

O-099-06

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 82098
BY FOUR STAR DISTRIBUTION
FOR A DECLARATION OF INVALIDITY
IN RESPECT OF A TRADE MARK No 1461059**

CICA

CICA

**STANDING IN THE NAME OF
C & J CLARK INTERNATIONAL LIMITED**

BACKGROUND

1) The registered proprietor has the following trade mark registered in the UK:

Mark	Number	Effective Date	Class	Specification
 <p>A series of two marks.</p>	1461059	10.04.91	25	Footwear, boots, shoes and slippers; parts and fittings for all the aforesaid goods; all included in Class 25.

2) By an application dated 4 April 2005 Four Star Distribution applied for a declaration of invalidity in respect of the registration. The grounds are, in summary:

a) The mark is in breach of Section 5(2)(b) of the Trade Marks Act 1994 as it is similar to the following trade mark which is owned by the applicant:

Mark	Number	Effective Date	Class	Specification
CIRCA	1432636	20.06.90	25	Suits, articles of underclothing, shirts, T-shirts, sweatshirts, blouses, slacks, trousers, skirts, dresses, jackets, overalls being protective articles of clothing (not for protection against accident or injury), waistcoats, pant-hose, knitted articles of clothing, articles of clothing made from knitted materials, scarves, hats, dressing gowns, bathrobes, articles of sports clothing, articles of outerclothing, sleeping garments, aprons, belts, caps, gloves, tights, jeans, neckwear, swimwear all being articles of clothing all included in Class 25.

b) The applicant has used the above mark in the UK in relation to the following goods “Shirts, T-shirts, sweatshirts, slacks, trousers, jackets, knitted articles of clothing, articles of clothing made form knitted materials, hats, articles of sports clothing, articles of outer clothing, belts, caps, jeans, articles of underclothing, scarves, gloves and swimwear”.

3) The registered proprietor filed a counterstatement which questioned the legal status of the applicant and requested that genuine use of all, or any, the goods for which it is registered be shown. It also includes the following statement:

“The proprietor of the registration in suit agrees that the trade marks CICA and CIRCA are very close and that, in respect of the same goods, CIRCA is confusingly similar to CICA. However, in view of the fact that none of the goods for which the mark in suit is registered are the same as or confusingly similar to those for which No. 1432636 is registered, the registration in suit does not offend under Section 5 of the Act as alleged sufficient for there to be a Section 47 case.”

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 11 January 2006 when the applicant was represented by Mr Olsen of Messrs Field Fisher Waterhouse, and the registered proprietor by Mr Cornford of Messrs Stevens Hewlitt Perkins.

APPLICANT’S EVIDENCE

5) The registered proprietor filed a witness statement, dated 9 June 2005, by John Raymond Olsen, their Trade Mark Attorney. He provides a number of exhibits which I shall detail below. He also states that the applicant company is a company duly incorporated under the laws of California. He states that on 7 December 2001 Circa Footwear, the former owner of UK trade mark CIRCA registration No. 1432636 merged with and into the applicant company.

6) The exhibits are as follows:

- JR01: a certificate of ownership of Circa Footwear by the applicant. This states that the applicant company, Four Star Distribution, is a Californian corporation which owns, *inter alia*, Circa Footwear.
- JR02: An assignment certificate of the UK Trade Mark CIRCA registration No. 1432636 showing the applicant’s ownership of the mark.
- JR03: Invoices evidencing use of the mark in the UK during the period 1999-2002. These consist of the following:
 - a) Three invoices for the year 1999. Two are from Four Star Distribution (Far East) Limited (hereinafter 4*) in Hong Kong to Slam City Skates in London (hereinafter SCS). The items originate in the USA and Korea and are invoiced “Ex-factory, Amsterdam”. The other invoice is from SCS to Mischief (an outlet in Stockton-on-Tees) and is for twenty-seven pairs of shoes, seven sweatshirts, nine T-shirts and eight hats. All of which are CIRCA items.
 - b) Eleven invoices for the year 2000. Ten are from 4* to SCS. Of these six are marked Delivered Duty Paid (DDP) Amsterdam. Four are marked as “Ex-factory Amsterdam”. The six DDP invoices are after 5 April 2000 whilst only one of the “ex-factory” invoices is after this

date. The remaining invoice is from SCS to Mischief and is for twenty-five pairs of shoes.

- c) Twenty two invoices for the year 2001. Twenty are from 4* to SCS and are marked DDP Amsterdam. One is marked “Free on Board, Korea” and is for shoe laces. The other invoice is to Mischief and is for twenty-two pairs of shoes.
 - d) Sixteen invoices for the year 2002. Fourteen of which are from 4* to SCS and are marked DDP Amsterdam. One is to Solid SE a company in the Benelux and is also marked DDP Amsterdam. The final invoice is from SCS to Mischief and relates to forty-five pairs of shoes.
- JR04: a DVD of the Circa Footwear European Tour of June 2001 relating to skateboarding. This includes some footage shot in London where banners for “CIRCAFOOTWEAR” were, fleetingly, visible. It is not clear whether the skate boarders featured are wearing CIRCA clothing as labels cannot be seen and none has the name CIRCA emblazoned upon it. It is clear that not all are wearing CIRCA footwear as there are shots of shoes being spray painted to cover other well known brands.
 - JR05: A collection of publications, magazines and catalogues showing use of the mark CIRCA. This shows use on clothing and shoes of the mark CIRCA. However, of those items which show an address, all are in the USA or Canada.

REGISTERED PROPRIETOR’S EVIDENCE

7) The registered proprietor filed a witness statement, dated 15 July 2005, by Judith Enid Derbyshire the Company Secretary of Clarks, the registered proprietor. Ms Derbyshire comments that although the applicant has shown that it has used its mark on all of the goods for which it is registered it has not shown that items of clothing are similar to shoes. She states: “I doubt that any person would have any difficulty in distinguishing the goods listed in the CICA registration from those which CIRCA is registered”. She also repeats that the marks CICA and CIRCA are “very similar”.

8) Ms Derbyshire states that the mark CICA has been used in the UK on footwear since 1991 and that there has been no confusion with the applicant’s mark. At exhibit JED1 she provides examples of brochures and catalogues from 1992-1999 showing use of the CICA mark on footwear. She states that in the period 1990-2002 her company has sold footwear under the CICA trade mark worth £225 million.

APPLICANT’S EVIDENCE IN REPLY.

9) The applicant filed a second witness statement, dated 31 August 2005, by its Trade Mark Attorney, Mr Olsen. He states that the registered proprietor opposed an application to register the mark CIRCAFOOTWEAR in OHIM. The Community Trade Marks Registry considered the marks (CICA and CIRCA FOOTWEAR) confusingly similar and rejected the application. At exhibit JR06 he provides a copy of the decision. He also states that the registered proprietor opposed the applicant’s

mark 1461059 in the UK at the application stage. However, I note that in this case the mark CIRCA had a specification which covered both “clothing and footwear” as did three of the four CICA trade marks relied upon by the opponent, C & J Clark International Ltd.

10) That concludes my review of the evidence. I now turn to the decision.

DECISION

11) In their counterstatement the registered proprietor questioned the legal status of the applicant company. This aspect of their defence did not feature at the hearing and was only obliquely raised. In my opinion the applicant has shown that it is a legal entity and, although not necessary, has shown that it has title to the mark as claimed in the statement of grounds.

12) Also the issue of whether the applicant had used their mark in the UK did not feature at the hearing. Submissions in writing were sought following the hearing and have been incorporated into the decision.

13) The request for the declaration of invalidity is made under the provisions of Section 47 (2) (a) of the Act, which states:

“47(2) The registration of a trade mark may be declared invalid on the ground -

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b)

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

14) I will now consider the position under section 5(2)(b) which reads:

“5.-(2) A trade mark shall not be registered if because -

- (a)...
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

15) An “earlier trade mark” is defined in section 6, the relevant parts of which state:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

16) The applicant for invalidity is relying upon its trade mark 1432636 which has an effective date of 20 June 1990 and is clearly an earlier trade mark.

17) The application for invalidity was filed on 4 April 2005. I must therefore consider the position under The Trade Marks (Proof of Use, etc.) Regulations 2004. Paragraph six of which states:

“6. In section 47 (grounds for invalidity of registration), after subsection (2) there shall be inserted –

“(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

- (b) the registration procedure for the earlier trade mark was not completed before that date, or

- (c) the use conditions are met.

(2B) The use conditions are met if –

- (a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has 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, or

- (b) it has not been so used, but there are proper reasons for non-use.””

18) As the mark that the applicant for invalidity is relying upon was registered more than five years prior to the request for invalidity I must first consider whether the applicant has fulfilled the requirement to show that genuine use of the mark has been made.

19) The applicant’s evidence of use is contained within exhibits JR03-5 which are detailed at paragraph 6 above. The application for invalidity was made on 4 April 2005 and so the applicant must show use within the period 5 April 2000 – 4 April 2005. The applicant contended that evidence prior to this date should be considered but did not state any reason for disregarding the regulation set out in paragraph 17 above.

20) Exhibit JR04 does not show genuine use of the mark in the UK. It shows a number of professional skateboarders performing at various venues around Europe including some in the UK. Clearly, this tour was sponsored by, amongst others, the applicant company. There are three fleeting glimpses of a banner with “CICAFOOTWEAR” on it on the floor of one of the arenas. I do not regard this as showing genuine use of the mark in suit on the specification for which it is registered.

21) Exhibit JR05 shows use of the mark on items of clothing and footwear. However, only some of the items in this exhibit have addresses, and all of these addresses are in the USA or Canada. There is no evidence that these articles were distributed in the UK. I do not consider this to show genuine use of the mark in suit in the UK.

22) Lastly, I consider exhibit JR03. This exhibit shows a large number of invoices from Four Star Distribution (Far East) Limited based in Hong Kong to Slam City Skates based in London. These invoices show that the goods originate from numerous countries world-wide. But all of the invoices are marked either “ex-factory Amsterdam” or “Delivered Duty Paid (DDP) Amsterdam”. There is no evidence that these items ever entered the UK, let alone offered for sale in the UK. There are only four invoices which show goods being delivered in the UK. There is one invoice per year for the years 1999-2002 inclusive from Slam City Skates, London to Mischief in Stockton-on-Tees. The first of these, dated December 1999, is prior to the relevant date and therefore cannot be taken into account. The other three invoices are all within the relevant period but show use of the applicant’s mark on shoes only.

23) The applicant contends that as the invoices contained within exhibit JO3 also have “ALPI International Forwarders B.V. – Amsterdam” on them that the duty was paid on the goods upon entry into the European Union and en-route to Slam City Skates in London. They also claim that the invoices to Mischief prove that the goods entered the UK. In my view the fact that the invoices have the name of an international forwarder on them does not prove that they were routed to the UK, they could just as easily have been sent to any other country by the “International Forwarder”. Similarly, although in December 1999 there is an invoice which refers to sixteen sweatshirts and three caps, bearing the mark CIRCA being supplied to Mischief in Stockton-on-Tees there is no corroborative evidence for anything other than shoes being imported into the UK after April 2000.

24) In raising an invalidity action the onus is upon the applicant to make out its case. This should not rely upon inference. It should have been very simple for the applicant to show that items of clothing bearing its CIRCA mark had been offered for sale within the UK during the period April 2000- April 2005.

25) As the applicant has failed to show use of the mark relied upon within the five years prior to the date of the application for invalidity on any of the goods contained within the specification for which the mark is registered then the application for invalidity must fail.

COSTS

26) As the applicant was unsuccessful the registered proprietor is entitled to a contribution towards its costs. I order the applicant to pay the registered proprietor the

sum of £2000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of April 2006

**George W Salthouse
For the Registrar,
the Comptroller-General**