

O-469-19

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK REGISTRATION NOS. 1586464 & 2161562B
IN THE NAME OF BOI TRADING COMPANY LIMITED
FOR THE TRADE MARKS**



ELIZABETH EMANUEL

AND

ELIZABETH EMANUEL

**AND THE APPLICATION FOR CANCELLATION THEREOF
UNDER NOS. CA00501968 & 501969**

**BY
EMANUEL MAYFAIR LIMITED**

Background & Pleadings

1. Boi Trading Company Limited ('Boi') are the registered proprietors of the following UK trade marks.

UK TM No.1586464	UK TM No. 2161562B
 <p>Filing date: 28 September 1994 Registration date: 14 February 1997</p> <p>Class 25: Suits, articles of underclothing, lingerie, articles of athletic, sporting and gymnastic clothing; stocking, shirts, t-shirts, sweatshirts, blouse. Trousers, skirts, dresses, bridal dresses, fancy dress costumes; jackets, overalls, waistcoats, pants-hose, knitted articles of clothing, scarves, dressing gowns, bath robes, sleeping garments, hats, socks, belts, caps, gloves and aprons, all for wear; jeans, neckwear, swimwear, bridal wear and footwear; all included in class 25.</p>	<p>ELIZABETH EMANUEL</p> <p>Filing date: 18 March 1998 Registration date: 25 July 2008</p> <p>Class 3: Perfume, cosmetics, soap, essential oils and hair lotions.</p> <p>Class 14: jewellery and watches.</p> <p>Class 18: Baggage</p> <p>Class 25: Clothing, footwear and headgear.</p>

2. Emanuel Mayfair Limited ('Emanuel') seeks revocation of the registered mark no. 1586464, in full, on the grounds of non-use based on Section 46(1)(a) of the Trade Marks Act 1994 ('the Act') in respect of the time period 15 February 1997 to 14 February 2002, with an effective revocation date of 15 February 2002, and under

section 46(1)(b) for the time periods set out below, with an effective revocation date of 15 February 2007¹:

Start date	End date
15/02/02	14/02/07
15/02/07	14/02/12
15/02/12	14/02/17
07/02/13	06/02/18

3. Emanuel seeks revocation of the registered mark no. 2161562B, in full, on the grounds of non-use based on Section 46(1)(a) of the Trade Marks Act 1994 ('the Act') in respect of the time period 26 July 2008 to 25 July 2013, with an effective revocation date of 26 July 2013.

4. Boi filed a counterstatement in which it denied all the grounds of revocation.

5. Boi filed evidence in these proceedings. No hearing was requested and neither side filed written submissions in lieu of a hearing. This decision is taken following consideration of the material before me.

6. Both parties were represented in these proceedings, Boi by Shoosmiths LLP and Emanuel by Withers & Rogers LLP.

Registered Proprietor's evidence

7. Boi filed a witness statement in the name of its director, Amarjit Singh, and appended 9 exhibits.

8. Mr Singh states that Boi acquired the trade marks at issue on 15 May 2018 following an assignment from their predecessors in title. He further explained that

¹ Given there four periods pleaded under section 46(1)(b), this date is the earliest effective revocation date under the first of the four pleaded periods of non-use.

there have been difficulties in obtaining archive material, records and evidence from the previous owners. Notwithstanding these issues, he states that the both marks have been used continuously since their respective registration dates and both marks have been used in the five years preceding the date of the revocation action.

9. Exhibit AS1 comprises a selection of invoices from one of Boi's predecessors in title, Hornby Street Limited, dated between 2012 and 2014. There is no reference to either of the contested marks on any of the invoices, however some invoices contain a reference to 'brand codes', one being EE and another EEManuel (in addition to other brand codes JUICE and ROCK N REL) which the declarant states is an indication that those invoiced garments, namely jeans, kimonos and pyjama sets, bore the two trade marks at issue. In addition, the declarant states that invoices containing the words Etta, Osako, Wallflower and Sukuri are also Elizabeth Emanuel branded products. Although I note that on page AS1.7, the word Etta also appears in the garment description for jeans bearing the 'Juice' brand code.

10. Exhibit AS2 comprises technical specification drawings (line drawings) of different garments dated between 2012 and 2013. Each page is headed with the figurative mark  ELIZABETHEMANUEL with the word 'London' underneath it and the word mark **Elizabeth Emanuel** appears in the technical rubric at the foot of each page under the heading 'Branding'. Some of the garment drawings appear to have the word mark and the  element of the contested figurative mark as embellishments and decorations on the garments themselves.

11. Exhibit AS3 consists of technical line drawings and specifications for the swing tags and garment labels intended for the garments outlined in AS2. The exhibit itself is undated but as the declarant states that these labels were used in the garments in AS2, I assume a date range between 2012-2013. In terms of detail, one of the garment labels bears the word mark with the additional word 'London' and the other label bears the  ELIZABETHEMANUEL mark with the additional word 'London'.

12. Exhibit AS4 consists of 10 pages of line drawings of various garments, namely pyjamas, robes, blouses, jeans and trousers. Only two of the drawings, namely AS4.4 and AS4.5 are dated by means of a circular device in the bottom right corner stating that “all designs copyrighted The Juice Corporation 2008”. The Juice Corporation is confirmed by the declarant as another of their predecessors in title. The mark used to title these drawings is  .

13. Exhibit AS5 consists of one page of line drawings of bathrobes, two photographs of the actual garment and one close up of the bath robe decorative embellishment, being  . The document is dated Autumn/Winter 2013.

14. Exhibit AS6 consists of line drawings and photographs of a kimono, pyjamas, a nightdress, a jumpsuit and a dress. The line drawings and jumpsuit photograph are titled with the  mark. However there is no apparent use of any mark on the photograph, referenced AS6.3, of the garment entitled Geisha fan dress. The images themselves are undated but the declarant states the images were used in 2014.

15. Exhibit AS7 consists of line drawings and photographs of kimonos, pyjamas, nightwear and robes. The line drawings and photographs are titled with the  mark. Although the line drawings images are difficult to make out in detail, there appear to be swing tags containing the  mark drawn as part of the garment drawings. The images are undated but the declarant states that they were used between 2012 and 2014.

16. Exhibit AS8 contains undated photographic images of garments which the declarant states are the products of the line drawings contained in previous exhibits. No marks are apparent from the photographic images.

17. Exhibit AS9 consists of copy pages from the Elizabeth Emanuel ‘brand book’ which the declarant states was designed and published in 2011 and was still being distributed in the UK between 2013 and 2018. The brand book contains a series of

photographic images of celebrities and goods namely lingerie, eveningwear, casualwear, wedding outfits, footwear, handbags, jewellery, perfumery and furniture. It is unclear if the celebrities are wearing goods from any Elizabeth Emanuel ranges as no attributions are given. The brand book page headers include the word mark ELIZABETH EMANUEL in plain and stylised typefaces and the  mark with the additional word 'London'.

18. Exhibit AS10 consists of a number of screenshots from The Juice Corporation website taken by the WayBack Machine internet archive service dated between February 2013 and February 2018. The  mark with the additional word 'London' and the word mark ELIZABETH EMANUEL appear in the screenshots with some additional rubric about the designing of the late HRH Diana, Princess of Wales's wedding dress.

19. That concludes my summary of the evidence.

Legislation

20. 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.”

21. 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.”

The case law regarding genuine use

22. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“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 Bunderversammlung 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].

23. I am also guided by the following case law in assessing evidence. 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.”

24. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. also sitting 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.”

Decision

25. It is clear from the guidance given above that I must consider a number of factors when assessing whether genuine use of the mark has been shown from the

evidence provided. In such cases of non-use, the onus is on the Registered Proprietor to provide sufficiently 'solid' evidence to refute the claims made. In this case there are some particular deficiencies within the evidence provided. Specifically, there is a lack of annual turnover figures resulting from sales of the goods under the marks at issue. I note the invoices provided at exhibit AS1 which the declarant states are a confirmation that goods were sold to UK distributors during the relevant period. However, many of those invoices contain a mixture of goods, some bearing the Elizabeth Emanuel contested marks and others from unrelated brands. Furthermore, several of the invoices are duplicated. From these invoices it is difficult to make out a coherent picture of what turnover was actually generated by the contested marks during the relevant period. Furthermore, I cannot reconcile the reference numbers given on the line drawings for the jeans products with those given on the invoices. I can only reconcile those reference numbers for the Osako kimonos and the Wallflower Sukuri pyjama sets set out on page AS4.21 with the invoices for the same goods.

26. In relation to those exhibits comprising the line drawing designs, it is not made clear by the declarant what purpose these designs serve, who or what they were created for, whether they are documents for internal use or for the external customers and if so who those customers were.

27. Unfortunately there is also no evidence relating to advertising of the goods or even any promotional information as to where the goods were available for sale for example in mail order catalogues or in shop displays. In addition, no figures have been provided for expenditure relating to advertising of the goods.

28. In relation to the goods bearing the contested marks, the evidence contained in exhibits AS2-8 indicates that the marks appear to have been used on *nightwear, robes, kimonos, tops, blouses, jeans and trousers* only. However, the invoices indicate that only *jeans, kimonos and pyjama sets* were sold under the contested marks. There was no evidence provided to show that the contested marks were used on *headgear and footwear* in the class 25 specification for the word mark or for the remainder of the goods claimed in the class 25 specification for the figurative mark namely *Suits, articles of underclothing, lingerie, articles of athletic, sporting and*

gymnastic clothing; stocking, shirts, t-shirts, sweatshirts, skirts, dresses, bridal dresses, fancy dress costumes; jackets, overalls, waistcoats, ganti-hose, knitted articles of clothing, scarves, hats, socks, belts, caps, gloves and aprons, all for wear; neckwear, swimwear, bridal wear and footwear

29. In terms of the remaining goods covered by the specifications of the figurative mark, namely goods in classes 3, 14 and 18, the only evidence provided was exhibit AS9, referenced as the 'brand book'. However, whilst the contested marks appear as headers on each page, there is no indication that the contested marks are used on the goods pictured, for example there are no labels apparent on the lingerie items or on the inside sole of the footwear. To give a further specific example, on page AS9.1 there are four small images of the pages of the brand book featuring wedding/occasion wear, accessories, footwear and jewellery. No trade marks at all are apparent from these images. Where there is text, it is unclear what it says or whether it does specify that these goods bear the contested Elizabeth Emanuel marks. Some other pages of the exhibit merely contain photographs of celebrities such as HRH The Duchess of Cambridge, including official Royal photographs, without any reference to the featured clothing bearing the contested marks. On page AS9.8, there is a single image of a perfume bottle bearing the contested figurative mark. The other images contain third party perfume trade marks. Likewise, page AS9.10 features images of room interiors with no indication of whether the furniture goods pictured therein bear the contested marks. There is no pricing information apparent from the goods in the brand book. On page AS9.13 there is a page of technical information which indicates that 5 of these books were printed. The declarant gives no information about how they were distributed or who they were intended for e.g. buyers, retailers etc. Overall this exhibit is insufficient to demonstrate use on goods in classes 3, 14 and 18.

30. With regard to the screenshots of the Juice Corporation's website in exhibit AS10, the Elizabeth Emanuel marks are apparent from the screenshots, but there is no additional information such as volumes of web traffic, i.e. the number of times the website was visited nor is there any indication that Elizabeth Emanuel goods were purchased from this website. The screenshots merely indicate that Elizabeth Emanuel

was one of a number of brands under the control of the Juice Corporation at the time the screenshots were captured.

31. In terms of the relevant dates, the invoices provided for the *jeans*, *kimonos* and *pyjama sets* which the declarant states bear both the contested marks are dated as follows:

- 24 October 2012
- 23 November 2012
- 27 November 2012
- 20 March 2013
- 5 April 2013
- 15 September 2013
- 8 November 2013
- 17 January 2014
- 12 March 2014
- 1 September 2015

32. I find that there has been genuine use shown for *jeans*, *kimonos* and *pyjama sets* only, for both of the contested marks within the most relevant time period.

Outcome

33. UK TM No. 1586464 will be partially revoked for non-use in relation to the remainder of the goods, namely *Suits, articles of underclothing, lingerie, articles of athletic, sporting and gymnastic clothing; stocking, shirts, t-shirts, sweatshirts, blouse. Trousers, skirts, dresses, bridal dresses, fancy dress costumes; jackets, overalls, waistcoats, ganti-hose, knitted articles of clothing, scarves, dressing gowns, bath robes, sleeping garments, hats, socks, belts, caps, gloves and aprons, all for wear; neckwear, swimwear, bridal wear and footwear; all included in class 25* with effect from 15 February 2002. The mark remains registered in respect of *jeans, kimonos, pyjama sets*.

34. UK TM No. 2161562B will be partially revoked for non-use in relation to classes 3, 14 and 18 in their entirety and in class 25 for the terms *clothing, footwear, headgear* with effect from 26 July 2013. The only goods remaining in the class 25 specification will be *jeans, kimonos, pyjama sets*.

Costs

35. As the applicant for cancellation has been largely successful, it is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award the following costs taking into account the degree of success obtained by the applicant for cancellation:

£200 Application fee

£200 Preparing a statement and considering the counterstatement

£500 Considering evidence

£900 Total

36. I order Boi Trading Company Limited to pay Emanuel Mayfair Limited the sum of £900. 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 12 August 2019

June Ralph

For the Registrar

The Comptroller-General

