mention of the word or mark Fitbitch in this invoice.

20. RW7(ii) is an invoice from ESC Products, addressed to Fitbitch for T-shirt printing dated in 2013 for 15 vests at £7.05 each totalling inc VAT £126.90. The exact date is illegible from the copy provided.

21. RW8 (i) is described as showing promotional material printed in the Daily Express in August 2009 and March 2016. The first document is undated and has no reference to its provenance. The article is a written testimonial from a client who had attended a Fitbitch course. It refers to Fitbitch as offering "*Running and boot camp courses.*" and provides a link at the end to fitbitchbootcamp.com. Again, there is no reference within this document to merchandise but merely the offering of Fitbitch fitness courses. The second document appears to show a screen shot from The Express online with the headline "Run, sleep and eat better: the 20 best ways to be happier." It is dated Sunday 27 March 2016. The article contains a quotation from Rachael Woolston about the benefits of regular exercise, she is referred to as "Fit Bitch Boot Camp founder and running coach". Again, there is no reference to clothing or merchandise within this article.

22. RW9 is described as an article from So Tunbridge Wells magazine building awareness of the brand merchandise. The copy provided is again in an unreadable format. It is headed "FitBitch Boot Camp in So Brighton magazine" dated Wednesday, 15 September 2010.

23. RW10 comprises three copy photographs described as images of women wearing Fitbitch merchandise between 2010-17 at events all over the world. The images themselves are undated but are headed as follows.

1. Palma, October 2015
2. Berlin, May 2012

3. Lake Garda, October 2012

Images 1 and 3 show various women wearing purple vests and race numbers but none with the trademark as displayed on the front cover. Image 2 is of 8 women holding medals. The female in the centre of the group is wearing a purple sweatshirt with FitBitch displayed on the front breast.

Decision

24. 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) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the 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.”

25. 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.”

26. What constitutes genuine use has been subject to a number of judgments. 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:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case

C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in 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 that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. 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 Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [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].”

27. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, 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.”

and further at paragraph 28:

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

29. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round- or lose it”” [original emphasis].

30. If any question arises in UK proceedings as to the use to which a UK registered trade mark has been put, it is for the proprietor to show what use has been made of the mark. Therefore, an application to revoke for non-use places the onus of proof on the proprietor to prove the use which has been made of the mark. Equally, if the proprietor is not able to show genuine use, the onus rests on them to show that there were proper reasons for the non-use.

31. It is clear from the guidance that a number of factors must be considered when assessing whether genuine use of the mark has been demonstrated by the evidence filed. The responsibility is on the proprietor to provide sufficiently solid evidence to counter the application, a task which should be relatively easy to attain.¹ In this case there are a number of deficiencies in the evidence provided. Specifically, there is a lack of evidence regarding regular sales figures. The only evidence provided relating to the actual sale of t shirts and hoodies within the relevant periods are in the form of two sales transactions dated 21 June 2015 and 22 September 2017 and an invoice dated 9 August 2013. Only two invoices have been provided showing the supply of clothing, one for an order of 11 hoodies in July 2013 and the other for printing services (15 vests) in June 2013. The annual sales figures provided do not differentiate between the provision of services as opposed to the sale of merchandise and so there is no evidence of the actual annual sales figures relating to clothing alone.

32. I accept that according to the caselaw there is no quantitative threshold and that sometimes minimal use is sufficient in order to be deemed genuine.² However, in *Memory Opticians Ltd's Application*, BL O/528/15, Professor Ruth Annand, as the Appointed Person, upheld the Hearing Officer's decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5 year period. In this case there had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and were localised to 3 branches. This level of use was held to be insufficient to create or

¹ *Awareness Limited v Plymouth City Council*, Case BL O/236/13

² *Naazneen Investments Ltd v OHIM*, Case T-250/13

maintain a market under the mark. Consequently, it was not genuine use. In the case before me, Ms Woolston has only demonstrated total sales of four t shirts and seven hoodies throughout the relevant period and therefore the evidence of any sales is so limited that I am unable to find that it was sufficient to have created or maintained a share in the market for clothing, which is a very large market. Even taking into account the order for the supply of hoodies on 8 July 2013, these amounted to only 11 hoodies and, similarly the order for the printing of vests in 2013 was only for 15 items. Additionally, no evidence has been provided at all regarding the offering for sale of caps or sweat bands on the website or elsewhere.

33. Whilst there is some evidence of promoting the business through magazine articles, it is clear to me that this was primarily to target the fitness/bootcamp services side of the business and not the merchandise. The various articles dated between February 2010 and March 2016 refer to clients using FitBitch as a forum to lose weight or to get fit. Other than a small quantity of photographs showing participants wearing purple vests there is no information within these articles as to where any of the clothing can be purchased.

34. In *Silberquelle GmbH v Maselli-Strickmode GmbH*, Case C-495/07, the Court of Justice of the European Union held that:

“17. It is settled case-law that ‘genuine use’ within the meaning of the Directive must be understood to denote actual use, consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (Case C-40/01 *Ansul* [2003] ECR I-2439, paragraphs 35 and 36, and Case C-442/07 *Verein Radetzky-Orden* [2008] ECR I-0000, paragraph 13).

18. It follows from that concept of ‘genuine use’ that the protection that the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison

d'être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings (*Ansul*, paragraph 37, and *Verein Radetzky-Orden*, paragraph 14).

19. As the Commission submitted in its observations to the Court and as the Advocate General stated in points 45 and 55 of his Opinion, it is essential, in the light of the number of marks that are registered and the conflicts that are likely to arise between them, to maintain the rights conferred by a mark for a given class of goods or services only where that mark has been used on the market for goods or services belonging to that class.

20. For the reasons set out in points 48 and 56 of that Opinion, that condition is not fulfilled where promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter.

21. In such a situation, those items are not distributed in any way with the aim of penetrating the market for goods in the same class. In those circumstances, affixing the mark to those items does not contribute to creating an outlet for those items or to distinguishing, in the interest of the customer, those items from the goods of other undertakings.

22. In the light of the foregoing considerations, the answer to the question referred is that Articles 10(1) and 12(1) of the directive must be interpreted as meaning that, where the proprietor of a mark affixes that mark to items that it gives, free of charge, to purchasers of its goods, it does not make genuine use of that mark in respect of the class covering those items.”

35. In this case, Maselli was a fashion company which used the mark for non-alcoholic beverages which it offered free of charge to purchasers of its clothes. The court found that a proprietor does not make genuine use of a mark in respect of goods in one class where it affixes that mark to items it gives away free of charge to purchasers of its goods in a different class. I accept entirely that the case of *Silberquelle* above related to goods being given away free of charge and that in this case the merchandise was not free of charge, however I am not persuaded that the sales figures show real

commercial exploitation, are of sufficient scale and frequency and at a sufficient level to establish genuine use. Not every commercial sale constitutes genuine use (*Reber*). At this level, it appears that the sale of t shirts and hoodies was more of a promotional addition for the advancement of the primary function of the business namely the provision of fitness courses. There is no evidence to support any attempt to maintain or create a market for the clothing in their own right.

36. Whilst Ms Woolston states that she is selling merchandise to a world-wide market and that her website is accessible globally and sales are global, she has only produced one transaction payment which purports to show a sale in the USA. Ms Woolston has not provided any evidence of any serious effort to develop the market globally³ or particularly in the USA or that there is any intention to create a market in another territory. If there were I would have expected the website to offer the goods in a choice of currency, with details shown of shipping costs outside the UK. I note the email exchange at exhibit RW4(i) where shipping costs are outlined, in my view this is as a result of an enquiry from the customer rather than a purchase option from the website. If the sale is as a result of happenstance without any targeting from the proprietor then it is questionable whether such indirect and passive mere visibility would constitute use⁴. There is no evidence to suggest that there has been any intention to develop the market in the USA or elsewhere. The photographs outlined in paragraph 23 do not support any intention to develop the clothing brand worldwide.

37. As mentioned above the use of the mark does not have to be quantitatively significant for it to be deemed genuine, but the only evidence of any sales within the relevant period takes the form of the three invoices mentioned at paragraph 31. These invoices are insufficient to persuade me that such use is justified in the relevant sector for creating or preserving a market share in those goods, especially when considering the nature of the goods and the particular market namely the clothing industry. It is anticipated that the scale and frequency of use of the mark for clothing would be much

³ *Walton International & Anor v Verweij Fashion BV* [2018] EWHC 1608

⁴ *Abanka DD V Abanca Corporacion Bancaria SA* [2017] EWHC 2428 (Ch)

higher. Whilst there is some evidence of promoting the business through magazine articles, it is clear to me that this was primarily to target the fitness/bootcamp services side of the business and not the merchandise. The various articles dated between February 2010 and March 2016 refer to clients using FitBitch as a forum to lose weight or to get fit. Ms Woolston has filed very little evidence demonstrating use for clothing, and in fact has not filed any evidence for sweat bands or caps.

38. The main function of a trade mark is that it enables consumers to distinguish the goods and services of one undertaking from another. If a mark is not being used its function is redundant. It also prevents other traders who are in a position to commercialise goods and services, using the same or similar marks thereby harming commerce and innovation. This public interest point was explained by Justice Jacob (as he then was) in *La Mer* [2002] E.T.M.R. 34 (paragraph 19):

“There is an obvious strong public interest in unused trade marks not being retained on the registers of national trade mark offices. They simply clog up the register and constitute a pointless hazard or obstacle for later traders who are trying actually to trade with the same or similar marks. They are abandoned vessels in the shipping lanes of trade.”

Outcome

39. Taking into account all the circumstances of the case Ms Woolston has not shown that there has been genuine use of the mark (or proper reasons for non-use) within the section 46(1)(a) or (b) periods in relation to her Class 25 goods. In my view Ms Woolston has failed to discharge the burden placed on her to show genuine use in respect of any of the goods in Class 25 for which the trade mark is registered. The application for revocation on the grounds of non-use therefore succeeds under section 46(1)(a) and (b). Consequently, the trade mark is partially revoked for all the goods in Class 25 with effect from 23 January 2015. The proprietor's trade mark remains validly

registered for the services in class 41, there being no objection raised for these services.

Costs

40. As Ms Cerminara has been successful, ordinarily she would be entitled to an award of costs. However, she is unrepresented and as such was invited by the tribunal to indicate whether she intended to make a request for an award of costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the proceedings. It was made clear by letter dated the 7 September 2018 that if the pro-forma was not completed, no costs other than the official fees arising from the action would be awarded. Ms Cerminara did not respond to that invitation. On this basis Ms Cerminara is only entitled to the reimbursement of the official fee in the sum of £200.

41. I order Rachael Woolston to pay the sum of £200 to Linda Cerminara. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of November 2018

Leisa Davies

For the Registrar