

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL TRADE MARK REGISTRATIONS NOS. 682040 AND 1042842 AND UK TRADE MARK REGISTRATION NO 1436894 IN THE NAME OF HUBER HOLDING AG

AND IN THE MATTER OF THE APPLICATIONS FOR REVOCATION THERETO UNDER NOS. 503049, 503050 AND 503051 BY SOLOMON AND SILVER LIMITED

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF D JOHNSON (O/078/21) DATED 3 FEBRUARY 2021.

DECISION

Introduction


1. This is an appeal by Huber Holding AG ("**Huber**") from decision O/078/21 of Denzil Johnson ("**Decision**") in relation to Huber's International Registrations 682040 ("**IR040**") and 1042842 ("**IR842**"), and UK Trade Mark Registration 1436894 ("**UK894**").
2. In its application filed on 4 March 2020, Solomon and Silver Limited ("**Solomon**") sought full revocation of each mark, on grounds of non-use by Huber or with its consent, based on an alleged uninterrupted period of five years of non-use from 31 October 2014 to 30 October 2019.
3. Huber successfully sought consolidation of the three actions, and adduced evidence in support of its case in the form of a witness statement given by Florian Neu, the Managing Director of a company in the group of companies owned by Huber. Neither side requested an oral hearing, with both parties instead filing written submissions in lieu. In his Decision, Denzil Johnson for the Registrar partially revoked the marks.
4. On 3 March 2021 Huber filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994. The appeal concerns only IR040 and UK894 – the Hearing Officer's decision in relation to IR842 is unchallenged.

The Hearing Officer's decision

5. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):
 - a) In relation to sufficiency of use, Huber's case rests upon the evidence of the selection of invoices and turnover figures.
 - b) Although the annual turnover of goods under the marks was modest, the low prices of the individual items and the continuous frequency of the use meant that the Hearing Officer was satisfied that there had been genuine use.
 - c) The Hearing Officer had some difficulties in matching up product codes in the invoices against product in the sample catalogues submitted by Huber. Nonetheless, he was satisfied

that use had been made in relation to some of the goods detailed in the respective class 25 specifications.

- d) The references in the invoices to specific goods led the Hearing officer to determine the fair specifications set out in the table below.

Number	Mark	Original specification	Revised specification
IR040	SKINY	Class 25: Clothing, including underwear and stockings	Class 25: Underwear; leggings
IR842	SKINY	Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices Class 25: Headgear, footwear, socks, stockings, bras, lingerie, underwear	Class 25: Bras, lingerie, underwear
UK894		Class 25: Waistcoats, shirts, collars, cuffs, vests, blouses, stockings, articles of under clothing, night-wear, dressing gowns, bathing suits, bathing caps, swimming trunks; all included in Class 25	Class 25: Shirts (being sleepwear and loungewear), vests, leggings, articles of under clothing, night-wear, dressing gowns

Grounds of Appeal

6. Huber contended that the Hearing Officer made the following errors of principle in his assessments:
- First, the Hearing Officer erred in ignoring, as self-standing evidence of use, the contents of catalogues submitted in evidence by Huber. Those catalogues had been distributed in the UK in significant numbers.
 - Secondly, even if he was not wrong to ignore the catalogues as self-standing evidence of genuine use, the Hearing Officer erred in his assessment of the entries in invoices for “bikini briefs” and “padded triangles”. He treated them as exclusively underwear, when he should have concluded that they also proved genuine use for swimwear.
 - Thirdly, the Hearing Officer took an inconsistent approach to the fair specification of the Marks. He held that genuine use had been made of sleepwear and loungewear, and for vests, night-wear, and dressing gowns. He included those in the specification of UK894 (with sleepwear and loungewear being included within the specification of “shirts”, for which UK894 was registered). However, when considering the fair specification of IR040, which was registered for “clothing” and so encompassed every such item, he did not include those items.
7. Huber expanded upon the above in its skeleton argument and in oral submissions by Counsel at the hearing.
8. Solomon did not attend the hearing, but filed written submissions prior to the hearing, saying (in summary):
- The Hearing Officer did not ignore the catalogues. Rather, he took them into account, along with the other evidence relied upon by Huber, and concluded that the presence of images

of swimming trunks in the catalogue was not sufficient to offset the absence of quantifiable sales information. He was entitled to reach that decision based on all the facts before him, for which he had concluded that certain aspects of the evidence were more relevant/probative than others.

- b) The Hearing Officer had identified deficiencies in Huber's evidence of use, including that "it is difficult to consistently match invoice product codes against product in the sample catalogue evidence". The onus was on Huber to prove use, and any ambiguity in Huber's evidence ought not to be resolved in its favour. In any case, the items in the catalogues relied upon by Huber to demonstrate use of the marks on swimwear items are far from conclusive.
- c) The UK894 mark was registered for 'clothing, including underwear and stockings'. The use of the word 'including' is extremely vague and is not typically accepted by the UKIPO. Consequently, it appears that the Hearing Officer substituted the word 'including' (not acceptable) for 'namely' (acceptable under UKIPO practice), so was therefore unable to expand the specification any more broadly, given that the word 'namely' acts as a limitation to protection.

Standard of review

9. The approach to be adopted in an appeal hearing has been laid down a number of times in case law, both in general terms (e.g. by the Supreme Court in *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671) and specifically in relation to appeals before the Appointed Person (Daniel Alexander Q.C. sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17), approved by Arnold J in *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch)). These cases establish the following principles:
- Appeals to the appointed person are by way of review, not re-hearing;
 - It is necessary for the appellant to satisfy the appeal tribunal that there was a distinct and material error of principle in the Hearing Officer's decision, or that the Hearing Officer was wrong;
 - In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it;
 - In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation;
 - Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance,

concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice;

- The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account.

10. I shall bear all the above in mind when reviewing the Decision.

Discussion

11. Looking at the various alleged errors of principle in turn, my analysis is as follows.

(a) A failure to take into account the contents of the catalogues

12. It was common ground between the parties in their submissions that advertising, including catalogues, is capable in principle of providing evidence of trade mark use. The Hearing Officer, at paragraph 21 of the Decision, reproduced Arnold J's (as the then was) summary of the law relating to genuine use in *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch), which includes the following principles:

- 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: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 at [37]; and
- 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];

13. Furthermore, the Hearing Officer cited the comments of Mr Daniel Alexander Q.C., sitting as the Appointed Person in *Awareness Limited v Plymouth City Council*, Case BL O/236/13:

“22. The burden lies on the Proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be skeptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

14. Finally, the Hearing Officer said at paragraph 22 of the Decision:

“When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

15. Consequently, therefore, the Hearing Officer and both parties were all (correctly) of the view that there is no particular mandatory form of evidence which must be submitted to prove genuine use, and that catalogues, as a category, are potentially capable of proving use. On the other hand, as rightly conceded by Counsel for Huber during the hearing of this appeal, there is no rule of law that the inclusion, in a catalogue, of a product bearing the contested mark proves, in and of itself, genuine use of the mark. Consequently, whether or not a particular catalogue, relied upon in a particular non-use action, does actually prove genuine use is a matter for the hearing officer, to be determined on all the facts.

16. At paragraph 37, the Hearing Officer said “On the question of sufficiency of use, I consider that the proprietor’s case rests upon the evidence of the selection of invoices and turnover figures”. It is clear, therefore, that the Hearing Officer rejected the catalogues as a free-standing form of evidence of use. Had the Hearing Officer given even a brief explanation of his reason(s) for rejecting the catalogues, it is likely that his decision in that regard would have been difficult or impossible for Huber to challenge, unless it was a decision that no reasonable hearing officer could have reached.

17. The Hearing Officer did not, however, give any express reasons for rejecting the catalogues as a free-standing form of evidence. Counsel for Huber invited me to draw inferences as to his reasons, based on other parts of the Decision. Specifically, at paragraph 38 the Hearing Officer said:

“On the additional evidence adduced to show genuine use in the form of catalogue samples, I found certain deficiencies. I agree with the applicant that it is difficult to consistently match invoice product codes against product in the sample catalogue evidence. For example, invoice dated 24 August 2019 (at page 120 of FN2) shows the sale of item number 085450 (in black, in four different sizes). This is cross-referenced against the 2019 Spring/Summer catalogue (at page 7 of FN3), which shows this product code as: “085450 padded triangle | Triangel gepaddet”; and that that said item can be found at page 87 of said catalogue. However, page 87 of that catalogue has not been exhibited. Having said that, I do not agree that it is “not possible to determine with accuracy what category the products listed on the invoices fall under (the written descriptions being inadequate or vague) and whether, indeed, the Contested Mark is affixed to those goods”.

18. At paragraph 47 he said:

“When considering use in relation to swimwear, I find that the only reference to swimwear (in the invoice evidence) relates to the sale of tunics, which are categorised as “Swimwear Accessories Women”. I also noted the use of the marks on swimming trunks, as displayed in the sample catalogue evidence; however, in the absence of sales of these

items, I conclude that the evidence is insufficient to demonstrate genuine use of the marks in relation to any type of swimwear”.

19. Given the contents of the two paragraphs above, I was invited to infer that that the Hearing Officer must have adopted the view that it is necessary, to prove genuine use, for a proprietor to provide evidence of actual sales, and that the catalogues were therefore relevant only to corroborate/interpret the invoices submitted by Huber.
20. In my view, whereas Counsel for Huber may well be correct in this regard, it is not necessary for me to draw any such inference. In my view, a failure to consider relevant evidence, or at least to provide a reason for rejecting a potentially relevant piece of evidence, constitutes an error of principle in and of itself, whatever the underlying reason for the failure. Support for that is provided by the comments of Mr Daniel Alexander Q.C., sitting as the Appointed Person in *TT Education v Pie Corbett* [2017] ETMR 26 at paragraph 67):

“It follows that, in the absence of some other identifiable error, such as (without attempting an exhaustive account) a material error of law, or the making of a critical finding of fact which has no basis in the evidence, or a demonstrable misunderstanding of relevant evidence, or a demonstrable failure to consider relevant evidence, an appellate court will interfere with the findings of fact made by a trial judge only if it is satisfied that his decision cannot reasonably be explained or justified.”
21. Accordingly, having reminded himself that catalogues are potentially capable of proving genuine use, the Hearing Officer rejected the catalogues as a free-standing form of evidence, but without giving any reasons for that rejection, and in so doing made an error of principle.
22. As a consequence of that error of principle, I am entitled to consider the catalogue evidence myself and form my own view as what (if anything) it establishes. Huber’s uncontested evidence was that over the 5-year relevant period:
 - approximately 1,000 catalogues were distributed in the UK;
 - customers relied upon those catalogues to place orders; and
 - customers placed orders worth around €1 million for goods bearing the SKINY mark.
23. Although the figures above are relatively modest in the context of the clothing industry, the Hearing Officer concluded that Huber’s use was more than mere token use for the sole purpose of preserving the rights conferred by the marks, and accordingly constituted genuine use.
24. In my assessment, the catalogues relied upon by Huber, when viewed alongside the evidence of turnover and Huber’s selection of sample invoices, serve to do more than merely corroborate/interpret the invoices. The catalogues are, in and of themselves, evidence of genuine use of the mark. They are a bona fide effort to “create or preserve an outlet for the goods or services that bear the mark” (*Ansul* at [37]-[38]).
25. The catalogues contain a substantial number of instances of the marks being used in relation to swimwear. Huber points, for example, to the following examples (the page numbers are in relation to the Exhibit FN3 to Mr Neu’s witness statement):
 - Page 19 - the swimwear range marketed under the “Shiny Desert” sub-brand, also shown at page 29;

- Pages 22 and 23 - both men's and women's garments are shown;
- Pages 28 to 29 - 5 different ranges of swimwear, under the sub-brands Aloha, Boho Girl, Island Fever, Desert Flower, and (as mentioned above) Shiny Desert;
- Page 31 – men's swimwear (the Colourblock and Beachbar ranges), then (in other catalogues) at pages 47 and 48; at page 76, 82 to 84, and 87; at 138 and 139;
- More women's swimwear is shown at page 16; page 75; pages 80 to 82; at 128; and at 132 to 136.

26. I agree with Huber that the catalogue evidence demonstrated that swimwear had been extensively marketed by the Appellant at least by way of advertising. Genuine use had accordingly been made of swimwear for the purposes of IR040 (which was originally registered for "Clothing"), and of "bathing suits" and "swimming trunks" for the purposes of UK894 (which was registered for those specific types of garments).

(b) The Hearing Officer erred in his assessment of the entries in invoices for "bikini briefs" and "padded triangles"

27. Ground (b) was advanced by Huber as a fall-back argument in the event that ground (a) did not succeed. I informed Counsel for Huber during the hearing that the appeal on ground (a) had succeeded, with my reasons to follow, and therefore it was not necessary to go on to consider ground (b).

(c) An inconsistent approach to the fair specification of the Marks

28. As part of his reasoning in order to settle the fair specification of UK894, the Hearing Officer determined that genuine use had been made of the Marks for the following:

- a. Sleepwear and loungewear (paragraph 48 of the Decision);
- b. Shirts being sleepwear and loungewear (paragraphs 45 and 49);
- c. Vests; nightwear and dressing gowns (paragraph 49).

29. The Hearing Officer included each of the above in the fair specification of UK894. When settling the fair specification of IR040, however, none of the above were included.

30. The original specification of IR040 was for "Clothing, including underwear and stockings". Solomon contended, in its written submissions for the appeal, that the use of the word 'including' is extremely vague and is not typically accepted by the UKIPO. Solomon suggested that the Hearing Officer had substituted the word 'namely' instead of 'including', and was therefore unable to expand the specification any more broadly, given that the word 'namely' acts as a limitation to protection.

31. I regard this contention as speculative, as the Hearing Officer gave no express indication as to why he chose not to include the categories listed in paragraph 28 in the fair specification of IR040. Furthermore, as submitted by Counsel for Huber, even if Solomon's contention were correct, it would constitute an error of principle on the Hearing Officer's part. In that regard, I was directed to the entry for "Including, for example, namely, as well as, in particular, specifically i.e." in the Trade Marks Manual at <https://www.gov.uk/guidance/trade-marks-manual/the-classification-addendum>, which states:

“While not desirable in specifications since it encourages tautology, such wording should usually not be changed. Such terms are not allowable in Class 35 (with the exception of “namely” see below) for specifications covering retail services as they do not create the legal certainty that is required. However, in other class the terms may be allowed. For example we would allow:



Biocides including insecticides and pesticides Paper articles of stationery in particular envelopes Dairy products namely cheese and butter

Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”.

32. In my view, a more likely explanation for the inconsistent treatment of IR040 and UK894 is a simple slip or transcription error on the part of the Hearing Officer. Such a slip falls within the category of “wrong”, and is amenable to correction on appeal. Accordingly, the specification of IR040 should include the same categories of goods as the Hearing Officer included in UK894.

Conclusion

33. Taking into account everything I refer to above, the specifications for the two marks in this appeal (IR842 being uncontested) should be revised as follows:

Number	Mark	Original specification	Revised specification
IR040		Class 25: Clothing, including underwear and stockings	Class 25: Underwear; leggings; vests, dressing gowns, sleepwear, loungewear, swimwear
UK894		Class 25: Waistcoats, shirts, collars, cuffs, vests, blouses, stockings, articles of under clothing, night-wear, dressing gowns, bathing suits, bathing caps, swimming trunks; all included in Class 25	Class 25: Shirts (being sleepwear and loungewear), vests, leggings, articles of under clothing, night-wear, dressing gowns, bathing suits, swimming trunks

Costs

34. Clearly, Huber has been the successful party in this appeal. It is entitled to a contribution towards its costs of the appeal, and I therefore make an order that Solomon pays to Huber a contribution of £1,500 towards its costs of the appeal.
35. As for the costs of the original application, the Hearing Officer held that although both parties had achieved a measure of success, Solomon was more successful than Huber, and accordingly he ordered Huber to pay the sum of £1,500 towards Solomon’s costs.
36. In my view, the outcome of Solomon’s application, in light of this appeal, is that each party has been approximately equally successful. Accordingly, the order for the original application should be varied to “no order as to costs”, and Solomon will have to repay the £1,500 to Huber,

if that payment has already been made, in addition to paying the £1,500 in relation to the appeal.

Dr. Brian Whitehead

13 June 2021

Representation

Thomas St Quintin, Hogarth Chambers, instructed by Page, White & Farrer Limited for the Proprietor / Appellant

Solomon and Silver Limited for the Revocation Applicant / Respondent