

IN THE MATTER OF REGISTERED TRADE MARK NO. 2114931 IN THE
NAME OF TRIPP LIMITED

AND IN THE MATTER OF APPLICATION FOR REVOCATION THEREOF NO.
81931 BY PAN WORLD BRANDS LIMITED

DECISION

Introduction

1. On 10 November 2004 Pan World Brands Ltd (“the applicant”) applied to revoke UK registered trade mark number 2114931 (“the trade mark”) standing in the name of Tripp Ltd (“the proprietor”) for want of genuine use pursuant to section 46(1)(a) and (b) of the Trade Marks Act 1994. The trade mark consists of the word EXTREME registered on 27 June 1997 with effect from 6 November 1996 in respect of the following specification of goods in Class 18: “Luggage; travelling bags; travelling sets; handbags; purses; wallets; document covers; document cases; articles of leather; articles of imitation leather.”
2. After evidence had been filed and a hearing held, Mike Foley acting for the Registrar held in a written decision dated 5 December 2006 (O/342/06) that the trade mark should be revoked with effect from 9 November 2004. The proprietor appeals against the decision in so far as it relates to the registration of the trade mark for “luggage”. The proprietor accepts that the evidence does not show use of the mark in relation to goods other than “luggage”, and accordingly that the revocation of the trade mark should stand with respect to

the remainder of the specification. The applicant contends that revocation should take effect from 28 June 2002 rather than 9 November 2004.

Relevant provisions of the Trade Marks Act 1994 and the Trade Marks Rules 2000

3. Section 46 of the 1994 Act provides in relevant part as follows:
 - (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 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;...
 - (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 expiry of the five year period and before the application for revocation is made: ...
 - (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.
4. These provisions implement Articles 10(1), 12 and 13 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks. They correspond to Articles 15(1) and 50(1)(a),(2) of Council Regulation 40/94/EC of 20 December 1993 on the Community trade mark.
5. Section 100 of the 1994 Act provides:

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 it.
6. Rules 31 and 31A of the 2000 Rules (as amended) provide as follows:

- 31.(1) An application to the registrar for revocation of a trade mark under section 46, on the grounds set out in section 46(1)(a) or (b), shall be made on Form TM26(N) and be accompanied by a statement of the grounds on which the application is made.
 - (2) The registrar shall send a copy of the Form TM26(N) and the statement of the grounds on which the application is made to the proprietor.
 - (3) The proprietor shall, within three months of the date on which he was sent a copy of the Form TM26(N) and the statement by the registrar, file a Form TM8, which shall include a counter-statement, and be accompanied by-
 - (a) two copies of evidence of use of the mark; or
 - (b) reasons for non-use of the mark,otherwise the registrar may treat him as not opposing the application.
 - (4) The evidence of use of the mark shall-
 - (a) cover the period of non-use alleged by the applicant on Form TM26(N), or
 - (b) where the proprietor intends to rely upon section 46(3), show that use of the mark commenced or resumed after the end of that period but before the application for revocation was made.
 - (5) The reasons for non-use of the mark shall cover the period of non-use alleged by the applicant on Form TM26(N).
 - (6) The registrar shall send a copy of Form TM8 and any evidence of use, or reasons for non-use, filed by the proprietor to the applicant and the date upon which this is sent shall, for the purposes of rule 31A, be the 'initiation date'.
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- 31A.(1) The applicant may, within three months of the initiation date, file any evidence he may consider necessary to adduce in support of the grounds on which the application was made.
 - (2) Where the applicant files no evidence under paragraph (1), the registrar shall notify the proprietor that no evidence was filed.
 - (3) The proprietor may, within the relevant period, file such evidence as he may consider necessary to adduce in support of his case.
 - (4) The relevant period-
 - (a) where the applicant files evidence under paragraph (1), is the period beginning on the date on which a copy of the evidence is filed and ending three months after that date; or
 - (b) where the applicant does not file evidence under paragraph (1), is the period beginning on the date that the registrar sent the proprietor a notification under paragraph (2) that no evidence was filed and ending three months after that date.
 - (5) Where the proprietor files evidence under paragraph (3), the applicant may, within three months of such evidence being filed, file evidence in reply; such evidence shall be confined to matters strictly in reply to the proprietor's evidence.
 - (6) The registrar may at any time, if she thinks fit, give leave to either party to file evidence upon such terms as she thinks fit.

The statements of case and the evidence

7. The applicant's Form 26(N) stated that the application was based on both section 46(1)(a) and (b), that the five year period relied upon under section 46(1)(b) was "any uninterrupted 5 year period between 27 June 1997 and 9 November 2004" and that it wanted revocation to take effect from 9 November 2004. In its statement of grounds the applicant pleaded *inter alia*:

The Applicant has made investigations to ascertain whether the Trade Mark has been used from the date of registration and/or has been in use during the last five years. Such investigations have not revealed any genuine use of the Trade Mark from its grant date of 27 June 1997.

8. In its counterstatement the proprietor pleaded *inter alia*:

Under its former name of Equator PLC, Tripp used the EXTREME Trade Mark in respect of a range of goods in Class 18 from approximately 1997 to 2001 including use in respect of holdalls and other bags.

9. The counterstatement was accompanied by a witness statement made by David Moore of its trade mark attorneys Jensen & Son. I would comment that it is preferable for evidence of use of a trade mark to be given by a witness with first hand knowledge. If hearsay evidence is to be given, it must properly identify the source(s) of the information deposed to, which Mr Moore's statement did not. In the present case nothing turns on these points since the admissibility of Mr Moore's evidence was not objected to and it was subsequently corroborated by a witness who did have first hand knowledge.
10. The substance of Mr Moore's evidence was as follows:

Introduction to Tripp

4. Trip is a wholly owned subsidiary of Tripp Holdings Ltd. Tripp is a United Kingdom based designer and retailer of high quality luggage and travel goods, and supplies items of luggage bearing its brands within the United Kingdom and elsewhere.

5. Tripp was first incorporated in the United Kingdom in July 1988 under the name Banecourt Plc and began trading in luggage in and around 1990. It changed its name to Equator Plc on 28th March 1989. Subsequently, on 29 April 1993 it changed its name to Equator Group Plc.
6. Equator Group Plc ran into financial difficulties in the late 1990s and underwent a management buy-in at its banks insistence in May 2001. It changes its name to Greenwich-Group Ltd at that point in time. It was renamed Tripp Ltd recently on 22nd April 2003. Tripp now has 350 employees within the company. I attach as Exhibit DM1 an extract from Companies House showing this chain of title.
7. Having begun trading in 1990, Tripp, as a luggage designer and importer had grown from a wholesaler with half a dozen factory outlets into one of the UK's largest supplier [sic] of luggage, bags and accessories to the middle market principally through the concessions it operates in Debenhams stores in accordance with an exclusive arrangement between Tripp Ltd and Debenhams Plc. These comprise over 100 stores throughout the U.K. The exclusive relationship with Debenhams Plc has been operating for in excess of 12 years and is a relationship critical to the business. Tripp also operates 7 stand-alone factory outlets within the United Kingdom and Ireland in: Cheshire Oaks, Cheshire; Peak Village, the Peak District; Killarney, Southern Ireland; Boundary Mill, Lancashire; Whitley's, Bayswater, London; Barking, Essex and another in York.
8. For the purposes of this litigation, I now focus in detail upon Tripp's activities with respect to the Extreme brand.

The Extreme Brand

9. Tripp filed an application for EXTREME under No.2114931 for "Luggage; travelling bags; travelling sets; handbags; purses; wallets; document covers; document cases; articles of leather; articles of imitation leather"; which was registered on 27th June 1997.
10. EXTREME was an important product brand for Tripp from 1997 to 2000 and was used in relation to at least luggage and bags in that period. Following the change of ownership of the business, the product portfolio of the company was reviewed and the EXTREME range was discontinued in 2001 due to quality problems with the supplier. Unfortunately, the previous management of Tripp did not keep accurate or complete records. I attach as **Exhibit DM2** a copy of a poster used to advertise the EXTREME holdall in 2001 at a price of £35. The poster would at the very least have been displayed in the company [sic] own shops and in Debenhams stores and I believe also in the national press, where Tripp advertise from time to time.

11. Tripp sold its EXTREME branded luggage through the same Debenhams retail concessions and company owned outlets located throughout the entirety of the United Kingdom through which it supplies its Tripp and other branded products. I attach as **Exhibit DM3** some dispatch notes from the company archives showing that EXTREME branded products were sent from the main warehouse in Doncaster to the respective stores noted therein.

11. Exhibit DM2 consists of a copy of a poster bearing a photograph of a holdall. It is headed “‘Extreme’ by Equator” and also bears the statements “medium holdall £35” and “the luggage department”.

12. Exhibit DB3 comprises the following copy documents:
 - (1) Two documents headed “Secondary Pick List (Detailed) 179/0170”, one for “Pick Line: 55 A1744208300 Extreme Lrg Holdall Silver” and one for “Pick Line: 54 A1744008300 Extreme Med Holdall Silver”. Each document has columns headed “Order Number”, “Cust Name”, “Cust Town”, “Pick Location” and “Pick Quantity”. In each case there are six entries, five of which give the customer as “Equator Dept, Debenha[m]” in Oldham, Crawley, Barrow in Furness, Leeds and Stoke. The sixth entry in each case gives the customer as “Equator Luggage” in Trafford Park. The quantities range from a low of 1 to a high of 4. These documents are undated: comparison with the next two documents suggests that this is because they have been photocopied in such a way as to omit the portion bearing the date.

 - (2) Two documents of the same format as those described in subparagraph (1) above, but this time headed “Secondary Pick List (Detailed) 179/0171” and dated 6 September 2000. These documents have a larger number of entries. In each case the customer is given as “Equator Dept, Debenha[m]” in every entry bar one, where it is “Debenhams Milton Keynes”. Apart from Milton Keynes, in each case the towns listed are London, Northampton, Bedford, Nottingham, Wigan, Hull, Chester, Bournemouth, Eastbourne”. The quantities range from 1 to 13.

- (3) Two documents headed “Standard Pick List” which are in a different format to those described in sub-paragraphs (1) and (2) above. The first is dated “Printed 19-Jun-2001 To Ship 18-Jun-2001” and the second “Printed 20-Jun-2001 To Ship 20-Jun-2001”. Both documents identify the “owner” as “LMI”. The first document states “Deliver To:- Travel Accessories ... Killarney ... Ireland”. Amongst a long list of other goods are 10 Cases/Units of Product Code A19353010000 Description EXTREME SMALL HOLDALL BLK. The second document states “Deliver To:- Debenhams Luggage ... Glasgow ... Scotland ... ” Amongst a long list of other goods are 1 A23572084000 EXTREME LGE HOLDALL GRAPHITE, 3 A23573084000 EXTREME MED HOLDALL GRAPHITE, 3 A23574058000 EXTREME LGE HOLDALL ELEC BLUE and 3 A23575058000 EXTREME MED H/ALL ELEC BLUE.
- (4) A document headed “Archive Order Enquiry” dated “Sales Order Entry Date 14-Feb-01 ... Pick note Printed Date 19-Feb-01 ... Despatched Date 20-Feb-01 ... Archive Date 09-Feb-02”. Among other entries this includes entries for 23 A1935301000 EXTREME SMALL HOLDALL BLK, 21 A19354058000 EXTREME SM HOLDALL EL/BLUE, 10 A19355010000 EXTREME MED HOLDALL BLK, 17 A19356058000 EXTREME MED HOLDALL EL/BLUE, 9 A19357010000 EXTREME LGE HOLDALL BLK and 6 A19358058000 EXTREME LRG HOLDALL EL/BLUE.
13. The registry duly sent copies of the proprietor’s Form TM8, counterstatement and evidence to the applicant. By letter dated 23 May 2005 from the applicant’s trade mark attorneys to the registry, the applicant stated that it had elected not to file any evidence under rule 31A(1). The letter went on to express surprise that the evidence “has been accepted as discharging the necessary onus of [sic] the registered proprietor at this stage of the proceedings” and to make several detailed criticisms of Mr Moore’s witness statement and exhibits. In particular, the applicant argued that there was no

evidence to support Mr Moore's claims concerning the poster and queried the reference to LMI on the pick lists.

14. Subsequently the proprietor filed under rule 31A(3) a witness statement made by James McDiarmid, who identified himself as having been the proprietor's managing director since January 2001.
15. The substance of Mr McDiarmid's evidence was as follows:
 3. I should like to comment on the matters raised by the representatives of the Applicant for revocation in their letter of 23rd May 2005. Firstly I can confirm that the poster showing use of Extreme by Equator in respect of luggage exhibited at DM2 and re-exhibited at JM1 was used as point of sale advertising in our concessions in Debenhams and company shops in the period from January 2001 until the summer of 2001, when the Extreme luggage was discontinued.
 4. The dispatch notes refer to LMI as the owner of the goods. LMI stands for Luggage Manufacturing International and was an operating division of Tripp Ltd (then called Greenwich Group Ltd) and was not a separate company. At that time, the company was divided into several operating divisions responsible for different aspects of the company's business for internal manufacturing reasons. The dispatch notes are only exemplary of the shipments to two stores (our own store in Killarney and Debenhams in Glasgow). Shipments also took place to the other hundred or so stores we operated in at that time. I estimate that sales in 2000/1 were of the order of several hundred thousand pounds.
16. The applicant did not file any evidence in reply under rule 31A(5). Nor did it apply to cross-examine either Mr Moore or Mr McDiarmid.

The hearing officer's decision

17. Having summarised the evidence, in the operative part of his decision the hearing officer began by quoting sections 46 and 100 of the 1994 Act and then discussed the law by reference to *CARTE BLUE Trade Mark* [2002] RPC 31, Case T-39/01 *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market* [2002] ECR II-5233, *PHILOSOPHY DI ALBERTA FERRETTI Trade Mark* [2003] RPC 15, Case C-40/01 *Ansul BV v Ajax*

Brandbeveiliging BV [2003] ECR I-2439, *BUD Trade Mark* [2002] RPC 38 and *POLICE Trade Mark* [2004] RPC 35. He also referred to the decision of Blackburne J in *LABORATORIES DE LA MER Trade Mark* [2005] FSR 29; but surprisingly he did not refer either to the ruling of the European Court of Justice (Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-6469) or to the judgment of the Court of Appeal ([2006] FSR 5) overturning the decision of Blackburne J in that case.

18. The substance of the hearing officer's reasoning is contained in the following paragraphs in his decision:

24. Mr Edenborough made a number of criticisms of the evidence provided by the registered proprietors. In relation to Exhibit DM2 he argued that the claim to the poster having been used as point of sale advertising at the registered proprietors' concessions in Debenham's from January to the summer of 2001 cannot be correct because in May 2001 the corporate name was changed from Equator Group to Greenwich Group. I am not sure that Mr Edenborough has found an inconsistency in the registered proprietors' evidence. Mr Moore says that there was a 'management buy-in...in May 2001', and that the company changed its name '...at that point in time', which suggests that the name change followed the event, but this still means that the poster would have been in use up to May 2001, which to my mind is early summer. Mr Edenborough also submitted that the poster showed use of the mark 'EXTREME BY EQUATOR' which is not use of the mark as registered. The registered proprietors dispute this stating that based on *Elle* [1997] FSR 529 and *Bud* [2003] RPC 25, this is use in a form differing in elements that did not alter the distinctive character of the registered mark. The poster clearly says that the use is of the brand EXTREME by an entity trading as Equator; I do not see that the registrar or the public could see it any other way. I therefore take the view that the registered proprietors are correct. However, beyond the claims made in the Witness Statement there is nothing either on the poster or in any of the other evidence that supports that it was actually used when and where it is claimed.

25. Mr Edenborough also argued that an examination of the changes of corporate name support the contention that use of the EXTREME brand started some time around 6 November 1996, the date on which the trade mark was filed, but before 31 January 1997 (or soon thereafter), the time when the company changed its name. Mr Edenborough submitted that 'it does not make any sense to advertise a product under the name of a corporate vehicle that its bank has insisted undergoes a management buy-in ...It makes more commercial sense to stop promoting the old, bankrupt name, and to start building up a

goodwill in the new, freshly-financed name.’ Mr Edenborough may well be correct, but an assertion based on the argument that something cannot have happened because there is a more sensible alternative does not establish that it did not occur; there is no onus upon an owner of a trade mark to use it sensibly.

26. Where I have some sympathy with Mr Edenborough’s case is in the vague and often uncertain nature of the claims made in the Witness Statements provided by Mr McDiarmud [sic] and Mr Moore. To me, statements such as ‘The poster *would at the very least* have been displayed in the company’s own shops and in Debenhams ...*and I believe* also in the national press...’ suggest a degree of guesswork, whether educated or not I do not know because there is no background to these statements. There is a lack of corroborative evidence, be it as Mr Edenborough says, from third party sources such as an officer of Debenhams, or from the archive records of any of the national papers in which the proprietors’ advertised. Beyond the documentation provided in Exhibit DM3 to which I shall come next, there is scant evidence from the company’s own records, and nothing relating to the activities claimed, such as the design of the posters, or the instructions and resulting invoices relating to the placing of publicity in the press.
27. Mr Edenborough criticises the documents shown as Exhibit DM3 on three counts, namely, that if they show use this is internal use, which pursuant to the *Ansul* decision cannot count towards maintaining a registration, that there is no evidence that shows how the mark was used on the products themselves, and that they originate from an entity called LMI, stated to be an operating division of the Greenwich Group Ltd. Mr Edenborough also noted that the deliveries relate to Scotland and Ireland, and if held to be sufficient to maintain the registration, this should be reflected in any specification.
28. I consider there to be substance to Mr Edenborough’s criticisms, but to my mind it is the first of his points that highlights the real problem with the probative value of these documents. Most are described as ‘picking lists’ which I understand to be used by an organisation to compile orders from their stocks. Whilst they contain details that indicate an order is in the process of being fulfilled, they are clearly internal documents that in all probability would not be seen by anyone outside of the supplying company; I do not know one way or the other and it is not for me to guess.
29. The final documents [sic] is headed as being an ‘Archive Order Enquiry’, and appears to relate to an order placed in February 2001, *inter alia*, for EXTREME holdalls by an un-named customer. The document shows the status ‘complete’ and lists various actions by date, as follows:

Sales Order Entry Date 14-Feb-01
Start Due Date 14-Feb-01

Expected De/Booking Date 14-Feb-01
Allocated Date 19-Feb-01
Pick Note Printed Date 19-Feb-01
Pick Confirmed Date 20-Feb-01
Despatched Date 20-Feb-01
Actual Delivery Date
Depot Pod Keyed Date
Customer Pod Keyed Date
Invoiced Date
Cancelled Date

30. The date against 'Despatched' could be taken as showing that the goods listed had been loaded for transportation to the next step in the retail chain, and the status 'Complete' as an indication that they had been delivered. However, the absence of details beyond 'despatched' could also mean that there was no actual delivery and that the status 'Complete' is a reference to the order having been cancelled. Without the support of other paperwork such as invoices or delivery notes, there is nothing that shows that the goods on the pick lists or archived order ever took place. That some of the goods on these documents were described as being EXTREME does not necessarily mean that anyone outside of the company had knowledge of the name, and does not, with any certainty, show use of the mark in a market, be it from manufacturer to retailer, or manufacturer to end consumer. I would agree with Mr Edenborough; these documents cannot, of themselves, maintain the registration.
31. Mr Edenborough attacks Mr McDiarmid's statement in which he says '*I estimate that sales in 2000/1 were of the order of several hundred thousand pounds*' stating that there is not a single supporting invoice, and no explanation as to why. Mr Edenborough is of course correct, but I am just as, if not more troubled by the fact that the figure given is an 'estimate...of the order of...', with no explanation of the basis on which the estimate was made, and no idea of its accuracy. The explanation given in the written submissions is that the previous management did not keep 'accurate' or 'complete' records. If neither accurate or complete records are available, what did Mr McDiarmud use as the basis for his estimate?
32. The evidence of use provided by the registered proprietors 'suggests' that the registered proprietors have used the EXTREME mark in relation to various holdalls supplied to two traders within the relevant period, but in all areas goes only part way to providing the substance and certainty necessary to draw the inference that the mark has actually been used. There is no conclusive evidence showing that they have brought the mark to the attention of a trader, be it wholesaler or retailer, and a complete absence of evidence showing any use that would have impacted on the consumer or market. As was stated [by] Mr Justice Wilberforce in the *NODOZ* case [1962] RPC 1 at page 7 line 34 to 41:

‘The respondents are relying upon one exclusive act of user, an isolated act, and there is nothing else which is alleged or set up for the whole of the five year period. It may well be, of course, that in a suitable case one single act of user of the trade mark is sufficient; I am not saying for a moment that that is not so; but in a case where one single act is relied on it does seem to me that that single act ought to be established by, if not conclusive proof, at any rate overwhelmingly conclusive proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established.’

33. I appreciate that this is a case determined under the 1938 Trade Marks Act, but it seems to me to be just as appropriate to the requirements of today’s legislation.
34. **In summary, I determine that the registered proprietors have not used the trade mark within the meaning of Section 46(1)(a) or (b) of the Act, and that the registration should be revoked with effect from 9 November 2004.**

Standard of review

19. This appeal is a review of the hearing officer’s decision. Counsel were agreed that the hearing officer’s decision involved an assessment of the kind to which the approach set out by Robert Walker LJ in *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applied:

In such circumstances an appellate court should in my view 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.

A decision does not contain an error of principle merely because it could have been better expressed.

The law as to genuine use

20. Before turning to the proprietor’s appeal, it is convenient to begin by considering the relevant principles of law.

What constitutes genuine use?

21. In *Ansul*, the European Court of Justice held as follows:

35. ... 'Genuine use' therefore means actual use of the mark....
36. '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...
37. It follows that 'genuine use' of the mark 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. The protection the mark confers and the consequences of registering it in terms of its enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.
38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.
39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.

22. In *La Mer* the ECJ held as follows:

21. ... it is clear from paragraph [39] of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive even if that use is not quantitatively significant. Even

minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case by case assessment which it is for the national court to carry out....
 24. In addition, use of the mark by a single client which imports the products for which the mark is registered 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 of the mark.
 25. In those circumstances it is not possible to determine *a priori*, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down.
23. These principles were re-iterated by the ECJ in Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market* [2006] ECR I-4237 at [70]-[72] and by Advocate General Sharpston in her Opinion in Case C-234/06 *Il Ponte Finanziaria SpA v Office for Harmonisation in the Internal Market* (unreported, 29 March 2007) at [68]. It is therefore clear that “genuine use” represents a qualitative, not a quantitative, criterion. The essential question is whether the trade mark has been used to create or maintain a share in the market for the goods or services in respect of which the mark is registered. A quantitatively small amount of use may suffice for this, but use which is merely for the purpose of preserving the registration or merely internal to the proprietor’s undertaking will not.

Burden of proof

24. There was some debate at the hearing before me as to the incidence of the burden of proof. In my judgment the position is as follows. The legal burden of proving that the requirements for revocation under section 46(1)(a) or (b) are met lies on the applicant for revocation. By virtue of section 100, however, the evidential burden of showing what use has been made of the mark lies

upon the proprietor. Similarly, by virtue of rule 31(3)(a), if the mark has not been used, the evidential burden of showing what the reasons for non-use are lies upon the proprietor. The evidential burden may shift during the course of the proceedings: if, for example, the applicant for revocation were to accept that the proprietor's evidence showed use of the trade mark but to contend that the use was not genuine because it was purely for the purpose of preserving the registration, then the evidential burden of showing that that was the case would lie upon the applicant (although the applicant might be able to discharge that burden by relying upon the proprietor's own evidence). Finally, once the evidence is complete, the tribunal should not decide whether there has been genuine use, or proper reasons for non-use, purely on the basis that the party bearing the burden of proof has not discharged that burden unless it cannot reasonably make a finding in relation to that issue despite having striven to do so: see *Stevens v Cannon* [2005] EWCA 222 at [46].

Procedure under rules 31 and 31A

25. In *MOO JUICE Trade Mark* [2005] EWHC 2584 (Ch), [2006] RPC 18 Kitchin J had to consider what was required of a trade mark proprietor by rule 31(3)(a). He said at [16]:

To my mind the requirement laid down by r. 31(3) is not therefore satisfied by a proprietor who simply asserts, through a relevant witness, that the trade mark has been used. Such a bare assertion would provide no evidence as to the actual use made by the proprietor. The evidence must provide a sufficient explanation of how the mark for the tribunal has been used for the tribunal to conclude that the proprietor has an arguable defence to the application. I respectfully agree with Mr Geoffrey Hobbs QC, sitting as the appointed person, in *YORK Trade Mark* (Decision O-191-05 of 1 July 2005) when he said, at [10]:

‘The purpose of rule 31(3) is to allow the Registrar to make an order for revocation if it does not appear from information provided in the manner prescribed by rule 31(2) [now rule 31(3)] that the proprietor has a viable defence to the pleaded allegation(s) of non-use.’

Conversely, however, the evidence does not have to be so persuasive that, if unanswered, it would necessarily discharge the burden of proof lying upon the proprietor. The scheme which I have summarised

clearly contemplates that the proprietor should have an opportunity to supplement its evidence even if the applicant for revocation chooses to file no evidence. The purpose of the evidence under r. 31(3) is to establish that the proprietor has an arguable or viable defence to the attack mounted upon the registration and to provide the applicant for revocation with sufficient information to enable him to investigate the use of the mark upon which the proprietor chooses to rely.

26. Basing herself upon the last sentence of this passage, counsel for the proprietor submitted that, if a proprietor filed evidence under rule 31(3) which established an arguable case of use of the trade mark and the applicant for revocation did not file any evidence under rule 31A(1), then it would be very difficult for the application to succeed. In my judgment this submission goes too far: as I believe Kitchin J makes clear, the fact that the proprietor's evidence establishes an arguable defence to the application does not necessarily mean that the defence will succeed if the evidence is unchallenged.
27. On the other hand, I consider that counsel for the proprietor was right to emphasise that the procedure gives the applicant the opportunity to investigate and challenge the proprietor's rule 31(3) evidence. Furthermore, where, as in the present case, the proprietor files a further round of evidence under rule 31A(3), the applicant has a second opportunity to investigate and challenge the proprietor's evidence. Still further, even if the applicant chooses not to file any evidence in response, it has the opportunity in an appropriate case to cross-examine the proprietor's witness(es) at the hearing.
28. I would add that I regard this procedure as consistent with my analysis of the burden of proof in paragraph 24 above, and in particular as confirming that the evidential burden may shift during the course of the proceedings and that deciding whether or not there has been genuine use purely on the basis of the burden of proof should be the counsel of last resort.

Standard of proof

29. The standard of proof is the ordinary civil standard of proof upon the balance of probabilities. In *LABORATOIRE DE LA MER Trade Marks* [2002] FSR 51 at [9] Jacob J said:

Those concerned with proof of use should read their proposed evidence with a critical eye – to ensure that use is actually proved – and for the goods and services of the mark in question. All the t’s should be crossed and all the i’s dotted.

This remains wise advice. Jacob J did not suggest, however, that the standard of proof was anything other than the normal standard.

30. *NODOZ Trade Mark* was a decision under section 26(1)(b) of the Trade Marks Act 1968. In that case the applicant for rectification had adduced positive evidence, which included independent evidence from a prominent representative of the relevant trade, that the trade mark had not been used by the proprietor. As the passage from the judgment quoted by the hearing officer shows, the proprietor relied upon a single isolated transaction as showing that there had been *bona fide* use of the trade mark during the relevant period. Furthermore, the transaction was alleged to consist of the supply of pharmaceutical tablets to an individual resident in Britain directly by a US supplier, and there was no evidence that the tablets or an accompanying invoice had actually arrived. It was specifically in that context that Wilberforce J said that “if not conclusive proof, at any rate overwhelmingly convincing proof” was required (a statement which the hearing officer misquoted in his decision). In my judgment this statement is an application of the general principle that, when applying the standard of proof on the balance of probabilities, the less probable the event alleged, the more cogent the evidence must be to demonstrate that it did indeed occur: see *Re H (Minors)* [1996] AC 563 at 586. I consider that the hearing officer was correct to say that this principle is equally applicable under section 46(1) of the 1994 Act. Whether he was correct to regard it as applicable to the present case I shall consider below.

What constitutes evidence of use?

31. Basing himself upon the first three sentences of the passage I have quoted from *MOO JUICE*, counsel for the applicant submitted (1) that a mere assertion of use of a trade mark by a witness did not constitute evidence of use sufficient to defeat an application for non-use, and (2) it followed that mere testimony from a representative of the proprietor was not enough and such testimony had to be supported either by documentary records or corroborated by an external witness. I accept submission (1) but not submission (2). Kitchen J's statement that "bare assertion" would not suffice must be read in its context, which was that it had been submitted to him that it was sufficient for the proprietor to give evidence stating "I have made genuine use of the trade mark". A statement by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark has been used would not in my view constitute bare assertion. As counsel for the applicant accepted, it might not be possible for a trade mark proprietor to produce documentary evidence: for example all the records might have been destroyed in a fire. In such circumstances I do not see anything in either the Directive, the 1994 Act or the 2000 Rules which would require the proprietor to adduce evidence from an external witness (which is not to say that it might not be advisable for the proprietor to do so).

32. In this respect it is important to note that, as counsel for the applicant rightly conceded, the position in OHIM is different. This is because Rule 22(2) and (3) of Commission Regulation 2868/95 of 13 December 1995 implementing the Community trade mark regulation provide:
 - (2) The indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with paragraph 3.
 - (3) The evidence shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 76(1)(f).

Rule 22(3) makes documentary records the primary form of evidence required for proof of use in OHIM. In these circumstances it is understandable that the jurisprudence of the Court of First Instance and of the Boards of Appeal indicates that witness statements from representatives of the proprietor unsupported by documentary records or external evidence should be given little weight.

Unchallenged evidence

33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.

This rule [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficulty in submitting that the evidence should be rejected.

However the rule is not an inflexible one...

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [2005] EWCA Civ 267, [2005] RPC 31 at [59]-[60].
35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is

not obliged to accept a witness's evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.
37. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] BusLR 864 and *EINSTEIN Trade Mark* (O/068/07). Another recent example is *Scholl Ltd's Application* (O/199/06). I consider that hearing officers should guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically).

The appeal

38. The proprietor contends that the hearing officer erred in principle in four main respects. First, he disbelieved or discounted unchallenged evidence of the proprietor which he was not entitled to do. Secondly, he misinterpreted or misapplied the reference to "internal use" in *Ansul*. Thirdly, he misinterpreted *NODOZ* and applied an incorrect standard of proof. Fourthly, he failed to

assess the evidence as a whole. In my judgment each of these contentions is well-founded for the following reasons.

39. So far as the first point is concerned, I consider that the hearing officer fell into the trap identified in paragraph 37 above. Two examples of this stand out. First, in paragraphs [24] and [26] of his decision the hearing officer discounted the proprietor's evidence concerning the poster. Mr McDiarmid expressly confirmed, however, that the poster was displayed as point of sale advertising in Debenhams' and the proprietor's own shops in 2001. That was wholly unchallenged evidence from a witness with knowledge of the facts supported by the exhibition of a copy of the document in question. The applicant was not entitled to invite the hearing officer to disbelieve that evidence, nor was he entitled to dismiss it.
40. Secondly, in paragraph [31] of his decision the hearing officer discounted the proprietor's evidence concerning the sales of EXTREME holdalls. Again, however, Mr McDiarmid gave evidence that the sales in 2000/1 were of the order of several hundred thousand pounds. The hearing officer criticised this evidence on the basis that it was unsupported by any invoices, that there was no explanation of the basis on which the estimate was made and that one could have no idea of its accuracy.
41. So far as the first criticism is concerned, the proprietor's evidence explained that it sold goods through its own retail stores and through concessions in Debenhams. As counsel for the applicant accepted, a concession is a well-known trading arrangement in which a supplier operates a store within a store and thereby sells direct to the consumer. It follows that there would not have been any invoices from the proprietor to the retailers.
42. As to the second criticism, in my judgment the basis on which Mr McDiarmid's estimate was made is perfectly clear from his evidence, namely he was the proprietor's managing director at the relevant time. He was therefore in a position to give an estimate of sales from his own knowledge. In giving that estimate he will have been able to take into account among other

things (i) the fact that, as he explained, the proprietor had sold the holdalls through about a hundred stores, (ii) the fact that the holdall was an existing line of the proprietor's and (iii) the snapshots of quantities given by the documents in exhibit DM3. As Mr Moore had previously explained, proper records which could be used to give a more detailed estimate had not been kept.

43. As to the third criticism, Mr McDiarmid was careful to indicate the accuracy of his estimate by saying that sales were "of the order of several hundred thousand pounds". Clearly he was not able to be more precise. In any event, however, in the circumstances of this case the precision of the estimate is beside the point. Even if it is supposed that Mr McDiarmid's estimate might have been out by an order of magnitude, that would still mean sales of the order of several tens of thousands of pounds, which would be quite sufficient to demonstrate genuine use.
44. Each of these criticisms should have been put by the applicant to Mr McDiarmid in cross-examination if it wished to advance them. In the absence of cross-examination, the applicant was not entitled to invite the hearing officer to disbelieve Mr McDiarmid's evidence, nor was the hearing officer entitled to discount it.
45. Turning to the proprietor's second point, the hearing officer concluded in paragraph [30] of his decision that the documents in exhibit DM3 could not maintain the registration on the ground that they merely showed use of the trade mark internal to the proprietor. So far as the appearance of the word *EXTREME* on the documents themselves is concerned, that might be so (it might not, since copies of such documents might have gone to the stores and in the light of the decision of the Court of Appeal in *LABORATOIRE DE LA MER* that might count as genuine use; but, as the hearing officer rightly pointed out, the proprietor's evidence fails to say whether this was so or not). The real point of exhibit DM3, however, is that it constitutes contemporaneous documentary support for the proprietor's evidence that quantities of *EXTREME* holdalls were sent to shops, including a number of branches of

Debenhams, for retail sale. Thus it is not merely evidence of use internal to the proprietor, but also corroborates evidence of use external to the proprietor.

46. As to the proprietor's third point, in my judgment the approach articulated by Wilberforce J in *NODOZ* is not applicable to the present case. This is not a case where there is any positive evidence of non-use from the applicant. On the contrary, the applicant twice failed to file evidence in response to the proprietor's evidence. Nor is this a case where the proprietor is relying upon a single isolated transaction of an unusual character during the relevant five years. On the contrary, the proprietor is relying upon substantial sales through mainstream retail outlets over a four year period. Accordingly, in requiring the proprietor to provide "certainty" and "conclusive evidence", the hearing officer imposed an incorrect standard of proof.
47. As to the proprietor's fourth point, the hearing officer's approach was a molecular one of considering each item of evidence individually. He failed to step back and consider the evidence as a whole to see what facts it established. This is illustrated by his approach to exhibit DM3 which I have already commented on.
48. Overall, it appears from paragraph [32] of his decision that the hearing officer's conclusion was that the proprietor had not satisfactorily established that it had used the trade mark at all and that there was "a complete absence of any evidence showing any use that would have impacted on the consumer or market". In my judgment this conclusion was plainly wrong.
49. Looking at the evidence as a whole, I am in doubt that it establishes that there were substantial retail sales by the proprietor and by Debenhams of large, medium and small holdalls in four colourways under the trade mark during the period 1997-2001. It is fair to say that the evidence is not explicit that the holdalls had the trade mark actually affixed to them; but I consider that that is the fair reading of Mr Moore's evidence, and in particular his references to "EXTREME branded luggage" and "EXTREME branded products" in paragraph 11 of his statement. In any event, the evidence is clear that the

holdalls were advertised and sold by reference to the trade mark, in particular by means of the poster. Accordingly, in my judgment the proprietor has demonstrated genuine use of the trade mark in relation to holdalls during the relevant periods. I would comment that the proprietor's evidence could have been better, and if it had been no doubt this dispute would have been resolved in the proprietor's favour at an earlier stage, but nevertheless it was sufficient.

50. Counsel for the applicant argued, particularly by reference to the poster, that, if there was genuine use at all, it was genuine use of the mark EXTREME BY EQUATOR rather than of the trade mark. In my judgment the hearing officer was right to reject this argument for the reasons he gave in paragraph [24] of his decision.

Partial revocation

51. The proprietor accepts that the registration must be partially revoked pursuant to section 46(5). The question which arises is as to the scope of the revised specification. As noted above, the proprietor contends that the registration should be maintained so far as it relates to "luggage". The applicant contends that, if there has been genuine use of the trade mark, it is only in relation to holdalls and accordingly the specification should be restricted to "holdalls".
52. I considered the principles applicable under section 46(5) at some length in *NIRVANA Trade Mark* (O/262/06) at [36]-[59]. Since then the CFI has given judgment in *Case T-256/04 Mundipharma AG v Office for Harmonisation in the Internal Market* (unreported, 13 February 2007). In that case the opponent's mark was registered in respect "pharmaceutical and sanitary preparations; plasters". The applicant did not dispute that the mark had been used in relation to "multi-dose dry powder inhalers containing corticoids, available only on prescription" and the Board of Appeal found that the opponent had only proved use of the mark in relation to those goods. On appeal to the CFI the opponent contended *inter alia* that use should be taken to have been proven in relation to "therapeutic preparations for respiratory illness". The CFI upheld this contention.

53. In its judgment, having recapitulated paragraphs [45] and [46] of its judgment in Case T-126/03 *Reckitt Benckiser (España) SL v Office for Harmonisation of the Internal Market (ALADIN)* [2005] ECR II-2861 and recorded that it was not disputed that the mark had been used in relation to “multi-dose dry powder inhalers containing corticoids, available only on prescription”, the CFI went on:

26. Next, it should be borne in mind that the earlier mark was registered for ‘pharmaceutical and sanitary preparations; plasters’. That category of goods is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently. Consequently, the fact the earlier mark must be regarded as having been used for ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’ confers protection only on the sub-category within which those goods fall.
27. In the contested decision, the Board of Appeal held that the earlier mark was to be taken into consideration only in so far as it covered goods the genuine use of which was not contested. It thus defined a sub-category corresponding to those goods, namely ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’.
28. That definition is incompatible with Article 43(2) of Regulation No 40/94, as interpreted in the light of *ALADIN*, and applicable to earlier national marks pursuant to Article 43(3) of that regulation.
29. The Court notes in this respect that, since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product or service in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a sub-category of goods or services.
30. The purpose and intended use of a therapeutic preparation are expressed in its therapeutic indication. However, the definition employed by the Board of Appeal is not based on that criterion as it does not state that the goods in question are intended for the treatment of health problems and does not specify the nature of those problems.
31. Moreover, the criteria chosen by the Board of Appeal, namely the dosage form, the active ingredient and the obligation to obtain a doctor’s prescription, are, as a rule, inappropriate for defining a sub-category of goods as contemplated in *ALADIN*, as the application of those criteria does not fulfil the abovementioned criteria of purpose and intended use of the goods. In fact, a given medical condition can often be treated using a number of types of medication with different

dosage forms and containing different active ingredients, some of which are available over-the-counter whilst others are available only on prescription.

32. It follows that, in failing to take into account the purpose and intended use of the goods in question, the Board of Appeal made an arbitrary choice of sub-category of goods.
 33. For the reasons set out in paragraphs 29 and 30 above, the sub-category of goods covering those the genuine use of which has not been contested must be determined on the basis of the criterion of therapeutic indication.
 34. The sub-category proposed by the intervener, namely 'glucocorticoids', cannot be accepted. That definition is based on the criterion of the active ingredient. As discussed in paragraph 31 above, such a criterion is not generally appropriate by itself for defining sub-categories of therapeutic preparations.
 35. By contrast, the definition proposed by the applicant and OHIM, namely 'therapeutic preparations for respiratory illnesses', is appropriate in two ways: first, it is based on the therapeutic indication of the goods in question and, second, it allows for the definition of a sufficiently specific sub-category, as contemplated in *ALADIN*.
 36. In the light of the foregoing, the Court finds that the earlier mark must be deemed to have been registered, for the purposes of the present case, for 'therapeutic preparations for respiratory illnesses'.
54. Although at first blush this suggests an approach which is somewhat different to that laid down by the English authorities considered in *NIRVANA*, I consider that the difference is smaller than might appear. The essence of the domestic approach is to consider how the average consumer would fairly describe the goods in relation to which the trade mark has been used. Likewise, paragraph [29] of *Mundipharma* indicates that the matter is to be approached from the consumer's perspective.
55. To the extent that there is a difference between them, I remain of the view expressed in *NIRVANA* that I am bound by the English authorities interpreting section 46(5) of the 1994 Act and Article 13 of the Directive and not by the CFI's interpretation of Article 46(2) of the CTM Regulation since, as already noted above, there are differences between the two legislative contexts. Nevertheless I consider that English tribunals should endeavour to follow the

latter so far as it is open to them to do so. *Mundipharma* suggests that, within the spectrum of domestic case law, the slightly more generous approach of Jacob J in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch), [2004] FSR 19 is to be preferred to the slightly less generous approach of Pumfrey J in *DaimlerChrysler AG v Alavi* [2001] RPC 42.

56. Applying these principles to the present case, counsel for the proprietor submitted that a holdall was an item of luggage and would be so described by the average consumer having regard to its purpose and intended use and that it was not appropriate to attempt to sub-divide “luggage” into narrower sub-categories. With some hesitation, I have come to the conclusion that I accept these submissions.

Date of revocation

57. The hearing officer revoked the registration with effect from 9 November 1994 as had been requested by the applicant in its Form TM26(N). In his skeleton argument for the hearing before me counsel for the applicant submitted (as he had submitted to the hearing officer) that revocation should take effect from 28 June 2002. The applicant did not, however, file any notice of appeal against the hearing officer’s decision, nor did the applicant serve any respondent’s notice or otherwise notify the proprietor that it intended to take this point prior to exchange of skeleton arguments.
58. In *ACADEMY Trade Mark* [2000] RPC 35 at [34]-[35] Simon Thorley QC sitting as the Appointed Person held that the Appointed Person has inherent jurisdiction to permit the respondent to an appeal to serve a respondent’s notice including a cross-appeal. I agree with Mr Thorley that, so far as service of a respondent’s notice seeking to maintain the hearing officer’s decision on additional or alternative grounds is concerned, the Appointed Person has inherent jurisdiction to permit this. As I have previously indicated in *Mustafov’s Application* (O/218/05), I consider that such a respondent’s notice should be served 14 days after service of the notice of appeal. In the present case that was not done, but I am satisfied that the proprietor was not

prejudiced by the applicant's failure to serve a respondent's notice in a timely manner. Accordingly I am prepared to permit the applicant to do so out of time. I have therefore dealt with the applicant's argument that the hearing officer's decision should be affirmed on the ground considered in paragraph 50 above.

59. So far as a cross-appeal seeking to vary the hearing officer's decision is concerned, however, I have to say that I am not convinced that I do have jurisdiction to permit a respondent who has not filed a notice of appeal in accordance with the Rule 63 of the 2000 Rules to cross-appeal by means of a respondent's notice, particularly when no respondent's notice has actually been served. It is not necessary to express a conclusion on this point, however, since even if I do have jurisdiction to allow the applicant to contend that the hearing officer's decision should be varied so as to provide for revocation with effect from 28 June 2002, I have concluded that that contention should be rejected. My reasons are as follows.

60. In *Omega SA v Omega Engineering Inc* [2003] EWHC 1334 (Ch), [2003] FSR 49 at [11] Jacob J held that:

If a party wants revocation to take effect from a date earlier than the date of application for revocation, in my judgment, it should set out what date it wants and explicitly allege that the grounds for revocation existed at an appropriate earlier date.

Jacob J went on to observe that it was a little unfortunate that Form TN26(N) did not itself provide for the applicant to identify the date from which revocation was sought. Since then Form TM26(N) has been changed so that it does provide for this.

61. As noted above, in the present case the applicant completed Form TM26(N) by specifying 9 November 2004 as the date from which it wanted revocation to take effect. It did not seek revocation from any earlier date; nor did it explicitly allege that grounds for revocation existed at an earlier date. The applicant did not apply to amend its Form TM26(N) at any stage. Counsel for

the applicant submitted that it was implicit from the applicant's reliance upon section 46(1)(a) that it was alleging that grounds for revocation existed as at 28 June 2002 and therefore was seeking revocation as of that date. I do not accept this. In my judgment the Form TM26(N) is internally inconsistent: on the one hand it expressly invokes section 46(1)(a), which would justify revocation with effect from 28 June 2002; but on the other hand the only date from which revocation is sought is 9 November 2004. Given the applicant's failure to comply with the guidance given in *Omega*, I consider that the proprietor and the hearing officer were entitled to resolve this inconsistency by relying upon the statement that revocation was sought from 9 November 2004. One would expect the applicant to have specified the earliest date of interest to it. The applicant might not have had any commercial interest in seeking revocation with effect from earlier than 9 November 2004 e.g. because it was trying to clear the way for future use of the trade mark. If so, the five year period of most relevance to it would be that prior to 9 November 2004. This is particularly so given that the effect of section 46(3) is that it would not avail the applicant to establish non-use within the period covered by section 46(1)(a) if the proprietor were to show that it had commenced use after that period and before the application was made.

62. Finally, counsel for the applicant also submitted that the hearing officer should in any event have ordered revocation with effect from 10 November 2004, rather than 9 November 2004, in view of the applicant's reliance on any five year period "between 27 June 1997 and 9 November 2004". I do not agree. Even assuming that this is a legitimate way for an applicant to identify the periods relied upon for a non-use attack, as to which I shall express no opinion, I consider that the hearing officer was entitled to interpret this when read in conjunction with the requested revocation date as specifying at least the five year period ending on the day before 9 November 2004. That interpretation accords with the approach to calculation of the date for revocation set out in the Registrar's Tribunal Practice Notice 1/2007.

Conclusion

63. The appeal is allowed. Accordingly the application for revocation will be dismissed so far as the registration of the trade mark in respect of “luggage” is concerned, but the trade mark will be revoked with respect to the remainder of the specification of goods with effect from 9 November 2004.

Costs

64. The hearing officer ordered the proprietor to pay the applicant the sum of £1,450 as a contribution to its costs. I shall set aside that order. Bearing in mind that the applicant has succeeded in achieving partial revocation of the trade mark, but that the proprietor has prevailed on the main ground of contention, I shall order the applicant to pay the proprietor the total sum of £2,000 as a contribution to its costs of the proceedings at first instance and on appeal.

7 June 2006

RICHARD ARNOLD QC

Kathryn Pickard, instructed by Jensen & Son, appeared for the proprietor (appellant).
Michael Edenborough, instructed by Barlin Associates, appeared for the applicant (respondent).