

O/440/17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 754834
TIGERCAT IN THE NAME OF TIGERCAT INTERNATIONAL INC

AND

IN THE MATTER OF AN APPLICATION FOR REVOCATION (NON
USE) BY CATERPILLAR INC

Background and pleadings

1. Tigercat International Inc is the registered proprietor of International trade mark registration No 754834 consisting of TIGERCAT. The trade mark was registered on 13th December 2000 and protected in the UK on 28th September 2001. It is registered in respect of the following goods:

Class 07:

Forestry machines and parts and components therefor; bulldozers; ditchers (ploughs); diggers (machines); straw (chaff) cutters; chaff cutters; cutting machines; for tress; raking machines; excavators; saws machines for forestry use; wheeled loaders.

Class 12:

Apparatus for locomotion by land; (not bicycles, electrically assisted bicycles, and parts and components therefore); forestry vehicles and parts and components therefore; motors and engines for vehicles; dumper trucks; fork lift trucks.

2. Caterpillar Inc seeks revocation of the trade mark registration on the grounds of non use based upon Section 46(1)(a) and (b) of the Trade Marks Act 1994. Tigercat International Inc filed a counterstatement denying the claim.
3. Revocation is sought under Section 46(1)(a) in respect of the 5 year time period following the date of protection in the UK , namely 29th September 2001 to 28th September 2006. Revocation is therefore sought from 29th September 2006. Revocation is also sought under Section 46(1)(b) in respect of the following time period: 7th March 2006 to 6th March 2011 (revocation is

sought from 7th March 2011) and 7th March 2011 to 6th March 2016 (revocation is sought from 7th March 2016).

4. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

5. A Hearing took place on Wednesday 19th July 2017, with the Registered Proprietor represented by Benet Brandreth of Counsel, instructed by Gowling WLG (UK) Ltd and the applicant by Alaina Newnes of Counsel instructed by Hogan Lovells.

Preliminary Remarks

6. It should be noted that during the proceedings, the Registered Proprietor surrendered the following parts of its registered specification:

Class 07:

Bulldozers, ditchers (ploughs); diggers (machines); straw (chaff) cutters; chaff cutters; raking machines; excavators; wheeled loaders.

Class 12:

Dumper trucks; fork lift trucks.

Legislation

7. Section 46(1) of the Act states that:

“The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c).....
.....

(d).....

(2) For the purpose of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period

but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

8. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

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

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

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

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

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

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

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve

an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

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

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

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

Registered Proprietor's Evidence

10. This takes the form of a witness statement, dated 9th September 2016, from Mr Anthony Iarocci, the President of Tigercat Industries Inc. The witness statement has a large exhibit attached. As such, though all of the evidence has been perused in detail, the summary that follows describes the key pieces of evidence only:

- Mr Iarocci explains that the RP has sub-licensed its rights to use the Trade mark in the UK to two dealers: The Forestry Shop between 2002 to 2006 and then Treetop Forestry Ltd from 2006 to the present day. As such, the mark has been in constant use from 2002 to the present day in respect of all of the goods in classes 07 and 12 for which the mark is registered.
- Exhibit 2 is a selection of copies of photographs, from Trade Shows. These are dated within the final relevant period (from 2011 to 2014). It is noted that all appear to be in respect of Forestry machines/vehicles.
- Exhibit 3 is a selection of screenshots from the opponent's website. These are also dated from 2011 onwards and is useful as an aid for identifying the different types of machines displayed in the earlier photographs.
- Exhibit 4 contains copies of magazines and advertisements. There has been much debate between the parties during the evidence rounds and at the Hearing as to whether or not each of the examples explicitly targets the UK market. While the point is arguable on occasion, it is noted that the following publications clearly target the UK market: the Forestry Journal and Forestry and Timber News. Further, within each of these, a number of different forestry machines/vehicles (I will return to this point later) are displayed, consistently over a period of some years – from 2011-2016.
- Exhibit 6 is a copy of Treetop Forestry Ltd's website. The following is noted: that they have been a selling agent for Tigercat since 2006; that their product range is extensive in respect of forestry equipment

(several types are listed) and that they also sell mulchers, a type of industrial equipment.

- Exhibit 7 is a selection of invoices. These are subject to a confidentiality order and so will be described in the broadest of terms. It is noted from there are invoices included from 2009 onwards. Further, that the products sold are different forestry machines/vehicles: harvesters, log skidders, forwarders. It is true that some are dated May 2016 which is after the relevant date. However, this does not make them irrelevant in building a picture regarding use made as it is evident that this is an ongoing business operation. There is one invoice referring to the sale of a mulcher. I understand that mulchers can be classed as forestry machines, but may also perform similar functions in other industrial contexts.

Applicant's evidence

11. This is in the form of a witness statement, dated 4th February 2017, from Lia Yasmin Young, an attorney within the legal services division of the applicant. The witness statement has been fully considered but is summarised in respect of the directly relevant information contained therein as follows:

- Ms Young claims that the RP does not have a forestry business in the UK. Rather, it is based in Canada.
- In respect of Treetop Forestry Ltd, Ms Young comments that according to its website, its main business is harvesting commercial timber in Scotland.
- Further, that its sales business appears to be selling equipment that it has already used in its own harvesting business.
- Exhibit 2 to Mr Iarocci's witness statement only contains harvesters and forwarders.
- Ms Young notes that a Tigercat base vehicle can be used with parts from other manufacturers (Logmax for example).
- Ms Young notes that there is a "new sales" section on the Treetop website but argues that it is unclear as to whether it actually offers any new products for

sale as opposed to the re-sale of equipment already used in its own harvesting business.

- In respect of market size, Ms Young provides information regarding the total number of forestry units sold in the years 2011 to 2016. It is noted that the market is niche and that the numbers involved are very small. The highest number being 111 forwarders in 2011.

Registered Proprietor's evidence in reply

12. This is a witness statement, dated 19th April 2017, from the same Mr Iarocci. The following relevant information is contained therein:

- Mr Iarocci accepts that the RP's business was founded in Canada, but denies the assertion that there is no business in the UK.
- Mr Iarocci accepts that harvesting is part of Treetop's business but also insists that it also sells Tigercat products both used and new, which is common practice for such dealerships.
- Mr Iarocci points out that the Treetop website includes a full product list of Tigercat products. This includes: mulchers, skidders, loaders, butchers and loggers.
- Mr Iarocci explains that it is common for dealers to supply products from a range of different companies.
- Mr Iarocci reasserts the number of invoices it has filed in support of its claim to genuine use.

13. This concludes my review of the evidence.

Analysis of evidence

14. The evidence from the Registered Proprietor is dated from 2009 onwards. It includes invoices, advertising material and website screenshots. The former

displays more than one forestry machine/vehicle and the latter includes a product list. It is true that there are no sales and advertising figures provided. Further there is no context. Having said that, the evidence from the Applicant shows that the relevant market is niche and that extremely small numbers of the relevant products are sold annually. Notwithstanding these issues, the above listed evidence is compelling and clearly demonstrates that genuine use has been made of the Tigercat trade mark, at least from 2009 onwards.

15. However, it is considered that use has not been shown across the full breadth of the specification as it currently stands. In this regard, the following is taken into account.

a) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

b) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

Conclusion – Non use

Preliminary remarks

16. It is noted that Class 07 covers “machines” and Class 12, “vehicles”. During the analysis of the evidence, drawing a distinction between the two terms has been challenging.

17. In considering Class 07 first of all, it is noted that Exhibit 6 contains a product list containing all of the types of forestry equipment bearing the Tigercat trade mark that it sells (and there are several). Further, some of these are clearly displayed throughout the evidence. Finally, it is considered that the following can accurately be described as forestry machines: harvesters and forestry mulchers. As such, the following is a fair specification for the use that has been demonstrated in respect of goods in class 07:

Class 07:

Forestry machines and parts and components therefore.

18. In respect of class 12, there is use shown in respect of products which can accurately be described as forestry vehicles: skidders and forwarders. However, the use on vehicles per se, does not extend beyond these specific examples. As such, it is considered that a fair specification is:

Class 12:

Forestry vehicles, namely skidders and forwarders and parts and components therefore.

19. The application therefore fails in this respect and the registration should be preserved as described above. The application succeeds in all other respects.

Final Remarks

20. It is noted that “mulchers” was listed in the evidence as a type of industrial equipment. However, in the context of the use here, it clearly has a forestry function and indeed, all of the evidence points to the Registered Proprietor’s trade in the UK as being solely forestry based. As such, it is considered that mulchers can fall within the surviving terms in Class 07.

COSTS

21. At the hearing, both parties indicated that the outcome of these proceedings needed to be known before submissions on costs could be advanced. The Registered Proprietor in particular felt strongly about this. This is because, in its view, the cancellation applicant is well aware of the use made of the attacked trade mark (the parties are competitors) and that any costs award should take account of this. As such, both parties are allowed two weeks from the date of this decision to file arguments on an appropriate costs award. A supplemental decision on costs will then be issued. The appeal period in respect of this substantive decision will start upon issue of the decision on costs.

Dated this 19th day of September 2017

Louise White

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