

**O-200-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 501 198  
BY FASHION TV BROADCASTING LIMITED  
FOR REVOCATION OF TRADE MARK NO 2 461 391  
STANDING IN THE NAME OF JOHN DAVID PHILPOTTS**

## Background and pleadings

1. John David Philpotts is the registered proprietor of trade mark registration No

2 461 391 consisting of . The trade mark was filed on 14<sup>th</sup> July 2007 and completed its registration procedure on 16<sup>th</sup> May 2008. It is registered in respect of footwear in Class 25.

2. Fashion TV Broadcasting Limited seek revocation of the trade mark registration on the grounds of non use based upon Section 46(1)(a) and (b) of the Trade Marks Act 1994. Mr Philpotts filed a counterstatement denying the claim.
3. Revocation is sought under Section 46(1)(a) in respect of the 5 year time period following the date of completion of the registration procedure<sup>1</sup>, namely 16<sup>th</sup> May 2008. Revocation is therefore sought from 17<sup>th</sup> May 2013. Revocation is also sought under Section 46(1)(b) in respect of the time period 11<sup>th</sup> May 2011 to 10<sup>th</sup> May 2016 with the desired date of revocation being 11<sup>th</sup> May 2016.
4. Only the registered proprietor filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

---

<sup>1</sup> That is, for the period 17<sup>th</sup> May 2008 to 16<sup>th</sup> May 2013.

## Legislation

5. 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

## O-200-17

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.”

6. 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.”

7. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

## O-200-17

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

## O-200-17

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

### Registered Proprietor's Evidence

8. As already stated, revocation is sought under Section 46(1)(a) in respect of the 5 year time period following the date of completion of the registration procedure, namely 16<sup>th</sup> May 2008. Revocation is therefore sought from 17<sup>th</sup> May 2013. Revocation is also sought under Section 46(1)(b) in respect of the

## O-200-17

time period 11<sup>th</sup> May 2011 to 10<sup>th</sup> May 2016 with the desired date of revocation being 11<sup>th</sup> May 2016. The evidence filed by Mr Philpotts must therefore demonstrate that there has been genuine use within the time periods detailed above.

9. The evidence is in the form of a witness statement, dated 15<sup>th</sup> November 2016, from the Registered Proprietor, John David Philpotts. He explains that he is the owner of the trade mark, the subject of these proceedings. The following relevant information is contained within the witness statement:
  - Turnover figures are provided for Oxygen branded footwear products in the UK. These are (in pounds sterling): 140,151 in 2009; 613,608 in 2010; 321,872 in 2011; 84,627 in 2012; 178,652 in 2015 and 249,711 in 2016. The gap in figures for the years 2013 and 2014 is explained as a closure of the owner's major supplier. The resumption of trade as evidenced by the figures in 2015 and 2016 followed a licensing agreement, dated 1<sup>st</sup> February 2014 between the owner and M V Footwear Limited to sell Oxygen branded footwear.
  - Several invoices and price lists are provided, covering the period 2009-2015. These are all within the relevant period with some displaying the trade mark as registered or otherwise referring to and providing details of Oxygen footwear.
  - Three retail customer letters are provided. These have been included by the owner to demonstrate that these have been customers purchasing Oxygen footwear from 2008 onwards. It is noted that each customer has added its signature to indicate agreement with a paragraph outlining a set wording prepared by the owner. I will discuss this further below.
  - As evidence of brand recognition, Exhibit JP4 is a copy of the outcome of a survey regarding women's footwear, conducted in December 2009, by Drapers. This publication, according to the owner, is a trade magazine for the fashion industry. It is noted that Oxygen branded boots are 4<sup>th</sup> in the best selling boot category as at December 2009.
  - Other examples of retailers' orders are provided. These are in the form of emails dated April and May 2013.

## O-200-17

- As regards marketing activity, the owner describes flyers sent out in September 2015 to all existing retail customers and potential new ones. On perusal of the flyer, it is noted that at least some of the products are branded Oxygen. The trade mark is displayed on the inside of the sole of the footwear. The owner also provides a photograph of its stand at the Moda Footwear Show at the NEC in Birmingham in 2015. The women's footwear products shown are clearly branded Oxygen.
- In addition to wholesaling Oxygen footwear, the owner describes his activities to sell direct to the general public via its own website, Amazon and Ebay. Screenshots from the various websites described are provided in support of this assertion clearly displaying women's Oxygen branded footwear. In respect of the Oxygen website, copies of customer orders are provided.
- Photographs of women's Oxygen branded footwear sold between 2009 and 2015 are provided.

10. The remainder of this witness statement is two - fold. First, it makes a number of submissions and exhibits some evidence in respect of costs incurred. I will return to this when dealing with costs at the end of this decision. Second, an additional witness statement is included as Exhibit JP11. This is dated 18<sup>th</sup> August 2016 and is from Mr Peter Leslie Leek. Mr Leek explains that he is a self employed footwear agent and represent Velashark S.A., a manufacturer of footwear. Mr Leek explains that in 2009, he met with Mr Philpotts with a view to finding a factory to produce footwear for him, which he intended to sell in the UK under his brand Oxygen. In 2010, Mr Philpotts placed orders with Velashark for boots branded Oxygen to be sold in the UK. These were delivered and since 2010, Velashark have continually supplied Mr Philpotts with boots and shoes branded Oxygen. These have been sold in the UK to wholesale customers and to the public via the internet. Mr Leek ends his statement by explaining that Velashark continue to supply Mr Philpotts with Oxygen branded footwear. They are (at the time of the date of the witness statement – August 2016) working on approx. 4000 pairs of boots which will be delivered in September 2016.

## Conclusion – Non use

11. It is noted that the applicant for revocation made a number of criticisms of the evidence filed. Much of this is entirely unfounded, for example, stating that evidence provided in respect of 2009 is outside of the relevant period. This is simply not the case, bearing in mind that one of the relevant five year periods started in 2008. Another example is in respect of what the applicant refers to as marks other than Oxygen being displayed on the invoices. Having also perused the photographic evidence provided, it is clear that these are merely style names and that the footwear sold is clearly Oxygen branded.

12. In terms of an evidence critique, it is true that there is no market context provided. However, this is footwear and so the market is enormous. In this context, the sales details provided are modest. However, they are consistent from 2009 onwards and cover both of the relevant five year periods. The channels of trade utilized are clearly set out, both wholesale and to the general public. There is also information regarding licensing arrangements and an additional witness statement (from Mr Peter Leek) regarding a manufacturing relationship. It is true that some of the evidence filed, namely the retail customer letters could have been provided in a different format. That is, witness statements from the individual retailers and in their own words could have been filed instead of letters in the form set out above. However, this is not fatal to this evidence in the sense that I can still accord some weight to it. Further, it must be considered as a piece of the jigsaw that is the evidence as a whole. In doing so, I consider that it is clear that the trade mark Oxygen has clearly been genuinely used throughout the relevant five year periods. Having said that, it is equally clear that the registered trade mark has not been used across the full range of goods for which it is registered, namely footwear. In framing a fair specification which accurately reflects the use made, the following guidance is taken into account:

## O-200-17

13. 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.”

14. 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

## O-200-17

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.”

15. It is clear that the registered trade mark is used on women’s footwear only. It is considered that this is a sufficiently clear sub category of the broader term footwear at large. **As such, the specification of the registered trade mark should be limited to women’s footwear.**

16. The application for revocation therefore partially succeeds. The specification of the registered trade mark is to be limited to “women’s footwear”.

## COSTS

17. In respect of costs, Mr Philpotts made a number of points in his witness statement regarding the award of costs in these proceedings. In essence, he considers the bringing of these proceedings by the applicant to have been reckless in that its efforts in researching whether or not Oxygen had been used were short sighted and inadequate. Mr Philpotts also highlights the background of the personnel involved with the applicant for revocation,

## **O-200-17**

including its representative. I have considered Mr Philpott's submissions, but bearing in mind the outcome of partial revocation as described above, I cannot agree that the revocation applicant has been reckless. Bearing in mind that each of the parties has achieved a fairly equal measure of success, I order that each party should bear its own costs.

**Dated this 27<sup>TH</sup> day of April 2017**

**Louise White**

**For the Registrar,  
The Comptroller-General**