

O-351-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 82016
BY BIBA + PARISCOP DAUD GMBH
FOR REVOCATION OF TRADE MARK NO. 1035953
IN THE NAME OF HACHEL INTERNATIONAL FOUNDATION**

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**IN THE MATTER OF Application No. 82016
in the name of BIBA + Pariscop Daub GmbH
For revocation of trade mark No. 1035953
in the name of Hachel International Foundation**

BACKGROUND

1. Trade mark No. 1035953 is registered in Class 25 in respect of the following range of goods:

Articles of clothing for women and girls, but not including any such goods for export to Africa.

2. The trade mark is as follows:



3. The trade mark is registered in the name of Hachel International Foundation.

4. By an application dated 20 January 2005, BIBA + Parscop Daub GmbH applied for the registration to be revoked under the provisions of Section 46(1)(b) of the Act, on the basis that the trade mark has not been put into genuine use, specifically, in the five years immediately preceding the filing of the action, or in the five years preceding 21 August 2003, in relation to the goods for which it is registered, either by the registered proprietors or with their consent, and there are no proper reasons for non-use.

5. In a Counterstatement filed on 9 May 2005, the registered proprietors claim that the mark has been used.

6. Both sides ask that an award of costs be made in their favour.

7. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. Neither party took up the offer of an oral hearing, so after a careful study of the papers and the written submissions I give my decision.

Registered proprietor's evidence Rule 31(3)

8. This consists of a Witness Statement dated 5 May 2005, from Carmel Levy, President of the Board of Hachel International Foundation, and Biba Corporation of America. Mr Levy confirms he has full access to the books and records of his company.

9. Mr Levy states that the name BIBA was first used in October 1964 when Barbara Hulanicki, one of the originators of the name, opened a shop in London. He recounts that in April 1966, Time magazine crowned London as "The City of the Decade", citing BIBA as "'The most in shop" for girls". Mr Levy recounts that in 1971, BIBA opened a boutique in New York, concessions in stores in Paris, Milan and Tokyo, and BIBA cosmetics went on sale in more than 300 Dorothy Perkins stores throughout the UK. Dorothy Perkins was a major shareholder in BIBA. In 1973 BIBA was bought by British Land and shortly after closed, although Dorothy Perkins continued to sell BIBA cosmetics. There is no evidence to corroborate either the date of opening of the shop, the claimed accolade from Time magazine, or the sales by Dorothy Perkins.

10. Mr Levy goes on to say that in 1977 his company purchased all rights in the BIBA name, in 1978 opening a store in London selling BIBA branded clothes, cosmetics, fashion items and jewellery. The store remained open for around two years. He goes on to make various claims, such as to the "iconic" status of the BIBA name, referring to a book entitled "BIBA: The BIBA Experience" published in 2004 to mark the 40th anniversary of the BIBA shop. Mr Levy does not exhibit a copy of the book.

11. Mr Levy states that his company has licensed third parties to manufacture and sell BIBA branded goods on their behalf, naming in particular Ecker Investments Limited, who, between 1994 and 1999 operated a BIBA shop in London selling articles of clothing, footwear, headgear, jewellery and cosmetics, and at some unspecified time, operated a concession in Selfridges selling articles of clothing, cosmetics and bags. Exhibit CL1 and CL2 are stated to consist of photographs of the store and the concession, respectively. The photographs show shop signage (both internal and external) bearing the BIBA name in conjunction with an "art-deco" style device, and also this device on its own. The photographs of the interiors show BIBA being used specifically in relation to cosmetics, but also that clothing was available for purchase. Some of the photographs are marked "97 9 19", seemingly recorded by the camera. I take these numerals to represent the date 19 September 1997, which is presumably when the photographs were taken.

12. Exhibit CL3 consists of photographs of BIBA branded products, namely, cosmetics, footwear, a jar of whole chillies, a handbag and a newspaper with the title BIBA, and a headline "Welcome to the new BIBA". The photographs show the BIBA name with various graphical elements, including the "art-deco" style design, and other similarly styled images that are more likely to be taken as decoration rather than part of the brand. But as with the other photographs, in all but one case there is nothing by which to date them. The exception is the photograph of the handbag, which shows the date 31/03/2005, this seeming to have been recorded by the camera, and is presumably the date on which the photograph was taken. The BIBA name can just be made out on the clasp of the bag.

13. Exhibit CL4 consists of various advertisements and features relating to BIBA clothing and cosmetics. Many do not indicate the date from which they originate or even the publication in which they appeared. Of those that do, three show use of BIBA in magazines/newspapers available in the UK in August 1997 and April 1999, both in relation to cosmetics. The products bear the BIBA name and “art-deco” device, the accompanying text simply referring to BIBA. The remaining parts of the exhibit consists of features that refer to the establishment of the BIBA name in the 1960s and 1970s, relating to the re-launch of the brand described as a “fashion leader”, in connection with a range of cosmetics, but as the article cannot be dated, it is not possible to pinpoint when this re-launch was taking place. Another article, marked as being from the August 1996 edition of Company magazine also announces the re-launch of BIBA branded clothing.

14. Mr Levy goes on to refer to Exhibit CL5, which consists of a delivery note and invoice relating to sales made by Selfridges; there is no mention of BIBA on either document. He goes on to refer to sales of BIBA and BIBA and device branded footwear made through Grattans 1999 Autumn/Winter catalogue. Exhibit CL6 is said to be a copy of an invoice showing total sales to Grattan of nearly £12,000 in the period July 1999 to February 2000. The invoice is dated 30 April 1999, raised by Christopher Joseph of Melian Agencies who Mr Levy says had been helping as a distributor, to Grattan plc, and is endorsed “paid 4/6/99”. The invoice mentions goods by the codes BIBA01, BIBA02, etc, and although not specifying the type of goods, from references such as “Cost £24.05 x 170 pairs...” it seems likely that it is footwear. Exhibit CL4 contains two pages marked as being from the Grattan catalogue which shows, amongst other things, BIBA footwear, BIBA being shown with the “art-deco” device, and also on its own in the descriptive text, but there is nothing such as corresponding code numbers by which to tie the goods in the catalogue to those listed on the invoice.

15. Mr Levy says that Christopher Joseph assisted with further sales of BIBA footwear through TK Maxx stores in Bristol, Reading, Hatfield, Woking, Croydon, Plymouth, Slough, Cheltenham, Ealing, Bedford and St Albans. Exhibit CL7 includes photographs of the shoes said to have been sold by TK Maxx. These show the BIBA and “art-deco” device on the upper sole. The exhibit also includes an order form from TK Maxx, for goods stated to be the BIBA label to be supplied by Brocade. The order form, numbered 0431048, bears the dates 19 July 2004, and the 15 and 30 August 2004 although due to poor copying I am not able to determine their significance. The order form uses descriptions for goods such as “Purple brooch trim ank” followed by the numerals “37, 38, 39 40” with the numbers “2,4,4,2” placed below. To me the figures appear to be shoe sizes and the quantity ordered. That these goods are items of footwear can be seen from the packing list and commercial invoices. These date from September and October 2004, show Brocade Shoes Limited as the agent, and contain product descriptions such as “40 cartons containing 480 pairs of ladies leather sandals, as follows:”. Although not stated as being BIBA branded, the packing lists/invoices state that they relate to order 431048 (the same as the TK Maxx order), and use the same style code numbers for the goods as those shown on the TK Maxx order. Taken together I consider it to be reasonable to infer that all documentation forming CL7 relates to BIBA branded footwear.

16. Mr Levy says that since 2000, products namely, clothing, jewellery, cosmetics, handbags and bags, have been sold under the BIBA and BIBA/Device brand in the UK via a mail-order service. Exhibit CL8 consists of a collection of invoices dating from 12 May 1999 through to July 2004, that are stated to be sales from mail order. These show the BIBA and “art-deco” device mark on the heading, and the name BIBA in the contact details on the footer, but apart from this there is nothing that shows the goods to have been sold as BIBA branded goods. In all but three cases the customer addresses have been blanked out although a number bear the statement “special instructions: sent to the London address noted”. The three that have the addresses included are also in London. Mr Levy goes on to say that the photographs forming Exhibit CL9 show some of the products itemised on the invoices in Exhibit CL8. Whilst these goods are listed on the invoices, and bear the BIBA and BIBA “art-deco” device marks, there is nothing such as product code numbers that links them to the invoices, or that enables me to place them in time.

17. Mr Levy concludes his Statement by stating that the BIBA brand continues to be used, and has at no time been abandoned.

Applicants’ evidence Rule 31A(1)

18. This consists of a Witness Statement dated 24 August 2005, from Jochen Halfmann, Managing Director of BiBA + Pariscop Daub GmbH, a position he has held since May 1999. Much of Mr Halfmann’s Statement consists of submissions on the evidence filed by Mr Levy. Where relevant facts are given I will summarise them, but otherwise I will note the submissions and take them into account in my determination of this case.

19. Mr Halfmann gives his views on the currency of the BIBA trade mark, describing it as an “antique” brand. He refers to Exhibit JH1, which consists of the book “BIBA: The BIBA Experience” referred to by Mr Levy. Mr Halfmann highlights comments such as “near mythical near history” as supporting his “antique” contentions. The extract also contains references such as “traces of the BIBA experience have survived”, “women who went there will never forget it...”, “children who grew up in BIBA nappies...have had the story of this extraordinary store passed on to them...” and the “hundreds of young women who were-and are still being-named BIBA bear testimony to its lasting impact”.

20. Mr Halfmann recounts that his company conducted investigations via YELL.Com to find out the addresses of the BIBA shops in Covent Garden and Conduit Street, London, referred to by Mr Levy. Exhibit JH2 consists of screen prints from the YELL.Com website taken on 12 August 2005. The results do not show an entry for any BIBA clothing shops, but there is one for a vintage clothes shop named “Biba Lives Vintage Clothing”.

21. Exhibit JH3 consists of an extract from the BBC London website also taken on the 12 August 2005, stating that it was last updated on 6 June 2005. The story entitled “Biba 40 Years On” relates to the rise and fall of the brand, culminating with the closure of its shops in 1975.

22. Mr Halfmann goes to Mr Levy's statement regarding the availability of BIBA branded goods via a mail-order service, and to the operation of a concession in Selfridges. He says that his company search for the mail-order operation failed to find any mention of this on the Internet. The results of the search are shown as Exhibit JH4. Whilst there does not appear to be a specific website for the registered proprietors, this could well be because the search was restricted to the UK. Notwithstanding this, there are mentions of "This new era of Biba saw the introduction of the peripheral merchandise that was to become...An upmarket re-launch of the mail-order catalogue offering...", several references to "Tips about Biba Blusher on the web... Browse our online catalogue and buy online today", the date being given as 27 July 2000, and a reference from eBay UK "Bargain Biba catalogue – Great prices on vintage clothing..". The results of the search for information relating to the Selfridges concession are at Exhibit JH5, and show that a search of the Selfridge website on 23 August 2005 found no use.

23. Mr Halfmann concludes his Statement by introducing Exhibit JH6, which consists of the results of an Internet search of UK web pages based on the search BIBA + clothing. Whilst the search did not bring up a site from which BIBA clothes could be purchased, the results are akin to those mentioned in relation to Exhibit JH4, with 40th Anniversary stories on the BBC and in the Telegraph showing there to be a current interest and awareness in BIBA clothing.

Registered proprietors' evidence Rule 31(A)(4)(a)

24. This consists of a Witness Statement dated 28 November 2005, from Helen Cawley, an Associate with D Young & Co, the registered proprietors' representatives in these proceedings. At Exhibits HJC1 to HJC8, Ms Cawley provides a collection of invoices dating from the period February 2000 to October 2004. Whilst these show the BIBA and "art-deco" device on the header, and the name BIBA in the contact details in the footer, there is nothing that links them to a sale of goods to persons in or from the UK. Exhibit HJC9 consists of a report from FT.com taken on 28 November 2005, which outlines the history of the brand and its originator, Barbara Hulanicki. Ms Cawley highlights the reference to the introduction of a new line of clothing and cosmetics, and to Ms Hulanicki having reinvented herself as a successful interior designer, but as it also states that she had lost the BIBA name, presumably not using that brand. There is a mention that the Textile Museum is planning a retrospective involving BIBA. Exhibit HJC10 consists of a printout from the website of Biba International Limited, a licensee of Hachel International Foundation. The only reference to dates is a mention of the "21st Century re-launch of BIBA" and various clothing and clothing accessory collections in 2006.

Applicants' evidence in reply Rule 31(A)(5)

25. This consists of a Witness Statement dated 17 March 2006, from Aiden Clarke, a partner of Marks & Clerk, the applicants' representatives in these proceedings. Much of Mr Clarke's Statement consists of submissions of the evidential value of the exhibits provided with Ms Cawley's Witness Statement. Whilst I do not consider it appropriate or necessary to summarise these submissions, I will, of course, take them fully into account in my determination of this case. Mr Clarke does provide evidence

at AVC1, which shows the Biba International Limited domain name was registered on 3 May 2005. The exhibit contains the reference:

“Biba is back. One of the most exciting and innovative names in British fashion will be relaunching in 2006. Includes shoes, handbags, clothing, fragrance, cosmetics, jewellery and eyewear.”

26. Mr Clarke notes the absence of any information such as a license agreement.

27. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

28. The relevant statutory provision in relation to an application for a revocation of a registered trade mark can be found in Section 46, which are as follows:

“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 case the application is made to the registrar, he may at any stage of the proceedings refer to 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."

29. Under the provisions of Section 100 of the Act, the onus of showing that the mark in question has been used within the relevant period, or that there are proper reasons for non-use, rests with the registered proprietors. Section 100 of the Act reads as follows:

"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."

30. The onus placed upon the registered proprietor is to "show" what use has been made of the mark, which suggests that the evidence required by Rule 31(A) must be more than mere assertion that the mark has been used; it must be actual evidence which shows how the trade mark has been used. See *Carte Bleue* [2002] RPC 31.

31. Section 46(1)(b) refers to "genuine use" having been made of the registered trade mark within specific periods of five years. In the case of subsection (b), the period can be any five years, and not just the five years leading up to the filing of the Application. See *La Mer Technology Inc v Laboratoires Goemar SA's* trade mark case [2004] WL 2945720

32. These periods must be considered in relation to the proviso contained within Section 46(3), which reads as follows:

“(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.”

33. The effect of Section 46(3) is not to extend the five-year period by three months. After a period of inactivity the use must commence after the expiry of the five years specified in the Application, but need not immediately follow, and will end with the Application for Revocation. But if the proprietor commences (or makes preparations) to use the mark after the expiry of the specified five year period, but within the three months immediately preceding the Application, the use will be disregarded, that is, unless the registered proprietors had been unaware of the potential Application. See *Philosophy Di Alberta Ferretti* [2003] RPC 15.

34. In paragraph 3 of their Statement of Case, the applicants claim is that there has been no genuine use of the mark for an unspecified period of five years. In paragraph 4 they are more specific in their assertions, alleging non-use during the five years prior to 20 January 2005, the date on which the application for revocation was made. Paragraph 5 sets a further period of non-use as the five years leading up to the 21 August 2003.

35. In the written submissions in support of the registration, the registered proprietors refer to the Witness Statement of Jochen Halfman. In particular to the statement that

“All of the information available suggests that BIBA is not being used now, and has not been used for the most relevant period for this action, which I understand to be **20 January 2000 to 20 January 2005** (the “Relevant Period”).”

36. The registered proprietors took this to mean that the allegations in paragraph 5 of the Statement of Case were not being pursued, and that the only relevant period was the one ending on 20 January 2005. Whilst Mr Halfman’s Statement could be read in this way, the expression “most relevant period” implies that there is more than one relevant period. As the applicants have not sought to amend the Statement of Case I must proceed on the basis that all of the allegations made are still in place.

37. There is no suggestion that if the evidence shows use by the registered proprietors, that this was a result of them becoming aware of a possible revocation action. It therefore seems to me that, subject to the proviso contained in Section 46(3), if the registered proprietors have made “eligible” use of the mark in the five years leading up to the date of application, this will be sufficient to defeat all attacks, either by having shown use within the alleged period of non-use, or, if after 21 August 2003, by virtue of the provisions of Section 46(3).

38. The Act refers to “genuine use” having been made of the trade mark but does not set out what constitutes use that is genuine? In Case C-40/01, *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 at page 725 paragraph 36, the European Court of Justice answered the question in the following terms:

“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 the 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 that have another origin.”

39. The *Ansul* decision stated genuine use 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. Such use must be in relation to goods or services that are already on the market, or about to be marketed and/or for which preparations are underway to secure customers, for example, by means of advertising. The *Bud* Trade Mark case [2002] RPC 38 at paragraphs 41 and 42 gives some useful, albeit limited guidance on advertising.

40. The assessment of whether there has been genuine use must take into account all of the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, and may include giving consideration, amongst other factors, to the nature of the goods or services at issue, the characteristics of the market concerned, and the scale and frequency of use; the use need not always be “quantitatively significant” for it to be deemed genuine.

41. In the *Police* trade mark case [2004] RPC 35, the Appointed Person considered that the *Ansul* judgement did not limit the factors to be taken into account in establishing whether use was genuine only to the three areas specifically mentioned. The judgement had stated that all facts and circumstances relevant to establishing whether there had been real commercial exploitation should be included in the equation, and that the size of a proprietor’s undertaking may be relevant.

42. Further guidance on the scale and frequency of use can be found in the *La Mer Technology Inc* case. This is the decision of a resumed appeal hearing following a reference to the ECJ on various questions relating to the meaning of “genuine use”. In his decision Blackburne J stated:

“**31.** Whether in any given case the proven use amounts to genuine use (“whether the commercial exploitation of the mark is real” as paragraph 38 of *Ansul* puts it) will depend on all of the facts and circumstances relevant to establishing such a state of affairs, including the characteristics of the market concerned and of the products or services in question, and the frequency or regularity of use of the mark. Even minimal use will be sufficient if, in the market concerned, the proven use is considered sufficient to preserve or create a market share for the goods or services protected by it. Thus, the sale or offering for sale (in, say, a trade magazine) of a single exceedingly costly and highly unusual item carrying the mark in a specialised market, for example a very large and complex piece of earth-moving equipment, may very well be

considered by itself to be sufficient in the market for such equipment to preserve or create a market share for items of that kind which carry the mark whereas the sale of a low priced everyday product in a widespread market, for example a single jar of face cream bearing the mark or the exposure for sale of, say, half a dozen such jars for sale on a shop shelf, would almost certainly not be. It would be irrelevant to this conclusion that, in the latter example, the purpose of the proprietor of the mark (or of some third-party acting with the proprietor's consent) when offering the jar of cream for sale was to create a share in the market for face cream sold in jars bearing the mark.”

43. Mr Justice Blackburne referred back to the decision of Jacob J in the earlier part of the appeal:

“15. Jacob J himself ventured an answer to those questions. At paragraph 29 of his judgment [2002] FSR 51 [29] he said this:

"I take the view that provided there is nothing artificial about a transaction under a mark, then it will amount to "genuine" use. There is no lower limit of "negligible". However, the smaller the amount of use, the more carefully must it be proved, and the more important will it be for the trade mark owner to demonstrate that the use was not merely "colourable" or "token", that is to say done with the ulterior motive of validating the registration. Where the use is not actually on the goods or the packaging (for instance it is in advertisement) then one must further enquire whether that advertisement was really directed at customers here. ...

Nor do I think that the absence of a *de minimis* rule significantly affects the policy behind the legislation. Yes, marks must be used within the relevant period, but there seems no reason to make a trader who has actually made some small, but proper, use of his mark, lose it. Only if his use is in essence a pretence at trade should he do so. And of course, if he has only made limited use of his mark it is likely that the use will be only for a limited part of his specification of services. If he has a wider specification, that can and should be cut back to just those goods for which he has made use ...”

44. Many of the exhibits filed by the registered proprietors go only part way in providing the detail necessary to determine whether, when, for what goods, and to what extent the mark has been used within any of the relevant periods. A typical example is the photograph of a handbag bearing the name BIBA (without the device element) that has a date of 31 March 2005 imprinted by the camera. Mr Levy says that it was on sale in the UK, but not whether this was before, at the time of, or after the date shown, or where or how many were sold. The extracts from Company magazine and a regional edition of the Daily Post provide more conclusive evidence of use. The Company magazine exhibit depicts a nail polish bearing the mark as registered. The item from the Daily Post contains no depiction of the goods, simply referring to it as “Biba”. However, as both date from April 1999 they do not show use within the five years prior to the application.

45. Another extract from a magazine entitled “Keep that edge” depicts a nail varnish, lipstick, face powder compact, cosmetic brush, all bearing the BIBA and art-deco device mark, stating that these are available from Selfridges, but there is nothing by which to date the feature. Exhibit CL5 consists of an invoice dated 11 June 1999, relating to goods originating from the registered proprietors that have been supplied to Selfridges. It does not state that the goods supplied are BIBA branded. However, by considering both pieces of evidence together, and taking account of the identity of the supplier-purchaser, that the descriptions and prices of three of the four goods listed are similar to those mentioned in the article, and the consistent use of the BIBA art deco logo on cosmetics products shown in other exhibits, I do not think it is unreasonable to infer that the invoice and article relate to the same goods, and at least as far as the cosmetics listed in the invoice are concerned, that they were on sale in 1999 under the BIBA art deco mark, but again this is too early to be of relevance.

46. Exhibit CL7 includes an order form from TK Maxx showing a number of dates from 19 July 2004 and the 30 August 2004. The quality of the copy is not good enough to see the stage in the transaction to which they relate. It refers to the goods ordered as being from the BIBA label, and contains information that suggest that it is an order for footwear of some sort, but it does not actually say this. The supplier is named as “Brocade”.

47. The exhibit also includes several packing lists/invoices dating from September and October 2004, stating the goods to which they relate in terms such as “40 cartons containing 480 pairs of ladies leather sandals, as follows:”. Shipping is to an address in the UK, the agent is noted as Brocade Shoes Ltd. Although the packing lists/invoices do not state that the footwear is BIBA branded, they use the same order number, refer to the goods by the same style code numbers and record the same supplier as the TK Maxx order.

48. The remaining part of the exhibit includes several photographs of ladies “strappy” shoes (that could fall within the description sandals) that Mr Levy says are the goods mentioned in the order and packing lists/invoices. The mark as registered can be seen on the upper sole. Whilst the shoes do not bear any visible marking, such as style number by which to link them to the documentation, their colours correspond to the product descriptions in the packing lists/invoices. Whilst I appreciate that these could be seen as rather slender threads on which to hang the conclusion that the pictures are of the shoes ordered by TK Maxx, I do not consider it unreasonable to take Mr Levy at his word; the applicants did not challenge the veracity of his statement.

49. To my mind, the sum of the parts of Exhibit CL7 amount to a whole that evidences the placing and fulfilment of an order, from a UK trader, for items of ladies footwear bearing the marks as registered, in the period July – September 2004. The description “clothing” covers all items used to clothe the body, including “footwear”, so this is use in relation to some of the goods for which the mark is registered.

50. Other evidence showing use of BIBA, both as a word or in the composite mark as registered can be found in Exhibit CL8, which consists of a number of invoices dating from the period 12 May 1999 to 17 July 2004. In their written submissions the applicants say that the existence of these invoices is not evidence that they have been paid and goods have been sold in the UK, or show that the registered proprietors were

“engaged in a regular trade in the sense that a market was being created or preserved in relation to the mark in suit”, submitting that “the whole transaction cries out for an explanation”, both being quotes from the decision in *Philosophy Di Alberta Ferretti*.

51. It cannot be denied that at face value most of the invoices appear to be flawed as evidence. Whilst each has the BIBA art deco mark as a header, and the name BIBA in the contact details at the foot of the page, in all but three cases the contact addresses for the customers have been blanked out in copying, which means that it is not possible to determine whether they relate to sales in the UK. However, some have a footer stating “SPECIAL INSTRUCTION: SENT PRODUCTS TO LONDON ADDRESS NOTED”, so even though the actual address is not known, it is possible to say that the customer was located in the UK. Those invoices that have an address show the customer to have been located in London. The invoices that can be placed as relating to sales to customers in the UK date from 11 February 2001 through to 17 July 2004, within the relevant five year window. They collectively relate to clothing, cosmetics, jewellery and a handbag. For convenience I have listed these by product type:

Clothing	Cosmetics	Jewellery	Other
T-shirts	bronzing face powder	gold hoop earrings	handbag
leather jackets	waterproof mascara	gold bangles	bag
long-sleeve top	rose face blush	gold necklace/charm set	
denim crop skirt	nail polish set	gold anklet	
mini skirt	lipstick	silver/gold ring sets	
stretch pants	pencil lipliners		
halter top	eye shadow kits		
turtleneck top	pencil eyeliners		
leather mini skirt	cream face foundation		
cotton tank top	blusher		
denim flow skirt	face powder.		

52. Even though they do not say that the goods were delivered and paid for, these invoices are clear evidence that over a period of years, goods were available for purchase by consumers located within the UK, and that these customers would have been exposed to the BIBA name in the form as registered.

53. The applicants argue that the evidence shows BIBA is a brand from the past. This is undoubtedly true. But statements such as “traces of the BIBA experience have survived” and “hundreds of young women who were – and are still being – named Biba bear testimony to its lasting impact” in the BIBA book exhibited by Mr Halfmann (JH1) indicates that there may be a residual awareness from the earlier trade in BIBA branded goods. However, as I do not know the basis on which these statements were made I put it as no more than “may”. That said, the extract from YELL.Com (JH2) shows there to be a shop promoting itself as trading in BIBA clothing from the past. The fact that the outlet specifically mention that it stocks BIBA clothing says to me that the name appears to be sufficiently well known for the trader to see worth in using it to attract consumers. But the extract originates from after the date of application and I have no way of assessing the extent of any impact on consumer awareness.

54. The position, therefore, is that there is use of the mark, as registered, within the relevant five year period, in relation to sandals, and articles of clothing, in both cases being for ladies/girls. Whilst falling within the scope of the specification of goods for which the mark is registered, the use shown does not cover all of the goods of the registration. Consequently, I must consider whether, and if so, to what extent the specification should be reduced to fairly reflect the use that has been made.

55. When considering partial revocation of a mark, the starting point is for the court to find as a fact what use had been made of the trade mark. In *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 17 it was stated that because of the rights conferred by Section 10(2) of the Trade Marks Act 1994, fairness to the proprietor did not require a wide specification of goods or services. This was approved in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32. In the *Thomson* case Aldous L.J conducted a useful critique of recent case law relating to revocation and referring to the *Decon* case said:

“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?”

56. This approach was cited with approval in *West (T/A Eastenders) v Fuller Smith & Turner plc* [2003] FSR 44, stating that the aim is to arrive at “a fair description which would be used by the average consumer for the products in which the mark has been used by the proprietor”. He went on to say:

“31 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 ... Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

57. Save perhaps in respect of the “sandals” to which I shall come later, I have little doubt that if a consumer were to be shown the articles for which the registered proprietors have established use and asked to say what it is that they see, they would either list the items by name, or as is more likely, will refer to it collectively as “clothing”. It cannot be a fair or equitable result to accept the use as being only in respect of the specific items alone, nor does the case law advocate such an approach. But conversely, it cannot be right to allow the registration to stand for a description of goods if the use can be seen to fall within a recognisable and definable subset of the goods for which the mark is registered.

58. Setting aside items for specialised purposes or activities, the general description “clothing” can be broken into three main subsets, namely “outer clothing”, “underclothing” and “footwear”. The goods for which use has been established fall squarely within the first of these groupings. Within this, it is possible to further identify sets such as formal/casual wear, knitwear, leatherwear, head gear, sleepwear and hosiery. Whilst I am aware that there are retailers specialising in the sale of one or

more of these areas, in relation to clothing for day to day wear the public's perception will generally be of a retailer conducting a trade that encompasses clothing across the spectrum of such goods. Whilst the consumer will be familiar with descriptions such as "knitwear" and "casual wear", these are more classifications for the industry in marking specific areas of the trade, and not likely to be used by the consumer in describing the nature and extent of the goods for which the registered proprietors have used their mark. I come to the position that the subset "Outer clothing" would be a fair reflection of the use shown by the registered proprietors.

59. This leaves the matter of the "sandals". Although notionally covered by the description "clothing", I consider it unlikely that a consumer would regard the footwear shown in the evidence as clothing. This reflects the circumstances of the trade where the retailing of footwear is distinct from clothing per se, both in terms of having shops selling footwear alone, and in the common practice for multi product stores to have a dedicated footwear section. The general heading "footwear" can be sub-divided into categories such as "boots", "shoes" and "slippers", all of which would be recognisable to the consumer. The description "sandals" covers several types of footwear all of which fall within the description "shoes", and which is how I consider the consumer would perceive and describe such goods.

60. From my deliberations and conclusions, and taking into account the existing limitations in the registered specification, I conclude that the registration should be revoked to "Outer clothing; shoes; all for women and girls; but not including any such goods for export to Africa".

61. In summary, I find that the application for revocation succeeds in part, and that with effect from the 20 January 2005, the registration should be revoked so as to reduce the specification to:

"Outer clothing; shoes; all for women and girls; but not including any such goods for export to Africa".

62. The applicants sought revocation in respect of the registration in its entirety. The registered proprietors sought to defend the whole of the registration. Both have succeeded in part. In these circumstances I do not consider it appropriate to make an award of costs.

Dated this 7th Day of December 2006

**Mike Foley
For the Registrar
The Comptroller-General**