

O-218-06

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 1339042 IN THE NAME OF
ADDICTION LIMITED**

AND

**IN THE MATTER OF AN APPLICATION FOR REVOCATION ON THE
GROUNDS OF NON-USE UNDER NO. 81983 BY BROOKS SPORTS INC**

TRADE MARKS ACT 1994

IN THE MATTER OF registration No. 1339042 in the name of Addiction Ltd and in the matter of an application for revocation on the grounds of non-use under No. 81983 by Brooks Sports Inc

Background

1. Registration No. 1339042 for the trade mark ADDICTION was registered with effect from 21 March 1988 and currently stands in the name of Addiction Ltd. It is registered in respect of the following specification of goods:

Underwear; sleeping garments; pyjamas, robes; knitted articles of clothing and articles of clothing made from knitted materials; shirts, tee-shirts; beachwear, socks, trousers; neckwear; scarves, ties, cravats; swimwear; articles of sports clothing; shorts, briefs and leotards; all included in Class 25.

2. On 21 December 2004, Field Fisher Waterhouse acting on behalf of Brooks Sports Inc filed an application for revocation of the registration. The application requests revocation of the registration under sections 46(1)(a) and (b) of the Act claiming that no use was made of the trade mark between 19 February 1990 and 19 February 1995. In the alternative it claims that no use was made of the trade mark between 10 July 1998 and 10 July 2003 and/or between 21 December 1999 and 21 December 2004.

3. Roiter Zucker on behalf of the registered proprietor filed a counter-statement along with evidence of use of the mark essentially denying all the claims made. It indicated that use of the trade mark in the UK commenced in 1984 in relation to goods in class 25 and that it has been used continuously since that date.

4. The applicant did not file any evidence, despite requesting and being granted an extension of the statutory period allowed for so doing. Neither party requested a hearing but both filed written submissions which I take into account. Both parties request an award of costs.

Registered proprietor's evidence

5. This consists of a witness statement of Edward David Woolf dated 5 May 2005. Mr Woolf says he is a director of Addiction Ltd, the registered proprietor, a position he has held since 1992.

6. Mr Woolf confirms that his company has sold goods falling within the class 25 specification under the trade mark throughout the UK. He states that the trade mark was first used in the UK in 1984 in relation to goods within class 25 and has been used continuously since that date.

7. Mr Woolf gives details of sales made under the trade mark as follows:

| Year | £ UK | Year | £ UK |
|------|------|------|------|
| 2004 | 2m | 1996 | 2.6m |
| 2003 | 1.8m | 1995 | 2.5m |
| 2002 | 3.1m | 1994 | 1.9m |
| 2001 | 3.2m | 1993 | 3.2m |
| 2000 | 2m | 1992 | 1.6m |
| 1999 | 1.9m | 1991 | 0.8m |
| 1998 | 1.7m | 1990 | 1.2m |
| 1997 | 2m | | |

8. Mr Woolf states that the trade mark has been used on ties, underwear, sleepwear, socks, t-shirts, shorts, waistcoats and sweatshirts. He says some of these have been sold with labels bearing the trade mark, some with swing-tags. He describes the other garments as having been “sold and marketed under the ADDICTION Trade Mark generally”.

9. Attached to Mr Woolf’s witness statement are a number of exhibits, as follows:

- Exhibit A-sample invoices, delivery notes and a credit note. Unlike the invoices, none of the delivery and credit notes date to within any of the relevant periods.
- Exhibit B-photograph of sample underwear with a related invoice.
- Exhibit C-photographs of sample underwear and related invoices.
- Exhibit D-photographs from trade shows. These are said to have been taken in September and October 2004.

10. That completes my summary of the evidence filed in these proceedings.

Decision

11. Applications for revocation of a registered trade mark are provided for under Section 46 of the Act. This 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) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
- (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes 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 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 either 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.”

12. Section 100 is also relevant and reads:

“100. 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.”

13. The ECJ considered the meaning of genuine use in *Ansul BV and Ajax Brandbeveiliging BV (Minimax)* [2003] RPC 40. It said:

“36 “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that “genuine use” of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Art. 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is 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.”

14. As part of its evidence the registered proprietor has filed at exhibit A numerous invoices. All of them are on printed stationery and bear the word ADDICTION at the top left hand side placed above what appears to me to be a small shaped underlining. In its written submissions the applicant contends that this is merely use of the registered proprietor’s company name and cannot therefore constitute genuine use of the trade mark. In light of the evidence filed, I see no merit in this contention. Whilst registration of a company name has an entirely separate form and function to the registration of a trade mark, it is not unusual for companies to use and/or register part or all of their names as trade marks. The invoices make reference to the company name, Addiction Ltd, elsewhere on them and I can see no reasons to doubt that the use of ADDICTION as it appears at the top left hand side of the invoices is use of the word as a trade mark.

15. In addition to the above, the registered proprietor has filed evidence (exhibits B and C) in the form of photographs intended to show use of ADDICTION on swing tickets and neck labels. The applicant contends that as the photographs post-date the relevant dates in these proceedings they should be discounted. With some of the photographs Mr Woolf exhibits what he refers to as a “related invoice” from within a relevant period. He also states that goods were sold with identical or similar swing-tags. Whilst I agree the photographs are dated as having been taken on 22 May 2005, and therefore after the relevant dates, I see no reason to doubt Mr Woolf’s claim and that the photographs merely exemplify how the mark was used on goods sold during the relevant periods.

16. I therefore go on to consider whether the use of the trade mark as shown in the evidence constitutes genuine use. I have no doubt that it does, within the meaning of the guidance given in *Ansul*. The invoices forming exhibit A which bear the trade mark refer to numerous sales to a number of retailers throughout the UK. The use is not internal. The invoices show a value of sales ranging from less than two hundred to more than fifty five thousand pounds, with the vast majority of them being for five figure sums. The use is not token. The sales confirm that the purpose of the use has been to create and sustain a market.

17. The question to be considered is whether use has been shown in relation to the goods covered by the registration. Although in its counter-statement the registered proprietor claims to have used the trade mark in relation to goods falling within the class 25 specification of goods, they do not claim specifically to have used it in relation to all the goods covered by the specification. Having reviewed the evidence, in some detail, I do not consider that use is proven in relation to all the goods covered by the registration. This position is supported by Mr Woolf’s evidence. As I set out above, in his witness statement he sets out a list of goods on which he claims the trade mark has been used. I therefore go on to consider on which goods use has been shown.

18. For convenience, I set out below the specification of goods as registered and the specification of goods for which use is claimed by Mr Woolf.

| Specification as registered | Use claimed |
|--|---|
| Underwear; sleeping garments; pyjamas, robes; knitted articles of clothing and articles of clothing made from knitted materials; shirts, tee-shirts; beachwear, socks, trousers; neckwear; scarves, ties, cravats; swimwear; articles of sports clothing; shorts, briefs and leotards; all included in Class 25. | Ties, underwear, sleepwear, socks, t-shirts, shorts, waistcoats, sweatshirts. |

19. The application for revocation was made in relation to three separate periods as set out in paragraph 2 above. There are invoices dated from within each of the relevant periods, although perhaps understandably, rather more from the latter periods than the earlier one. The invoices forming exhibit A show sales of a variety of

garments. These are described as “boxers” “boxer shorts”, “t/shorts sleepsets”, “trunks”, “socks”, “ties”, and “t-shirts”. In light of the evidence I consider that the registered proprietor has not shown use in relation to the following goods:

Robes, shirts, beachwear, trousers, neckwear, scarves, cravats, swimwear, articles of sports clothing, leotards

and it seems to me that the application is successful in respect of these goods.

20. In accordance with section 46(5) of the Act, the registration will be revoked in respect of the goods for which the registered proprietor has failed to show use. And in accordance with the provisions of section 46(6)(b) that revocation will take effect from the earliest of the three dates relied on by the applicant, namely 19 February 1995. The remaining specification of goods will therefore read:

“Underwear; sleeping garments; pyjamas; knitted articles of clothing and articles of clothing made from knitted materials; tee-shirts; socks, ties; shorts, briefs; all included in Class 25”.

Costs

21. The applicant pleaded its case on the basis that it was seeking removal of the registration in respect of the whole of the specification of goods or alternatively in respect of that part of it for which it is shown that grounds for revocation exist. It gave no further detail or substance to this latter part of its claim and did not file any evidence in support of any of its claims. For its part, whilst it did not claim to have used the mark on all goods covered by the registration, the registered proprietor did not seek to partially surrender the registration. It seems to me that both parties have achieved a measure of success. In view of this, I make no award of costs.

Dated this 2nd day of August 2006

**Ann Corbett
For the Registrar
The Comptroller-General**