

O-167-16

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 1503214B
FOR THE TRADE MARK



IN THE NAME OF LOOK CYCLE INTERNATIONAL
AND THE APPLICATION FOR REVOCATION THERETO
UNDER NO 83987
BY IPC MEDIA LIMITED

BACKGROUND

1) Look Cycle International is the registered proprietor (hereafter “the proprietor”) of trade mark registration No. 1503214B in respect of the following mark:



2) The trade mark was filed on 9 June 1992 and completed its registration procedure on 24 March 1995. It is registered in respect of the following goods:

Class 25: *Shoes and gloves; none being for use in relation to winter sports; all included in Class 25.*

3) IPC Media Limited (“the applicant”) seeks revocation of the registration on the grounds of non-use based upon Section 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”). The proprietor filed a counterstatement denying the claim and stating that it will provide evidence to demonstrate that the mark has been used in respect of the goods listed in the registration.

4) 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 25 March 1995 to 24 March 2000. Revocation is therefore sought from 25 March 2000. Revocation is also sought under Section 46(1)(b) in respect of the time period 11 February 2006 to 10 February 2011. Revocation is therefore sought from 11 February 2011.

5) Only the proprietor filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate. The applicant 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 careful consideration of the papers.

Proprietor’s evidence

6) This consists of a witness statement by Jean Marc Leman, financial and administrative director of the proprietor. Mr Leman provides a history of the proprietor and its predecessors explaining that it introduced a clipless pedal for cycling in the 1980s and was also at the forefront of producing carbon bicycle frames at around the same time. He states that the proprietor continues to

produce bicycles, bicycle frames, pedals, cleats, bicycle accessories and clothing for cyclists.

7) Mr Leman states that the proprietor began trading in the UK in around 1998. At Exhibit DB1, he provides a list of some of the proprietor's authorised retailers and distributors in the UK. One hundred and five outlets are identified. All are indicated as being a "pedal dealer", 34 are also indicated as being a "frame dealer" and 32 are indicated as being a "Keo fit center" (Later exhibits show that "Keo" is a secondary mark used in respect of cycle pedals and cleats). There are no other categories identified.

8) At Exhibit DB2, Mr Leman provides copies of catalogues for the years 2006 and 2008 to 2011. He states that these were issued to retailers and distributors. The catalogue from 2006 is in French. None of these catalogues relate to shoes of any kind. Gloves bearing the word mark LOOK across the knuckles are shown on two of the pages of the 2006 catalogue. A colour version of the mark appears on the same pages at the top left corner. Whilst some text appears in English, the goods are identified in French. For example, the gloves shown are identified as "Gants Hiver" (English: "Winter gloves").

9) The 2010 catalogue is in English and on page 64, two pairs of cycling gloves are shown. On one pair, the word LOOK can just be seen running the length of the back of the hand and fingers. A colour version appears at the top right of the page.

10) Whilst many of the models in these catalogues are shown wearing cycling shoes, there is no narrative relating to shoes and it is not possible to ascertain from the photographs if these shoes are branded LOOK, or whether they are of third party origin.

11) Exhibit DB3 consists of historical pages and screen shots from, what Mr Leman states is the proprietor's UK website. The website address is www.lookcycle.com. They are dated between 16 February 2010 and 29 August 2010. One extract from 1 March 2010 advertises various cycling clothing accessories and includes two pairs of gloves; "Wind Tex Gloves" and "3 Fingered Wind Tex Mitts". The latter have the word LOOK appearing on the back of the glove. No other mark is visible. Two further extracts, dated 4 March 2010 show larger representations of the same two pairs of gloves. These have the word LOOK visible on the back of the gloves. The colour version of the proprietor's mark appears at the top left of the pages.

12) Exhibit DB4 consists of three pages from a "special 2010" edition of the magazine 220 Triathlon. The pages contain an article reporting the "first ride" of a "LOOK 695" bicycle. No gloves are shown and the cyclist appearing in the photograph accompanying the article is wearing third party branded shoes.

13) Mr Leman provides UK turnover figures for proprietor between 2006 and 2011. He estimates that 0.16% relates to the sale of "gloves, socks and shoe covers" and this amounts to in the region of £125k to £250k per year.

14) Mr Leman states that one of the proprietor's main distributors is Fisher Outdoor Leisure Ltd, a leading supplier of bicycles, bicycle accessories, components and apparel to specialist cycle retailers in the UK. At Exhibit DB5, Mr Leman provides a selection of invoices for the years 2009 to 2011 relating to this supplier. Mr Leman states that "these invoices feature goods covered by the Registration as well as similar goods". Many hundreds of products are listed. GANT ETE ROUTE are listed in one invoice, dated 12 March 2010. These are shown as having a unit price of €12.33. "Gant" is the French for "glove", so I have assumed that these two references refer to gloves. A second invoice, dated 15 April 2011, contains a reference to 3 GANTS ETE ROUTE XL with a unit price of €10.45. This latter invoice is after the end of the last relevant period. There is no other mention of gloves and no mention, whatsoever, of shoes.

15) Two press releases are provided at Exhibit DB6, but make no mention of shoes or gloves.

16) Mr Leman states that the proprietor regularly sponsors athletes and cycling teams. At Exhibit DB7 he provides photographs of some sponsored athletes wearing LOOK branded clothing. None are shown wearing gloves or shoes.

Legislation

17) Section 46(1) of the Act states that:

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

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

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

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

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

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

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

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

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

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

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

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

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

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

18) 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.”

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

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

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

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

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

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

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

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

[70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

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

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

20) Firstly, there is no corroboratory evidence to support the claim that the proprietor has made genuine use of its mark in respect of *shoes*. There are no exhibits illustrating use of the mark in respect of such goods. Where Mr Leman provides turnover figures, he states that it is in respect of “gloves, socks and shoe covers”. He makes no reference to shoes. In the absence of any corroboratory evidence, I dismiss the proprietor’s claim that it has used its mark in respect to *shoes*.

21) In respect of *gloves*, Mr Leman has provided some exhibits of relevance. At Exhibit DB2 he provides a catalogue from 2006, but the goods are identified in French. Consequently, as the applicant submits in its written submissions, I am unable to conclude that this supports the claim that gloves have been sold in the UK under the mark at issue. A second catalogue from 2010 also shows two pairs of gloves appearing close to a colour version of the proprietor’s mark. An invoice dated 12 March 2010, shown at Exhibit DB5 also shows two pairs of gloves have been sold to the proprietor’s UK supplier. These gloves are marked at €12.33 a pair. Mr Leman fails to enlighten me regarding the turnover in the UK in respect of gloves because the figures he provides relate to “gloves, socks and shoe covers”. It is not explained why he provides turnover in respect of *socks* and *shoe covers*, but in doing so, he has obscured the level of sales, if there are any, in respect of *gloves*.

22) Taking all of the above into account, the high point of Mr Leman’s evidence is that cycling gloves were offered for sale in 2010 but there is evidence of only two pairs being sold in the UK, totalling €12.33 each. A second invoice refers to 3 pairs of gloves, but this is dated after the latest of the relevant periods. The evidence gives the impression that the proprietor has a long standing reputation and trade in bicycles and bicycle pedals and a smaller business in respect to cycling clothing. However, beyond the single transaction within the latest relevant period, I am unable to conclude that the proprietor’s mark has been used in the

UK in respect of cycling gloves. This conclusion is not disturbed if I were to factor in the invoice dated after the latest relevant period. This invoice relates to only a further three pairs.

23) I keep in mind the guidance in *Reber* that not every proven commercial use of the mark may automatically be deemed to constitute genuine use. This is the case in the current proceedings. Over a five year period, the evidence demonstrates the sale of only two pairs of gloves in a single transaction (or five pairs in two transactions, if I had accepted the second invoice as being relevant). As the applicant submitted in its written submissions, the evidence fails to satisfy the requirements set out in *Ansul* that the proprietor must demonstrate that there has been real commercial exploitation “warranted in the economic sector concerned to maintain or create a share in the market for the goods [...] protected by the mark”. The use shown is insufficient for me to conclude that there has been genuine use within the meaning of Section 46 of the Act.

Conclusion – Non use

24) No genuine use has been shown in respect of *gloves* or *shoes* and, therefore, the registration is revoked in its entirety from the earliest date claimed, namely, 25 March 2000.

COSTS

25) The applicant has been successful and is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place but that the applicant did file written submissions. I award costs on the following basis:

Application for revocation (including official fee)	£500
Considering other sides evidence and filing written submissions	£800
TOTAL	£1300

26) I order Look Cycle International to pay IPC Media Limited the sum of £1300. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of April 2016

**Mark Bryant
For the Registrar,
the Comptroller-General**