

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION No. 1015449

IN THE NAME OF ERIC GUANGYU WAN

AND IN THE MATTER OF REVOCATION No. 502360 THEREOF

BY WORLDWIDE BRANDS, INC. ZWEIGNLEDERLASSUNG DEUTSCHLAND

AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON

BY THE PROPRIETOR

AGAINST A DECISION OF MS STEPHANIE WILSON

DATED 12 DECEMBER 2019

DECISION

Background

1. This is an appeal against a decision of Ms Stephanie Wilson, acting for the Registrar, dated 12 December 2019, BL O/760/19, in which she revoked for non-use in its entirety with effect from 13 November 2010, Registration number 1015449 standing in the name of Eric Guangyu Wan (“the Proprietor”).
2. Registration number 1015449 was entered on the Register on 6 August 1973 for the trade mark CAMEL in Class 25 in respect of: *Shirts made from man-made fibres and/or from cotton.*
3. On 19 November 2018, Worldwide Brands, Inc. Zweignlederlassung Deutschland (“the Applicant”) filed an application to revoke Registration number 1015449 for reasons of non-use under Section 46(1)(b) of the Trade Marks Act 1994.
4. Several periods of non-use were alleged with the earliest effective date for revocation being 13 November 2010.
5. However, it was accepted that for present purposes the pertinent period was the last five-year period of non-use claimed from 13 November 2013 – 12 November 2018 (transcript, pp. 2 – 3).

Evidence of use

6. The Proprietor acknowledged that the Proprietor’s evidence was “very thin” (transcript, p.3).

7. The evidence comprised a Witness Statement of Emma Pettipher of Stobbs IP Limited, the Proprietor's representatives, dated 17 May 2019.
8. Ms Pettipher stated that the facts contained in her Witness Statement came from information given to her by the Proprietor's Italian legal representatives and from her own knowledge.
9. Ms Pettipher explained that the Proprietor was the General Manager of the company Guangzhou Hongqie Huwaiyongpin Youxiangongsi, which was the registrant of the Amazon UK store known as "Camel Crown". The Proprietor was also manager of the menswear division of Guangdong Camel Apparel Co, Ltd, a company owned by the Proprietor's parents, which was the registrant of the Amazon UK store "Camel Direct". Ms Pettipher referred to all three players as "my Client".
10. The Proprietor was assigned ownership of the contested registration in 2018 but Ms Pettipher was advised that her Client used CAMEL in the UK with the consent of the assignor.
11. I pause here to remark that no documents were adduced by the Proprietor in support of these facts.
12. As to her Client's use Ms Pettipher exhibited the following documents:

- 1) at EP1, copies of CAMEL "Lookbooks" for the years 2015 – 16, 2016 – 17, 2017 – 18 and 2018 – 19 showing a subset of her Clients' CAMEL clothing, men's shirts, and outdoor clothing.

The Hearing Officer accepted that the 2018 – 2019 Lookbook clearly displayed shirts; it was a "Shirt Special" edition.

However, the 2016 – 2017 Lookbook displayed only t-shirts and polo shirts. Whilst the Hearing Officer was prepared to accept that polo shirts might be regarded as within the meaning of "shirts" by the average UK consumer, that was not true of t-shirts.

The other Lookbooks were dismissed by the Hearing Officer as showing clothing other than shirts (the 2015 – 2016 and 2017 – 2018 Lookbooks did, however, display some t-shirts).

The meaning of "shirts" was a matter of contention to which I return below.

In the meantime, I record that whilst items in the Lookbooks appeared to have product numbers, there was no pricing/purchasing information, and no availability/distribution detail for the Lookbooks was supplied.

- 2) at EP2, sample listings of CAMEL clothing on Amazon UK. As the Hearing Officer noted these postings were undated but a number had product reviews that were dated.

The Hearing Officer remarked that none of these postings related to any products that could properly be described as “shirts” as stated in the specification of the contested registration.

In fact, there was one posting for a shirt at EP2: “Camel Men’s Shirt Solid Color Long Sleeve Business Casual Shirt” in “Colour: Green”, “Price: £35.99”. The shirt was said to have been first available on Amazon on 26 November 2018. There were two verified purchases/product reviews dated 12 September and 18 October 2018, but disconcertingly both related to the purchase of green sandals.

It is not clear from the exhibited copy posting who was selling the shirt (in contrast to other listings which refer to CAMEL CROWN). The listing for the shirt was duplicated in EP2.

- 3) at EP3, a print out from the Camel Direct Amazon UK store listing orders for jackets dating from 27 March 2016.

None of these related to “shirts” within the specification of the contested registration and were of no assistance to the Proprietor.

- 4) at EP4, a selection of copy invoices dated between April 2016 and August 2018.

The invoices in the main related to jackets, shorts, and trousers, which were of no assistance to the Proprietor.

There was one invoice for a white ladies’ t-shirt purchased on 11 April 2016 for £19.99 and shipped to an address in Preston, Lancashire. As stated above the issue of t-shirts was contentious.

The Hearing Officer did not mention (when discussing EP4) that EP4 also contained two separate invoices for the sale of: (a) two, “Camel Men’s Shirt Solid Color Long Sleeve Business Casual Shirt” at £35.99 each, purchased on 12 December 2018 and sent to Pershore, Worcestershire; and (b) one, “Camel Men’s Shirt Solid Color Long Sleeve Business Casual Shirt” at £35.99 again purchased on 12 December 2018 but despatched to Stourport-on-Severn.

The Hearing Officer did however mention the sale of three shirts in connection with EP5 below with a footnote reference to EP4. The order numbers indicated that the invoices at EP4 and breakdown of sales at EP5 related to the same sales of the three shirts.

- 5) at EP5, a breakdown of sales figures for products on the Amazon UK store. As I have indicated, the sale of three Camel men’s shirts were recorded on this breakdown as purchased on 12 December 2018, each for the sum of £35.99, which appeared to be the shirts the subject of the invoices described above at EP4. The launch date of these shirts was said on the breakdown to be 25 May 2018 (although the shirt appeared first to have been made available on amazon.co.uk on 26

November 2018 – see EP2 above). The “Shop” column of the breakdown listed “Amazon UK – camel shoes” against these sales. The breakdown at EP5 also referred to the sale of the one t-shirt for which there was a copy invoice at EP4. The breakdown gave a launch date of 16 March 2016 for the t-shirt.

13. In sum, therefore, the Proprietor’s claimed evidence of use in connection with *Shirts made from man-made fibres and/or from cotton* in Registration number 1015449 comprised:
 - (a) four CAMEL Lookbooks, which displayed use of CAMEL in relation to *inter alia* shirts, polo shirts and t-shirts, the latter being a point of contention. No distribution details of the Lookbooks were supplied;
 - (b) the offer of a “Camel Men’s Shirt Solid Color Long Sleeve Business Casual Shirt” on amazon.co.uk stated on that web page to have been first available on 26 November 2018;
 - (c) an invoice for the sale of a CAMEL white t-shirt to a customer in Lancashire on 11 April 2016 for £19.99, and the sales of three CAMEL men’s shirts to customers in Worcestershire on 12 December 2018 at £35.99 each. The shirts were said on the breakdown to have been launched on the CAMEL CROWN Amazon UK site on 25 May 2018.

The Hearing Officer’s decision

14. The Hearing Officer noted by reference to Section 100 of the Act and the decisions of Mr Daniel Alexander QC sitting as the Appointed Person in *PLYMOUTH LIFE CENTRE Trade Mark*, BL O/236/13, at paragraph 22, and *GUCCI Trade Mark*, BL O/424/14, at paragraph 56 that the onus was on the Proprietor to prove genuine use of the mark for the registered goods during the relevant period.
15. Regarding the meaning of “genuine use” in the ground of revocation in Section 46(1)(b) of the Act, the Hearing Officer instructed herself according to the summary of applicable principles set out by Arnold J. (as he then was) in *Walton International Ltd v. Verweij Fashion BV* [2018] EWHC 1608 (Ch) at paragraph 115.
16. As was made clear by those principles, whilst there is no quantitative threshold for genuine use, not all proven commercial uses will automatically amount to genuine use within the meaning of Section 46(1)(b). The test is whether the use shown would be viewed as warranted in the economic sector concerned to maintain or create a share in the market for the registered goods in suit (*Walton* principles (7) – (8), *STRADA Trade Mark*, BL O/528/15, paras. 24 – 45, cited with approval in *The London Taxi Corporation Ltd v. Frazer-Nash Research Ltd* [2016] EWHC 52 (Ch), para. 217, *JAMES ARTHUR Trade Mark*, BL O/543/20 paras. 9, 15 and 20).
17. The Hearing Officer’s determinations were as follows:
 - “20. The burden of proving use lies with the proprietor. The proprietor states in its written submissions that the Contested Mark has clearly been in use in

the UK since at least 2015. Whilst that may be the case, the burden is on the proprietor to show that it has used the Contested Mark in the UK during the relevant periods in relation to the goods for which it is registered. Even if it is the case that the average consumer would consider polo shirts to fall within the term “shirts”, that means that there is only two Look Books that show use of the Contested Mark in relation to shirts. As the applicant notes, no information is given about distribution of these Look Books. The only sales information that the proprietor has provided in relation to “shirts” is evidence of 3 sales which took place in December 2018. These appear to relate to the order details provided relating to 3 shirts in December 2018 from the proprietor’s Amazon site [f/n ref. EP4]. As these revocation proceedings were commenced on 19 November 2018, these sales were made after these proceedings were issued and outside of the relevant periods. In any event, the sale of 3 items is not sufficient, in my view, to establish genuine use of the Contested Mark in relation to “shirts”. Taking the evidence as a whole, I am not satisfied that the proprietor has demonstrated genuine use of the Contested Mark during any of the relevant periods in relation to the goods for which it is registered.

Final Remarks

21. Even if I am wrong in my finding that the UK average consumer would not consider t-shirts to fall within the meaning of the term “shirts”, the proprietor has provided only one invoice for £19.99 which relates to t-shirts [f/n ref. to EP4]. The sales relating to t-shirts identified in the sales breakdown amount to only 1 product [f/n ref. to EP5]. Even if t-shirts falls within the meaning of the term “shirts”, this would bring the total number of sales in relation to “shirts” as evidence by the proprietor to 4. This is not, in my view, sufficient to establish genuine use.”

Grounds of appeal

18. The first ground of appeal was that the Hearing Officer erred in her interpretation of “shirts” within the specification of the contested registration. It was said that she should have held that the term included t-shirts.
19. I was referred to the definition of “T-shirt” in the online Collins Dictionary: “A T-shirt is a cotton shirt with no collar or buttons. T-shirts usually have short sleeves”. I was also referred to the following passage in *British Sugar plc v. James Robertson and Sons* [1996] EWHC 387 (Ch) (jam not a dessert sauce):

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”
20. The Hearing Officer’s finding on this issue was:

“13 ... In my view, the term “shirts” will be viewed by the UK average consumer as a garment with both a collar and sleeves. I do not, therefore,

consider that t-shirts fall within the meaning of this term. I accept that there is a greater possibility that polo shirts will be seen as falling within this meaning as they do have a collar and sleeves and may be seen as a less formal type of shirt.”

21. It seems to me that this finding is consistent with the *British Sugar* approach and, moreover, with the following guidance in the specific context of proving use (albeit partial use) in *Thomson Holidays Ltd v. Norwegian Cruise Line Ltd* [2002] EWCA Civ 1828:

“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 section 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.”
22. I do not accept, therefore, that the Hearing Officer erred in deciding that t-shirts did not fall within the meaning of “shirts” as understood by the average consumer. In fact I agree.
23. Further, it struck me that in any event this argument of the Proprietor was academic.
24. The Proprietor’s point was that the Hearing Officer should have taken into account the Proprietor’s sale of one CAMEL t-shirt for the sum of £19.99 within the relevant period in her assessment of genuine use. The short answer to this is that she did – but did not regard this coupled with the Proprietor’s other proven use sufficient to establish genuine use.
25. The second ground of appeal was that the Hearing Officer missed in the evidence contained in EP2 the listing for the CAMEL shirt. I have already commented on this at paragraph 12 subparagraph 2) above.
26. I agree that the Hearing Officer’s statement that: “... none of these postings [exhibited at EP2] relate to any products that could properly be described as “shirts” ...” was incorrect.
27. Nevertheless, as noted above there were issues with this copy posting in that it was unclear who was selling the item, and the product reviews related to green sandals (not shirts). Further the Hearing Officer clearly took account of the three sales that had been made of this shirt within the UK.

28. By the time of the hearing the Proprietor's argument seemed to have shifted to criticising the Hearing Officer for failing to take into account that although the sales of these shirts occurred on 12 December 2018 after the application for revocation was filed on 19 November 2018, the Proprietor's breakdown of sales at EP5 indicated that the shirt was launched on 25 May 2018.
29. Again, I think this was a non-point.
30. The fact of the matter was that the Hearing Officer did take this into account (decision, para. 17) – I would add even though the amazon.co.uk listing at EP2 said that the shirt was first available on 28 November 2018.
31. Moreover, the Hearing Officer was clearly prepared to give the Proprietor the benefit of the three sales of the shirt despite these occurring after the revocation action was filed when she concluded that (allowing the Proprietor also to benefit from the sale of the one t-shirt): "... this would bring the total number of sales in relation to "shirts" as evidence[d] by the proprietor to 4. This is not, in my view, sufficient to establish genuine use".
32. It seemed to me that the third and fourth grounds of appeal amounted to arguments from different sides of the same coin. The third ground of appeal was that the Hearing Officer wrongly applied a *de minimis* rule; the fourth ground was that she failed to view the Proprietor's evidence in the round.
33. I reject these criticisms.
34. First, the Hearing Officer instructed herself, and was clearly aware that there was no *de minimis rule* of genuine use (decision paras. 9 – 10).
35. Second, the Hearing Officer rightly stated:

"11. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself ...".
36. The Proprietor suggested here that the Hearing Officer dismissed the Lookbooks. That is a misreading of the decision.
37. The Hearing Officer clearly took the Lookbooks into account but also noted that no information whatsoever had been supplied regarding their distribution (or I would add even their availability in the UK). That rightly in my judgment affected the weight she could properly afford to the Lookbooks in her global assessment of genuine use.
38. Linked to the above, the Proprietor sought to suggest at the appeal hearing, that the Proprietor's proven marketing of clothing other than shirts under and by reference to the CAMEL mark sufficed to establish that the Proprietor's use of CAMEL in relation to shirts was genuine.
39. Attractive though that argument might seem, it was of no assistance to the Proprietor.

40. There was no suggestion in the decision by the Hearing Officer that the Proprietor's proven use of CAMEL in relation to "shirts" was somehow sham or non-commercial.
41. The point was that in accordance with established law, that proven use was insufficient to prove genuine use of the registered goods, which were "shirts" as stated in the specification. That was a finding that the Hearing Officer was entitled to make, irrespective of any use the Proprietor might have shown in relation to other goods not within the specification.

Conclusion and costs

42. In the result the appeal has failed.
43. The Hearing Officer's decision to revoke Registration number 1015449 in its entirety with effect from 13 November 2010 must stand.
44. The Hearing Officer ordered the Proprietor to pay to the Applicant costs in the sum of £950 in relation to the revocation proceedings. I will order the Proprietor additionally to pay to the Applicant costs in the sum of £500 in respect of the appeal. The total sum of £1,450 is to be paid by the Proprietor to the Applicant within 28 days of the date of this decision.

Professor Ruth Annand, 14 December 2020

Mr Julius Stobbs of Stobbs appeared for the Proprietor/Appellant

Mr Matt Sammon of Sonder IP appeared for the Applicant/Respondent