

**O/0641/23**

**TRADE MARKS ACT 1994**

**AND IN THE MATTER OF REGISTRATION NO. UK00905818521  
IN THE NAME OF SEVEN S.P.A. FOR THE FOLLOWING TRADE MARK:**

**eleven**

**IN CLASSES 5, 8, 18, 21, 25 AND 28**

**AND AN APPLICATION FOR REVOCATION THERETO**

**UNDER NO. 505017**

**BY BUSINESS SOLUTIONS INTL LTD.**

## **BACKGROUND AND PLEADINGS**

1. The trade mark shown on the cover page of this decision (“the Contested Mark”) stands registered in the name of Seven S.P.A. (“the proprietor”). The Contested Mark was filed on 6 April 2007 and registered on 3 March 2014. The Contested Mark stands registered for the goods shown in the Annex to this decision.

2. On 21 June 2022, Business Solutions INTL Ltd. (“the applicant”) sought revocation of the Contested Mark on the grounds of non-use. Under section 46(1)(a) of the Trade Marks Act 1994 (“the Act”) the applicant claims non-use in the five-year period following the date on which the Contested Mark was registered, i.e. 4 March 2014 to 3 March 2019, with an effective date of revocation of 4 March 2019. Under section 46(1)(b) of the Act, the applicant claims non-use in respect of the Contested Mark for the period between 21 June 2017 to 20 June 2022, with an effective date of revocation of 21 June 2022.

3. The proprietor filed a counterstatement defending its registration in respect of “backpacks; travelling bags; bags for sports; school bags”.

4. The proprietor is represented by Bromhead Johnson LLP and the applicant is represented by Haseltine Lake Kempner LLP.

5. Only the proprietor filed evidence. The applicant filed written submissions during the evidence rounds. Neither party requested a hearing, and only the proprietor filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE AND SUBMISSIONS**

6. The proprietor filed evidence in chief in the form of the witness statement of Livia Pasqualigo dated 5 December 2022, which is accompanied by 2 exhibits. Ms Pasqualigo is a Trade Mark Attorney acting on behalf of the proprietor. Her evidence introduced two documents:

- a) The original witness statement of Aldo Rosario Di Stasio dated 5 December 2022, which is accompanied by 7 exhibits. Mr Di Stasio is the Managing Director of the proprietor.
- b) The translated witness statement of Mr Di Stasio, which Ms Pasqualigo certifies as being a true translation.

7. The proprietor's evidence was accompanied by written submissions dated 6 December 2022.

8. The applicant filed written submissions during the evidence rounds dated 9 February 2023.

9. The proprietor filed written submissions in lieu dated 6 April 2023.

## **RELEVANCE OF EU LAW**

10. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **DECISION**

11. Section 46 of the Act is relevant to the revocation proceedings which states:

“46. - (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.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

12. As the Contested Mark is a comparable mark, the proprietor can rely upon use of the mark in the EU for any and all parts of the relevant periods which fall prior to IP Completion Day (i.e. 31 December 2020) pursuant to paragraphs 7 and 8 of Part 1, Schedule 2A of the Act.

13. 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.”

14. 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].”

15. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is not, therefore, genuine use.

16. As noted above, the relevant periods are 4 March 2014 to 3 March 2019 (“the First Relevant Period and 21 June 2017 to 20 June 2022 (“the Second Relevant Period”).

17. I note the following from the proprietor’s evidence:

- a) Mr Di Stasio states that the Contested Mark has been affixed on goods, namely, on the inner labels of goods in the Appack Collection.
- b) Mr Di Stasio states that products bearing the Contested Mark have been sold from 2018 to 2020 in the European Union (in particular, Italy, France and Croatia) with a total turnover of approximately €2million.
- c) Invoices have been provided dated between 29 May 2018 and 23 December 2020.<sup>1</sup> None of the invoices display the Contested Mark, but Mr Di Stasio gives narrative evidence that the goods listed in the invoices displayed the Contested Mark in their labels. In relation to the goods listed in the invoices, Ms Pasqualigo provides the following translation:

<b>Italian</b>	<b>English</b>
Trolley	Trolley case
Zaino; zainetto	Backpack; rucksack; schoolbag
Astuccio	Writing case; pencil case
Tombolino; tomboletto (astuccio)	Writing case; pencil case
Bustina	Pouches for writing instruments

Although the locations of some of the customers are not particularly clear from the redacted addressed, they appear to me to be located in Italy and I bear in mind Mr Di Stasi’s narrative evidence that all of the invoices were addressed to customers in the EU. I note the following quantities have been sold of goods in the Appack range:

Trolley case	8275
Backpack; rucksack; schoolbag	9545
Writing case; pencil case	6274

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<sup>1</sup> Exhibit ARDS1

d) An example of a label bearing the Contested Mark is shown below:<sup>2</sup>



e) The proprietor has been selling goods in the Appack collection on Amazon.co.uk since April 2018.<sup>3</sup>

18. The Contested Mark is a word only mark. Consequently, use in the form shown in paragraph 17(d) above would be covered by notional and fair use of the mark and is use upon which the proprietor can rely.

19. 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<sup>4</sup>.

20. Clearly, the photographs of the Contested Mark in use on labels are not dated. The Contested Mark also does not appear on any of the invoices filed. However, Mr Di Stasio has given narrative evidence that the Contested Mark has been affixed on the products in the Appack range between 2018 and 2020 (on the labels). The invoices show the number of Appack products that have been sold in those years in the EU. Mr Di Stasi confirms that sales of products in the EU bearing the Contested Mark

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<sup>2</sup> Exhibit ADRS3

<sup>3</sup> Exhibit ADRS5

<sup>4</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

during that period amounted to over €2million. This is supported by invoices which show reasonable sales.

21. I have borne in mind the applicant's submissions that use of the Contested Mark on an inner product care label fails to "show publicly and outwardly [sic] use of the Mark". The applicant continues:

"Consumers would not be able to see the Mark when purchasing the goods, and it is therefore submitted that the Mark is not used in accordance with the essential function of a trade mark, being to guarantee the origin of the goods for which it is registered."

22. I disagree with this line of argument. Firstly, it is entirely acceptable for more than one trade mark to be used on a product and, indeed, it is relatively common. Consequently, I do not consider the Contested Mark being used alongside another trade mark to be problematic, even if that other trade mark is more visible. Secondly, use on a label is clearly trade mark use; it identifies the origin of the goods. Thirdly, consumers are likely to inspect the product (either prior to purchase if they are buying it from a physical outlet; or following purchase if they are buying it online). The Contested Mark appearing on the inside label fulfils the function of identifying for the consumer the trade origin of the goods. Consequently, this is use upon which the proprietor can rely in demonstrating genuine use.

23. Whilst I appreciate that many of the exhibits do not display the Contested Mark at all, the case law makes it clear that the evidence must be viewed as a whole. I also note that the evidence only shows sales for part of the Second Relevant Period and an even smaller part of the First Relevant Period. Notwithstanding that, given the reasonable scale of the use shown, I am satisfied that there has been genuine use of the Contested Mark in relation to backpacks, schoolbags, trolley cases and pencil cases during both relevant periods. Even if the evidence in relation to the First Relevant Period were not, of itself, sufficient to demonstrate genuine use during that period, the continued use post-dating the First Relevant Period would still be relevant pursuant to section 46(3) of the Act.

24. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

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

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

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

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

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably

be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

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

26. The proprietor has defended the Contested Mark in respect of "backpacks; travelling bags; bags for sports; school bags". Clearly, as the proprietor has shown use of backpacks and school bags, these are terms that it can retain. The evidence has not shown genuine use of sports bags and, consequently, I do not consider that the proprietor should retain this term. The proprietor's use of backpacks and trolley cases (which are both types of travelling bags) is, in my view, sufficient to retain that broader term. Consequently, I consider a fair specification to be:

Class 18      Backpacks; travelling bags; school bags.

## **CONCLUSION**

27. The application for revocation is successful in relation to the undefended goods, as well as "bags for sports". Consequently, the Contested Mark is revoked for the following goods:

Class 5      Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetical substances for medical use, foodstuffs for babies; plasters, materials for dressings; material for stopping teeth,

dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

Class 8 Hand tools and implements (hand operated); other than tools used in the repair and maintenance of automobiles; cutlery; side arms; razors.

Class 18 Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks; umbrellas, parasols and walking sticks; whips, harness and saddlery; attaché cases; bags for sports; bandoliers; beach bags; briefcases; card cases [notecases]; chain mesh purses; clothing for pets; collars for animals; covers for animals; dog collars; game bags [hunting accessories]; handbag frames; handbags; haversacks; leather shoulder belts; leather shoulder straps; music cases; muzzles; net bags for shopping; pocket wallets; purses; rucksacks; school satchels; shopping bags; shoulder belts [straps], of leather; sling bags for carrying infants; slings for carrying infants; straps for skates; suitcase handles; vanity cases [not fitted]; wheeled shopping bags.

Class 21 Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

Class 25 Clothing, sandals in plastic for the sea, headgear.

Class 28 Games and playthings; other than model cars; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

28. The application for revocation is unsuccessful in relation to the following goods, for which the Contested Mark may remain registered:

Class 18 Backpacks; travelling bags; school bags.

## **COSTS**

29. The applicant has enjoyed a greater degree of success and, consequently, is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I have borne the only partial success in mind. I award the applicant the sum of **£1,250**, calculated as follows:

Preparing the notice of cancellation and considering the proprietor's counterstatement	£200
Considering the proprietor's evidence	£500
Written submissions	£350
Official fee	£200
<b>Total</b>	<b>£1,250</b>

30. I therefore order Seven S.P.A. to pay Business Solutions INTL Ltd. the sum of **£1,250**. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 5<sup>th</sup> day of July 2023**

**S WILSON**

**For the Registrar**

## ANNEX

### Class 5

Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetical substances for medical use, foodstuffs for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

### Class 8

Hand tools and implements (hand operated); other than tools used in the repair and maintenance of automobiles; cutlery; side arms; razors.

### Class 18

Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; attaché cases; backpacks; bags for sports; bandoliers; beach bags; briefcases; card cases [notecases]; chain mesh purses; clothing for pets; collars for animals; covers for animals; dog collars; game bags [hunting accessories]; handbag frames; handbags; haversacks; leather shoulder belts; leather shoulder straps; music cases; muzzles; net bags for shopping; pocket wallets; purses; rucksacks; school bags; school satchels; shopping bags; shoulder belts [straps], of leather; sling bags for carrying infants; slings for carrying infants; straps for skates; suitcase handles; vanity cases [not fitted]; wheeled shopping bags.

### Class 21

Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

### Class 25

Clothing, sandals in plastic for the sea, headgear.

Class 28

Games and playthings; other than model cars; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.