

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO.
WO0000000858656
IN THE NAME OF ANTA (CHINA) CO., LTD
FOR THE TRADE MARK:**



**AND THE APPLICATION FOR REVOCATION THEREOF
UNDER NO. 500636
BY BROOKS SPORTS, INC.**

Background

1) Anta (China) Co., Ltd ('ACC') is the registered proprietor of International trade mark registration ('IR') No. WO0000000858656 for the following mark:



2) The IR designated the UK for protection on 09 October 2004 and protection was subsequently conferred on 03 March 2006. It is registered in respect of the following goods:

Class 18: Animal skins; purses; pelts; umbrellas; walking sticks; leather straps; gut for making sausages.

Class 25: Shoes; clothing; collars (clothing); children's wear; layettes (clothing); swimsuits; bathing drawers; waterproof clothing; football shoes; track shoes with spikes.

Class 28: Games; toys; board games; balls for games; body-training apparatus; bows for archery; machines for physical exercises; swimming pools (play articles); fencing gauntlets. (my emphasis)

3) Brooks Sports, Inc. ('BSI') seeks revocation of the IR, in full, on the grounds of non-use based upon Section 46(1)(a) and (b) of the Trade Marks Act 1994 ('the Act'). Its section 46(1)(a) claim is based upon the five year period following registration; i.e. 04 March 2006 to 03 March 2011, with a claimed date of revocation of 04 March 2011. Under section 46(1)(b), the claim is based on the five year period 29 June 2009 to 28 June 2014 with a claimed date of revocation of 29 June 2014.


4) ACC filed a counterstatement stating that it has used the IR in the UK, in relation to the goods which I have underlined above, and subsequently filed evidence to support that claim. BSI also filed evidence and submissions.

5) As neither party requested to be heard, the following decision is made after consideration of all the papers before me. The parties' evidence will be summarised to the extent that I consider necessary and submissions will be borne in mind.

Evidence

ACC'S evidence


6) This takes the form of a witness statement in the name of Huang Wenting, General Legal Counsel for ACC, accompanied by one exhibit. The main points arising from Mr Wenting's statement are:


- ACC provided the kit for the People’s Republic of China (‘PRC’) team who participated in the London Olympics of 2012. The kit bore the logo .
- As a result of the participation of the PRC team in the 2012 London Olympics, and their great success, there was considerable exposure of the logo shown above.
- For the period of the London Olympics, the government of the PRC established a hospitality and business nerve centre, in “China House”, in Waldorf Hilton London. As sponsors of the team of PRC, ACC’s logo



was displayed on the walls of China House.

- Exhibit HW1 consists of 9 photographs taken during the 2012 London Olympics. The first 2 photographs show members of the PRC team posing for

photographs wearing the team kit. The logo  is visible on the front right hand side of the team’s sweat jackets. The third and fourth photographs

show a room inside “China House” where the logo  is visible on the wall of the room alongside a number of other trade marks such as BMW. The fifth and sixth photographs show members of the PRC team standing on the medal podium wearing jackets identical to those shown in the first two photographs. The remaining three photographs show members of the PRC team competing in Olympic events wearing red vests bearing the logo

BSI’S evidence

7) In the circumstances of this case, I see no need to summarise this evidence in any detail. It suffices to record here that it comes from France Delord, a partner at Taylor Wessing LLP, the applicant’s representative in these proceedings with two exhibits thereto.

Decision

8) 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.”

9) 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.”

10) 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 stated:

“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 Bunderversvereinigung 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].

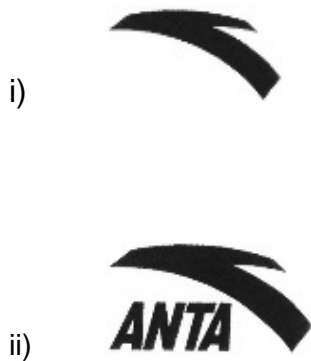
(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at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

11) The evidence before me shows no use of the IR in its registered form, only of two variants thereof. Therefore, the first issue that I need to address is whether use of the variants constitutes use of the IR. The two variants are:



12) In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) summarised the test under s. 46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."



13) The mark, as registered, is **ANTA 安踏**. It consists of three elements: i) the word ANTA, ii) the device above that word, and iii) the Chinese characters. All three elements are distinctive and contribute to the overall impression of the mark and its distinctive character as a whole. The difference between the IR and the variant marks is that each variant omits one or more of the distinctive elements present in the IR. That being so, the distinctive character of the variant marks clearly differs to that of the IR. It follows that the variant use falls outside of the parameters of section 46(2) of the Act. Examination of the form of use of a mark is fundamental to the enquiry into genuine use, as can be seen from the interplay between sections 46(1)(a) and (b) and 46(2). Section 46(2) connects directly to section 46(1): if the use falls outside of section 46(2), it cannot assist in proving genuine use as prescribed by sections 46(1)(a) and (b).

Outcome

14) The application for revocation on the grounds of non-use succeeds under both sections 46(1)(a) and 46(1)(b). Consequently, the mark is revoked under section 46(6)(b), the effective date of revocation being 04 March 2011.

Costs

15) As the applicant has been successful, it is entitled to an award of costs. Using the guidance provided in Tribunal Practice Notice 4/2007, I award costs to the applicant on the following basis

Preparing a statement and considering the counterstatement	£200
Application fee	£200
Preparing evidence and submissions	£500
Total:	£900

16) I order Anta (China) Co., Ltd to pay Brooks Sports., Inc the sum of **£900**. This sum is to 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 2016

**Beverley Hedley
For the Registrar,
the Comptroller-General**