O/0163/26

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK REGISTRATION NO. UK00910252864
IN THE NAME OF INCONTROL MEDICAL, LLC
FOR THE TRADE MARK:

IN CLASS 10

AND

APPLICATION NO. CA000507507 FOR REVOCATION
FOR NON-USE BY JOUETS LIMITED

Background and pleadings

1. Trade mark number UK00910252864[1] as shown on the front page of this decision ("the contested mark") stands registered in the name of InControl Medical, LLC ("the proprietor"). The contested mark has a filing date of 9 September 2011 based on a US priority filing date of 10 March 2011. The mark was registered on 9 February 2012 for the following goods:

> Class 10: Adult sexual stimulation aid for sexual dysfunction, namely, a combination vibrator, inflatable balloon and electrical stimulator.

2. On 29 June 2024, JOUETS LIMITED ("the applicant") filed an application to revoke the contested mark on grounds of non-use in accordance with sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 ("the Act").[2]

3. Under section 46(1)(a) of the Act, the cancellation applicant claims non-use of all goods in the five-year period following the date on which the mark was registered i.e., 10 February 2012 to 9 February 2017, with an effective date of revocation of **10 February 2017**. Under section 46(1)(b) of the Act, the cancellation applicant claims non-use of all goods from 27 June 2019 to 26 June 2024, with an effective date of revocation of from **27 June 2024.**

4. The proprietor filed a counterstatement denying all claims made by the applicant.

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[1] The contested mark is a comparable mark based upon an earlier EU trade mark ("EUTM") of the proprietor. Following the end of the transition period of the UK's withdrawal from the EU, all EUTMs registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

[2] The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

5. The cancellation applicant represents themselves, and the registered proprietor is represented by Forresters IP LLP.

6. Only the proprietor filed evidence during the evidence rounds. Neither party requested a hearing however, the applicant filed submissions in lieu of a hearing. This decision is taken following careful consideration of the papers on file.

Evidence

7. The proprietor filed two witness statements.

8. The first witness statement is dated 27 January 2025 from Emma Ekbergh. The witness statement has seven accompanying exhibits labelled 1-7. Ms Ekbergh is the legal representative of the proprietor.

9. The second witness statement is dated 31 January 2025 from Mr Herschel "Buzz" Peddicord. The witness statement has four accompanying exhibits labelled ICM01-ICM04. Mr Peddicord is the Chief Executive Officer of InControl Medical, LLC.

10. The purpose of the proprietor's evidence is to demonstrate that the contested mark has been put to genuine use during the relevant periods for which revocation is sought.

11. I have given due consideration to all of the relevant documents filed and will refer to the evidence to the extent that it is necessary in my decision.

DECISION

12. Section 46 of the Act states that:

> "(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 ("the variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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.

[…]

(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."

13. Section 100 of the Act 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."

14. As the contested mark is a comparable mark, pursuant to paragraph 8 of Part 1, Schedule 2A of the Act, the proprietor may rely upon use of the mark in the EU (including the UK) for any parts of the relevant periods which fall prior to IP Completion Day, being 31 December 2020.

15. As noted previously, the relevant period for assessing whether there has been genuine use of the mark is 10 February 2012 to 9 February 2017 ("the first relevant period") under section 46(1)(a); and 27 June 2019 to 26 June 2024 ("the second relevant period") under section 46(1)(b).

Relevant case law

16. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, 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 Bundervsvereinigung 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], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]; *Ferrari* at [33].

(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]."

17. As regards the territorial scope of the use of an EUTM, in *Walton International,*[3] Arnold J (as he then was), after setting out the eight applicable principles when assessing genuine use (which are the same as the eight principles he subsequently set out in *easyGroup Ltd*),[4] added the further three principles when assessing genuine use in the EU:

"118.*The law with respect to genuine use in the Union*. Whereas a national mark needs only to have been used in the Member State in question, in the case of a EU trade mark there must be genuine use of the mark "in the Union". In this regard, the Court of Justice has laid down additional principles to those summarised above which I would summarise as follows:

(9) The territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to genuine use in the Union: *Leno* at [44], [57].

(10) While it is reasonable to expect that a EU trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be

[3] *Walton International Ltd & Anor v Verweij Fashion BV*, [2018] EWHC 1608 (Ch), (which is also a decision by Arnold LJ, or Arnold J as he then was, that predates his decision in *easyGroup Ltd*).

[4] Ibid., paragraphs 114 and 115.

deemed genuine, since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]–[55].

(11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory of a single Member State, and in such a case use of the EU trade mark in that territory might satisfy the conditions for genuine use of a EU trade mark: *Leno* at [50]."

18. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[5]

19. In *Awareness Limited v Plymouth City Council*[6], Mr Daniel Alexander, QC (as he then was), sitting as the Appointed Person, observed that 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".

20. Furthermore, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs QC (as he then was) 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

[5] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09
[6] Case BL O/236/13

> 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."

Form of the mark

21. Before I move on to assess the sufficiency of the evidence, I shall begin by addressing the way in which the contested mark has been displayed in relation to the relevant goods in the evidence.

22. In this regard, I am mindful of *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, wherein Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD

MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still."

23. The contested mark is:

24. In the evidence, the mark is shown in a word-only format and in the following variation:

25. Firstly, I find the use of the word "Intensity" in the evidence to be an acceptable variant of the mark as registered. This is because the word element "Intensity" is the main distinctive element of the contested mark, and the omission of the figurative element does not alter the distinctive character of the mark as a whole.

26. In the variant form shown at [25], the contested mark is displayed in a pink and purple font instead of black and white, as it appears on the register. It is well established that registration of a mark in black and white covers use of the mark in different colours[7] and I do not consider that such use alters the distinctive character of

[7] See *Specsavers* [2014] EWCA Civ 1294 at [5] and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at [47]

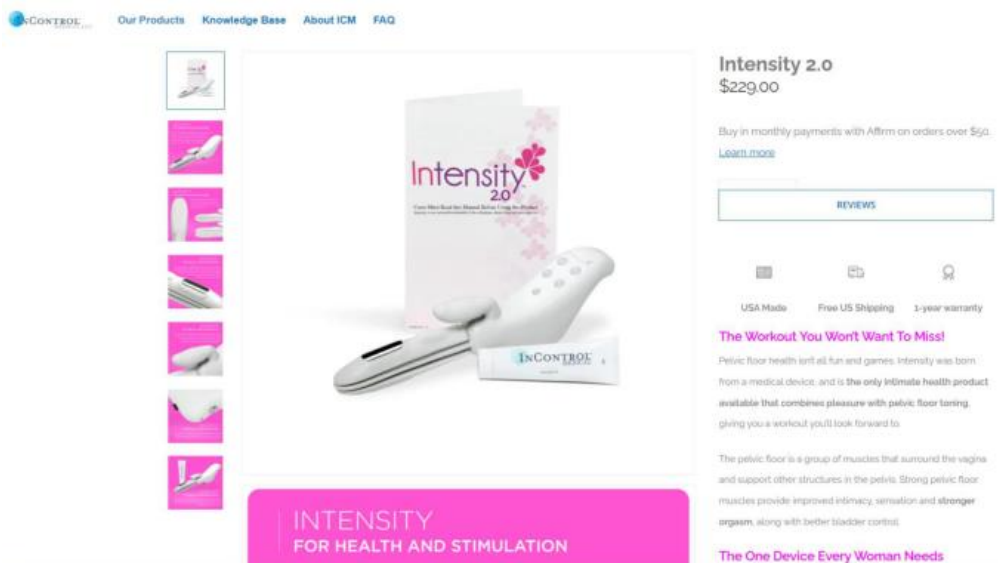
the mark. The “TM” presented in a smaller, subscript typeface merely indicates that the composite mark is being used as a trade mark and is therefore devoid of distinctive character. This variant is therefore acceptable use of the mark as registered.

Sufficient use

27. Mr Peddicord explains that his company is a MedTech company that manufactures and distributes devices that have been clinically proven to cure stress, urge, mixed urinary and bowel incontinence. He claims that the company has sold over 223,000 devices.[8]

28. At exhibits ICM01, Mr Peddicord provides an undated brochure depicting the contested mark alongside a device. I note that the brochure states that “Intensity is an intimate health and stimulation device that exercises pelvic floor muscles. Exercise enhances pelvic floor tone, strength and control, heightening intimate sensation.” The same brochure is included in exhibit 2 of the Witness Statement of Ms Ekberch.

29. Exhibit ICM02 includes undated screen printouts from the proprietor’s website showing the Intensity device being available for purchase in US dollars and indicates ‘free US shipping’:



[8] Paragraph 2 of the witness statement of Mr Peddicord.

30. Exhibit ICM03 includes undated printouts of the Intensity device available for sale on another website called “PourMoi”. Again, the price is shown in US dollars.

31. Included in exhibit ICM04 are stills from a YouTube advertisement of the Intensity device dated 16 December 2019. Mr Peddicord states that the video has received 10,511 views.

32. Turning to Ms Ekbergh’s evidence, exhibit 1 shows printouts of a video from the proprietor’s YouTube channel titled “Intensity- Intimate Health Wellness Device for Women InControl Medical”. The video is dated 11 May 2018 and has 22,019 views.

33. Exhibit 3 contains printouts of the proprietor’s website providing information about the Intensity device. The copyright symbol dates the article as 2024 however, the exact date is not provided so it is unclear if this falls within the second relevant period.

34. Exhibit 4 includes printouts from various websites selling or promoting the Intensity device. Several of the printouts are undated. Of the examples that are dated, it is unclear if the products are targeted at UK consumers for example, the Facebook advert dated 9 August 2021 displays the promotional discount in US dollars.

35. The printouts included in exhibit 5 also show the Intensity device being sold in US dollars. Again, the copyright symbol dates the article as 2024 however, the exact date is not provided so it is unclear if this falls within the second relevant period.

36. Exhibit 6 contains printouts of email exchanges that appear to be the proprietor responding to prospective distributors with information about its products and its pricing structure. The emails fall within the second relevant period however, only one of the recipients appears to be based in the UK. The remaining email addresses indicate that the recipients are based in the EU and cannot be taken into consideration as the emails are dated after IP completion. Even if these emails were sent to recipients in the relevant jurisdiction, they are merely emails of the proprietor providing information about its devices and pricing structure. They do not show that any subsequent purchases of the Intensity device were made.

37. Exhibit 7 includes printouts from the "Wayback Machine" showing the proprietor's website between March 2020 to September 2024. The printouts display prices next to the Intensity device in US dollars. A contact telephone number is also displayed on the website for customer queries, this does not appear to be a UK number. I also note that the telephone line is shown as being open from Monday-Thursday 8.30am to 5.00pm CST, I understand "CST" to mean Central Standard Time which suggests that the customer helpline is servicing customers based in the US.

38. That concludes my summary of the proprietor's evidence to the extent that I consider it necessary.

Assessment of genuine use

39. Whether the evidence is sufficient for this purpose will depend on whether it demonstrates that there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods and services at issue in the relevant territory during the relevant five-year period. In making this assessment, I am required to consider all relevant factors, including:

- The scale and frequency of the use shown;
- The nature of the use shown;
- The goods for which use has been shown;
- The nature of those goods/services and the market(s) for them; and
- The geographical extent of the use shown.

40. I have carefully considered the evidence provided by the proprietor and whether this meets the requirements for genuine use as per *easyGroup*, set out earlier in this decision. I am also mindful of the guidance from the *Dosenbach-Ochsner* and *Awareness* appeal cases emphasising the need to consider what the evidence fails to "show", and what might reasonably have been conclusively shown. With this in mind I find there are various shortcomings in the evidence.

41. The evidence as a whole is vague and the statements to not provide much in the way of supporting narrative. I accept Mr Peddicord's assertion that his company has sold over 223,000 devices however, he does not say when or where these products were sold and, I am therefore unable to conclude whether any devices were sold in the UK or EU in either of the relevant periods. Any evidence showing the Intensity device is available for customers to purchase appears to indicate that the product is primarily made available to customers based in the US.

42. I also note the lack of any further supporting information such as turnover or advertising figures. The mere existence of copies of screen prints of social media posts, websites and brochures in isolation, are of little evidentiary value without any supporting information such as an indication as to how many people viewed this information, over what period, the location of those people, the volume of custom generated as a result, or the extent that the relevant consumer had been exposed to the mark by viewing this material. These details have not been provided.

43. Whilst I accept that use of the mark need not always be quantitatively significant for it to be deemed genuine, I am not satisfied that the evidence is sufficient to show that there has been a real attempt to exploit the mark in the relevant territories during either of the relevant periods.

44. Taking the above into account, I find that the proprietor has failed to discharge the burden placed on them to provide sufficiently solid evidence of genuine use in the EU (before IP completion) or UK in respect of its goods in class 10. I conclude therefore that the proprietor has not shown genuine use of the mark in the relevant territories during either of the relevant periods.

CONCLUSION

45. The revocation is successful in its entirety under section 46(1)(a) of the Act. As there is no evidence of genuine use in either period, in accordance with section 46(6) of the Act, UK comparable trade mark number 910252864 shall be revoked in the UK

from the earlier revocation date sought, namely from 10 February 2017. The outcome of this revocation action affects only the rights conferred in the UK.

COSTS

46. The applicant for revocation has been successful and would ordinarily be entitled to a contribution towards its costs. As they are unrepresented, the tribunal invited the applicant to indicate whether it wished to make a request for an award of costs and, if so, to complete a pro-forma including a breakdown of its actual costs. The applicant failed to return the pro-forma and therefore other than an award for the official fee of £200, I make no further award of costs.

47. I hereby order InControl Medical, LLC to pay JOUETS LIMITED £200. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of February 2026

Catrin Williams
For the Registrar