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APPLICATION NO 500 524

BY CALICO LLC TO REVOKE TRADE MARK NO 2 363 435

FOR THE WORD MARK CALICO

IN THE NAME OF CALICO GLOBAL PTY LTD

FOR NON USE

Background and pleadings

1. Calico Global Pty Ltd is the registered proprietor of trade mark registration No 2 363 435 consisting of CALICO. The trade mark was filed on 17 May 2004 and completed its registration procedure on 12 November 2004. It is registered in respect of the following services:

Class 41

Education; providing of training; entertainment; sporting and cultural activities; includes the provision of on-line electronic publications and digital music (not downloadable) from the Internet, health club and gym services, health club and fitness services, provision of advice regarding exercise.

Class 44

Medical services: veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; includes medical analysis for the diagnosis and treatment of persons (such as X-ray examinations and taking of blood samples), pharmacy advice, provision of advice and information regarding health and nutrition.

2. Calico LLC seek revocation of the trade mark registration on the grounds of non use based upon Section 46(1)(a) and (b) of the Trade Marks Act 1994. Calico Global Pty Ltd filed a counterstatement denying the claim and asserting that its trade mark has been used during the relevant periods.
3. Revocation is sought under Section 46(1)(a) in respect of the 5 year time period following the date of completion of the registration procedure, namely 12 November 2004 to 12 November 2009. Revocation is therefore sought from 13 November 2009. Revocation is also sought under Section 46(1)(b) in respect of the time period 1 August 2009 to 31 July 2014. Revocation is therefore sought from 1 August 2014.
4. Only the registered proprietor filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Legislation

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

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

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

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

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

(d).....
.....

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

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

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

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

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

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

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

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

6. Section 100 is also relevant, which reads:

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

7. In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

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

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

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(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

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

8. Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that "*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*". The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

Evidence filed

9. This is a witness statement from Jack Owens, director of Calico Global Pty Ltd, the Registered Proprietor. He explains that CALICO was founded in 2004 and is a web based health and wellness company focussed on diet, fitness, healthy ageing and disease prevention. It provides a health platform that delivers online health diagnosis, consultation, fitness and nutrition programs and tools, to help participants live longer and healthier lives. Information/advice from experts is provided together with wearable technology and health and fitness tools for mobile and computer devices. The latter measure aspects of health by age, gender and location, and calculates health targets for consumers. The following relevant information is contained in the witness statement:

- From August 2009 to February 2012, the registered proprietor's website was MyCalico.com which now operates as the website of the Calico mobile app (having been superceded as a feature site by CalicoHealth.com and Calico.com.au) . MyCalico.com is accessed by consumers in the UK and

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exhibit 1 shows visitors numbers from the UK between the aforementioned dates. This is around 581 visits (around 3-4%).

- CalicoHealth.com used by consumers in the UK has been in operation since May 2014 to the present day. Before the launch of this website, UK customers transitioned from the MyCalico.com website and accessed and used the Calico.com.au, launched in February 2012. Exhibit 2 are excerpts showing visiting numbers during the period 1 September 2011 to July 31 2014. UK visits make up about 3-4% (about 1100 web visits) during this period. Exhibit 3 is a screen capture showing an example of a UK member of the Calicohealth.com website who had accessed the website in September 2012.
- Exhibit 4 shows a number of articles published on the Calicohealth.com website during the relevant period. These are general advice articles with access to direct advice from a Calico professional to a Calico member. It is alleged that all these services have been accessed by members in the UK.
- Exhibit 5 is screen shots taken between November 2011 and June 2014 showing biometric tools available on the website such as a body mass index calculator. Exhibit 6 provides similar information in respect of the MyCalico.com website on a few dates in 2009 and 2011.
- The Calico mobile application launched in October 2013 monitors workouts, stores the details of past workouts, sets fitness goals etc. It also provides a weight management tool and connects users with others in the community. The app includes an activity tracker and a digital music player. Exhibit 8 shows the content of an email advertising campaign in April 2013 with 2.8% of people who opened that advertisement on that day being in the UK.
- Exhibit 8 also includes reports from iTunes showing downloads of the app during 2012-2014. There were approximately 1,600 downloads per year with Europe being the second most popular continent and within that, the UK being the most popular territory. According to the Registered Proprietor, this amounts to at least a few dozen downloads being in the UK. Exhibit 8 also shows the Calico app as being one of the top apps on myhealthapps.net, a UK based website on 11 January 2014.

10. In considering the evidence filed, it is clear that it does suffer from a number of defects. As the Applicant points out, the vast majority of use of the trade mark under challenge has been in respect of Australia. The use of the mark made in respect of UK consumers has been small and true context such as market share is lacking. On the other hand, it is noted that the Registered Proprietor has engaged in promotional activity in respect of its mark aimed at UK consumers. An example of this is provided via an email advertising campaign in respect of its downloadable application for mobile devices which was opened by people in the UK. Further there is evidence that the application was downloaded by consumers in the UK. Information is also provided regarding the geographical spread of visitors within the UK and several counties and cities are included. Visitor numbers to the Registered Proprietor's website(s) are provided. They are small but can also be described as steady and use of the mark need not be quantitatively significant for it to be deemed genuine. Minimal use can qualify as genuine. Further, the use requirement in trade mark proceedings is not designed to assess commercial success or to restrict protection only to those marks which have been used on a large scale commercially. It is true that not all commercial use is deemed to be genuine use. However, taking into account all of the evidence filed, considered in totality, it is considered that it does

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show that there has been genuine use of the challenged trade mark in the UK during the second relevant period.

11. However, the evidence filed by the opponent does not show genuine use of the trade mark in connection with all the services covered by the challenged trade mark. As such, one must arrive at a fair specification that reflects the use made. In this regard, the following guidance is helpful:

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

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

In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a picky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to

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the appropriate specification having regard to the use which has been made.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

12. The services in Class 41 will be considered first of all. It is noted that the services for which the challenged trade mark is registered is in respect of the class headings. These are by their very nature, broad terms. It is considered that use has, on balance, been shown in respect of the *provision of advice regarding exercise*. Though this is included within the broad term *education* it would be unfair to accept that such use qualifies the registered trade mark for protection for the whole of the wider term. As such, a fair specification is considered to a limitation to *the provision of advice regarding exercise*.

13. In Class 44, once again, very broad terms are present such as *Medical services*. It is noted that part of the services provided under the challenged mark are at least pseudo diagnostic as they are assessment tools. An example is a Body Mass Index Calculator. However, it would be unfair to extrapolate this to qualify as protection for

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medical services as a whole. Rather, such tools should be seen in their proper context, which is in respect of health and nutrition advice. As such, it is considered that the Class 44 services be limited to *the provision of advice and information regarding health and nutrition*. It is this service that has been, on balance, shown to have been provided.

14. The sum of all this is that based on the evidence filed, the mark under challenge has only been used in respect of the following services:

Class 41:

The provision of advice regarding exercise.

Class 44:

The provision of advice and information regarding health and nutrition.

15. The mark will therefore be revoked in respect of the remaining services:

Class 41

Education; providing of training; entertainment; sporting and cultural activities; includes the provision of on-line electronic publications and digital music (not downloadable) from the Internet, health club and gym services, health club and fitness services.

Class 44

Medical services: veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; includes medical analysis for the diagnosis and treatment of persons (such as X-ray examinations and taking of blood samples), pharmacy advice.

Conclusion – Non use

16. The Registered Proprietor has only provided use from August 2009 in respect of a limited range of services as already outlined. In respect of those services for which no use has been shown (also outlined above), the registration will be revoked with effect from the earliest date from which the Applicant sought revocation. This is 13 November 2009. The following services remain registered:

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Class 41:

The provision of advice regarding exercise.

Class 44:

The provision of advice and information regarding health and nutrition.

COSTS

17. Both parties have achieved a measure of success in these proceedings, though it is clear that the applicant for revocation has been proportionally more successful than the registered proprietor. In the circumstances I award the applicant for revocation the sum of £650 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Revocation fee - £200
Preparing statement of case – £200
Considering other side's evidence - £250

TOTAL: £650

18. I therefore order Calico Global Pty Ltd to pay Calico LLC the sum of £650. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of June 2015

Louise White

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