

**O/707/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF UK REGISTRATION NO. 1079881  
IN THE NAME OF LAPP INSULATORS LLC  
IN RESPECT OF THE FOLLOWING TRADE MARK**

**LAPP**

**IN CLASS 17**

**AND**

**AN APPLICATION FOR THE REVOCATION THEREOF  
UNDER NO 503047  
BY  
KINGFISHER INTERNATIONAL PRODUCTS LIMITED**

## BACKGROUND AND PLEADINGS

1. Trade Mark No. 1079881 shown on the cover page of this decision stands registered in the name of Lapp Insulators LLC (“the registered proprietor”). It was filed on 17 June 1977 and completed its registration process on 29 March 1979. The mark is registered for the following goods:

### Class 17

*Electrical insulators and parts and fittings therefor included in Class 17.*

2. On 3 March 2020, Kingfisher International Products Limited (“the applicant”) sought revocation of the mark on the grounds of non-use. Under section 46(1)(a) of the Trade Marks Act 1994 (“the Act”), the applicant claims non-use in the five-year period following the date on which the mark was registered, i.e. 29 March 1979. It seeks revocation from 11 May 1984.

3. Under section 46(1)(b), the applicant claims that the mark has not been used during the following period: 10 September 2013 to 9 September 2018. The date on which it wants revocation to take effect is 10 September 2018.

4. The registered proprietor filed a defence and counterstatement denying the claims made and stating that use had been made of the registration during both relevant periods. In its counterstatement, the registered proprietor noted that the first relevant period ran from 11 May 1979 to 10 May 1984. This period ends with the date pleaded by the applicant as the effective date of revocation, but starts just over a month after the day on which the registration process was completed.

5. The registered proprietor filed evidence going to the question of use in the form of a witness statement from Eric J Kress, Director of Engineering and Quality at Lapp Insulators LLC since 1997. The witness statement is accompanied by five exhibits. I shall not summarise them here, but will refer to them during the course of my decision.

6. Neither side requested a hearing, but both filed written submissions in lieu on 27 July 2020. I shall also refer to these where appropriate.

7. In these proceedings, the applicant is represented by Bird & Bird LLP and the registered proprietor by Marks & Clerk LLP.

## **DECISION**

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

9. Section 46 of the Act is 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 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;

...

(2) For the purposes of subsection (1) use of a trade mark includes use in a form (the ‘variant form’) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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 either 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.”

10. Section 100 of the Act is also relevant and states that:

“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.”

11. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

“114. *The law with respect to genuine use.* The CJEU has considered what amounts to ‘genuine use’ of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeviliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

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

(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] and [76]-[77]; *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].”

### ***The first relevant period***

12. In its written submissions in lieu of a hearing, the applicant states that it has relied on the date shown on the UK register as the date of registration (17 June 1977) as the date for the purposes of establishing the first relevant period. These are not the dates that were pleaded. Furthermore, the contested mark was registered under the Trade Marks Act 1938, section 19 of which provided that the date of application be deemed the date of registration. As I have set out in paragraph 1 above, the mark completed its registration process on 29 March 1979 and this is the correct date for the purposes

of section 46. The mark could be revoked from any date following 29 March 1984. In the event, the applicant states in its written submissions that:

“Whether the Registration is cancelled from 18 June 1982 or 10 May 1984 is of no concern to the applicant.”<sup>1</sup>

13. The registered proprietor has filed no evidence of use between 1979 and 1984 as Mr Kress states that it has not been possible to obtain records going back that far. However, section 46(3) of the Act means that if use can be shown during the second relevant period, the mark cannot be revoked under section 46(1)(a).

### ***Form of the mark***

14. I must first consider the forms in which the mark has been used and decide which of those constitute acceptable variants. In *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12, the Court of Justice of the European Union (“CJEU”) held that:

“32. ... the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

...

35. Nevertheless, ... a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1).”

15. Where the issue is whether the use of a mark in a different form, rather than with, or as part of, another mark, constitutes genuine use of the mark as registered, the decision of Mr Richard Arnold QC (as he then was), sitting as the Appointed Person, in *NIRVANA Trade Mark*, BL O/262/06, is relevant. He said:

---

<sup>1</sup> Paragraph 15.



“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. ... 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.”

16. The applicant submits that none of the evidence, apart from some undated images on pages 52 and 53 of Exhibit EJK4, shows use of the mark as registered. It notes that the mark appears in the word form “Lapp Insulators” or “LAPP Insulators” or in the following device:



17. It continues:

“In all cases, the distinctive character of the Mark has been altered. The addition of the element ‘insulators’ is distinctive and would be perceived by consumers – thereby altering the distinctive character of the Mark. Equally, the figurative [variant] clearly impacts on the distinctive character of the Mark due to the addition of the spiral device element and the words [sic] INSULATORS.”<sup>2</sup>

---

<sup>2</sup> Applicant’s written submissions in lieu of a hearing, paragraph 27.

18. I disagree that in relation to the goods for which the mark is registered the element “insulators” is distinctive. Rather, it describes those goods. Consequently, I find that the distinctive character of the mark as registered is not altered by the use of “LAPP Insulators”. As a word mark protects the word itself, not simply the word presented in a particular capitalisation or font,<sup>3</sup> “Lapp Insulators” is also an acceptable form of the mark.

19. I now consider the figurative form. The words “LAPP INSULATORS” appear over the top of a grey device which resembles the shape of some of the insulators shown in the registered proprietor’s evidence.<sup>4</sup> The word “LAPP” is larger than “INSULATORS” and is presented in a slightly stylised form and the colour blue. However, I consider that the stylisation is minimal and does not alter the distinctive character of the mark. As the CJEU held in *Colloseum*, the use of a mark as part of another mark constitutes use of the mark as registered. I find that this is also an acceptable form of the mark.

### ***Use of the mark***

20. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK during the relevant five-year period. In making my assessment, I am required to consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods for which use has been shown;
- the nature of those goods and the market(s) for them; and
- the geographical extent of the use shown.

21. In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated that:

---

<sup>3</sup> See *China Construction Bank Corporation v Groupement des Cartes Bancaires*, Case BL O/281/14, paragraph 21.

<sup>4</sup> See, for example, Exhibit EJK2, page 22.

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v Comptroller-General of Patents* [2008] EWHC 2071 (Pat); [2008] RPC 35:

‘[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

22. What I take from Mr Hobbs’s comments is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole

shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark.

23. Mr Kress states that Lapp is a long-established company. It was formally founded in New York in 1916 and operates in Germany and the US.<sup>5</sup> It is the German office that is responsible for sales to the UK. Annual sales for LAPP branded insulators and related products are shown in the table below:<sup>6</sup>

| <b>Year</b> | <b>Total sales figures (EUR)</b> |
|-------------|----------------------------------|
| 2013        | 568,407                          |
| 2014        | 253,626                          |
| 2015        | 663,610                          |
| 2016        | 505,626                          |
| 2017        | 461,280                          |
| 2018        | 89,344                           |

24. The total number of LAPP branded products/units sold in the UK are set out in the following table:<sup>7</sup>

| <b>Year</b> | <b>Total number of products sold</b> |
|-------------|--------------------------------------|
| 2013        | 756                                  |
| 2014        | 345                                  |
| 2015        | 945                                  |
| 2016        | 1067                                 |
| 2017        | 905                                  |
| 2018        | 221                                  |

25. Mr Kress goes on to say that customers in the UK are public utilities and large companies such as Siemens. On the basis of the evidence from the website and brochure, I accept that the registered proprietor produces high-voltage insulators which would only be purchased by companies installing or maintaining high-voltage electricity transmission systems.

---

<sup>5</sup> Witness statement of Eric J Kress, paragraph 3.

<sup>6</sup> Paragraph 13.

<sup>7</sup> Paragraph 14.

26. The applicant submits that there are a number of issues with the figures. First, it states that there is no indication where the sales were made and that the fact that the figures are given in Euros leads it to assume that they were not made in the UK. Second, it observes that the figures claim to cover “insulators and related products” and submits that “we don’t know, and cannot assume, what quantum covers the Contested Goods (if any) and whether the products sold were bearing the Mark”.<sup>8</sup> Turning to the second table, it submits that the figures could cover any products and so it is not possible to infer how many units of the contested goods were sold. Finally, it notes that a proportion of the sales in 2013 and 2018 would have fallen outside the Second Relevant Period. While the applicant is correct in this point, I note that this still leaves four years from 2014 to 2017.

27. As I have noted above, the registered proprietor explains that sales to the UK are made from its German office and so the prices are given in euros. I accept this explanation. It is not unknown for evidence in Registry proceedings to contain UK sales figures in currencies other than sterling, where the entity making the sales is based in another jurisdiction. It seems reasonable to me to infer from the wording of paragraph 13 of Mr Kress’s witness statement, which I reproduce below, that these sales were made in the UK:

“Lapp Insulators has made extensive and significant sales of its products under the LAPP mark throughout its history in the United Kingdom, including during the Second Relevant Period. The annual sales figures for Lapp Insulators’ LAPP branded insulators and related products are set out in the table below:”

28. Nowhere does the registered proprietor state what it means by “related products”. However, I consider that the term denotes items that are connected to the insulators, in other words parts and fittings for them. The applicant is correct to say that Mr Kress does not distinguish what proportion of the sales can be accounted for by insulators or by the related products.

---

<sup>8</sup> Applicant’s written submissions, paragraph 22.

29. However, Exhibit EJK5 shows sample purchase orders for insulators, five of which are within the second relevant period. There are further items on two of the purchase orders, but I am unable to cross-refer the product code or description (“Coronaring”) with anything shown elsewhere in the evidence. Orders of insulators amount to €63,860 and were made from addresses throughout England.<sup>9</sup> The value of the other products is €4,760. The order acknowledgements come from Lapp Insulators GmbH, which, Mr Kress says, has the exclusive licence to use the mark in the UK.<sup>10</sup> This statement has not been challenged. The use was therefore made with the authority of the registered proprietor.

30. The applicant submits that there is no evidence to show that the orders were actually paid for or fulfilled:

“In other words, the Office cannot conclusively say that EJK5 shows that any sales have been made to UK customers. It seems odd that order forms and acknowledgements have been submitted in evidence rather than invoices: and given the weak nature of the rest of the evidence these are of little value.”<sup>11</sup>

31. The applicant casts doubt on whether the evidence shows that the mark has been used in relation to the contested goods. It accepts that it has been used as a trading name, but submits that:

“When the Proprietor says these products ‘*are LAPP products*’ even though they do not feature the LAPP trade mark on them, that is not correct. The use of LAPP as a trading name, or for the retail of the Contested Goods, is not use for the goods themselves. It is well established that use of a mark to retail products cannot be sufficient use to maintain a registration for the products themselves (see Case C-411/13P *Sanco SA v OHIM*, and Case T-105/05 *Assembled Investments (Proprietary) Ltd v OHIM*, upheld on appeal in Case

---

<sup>9</sup> Billing addresses were in Stafford, Hoddesdon, Oxford, Leicester and Slough, with shipping addresses also including Sussex, Surrey and Lancashire.

<sup>10</sup> Witness statement of Eric Kress, paragraph 3.

<sup>11</sup> Applicant’s written submissions in lieu of a hearing, paragraph 45.

C-398/07P *Waterford Wedgwood [sic] plc v Assembled Investments (Proprietary) Ltd* as followed by the Office recently in Case O-525-21 *Thameen Limited v PZ Cussons (International) Limited*). The Proprietor seems to admit in paragraph 15 that the use of the LAPP mark is retail use rather than use for the products themselves.”<sup>12</sup>

32. What Mr Kress said in paragraph 15 is as follows:

“Lapp Insulators sells its LAPP branded products in the United Kingdom to customers which include public utilities, as well as large companies such as Siemens. Attached and shown to me at **EXHIBIT EJK5** is a collection of invoices to customers in the United Kingdom during the Second Relevant Period. These invoices are addressed to customer addresses in the United Kingdom, and show the LAPP mark on the invoices and/or contain references to LAPP products in the itemised list. On occasion, the specific products listed in the invoices may not include reference to the LAPP mark; however, these are LAPP products, as demonstrated at **EXHIBIT EJK2**, **EXHIBIT EJK3** and **EXHIBIT EJK4**.”

33. The first point to make is that Mr Kress does not say that the products may not bear the LAPP mark. What he says is that the invoice (or purchase order) reference may not include the LAPP mark. Secondly, I do not understand the registered proprietor to be admitting that its use of the mark is in connection with retail services. Selling and offering to sell goods are not the same thing as providing retail services: see *Tony Van Gulck v Wasabi Frog Ltd*, BL O/391/14, in which Mr Geoffrey Hobbs QC, sitting as the Appointed Person, considers the case law quoted by the applicant.<sup>13</sup> The witness statement of Mr Kress and the brochure in Exhibit EJK2, which he states was made available to UK customers during the second relevant period, make clear that the registered proprietor manufactures insulators and sells them to customers. It does not seem plausible to me that these are the type of goods that would be the subject of retail services.

---

<sup>12</sup> Paragraph 47.

<sup>13</sup> The particular point I refer to here can be found in paragraph 9 of that decision.

34. The mark is used throughout the brochure. The applicant invites me to find that it is immaterial, containing nothing that would provide even indirect proof that the mark must have been put to genuine use for the contested goods in the second relevant period. It notes that the brochure contains no date and that, even if it had been made available to UK customers, there is no indication as to the number that might have seen it. As I have mentioned above, Mr Kress says in his witness statement that it was in use during the second relevant period and that it was made available to UK customers. While it might have been helpful to know how many copies were distributed in the UK, the numbers are likely to have been small, as these are not goods that would have a large number of potential purchasers. Consequently, I am not persuaded by the applicant's submissions that the absence of any evidence of advertising (beyond the brochure) or press articles or industry awards is significant.

35. I must consider the evidence as a whole, and I bear in mind the comments of the General Court ("GC") in *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09:

"In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*COLORIS*, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07, *Ferrero Deutschland v OHIM*, not published in the ECR, paragraph 36)."<sup>14</sup>

---

<sup>14</sup> Paragraph 53.



36. The registered proprietor has, under a statement of truth, provided sales figures for LAPP branded insulators and related products. The sales figures and volumes are not large, but these are specialist goods, not marketed at the general public. Taking the evidence as a whole, I find that it has shown use of the mark in relation to post insulators, which are the goods listed in the purchase orders and order acknowledgements. This use, in my view, represents real commercial exploitation of the mark. I find no evidence of use on parts and fittings for electrical insulators. To say that sale of the insulators implies sale of parts and fittings for them would, in my view, be a supposition, rather than a reasonable inference from the evidence before me. For the sake of completeness, no reasons have been given in the event that I find the mark has not been used for any of the goods covered by it.

### ***Framing a fair specification***

37. In *Euro Gida Sanayi ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC, sitting 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.”<sup>15</sup>

38. In *Property Renaissance t/a Titanic Spa v Stanley Dock Hotel Ltd t/a Titanic Hotel Liverpool & Ors* [2016] EWHC 3103 (Ch), Carr J summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas*

---

<sup>15</sup> Pages 10-11.

*Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, 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 to 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; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

39. In my view, the term “post insulators” does not represent a subcategory of goods that is capable of being viewed independently from the general term *Electrical insulators*. In my view, this would be a fair specification for the mark.

## **CONCLUSION**

40. The revocation has been partially successful. The mark will remain registered for *Electrical insulators*. It will be revoked as of 11 May 1984 for *parts and fittings therefor included in Class 17*.

## **COSTS**

41. Both parties have enjoyed an equal measure of success in this revocation. Consequently, I order each party to bear its own costs.

**Dated this 27<sup>th</sup> day of September 2021**

**Clare Boucher  
For the Registrar  
Comptroller-General**