

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION No. 2115051
IN THE NAME OF
PENN FISHING TACKLE MANUFACTURING CO.**

**AND IN THE MATTER OF APPLICATION FOR REVOCATION No. 83075
BY FOX INTERNATIONAL GROUP LIMITED**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE REGISTERED PROPRIETOR
AGAINST A DECISION OF MRS J. PIKE
DATED 3 AUGUST 2009**

DECISION

Introduction

1. This is an appeal against a decision of Mrs Judi Pike (BL O/252/09), acting for the Registrar, dated 3 August 2009, in which she partially revoked UK Registration number 2115051 standing in the name of Penn Fishing Tackle Manufacturing Co. (“Penn”) with effect from 17 May 2002.
2. UK Registration number 2115051 is for the trade mark EXTREME in respect of fishing tackle, fishing rods, reels and lines in Class 28. It was entered in the Register on 16 May 1997 with a filing date of 7 November 1996.
3. On 6 November 2007, Fox International Group Limited (“Fox”) applied to revoke the entire registration under section 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994. The alleged periods of non-use were 17 May 1997 – 16 May 2002 and 6 November 2002 – 5 November 2007 with claimed revocation dates of 17 May 2002 and 6 November 2007 respectively.
4. Penn took issue with the grounds of revocation in a Notice of defence and counterstatement dated 15 February 2008. Penn asserted continuous and ongoing use of EXTREME in the UK on the registered goods since 1999. Penn relied in support on a witness statement of David Caulfield, General Manager of Penn Trading Limited (a wholly owned subsidiary of Penn) dated 14 February 2008 and exhibits P-1 to P-6 thereto.
5. The evidence filed in support of the application comprised a witness statement of David John Crouch, Bromhead Johnson, Fox’s trade mark attorney, dated 22 May 2008. Mr. Crouch exhibited dictionary extracts as to the meaning of the word “extreme”. The only other objection to the evidence of use was contained in a letter to the Registrar dated 22 May 2008 wherein Mr. Crouch noted that EXTREME was

always used with other elements and observed that EXTREME was laudatory and lacking in distinctiveness. In a further letter to the Registrar dated 23 May 2008, Fox queried the chain of ownership of the mark but that challenge was not pursued.

6. Penn's evidence in support of its case consisted of a witness statement of Anne Wong, Carpmaels & Ransford, Penn's trade mark attorney, dated 18 December 2008 with exhibits AW1 to AW9, in which Ms. Wong sought to deal with the points raised by Mr. Crouch in his letters to the Registrar of 22 and 23 May 2008.
7. Neither party requested a hearing and only Penn's attorney submitted further written submissions in a letter to the Registrar dated 22 June 2008. In that letter, Carpmaels & Ransford commented that the applicant had raised only minor challenges to Penn's evidence of use and that those had been dealt with in exhibits AW1 to AW7 and AW8 respectively. The Hearing Officer decided the application on the papers before her.

The Hearing Officer's decision

8. The Hearing Officer's findings were in summary:
 - (a) Use was by Penn or with its consent.
 - (b) Penn's use of EXTREME with generic matter such as "boat" or "uptide" was use of the mark in a form which did not alter the distinctive character of the mark in the form in which it was registered (section 46(2) of the Act). Other uses like EXTREME VILLAN and EXTREME VENGEANCE constituted acceptable uses of a house mark and product mark (Case T-29/04, *Castellblanch SA v. OHIM* [2005] ECR II-5309).
 - (c) Genuine use had been shown in both periods for rods and reels.
 - (d) There was no genuine use for fishing tackle and lines. "Fishing tackle" was a broad term and "it would be contrary to the ratio legis to allow it to remain".
 - (e) "Rods" was a broad term within which it was possible to identify subcategories according to the type of fishing for which the rod was designed. On the evidence, the specification would be reduced to rods for use in sea fishing and saltwater fishing.
 - (f) On the other hand, there was no indication in the evidence that reels could similarly be subcategorised.
 - (g) Penn's registration should remain for:

Rods for use in sea fishing and saltwater fishing; reels
 - (h) However, Penn's registration should be revoked in respect of all other goods with effect from 17 May 2002.
 - (i) Since each side had achieved a measure of success there would be no order for costs.

The appeal

9. On 1 October 2009, Penn filed Notice of appeal to the Appointed Person under section 76 of the Act. The grounds of appeal concerned part revocation and the Hearing Officer's determination of what was a fair specification for UK Registration number 2115051 in view of the evidence of use. Penn argued in brief:
- (i) "Fishing tackle" was a narrowly defined category incapable of significant sub-division. Penn had shown genuine use of EXTREME for fishing rods and reels, which was sufficient to maintain registration for the entire category.
 - (ii) Although "rods for use in sea fishing and saltwater fishing" might reflect actual use, it was overly restrictive and not a fair description (*ANIMAL Trade Mark* [2004] FSR 383). Fishing rods were regarded as a single category in trade with the same trade channels, target consumers and advertising methods. Their subdivision into saltwater/sea fishing rods and freshwater rods was arbitrary and unjustified on the evidence. The average consumer would fairly describe the goods as "fishing rods".
10. Penn raised a further ground in its skeleton argument on appeal, namely that Penn had not been afforded a proper opportunity to address the Hearing Officer on it becoming apparent to her that more than a simple deletion, i.e., a rewriting within a broad term, might be required. The parties did not attend a hearing and part cancellation had not previously been put in issue.
11. At the appeal hearing before me, Ms. Fiona Clark of Counsel, instructed by Carpmaels & Ransford, appeared on behalf of Penn. Fox did not appear and made no written submissions other than to request that the appeal be decided on the papers. Ms. Clark accepted that the principles of *REEF Trade Mark* [2003] RPC 101, per Robert Walker L.J. at 109 – 110, applied to this appeal.

Section 46 of the Act

12. Section 46 of the Act relevantly 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;

[...]

(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.”

Those provisions implement articles 10(1), 12(1) and 13 of Directive 2008/95/EC and correspond to articles 15(1) and 51(1)(a) and (2) of Regulation (EC) 207/2009.

Part cancellation

13. The current law on part cancellation for non-use was succinctly summarised by Mr. Geoffrey Hobbs QC sitting as a deputy judge of the High Court in *Daimler AG v. Sany Group Co Ltd* [2009] EWHC 1003 (Ch), paragraph 9:

“The required degree of precision [with which the goods/services of the registration in suit may need to be redefined] has not yet been authoritatively defined by the European Court of Justice (it was touched upon obliquely in Case C418/02 *Praktiker Bau-und Heimwerkermärkte* [2005] ECR I-5873 at paragraphs 49 to 52). In three decisions of the Court of First Instance (Case T-256/04 *Mundipharma AG v. OHIM* [2007] ECR II-449; Case T-483/04 *Armour Pharmaceutical Co v. OHIM* [2006] ECR II-4109; Case T-126/03 *Reckitt Benckiser (España) SL v. OHIM* [2005] ECR II-2861) it has been indicated that the outcome should be a specification expressed in wording which covers no independent sub-category or sub-categories of goods other than the one(s) within which the relevant trade mark can be taken to have been used. In the most recent of these decisions (Case T-256/04 *Mundipharma AG* at paragraphs 27 to 36) it was emphasised that the chosen wording should reflect the purpose and intended use of the relevant goods. I have previously expressed the view that the aim should be to arrive at a fair specification by identifying and defining not the particular examples of goods for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify (*WISI Trade Mark* [2006] RPC 13, p. 580 at paragraphs 11 to 18; *DATASPHERE Trade Mark* [2006] RPC 23, p. 590 at paragraphs 19 to 25). That appears to me to be consistent with the case law in England (analysed by Mr. Richard Arnold QC sitting as the Appointed Person in *NIRVANA Trade Mark* (BL O/262/06) at paragraphs 36 to 59) and also with the case law of the Court of First Instance. However it is possible, that the case law in England may not fully accord with the case law of the Court of First Instance, as noted in the decision of Mr. Richard Arnold QC sitting as the Appointed Person in *EXTREME Trade Mark (Pan World Brands Ltd v. Tripp Ltd* [2008] RPC 2, p. 21 at paragraphs 51 to 56; see also Bently and Sherman *Intellectual Property Law* 3rd Edn (2009) pp 906, 907) ...”

14. In *EXTREME Trade Mark*,¹ Mr. Arnold said:

“52. I considered the principles applicable under section 46(5) at some length in *NIRVANA Trade Mark* (O/262/06) at [36]-[59]. Since then the CFI has given judgment in Case T-256/04 *Mundipharma AG v Office for*

¹ Coincidentally named but nothing to do with the present case

Harmonisation in the Internal Market (unreported, 13 February 2007). In that case the opponent's mark was registered in respect "pharmaceutical and sanitary preparations; plasters". The applicant did not dispute that the mark had been used in relation to "multi-dose dry powder inhalers containing corticoids, available only on prescription" and the Board of Appeal found that the opponent had only proved use of the mark in relation to those goods. On appeal to the CFI the opponent contended inter alia that use should be taken to have been proven in relation to "therapeutic preparations for respiratory illness". The CFI upheld this contention.

53. In its judgment, having recapitulated paragraphs [45] and [46] of its judgment in Case T-126/03 *Reckitt Benckiser (España) SL v Office for Harmonisation of the Internal Market (ALADIN)* [2005] ECR II-2861 and recorded that it was not disputed that the mark had been used in relation to "multi-dose dry powder inhalers containing corticoids, available only on prescription", the CFI went on:

"26. Next, it should be borne in mind that the earlier mark was registered for 'pharmaceutical and sanitary preparations; plasters'. That category of goods is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently. Consequently, the fact the earlier mark must be regarded as having been used for 'multi-dose dry powder inhalers containing corticoids, available only on prescription' confers protection only on the subcategory within which those goods fall.

27. In the contested decision, the Board of Appeal held that the earlier mark was to be taken into consideration only in so far as it covered goods the genuine use of which was not contested. It thus defined a sub-category corresponding to those goods, namely 'multi-dose dry powder inhalers containing corticoids, available only on prescription'.

28. That definition is incompatible with Article 43(2) of Regulation No 40/94, as interpreted in the light of *ALADIN*, and applicable to earlier national marks pursuant to Article 43(3) of that regulation.

29. The Court notes in this respect that, since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product or service in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a sub-category of goods or services.

30. The purpose and intended use of a therapeutic preparation are expressed in its therapeutic indication. However, the definition employed by the Board of Appeal is not based on that criterion as it does not state that the goods in question are intended for the treatment of health problems and does not specify the nature of those problems.

31. Moreover, the criteria chosen by the Board of Appeal, namely the dosage form, the active ingredient and the obligation to obtain a doctor's prescription, are, as a rule, inappropriate for defining a sub-category of goods as contemplated in *ALADIN*, as the application of those criteria does not fulfil the abovementioned criteria of purpose and intended use of the goods. In fact, a given medical condition can often be treated using a number of types of medication with different dosage forms and containing different active ingredients, some of which are available over-the-counter whilst others are available only on prescription.

32. It follows that, in failing to take into account the purpose and intended use of the goods in question, the Board of Appeal made an arbitrary choice of sub-category of goods.

33. For the reasons set out in paragraphs 29 and 30 above, the sub-category of goods covering those the genuine use of which has not been contested must be determined on the basis of the criterion of therapeutic indication.

34. The sub-category proposed by the intervener, namely 'glucocorticoids', cannot be accepted. That definition is based on the criterion of the active ingredient. As discussed in paragraph 31 above, such a criterion is not generally appropriate by itself for defining subcategories of therapeutic preparations.

35. By contrast, the definition proposed by the applicant and OHIM, namely 'therapeutic preparations for respiratory illnesses', is appropriate in two ways: first, it is based on the therapeutic indication of the goods in question and, second, it allows for the definition of a sufficiently specific sub-category, as contemplated in *ALADIN*.

36. In the light of the foregoing, the Court finds that the earlier mark must be deemed to have been registered, for the purposes of the present case, for 'therapeutic preparations for respiratory illnesses'."

54. Although at first blush this suggests an approach which is somewhat different to that laid down by the English authorities considered in *NIRVANA*, I consider that the difference is smaller than might appear. The essence of the domestic approach is to consider how the average consumer would fairly describe the goods in relation to which the trade mark has been used. Likewise, paragraph [29] of *Mundipharma* indicates that the matter is to be approached from the consumer's perspective.

55. To the extent that there is a difference between them, I remain of the view expressed in *NIRVANA* that I am bound by the English authorities interpreting section 46(5) of the 1994 Act and Article 13 of the Directive and not by the CFI's interpretation of Article 46(2) of the CTM Regulation since, as already noted above, there are differences between the two legislative contexts.

Nevertheless I consider that English tribunals should endeavour to follow the latter so far as it is open to them to do so. *Mundipharma* suggests that, within the spectrum of domestic case law, the slightly more generous approach of Jacob J in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch), [2004] FSR 19 is to be preferred to the slightly less generous approach of Pumfrey J in *DaimlerChrysler AG v Alavi* [2001] RPC 42.

56. Applying these principles to the present case, counsel for the proprietor submitted that a holdall was an item of luggage and would be so described by the average consumer having regard to its purpose and intended use and that it was not appropriate to attempt to sub-divide “luggage” into narrower sub-categories. With some hesitation, I have come to the conclusion that I accept these submissions”.

15. In *NIRVANA*, Mr. Arnold identified that the main difference between the approaches of the English courts and the General Court was that the former based a fair description of the use that had taken place on the perception of the average consumer whereas the latter provided no clear yardstick for determining when a sub-category of products cannot be further divided. To my mind, a danger with the category/sub-category approach is that invites sub-division according to the product(s) concerned. A tribunal may be seduced into equating a fair description with actual use shown.

Arguments on appeal

16. Ms. Clark noted that this was not a case where the specification was self evidently wide (c.f. computer software in *Mercury Communications Ltd v. Mercury Interactive (UK) Ltd* [1995] FSR 850, printed matter in *MINERVA Trade Mark* [2000] FSR 734). Her client’s registration was in Class 28 which included:

Games and play things; gymnastic and sporting articles; decorations for Christmas trees; children’s toy bicycles

The goods – fishing tackle, fishing rods, reels and lines – fell within the category of gymnastic and sporting articles.

16. Ms. Clark relied on the observations of Pumfrey J. in *Decon Laboratories Ltd v. Fred Baker Scientific Ltd* [2001] RPC 293 at paragraphs 22 to 24 (approved by the Court of Appeal in *Thomson Holidays Ltd v. Norwegian Cruise Line Ltd* [2003] RPC 32):

“... In my judgment, it would only be right as a matter of principle to divest the registered proprietor of a part of his statutory monopoly if one is satisfied that he ought to have to demonstrate confusion in fact, or at least be obliged to rely on section 10(2) ...

There is a balance to be held between the proprietor, other traders and the public having regard to the use which has in fact taken place.”

17. Similar sentiments were expressed by the General Court in Case T-126/03, *Reckitt Benckiser (España) SL v. OHIM* [2005] ECR II-2861 at paragraph 46 (see also

Mundipharma, para. 24, Joined Cases T-493/07, T-26/08 and T-27/08, *GlaxoSmithKline SPA v. OHIM*, 23 September 2009), para. 34)

“46. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

18. She also took me to the judgment of Jacob J. in *ANIMAL Trade Mark* [2004] FSR 383 where he said at paragraph 20:

“The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White’s brilliant and memorable example of a narrow specification) “three-holed razor blades imported from Venezuela” is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say “razor blades” or just “razors”. Thus the fair description is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (“the umbra”) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (“the penumbra”). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for one item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

19. Ms. Clark asked me to bear in mind that goods might have more than one purpose.

Fishing rods

20. The Hearing Officer's findings in relation to fishing rods were as follows (emphasis added):

“23. I find that there has been genuine use of rods, but that the use has been made in respect of certain types of rods only. Mr. Caulfield refers to EXTREME goods occupying a niche section of the overall fishing tackle market. The goods are frequently accompanied by descriptors such as beach, beachcaster, surf, uptide, downtide and boat. The 2000 Penn Fishing Tackle Europe catalogue states that EXTREME 2 rods are for beach anglers. The magazine extracts are from *Sea Angler*, indicating that sea fishing is a discrete type of fishing, with its own equipment and magazine publication. *Sea fishing with a course [sic] fishing rod may be the piscatorial equivalent of playing cricket with a badminton racket.*

[...]

27. ... In relation to rods, my examination of the evidence has informed me about the trade and led to my conclusion that sea fishing is a discrete area of fishing, with its own particular equipment and its own sector of the magazine market. There are specific rods for saltwater/sea fishing.”

21. Applying the category/sub-category approach set out by the General Court in *Reckitt Benckiser (ALADIN)*, the Hearing Officer concluded at paragraph 27:

“... I consider that the evidence demonstrates that ‘rods’ is a broad category within which it is possible to identify sub-categories, according to the type of fishing for which the rod is designed. ... I conclude that it is appropriate in this case to reduce the scope of the specification in relation to rods, which have been consistently represented as for use in sea fishing ...”

She then proceeded to redefine “fishing rods” in the specification as “rods for use in sea fishing and saltwater fishing” (paragraph 28).

22. Ms. Clark contended that the last sentence of paragraph 23 of the decision (highlighted above) was speculation on the Hearing Officer's part and might have caused her to misinterpret the evidence.
23. Turning to the evidence and in order to set the scene, Ms. Clark referred me to the Penn Fishing Tackle catalogue 2002/2003 (witness statement of David Caulfield, Penn's General Manager, dated 14 February 2008, exhibit P-2) which at page 46 spoke of fishing for “carp, pike, catfish etc plus tope and bass in saltwater”. Ms. Clark produced dictionary definitions (in the public domain) to show that at least carp and pike are freshwater fish. However to be fair to the Hearing Officer that was in the context of EXTREME reels where the Hearing Officer made no reduction.

24. Nevertheless, the same catalogue pronounced in relation to EXTREME V series rods:

- “Rods to suit all casting styles”
- “They have been carefully crafted and extensively tested to incorporate all the qualities needed to cover the many diverse beach situations and fishing styles around the British Isles”
- “One of the easiest rods you will find for the developing caster”
- “An extremely capable all round rod for the beach angler”
- “This archetypal ‘Bass’ rod is completely new and just waiting to search out our most popular fish in the surf from the rocks or in estuaries”
- “A true rock end rod, the Nor’easter completes the Extreme surf line up”.

Ms. Clark particularly emphasised the references to the EXTREME V series rods being all-rounders and for use in estuaries. As she pointed out, an estuary is the widening channel of a river where it nears the sea with a changing mix of freshwater and saltwater depending on the tidal flows.

25. Ms. Clark also took me to the 2000 Penn Fishing Tackle Europe Catalogue at P-2 which under the heading “Surf Rods” offered EXTREME 2 shore action rods and said:

“Extreme® 2 is a completely new series offering beach anglers a great range of rods at middle of the road prices that simply knuckle down and get on with the job ... excellent fishability ... For the angler looking to be a little more sporting from the beach ...”

Also advertised were Penn Extreme® 2 Match Rods - “ideal for the angler who enjoys pleasure fishing and perhaps dabbles in the local match circuit”.

26. Still in the 2000 Catalogue the section entitled “Boat Rods” read:

“Penn has been building quality boat rods for many years”.

It announced the introduction of a new range of downtide boat rods under the EXTREME brand. EXTREME®2 uptide boat rods were additionally featured with “the resilience to control and subdue large fish in comparatively shallow water” and “models to offer sport fishing throughout the British and European waters”. Ms. Clark observed that no distinction was drawn between freshwater and saltwater.

27. A *Wikipedia* entry for Recreational Boat Fishing exhibited to the witness statement of Anne Wong, dated 18 December 2010, at AW7 clearly contemplates boat fishing on rivers and lakes as well as at sea, and refers to the use of uptide and/or downtide rods for inshore (within easy sight of land and in water less than 30 metres deep) and offshore (deep sea or open water) boat fishing.

28. Ms. Clark then took me to other references to estuaries and all-rounders in Penn's evidence. Thus the *Sea Angler* magazine, March 2003, carried an advert for the EXTREME series with this description for the EXTREME VENGEANCE:

“This archetypal bass rod is completely new and different. 12ft long, powerful enough to control leads and fish in the surf, from the rocks or in estuaries.”

The *Sea Angler*, November 2004, contained a similar write up of the EXTREME VENGEANCE and the EXTREME VENOM MATCH was described as:

“[Replacing] the best selling Extreme Match [being] completely re-designed to be slimmer, lighter and even more user friendly. Super allrounders ...”.

29. Finally, Ms. Clark referred me to an extract from the Mullarkeys (Penn's stockist) price list 2006 (P-4) which listed several types of rod, including various models of EXTREME rods under the heading “Beach rods”. Ms. Clark's point was that the rods were all offered, advertised and marketed together. That supported her argument that the average consumer would fairly describe Penn's use as having been made in respect of fishing rods. Ms. Clark reinforced her point not only in relation to fishing rods but also in relation to fishing tackle by referring me to several print outs from the websites of fishing tackle retailers (Ms. Wong's witness statement, exhibits AW2 and AW3) which displayed similar practices.
30. I was persuaded that “rods for use in sea fishing and saltwater fishing” was not a fair specification in view of: (a) the evidence; and (b) the case law identified above. Accordingly, I informed Counsel that I intended to reinstate the specification to “fishing rods”. Penn had shown genuine use of EXTREME for various fishing rods including match rods, surf rods, beach rods, boat rods, uptide rods and downtide rods. I accepted Ms. Clark's submission that a test for infringement under section 10(1) on the one hand, or section 10(2) on the other hand, dependent on whether a rod was intended for use in saltwater or freshwater might prove difficult to apply in practice especially where a rod could be used for both purposes. In my judgment, the specification as reformulated by the Hearing Officer failed to achieve a just balance. The average consumer would not have chosen that description for trade mark purposes. Instead, they would have said “fishing rods”.

Fishing tackle

31. The Hearing Officer's finding was: “Fishing tackle is a very broad term and it would be contrary to the ratio legis to allow it to remain” (paragraph 27). The Hearing Officer appeared not to consider whether the genuine use that had been proven in respect of rods and reels – indubitably fishing tackle – justified in the public mind retention of the EXTREME registration for that wider term.
32. Penn had shown genuine use of EXTREME on various types of fishing rods. Penn's proven genuine use on reels similarly extended to a number of different types of reels. There was a suggestion in the evidence that EXTREME might have been used for bait but that was not pursued on appeal.

33. Ms. Clark said that the public would refer to fishing rods and reels, singly and collectively, as fishing tackle. Fishing tackle was a sufficiently narrowly defined category of goods. Allowing Penn to retain its registration for fishing tackle would not offend the objective of the non-use provisions, which was to reduce the number of conflicts between trade marks. The purpose and intended use of fishing tackle was the same – fishing. Fishing tackle was targeted at the same consumers and marketed through the same trade channels (AW2 and AW3).
34. Ms. Wong had exhibited to her witness statement a decision of the Cancellation Division of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) issued on 11 December 2008 under reference number 2533C, which concerned a contemporaneous application by Fox to revoke for non-use Penn’s Community trade mark registration for EXTREME (AW9). On comparable evidence, the Cancellation Division found that Penn had established genuine use in respect of fishing rods and reels. Such uses enabled Penn to retain its CTM registration for fishing tackle, which the Cancellation Division viewed as comprising a single group of products (paragraphs 24 to 27).
35. The Hearing Officer rightly said that she was not bound to follow the decision of the Cancellation Division. However, that is not to say it should be ignored especially since the case involved essentially the same facts (*ZURICH PRIVATE BANKING*, BL O/201/04).
36. Ms. Clark also relied on the decision in *ANIMAL* where Jacob J. refused to cut down a specification for clothing although he recognised that certain subcategories of products like diving suits and wetsuits would fall within that term even though no use had been shown. On the other hand, the judge limited footwear to casual footwear and headgear to the three types of hats for which genuine use had been established.
37. I note the observations of Mr. Arnold QC sitting as the Appointed Person in *EXTREME* that to the extent there is an unresolved difference between the CTM and English authorities, in applying the latter I should adopt the more generous approach favoured by Jacob J. in *ANIMAL*. That led Mr. Arnold to decide that proven genuine use on holdalls sufficed to maintain a registration for luggage.
38. Ms. Clark confirmed that her client did not wish a reference to the Court of Justice of the European Union .
39. I have not found the appeal on this point easy to determine. Nonetheless in my judgment, Penn’s specification for fishing tackle should be maintained. I reached that conclusion after a careful review of the evidence, arguments on appeal and case law to date. “Fishing tackle” represents in my view a fair description of the uses that have taken place.
40. The original registration in suit was in respect of:

Fishing tackle, fishing rods, reels and lines.

My decision has the effect that “lines” would already be covered despite express mention. I, therefore, see no point in removing them from the specification. Such is

the effect anyway of allowing a specification wider than actual use. Applying the test of Pumfrey J., the public would confirm that a likelihood of confusion should be presumed in the case of fishing lines.

Conclusion

41. In the event, the appeal succeeds. Registration number 2115051 should remain on the register for: Fishing tackle, fishing rods, reels and lines.
42. Penn is entitled to contributions towards its costs at first instance and on appeal. I will order Fox to pay Penn the sum of £1,400 in respect of the proceedings below and an additional £600 towards the costs of this appeal.

Professor Ruth Annand, 30 June 2010

Ms. Fiona Clark of Counsel instructed by Carpmaels & Ransford appeared on behalf of the Registered Proprietor/Appellant

The Applicant/Respondent did not attend and was not represented