

O/266/12

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 1450973
IN THE NAME OF RODI BEHEER B.V.

AND

AN APPLICATION UNDER NO 84011
FOR REVOCATION THEREOF
BY TRS MOTORSPORT TECHNOLOGY LTD

TRADE MARKS ACT 1994

IN THE MATTER OF registration No 1450973
in the name of Rodi Beheer B.V. and
an application under No 84011 for
revocation thereof by TRS Motorsport
Technology Ltd

Background

1.Registration No 1450973 stands in the name of Rodi Beheer B V (“RB”) and is for the trade mark JAMEX. The trade mark completed its registration process on 25 October 1991. It is registered for the following goods:

Shock absorbers, suspension units, suspension struts, coil springs, torsion bars; mountings, brackets; parts and fittings for all the aforesaid goods; all included in class 12.

2. On 9 March 2011, TRS Motorsport Technology Ltd (“TRS”) filed, on Form TM26(N), an application seeking to revoke the registration in its entirety. The application for revocation of the registration is made under grounds based on section 46(1)(b) of the Act. TRS claims that there has been no use of the mark in the relevant periods (see later in this decision) in relation to the above goods and that there are no proper reasons for its non-use.

3. RB filed a counter-statement denying the claims made and indicating that the mark has been used throughout the relevant periods on goods and promotional material sold and used in the UK.

4. Only RB filed evidence and provided written submissions. Neither party requested to be heard. I give this decision after a careful review of all the written material before me.

Decision

5. Revocation of a registration is provided for under section 46(1) of the Act which reads:

“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 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.”

6. Section 100 of the Act is also relevant, this 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.”

7. TRS seeks revocation of the registration from either 3 December 2004 or, in the alternative, 3 December 2009. The relevant periods within which RB must show genuine use of the mark (or proper reasons for its non-use) are, therefore, 3 December 1999 to 2 December 2004 or 3 December 2004 to 2 December 2009.

The evidence

8. RB's evidence takes the form of a witness statement, dated 15 August 2011, by Leon Rodi, who states he is Company Director of both RB and Marvex BV. He states he has also been a Director of Blok Beheer BV and Jamex BV, each of which were subsidiaries of RB and were using its JAMEX brand under a licence. Mr Beheer states he is also a Director of Jamex BVBA.

9. Mr Rodi states as follows:

“4. I first became involved with the JAMEX brand in 1996 when my company, Rodi Beheer B.V. purchased Blok Beheer B.V, which owned the rights to the brand including the Registration.

5. In 1998, I assigned the mark to Rodi Beheer B.V. as I wanted to keep all the Trade Marks in the same company. Between 1996 and 2000, the businesses supplied Sportsprings Limited in the UK on an exclusive basis with JAMEX branded car suspension parts through Jamex B.V. a wholly owned subsidiary of Rodi Beheer B.V.

6. Unfortunately in 1999, Jamex B.V. went into receivership. The ING bank, who had had a charge over some Trade Marks owned by Jamex B.V., sold the companies Trade Marks, which included a Benelux Trade Mark for the „Jamex’ mark which had been vested in this particular company. They also purported to sell the rights in the brand in the UK and other jurisdictions.

7. What followed was a lengthy, protracted and expensive legal battle. Jamex B.V., although it had acted as the vehicle for sales of products sold under the „Jamex’ brand in the UK, it had also done so under licence and had never owned the Registration or the goodwill in the brand, which had historically been vested in Blok Beheer B.V. and then in Rodi Beheer B.V in 1998.

8. The receivers sold these rights to a company named Tevema. My company was therefore participating in disputes with both Tevema and the ING bank to try to assert ownership over the „Jamex’ brand internationally. In 2004, Tevema went into receivership itself, and I was able to settle the dispute with its receivers, who transferred the Benelux Trade Mark back to the Businesses and agreed to drop its claim that it owned any rights in the brand.

9. Sales of products sold under the Jamex brand were resumed in 2005 through another wholly owned subsidiary of Rodi Beheer B.V., Marvex B.V. Marvex B.V. made its first sales of Jamex branded goods including car suspension parts featuring the registration in 2005.”

10. Mr Rodi states that in 2008, Jamex BVBA took over the licence of sales under the brand until 2010 when an agreement was reached between Marvex BV and a third party distributor, J S Raid Ltd, to distribute products in the UK. He states that products under the mark are “now” sold in the UK by Jamex Professional Ltd, a company set up by the Directors of J S Raid Ltd. At LR1 he exhibits details taken from the Companies House website which shows Jamex Professional Ltd to have been incorporated on 27 January 2011.

11. Mr Rodi states that the mark has been used on all goods for which it is registered as well as on other goods. He states that between 3 December 1999 and 2 December 2004 “over £19,917 of Relevant Goods featuring the Registration were delivered to Customers in the UK”. He exhibits copies of various invoices at LR2. There are 6 invoices, all addressed to Sportsprings Ltd in the UK. All are on JAMEX headed paper and they show:

Invoice No	Date	Payment Due	Details
13101	3.11.99	2.1.00	25 Jamex Sportsprings for a variety of motor vehicle makes and 3 Jamex Sportsline for Ford
13102	3.11.99	2.1.00	800 Jamex Sportsprings Box
13018	28.10.99	27.12.99	68 Jamex Shockabsorbers
13019	28.10.99	27.12.99	160 Jamex Shockabsorbers
13020	28.10.99	27.12.99	50 Sport Shockabsorbers (Audi) and 13 (Ford)
12807	14.10.99	13.12.99	220 Sportspring (Rover)

Although the dates of these invoices are before the first relevant period, I note that the due date for payment of them is within it.

12. Mr Rodi states that between 3 December 2004 and 2 December 2009, sales of “Relevant Goods to be delivered in the UK totalled a further €8820.92”. At LR3, he exhibits further copy invoices. All but the first are on Jamex headed paper (the first is identically laid out but is on Marvex headed paper). They show:

Invoice No	Date	Customer address	Details
12026	27.10.05	Portadown, N Ireland	34 Jamex Sportsprings for a variety of vehicle makes
54640	31.11.08	Farnham, Surrey	1 Jamex Xtreme (Fiat)
54631	24.11.08	Farnham, Surrey	2 Jamex Xtreme (BMW)
54625	20.11.08	Farnham, Surrey	1 Jamex Xtreme (Ford) 1 Jamex Xtreme (Renault)
54610	17.11.08	Farnham, Surrey	1 Jamex Xtreme (Seat), 1 Jamex Xtreme (Fiat) 2 Jamex Stabiliser connection bolt
54601	31.10.08	Farnham, Surrey	1 Jamex Xtreme (Citroen) and 2 Jamex stabiliser connection bolts
54559	17.10.08	Farnham, Surrey	2 Jamex Xtreme (1 x Seat and 1 x Honda)
54544	9.10.08	Farnham, Surrey	1 Jamex Xtreme (Seat) and 2 Jamex Stabiliser connection bolt
54495	18.9.08	Farnham, Surrey	1 Jamex Xtreme (Opel)

54483	15.9.08	Farnham, Surrey	4 Jamex Xtreme (Fiat, Seat, VW, Citroen) and 2 Jamex Stabiliser connection bolts
54459	5.9.08	Farnham, Surrey	2 Jamex Xtreme (Opel/Seat)
54442	29.8.08	Farnham, Surrey	4 Jamex Xtreme (Fiat, VW, Audi)
54431	25.8.08	Farnham, Surrey	1 Jamex Xtreme (BMW)
54450	29.8.08	Cleckheaton, West Yorks	1 Jamex Sportsprings (Alfa)
54437	25.8.08	Cleckheaton, West Yorks	2 Jamex Xtreme
54363	14.7.08	Cleckheaton, West Yorks	1 Jamex Xtreme (Renault)

13. At LR4, Mr Rodi exhibits a table produced by his then legal representatives setting out the relevant details of the above invoices.

14. Mr Rodi states that significant sums were invested in marketing the Jamex brand during the relevant periods and states that marketing catalogues were distributed in the UK between 2000 and 2006 though he gives no details of the amounts involved. At LR5 he exhibits examples of this material. There are 15 pages in the exhibit (pages 41 to 55). Because of the poor quality of the photocopying, it is not possible for me to see what is on every page though pages 43 and 44 simply have pictures of a woman in a state of undress and page 55 is completely blank. Page 41 bears a slightly stylised version of the word JAMEX on what could be the front cover of a catalogue though it bears no other identifiers and is not dated. Page 42 appears to consist of some sort of list though I cannot read what is actually written. Page 45 consists of an index, which, under the heading „suspension’ lists the words „sportsprings’ and „sportsline’. Page 49 appears to be the front cover of the 2004-2005 JAMEX catalogue with page 50 showing an index of goods. Page 52 appears to be the front cover of the 2006 JAMEX catalogue. Page 53 depicts various car parts including Sportspring coils and X-Treme shock absorbers along with other related parts. The remaining pages of the exhibit show unaddressed letters dated May 2003, September 2004 and March 2006. The letters are in the form of a covering letter introducing customers to the latest JAMEX catalogue. Mr Rodi gives no information of how many such catalogues were distributed nor does he state to whom they were issued.

15. Mr Rodi states that a number of websites and domain names were registered between 1999 and 2009 which include www.jamex.co.uk and www.jamex.com. At LR6 he exhibits printouts taken from the WHOIS database giving details of these domain names. They show jamex.co.uk to have been registered on 14 July 2006 and jamex.com to have been created on 13 May 2002.

16. Mr Rodi states that while sales suffered during some periods due to the legal dispute in which he was involved, by continuing to distribute marketing materials in the UK and setting up websites, he was making efforts to maintain a market share. He concludes by stating that at the time the application for revocation was made, he had resumed a steady and constant trade under the brand in the UK for 9 months, having put the mechanisms in place to do so 12 months earlier. At LR7 he exhibits another group of invoices. All are dated after the relevant periods.

17. That concludes my summary of the evidence filed to the extent that I consider it necessary.

18. The leading authorities on the principles to be applied in determining whether there has been genuine use of a trade mark are: *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. The general principles were summarised by the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd (Sant Ambroeus Trade Mark)* [2010] RPC 28 as follows:

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

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

19. In relation to determining what constitutes a fair specification, I must keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the *Premier Brands* case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say *Cox's Orange Pippins*, should the registration be for fruit, apples, eating apples, or *Cox's Orange Pippins*?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

20. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“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 threeholed 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 just one specific 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.”

21. Finally, the following comments of the General Court in *Reckitt Benckiser (España), SL v OHIM*, Case T- 126/03 are also relevant:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

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.”

22. The evidence of use filed is not particularly extensive, however, in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06, the GC stated:

“32 To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned in order to maintain or create a share in the market for the goods or services protected by the mark (*VITAFRUIT*, paragraph 27 above, paragraph 42, and *LA MER*, paragraph 26 above, paragraph 57; see, by analogy, *Ansul*, paragraph 24 above, paragraph 39, and the order in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 21).”

23. There is, therefore, no de minimis level of use to establish genuine use (also see inter alia *Sonia Rykiel création et diffusion de modèles v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-131/06 and *The Sunrider Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-416/04 P). In *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 the Court of Justice of the European Union (CJEU) held that it is necessary to establish whether the 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, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark”. In *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-234/06 P the CJEU stated:

“73 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The frequency or regularity of the use of the trade mark is one of the factors which may be taken into account (see *Sunrider v OHIM*, paragraph 71; see also, to that effect, *La Mer Technology*, paragraph 22).”

24. Mr Rodi has provided evidence of sales under the mark JAMEX in respect of (Xtreme) shock absorber units between August and November 2008, (Sportspring and Sportline) coils and suspension units in August 2005 and August 2008 as well as connection bolts between September and November 2008. Catalogues are said to have been distributed in the UK each year from 2000 to 2006. Sales figures for the relevant goods have been given for both relevant periods.

25. TRS has not challenged the evidence nor, indeed has it commented on it in any way. The evidence of use is not extensive. Whilst the invoices provided do not specify the particular goods sold, cross referencing them to the catalogues indicates them to be (parts of) suspension units. Whilst RB may not have shown separate and specific use in relation to each particular item as is included within the specification of the registration, all of those goods are ones which make up or allow for the fitting of a vehicle's suspension and are not, in essence, different from the goods for which use has been shown. They belong to a group which cannot be divided other than in an arbitrary matter. In my view, and absent any evidence to the contrary, the use which RB has shown is genuine and is sufficient to fend off the attack against it in relation to all the goods for which it registered.

Summary

26. The application for revocation fails in its entirety.

Costs

27. The application having failed, RB is entitled to an award of costs in its favour. I take into account the fact that other than filing the initial application and later requesting a stay, TRS took no active part in the proceedings. I also take note that only RB filed evidence and submissions and that it was professionally represented up to the time the matter was ready to be determined. I make the award on the following basis:

Preparation of a statement and considering other side's statement:	£300
Preparing evidence:	£500
Preparing written submissions:	£300
Total:	£1100

28. I order TRS Motorsport Technology Limited to pay Rodi Beheer BV the sum of £1,100. This sum is 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 9th day of July 2012

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