O-404-13

TRADE MARKS ACT 1994

IN THE MATTER OF:

APPLICATON No. 83914

IN THE NAME OF DOSENBACH-OCHSNER AG SCHUHE UND SPORT

FOR REVOCATION OF TRADE MARK REGISTRATION No. 2040937

IN THE NAME OF CONTINENTAL SHELF 128 LTD

	-	DECISION
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- 1. Continental Shelf 128 Ltd ('the Proprietor') has since 2008 been the owner of the trade mark CATWALK registered under number 2040937 with effect from 11 October 1995 for use in relation to 'articles of footwear, clothing and headgear' in Class 25.
- 2. On 22 November 2010, Dosenbach-Ochsner AG Schuhe und Sport ('the Applicant') applied under Section 46(1) of the Trade Marks Act 1994 for revocation of the registration on the ground of non-use in relation to all goods for which the trade mark was registered. In its defence the Proprietor claimed that it had used the mark in question in the United Kingdom continuously since 2008 in relation to 'articles of clothing' and that the application for revocation should to that extent be refused in accordance with the provisions of Section 46(3) of the Act. It was thus incumbent upon the Proprietor under Section 100 of the Act to adduce evidence which showed that the registration of its mark

in relation to all types of clothing in Class 25 had been supported by use in commerce of corresponding breadth during the relevant 5 year period.

- 3. Under Section 46(2) of the Act it was open to the Proprietor to rely on use of the trade mark **CATWALK** 'in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered'. However, the burden imposed upon the Proprietor by Section 100 of the Act could not be discharged by adducing evidence as to the use of any variant of the mark which altered the distinctive character of the mark as registered. It was for the Registrar to determine whether any variant upon which the Proprietor sought to rely was or was not an immaterial variant for the purposes of Section 46(2).
- 4. For the overall purpose of deciding whether there had been 'genuine use' of the trade mark, it was necessary for the Registrar to be satisfied that the evidence adduced by the Proprietor showed use of the nature and quality envisaged by the case law summarised at paragraphs [28] and [29] of the Judgment of the CJEU in Case C-149/11 Leno Merken BV v. Hagelkruis Beheer BV [2012] ECR I-0000; [2013] ETMR 16; in the following terms:
 - 28. The Court has already in the judgments in *Ansul* and *Sunrider v. OHIM* and the order in *La Mer Technology* interpreted the concept of 'genuine use' in the context of the assessment of whether national trade marks had been put to genuine use, considering it to be an autonomous concept of European Union law which must be given a uniform interpretation.
 - 29. It follows from that line of authority that there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to

guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether there is real commercial exploitation of the mark in the course of trade, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating market share for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see Ansul, paragraph 43, Sunrider v. OHIM, paragraph 70, and the order in La Mer Technology, paragraph 27).

5. The Proprietor's evidence of use initially consisted of a witness statement of Robert Hawley with three exhibits dated 1 February 2011. Mr. Hawley is a trade mark attorney with the firm that represents the Proprietor in respect of its trade mark matters globally. He stated:

The information contained in this Witness Statement comprises the Registrant's Counterstatement in these proceedings and comes from my personal knowledge or has been provided to be by the Registrant. I am authorised by the Registrant to execute this Witness Statement and, to the best of my knowledge and belief, all the information contained herein is true and correct.

He did not attempt to distinguish between the information in his witness statement which he was purporting to verify on the basis of 'personal knowledge' and the information outside his 'personal knowledge' which had been 'provided' to him by someone else.

- 6. With regard to use of the trade mark **CATWALK** by the Proprietor subsequent to 25 June 2008 (when it had acquired the registration in suit) his evidence was as follows:
 - 6. ... the Registrant reiterates its contention (made in paragraph 4 above) that it has made continuous use of the mark in the United Kingdom since date on which it assumed ownership of registration No. 2040937. To which end, Exhibit **RJH-02** hereto comprises a selection of CAD drawings and accompanying invoices referencing style codes, variously dated 2008 and 2009, and all bearing (and being instances of clothing sold in the UK under) the trade mark CATWALK.
 - 7. It will be noted that the above-mentioned invoices bear the name of Hornby Street Limited. However, such company is related to the Registrant, with both sharing the same shareholders and company Directors. Furthermore, Hornby Street Limited has the express permission of the registrant to use the trade mark the subject of registration No. 2040937. Exhibit **RJH-03** hereto comprises material confirming the veracity of the foregoing statement.

There were no graphic representations of the word **CATWALK** in any of the invoices in Exhibit RJH-02. The word **CATWALK** was graphically represented in the CAD drawings in the manner shown in the reproductions of them which I have attached as Annex A to this Decision. Each drawing carried the statement: 'All designs are owned by the Juice Corporation and protected by copyright. None of our designs or images may be used, copied or modified in any way for sale, profit or otherwise. Any infringement of our trademarks or copyrights will result in legal action'.

7. The evidence given by Mr. Hawley was heavily criticised for lack of probative value in written submissions filed on behalf of the Applicant. His paragraph 6 and Exhibit RJH-02 were challenged in the following terms:

We now refer to paragraph 6 of Robert James Hawley's Witness Statement and the accompanying documentation submitted as Exhibit RJH-02. We submit that the CAD drawings of clothing items displaying the mark CATWALK do not establish that these form part of a catalogue or product brochure belonging to the Registered Proprietor or any other third party having consent to use or market the Registered Proprietor's mark. Hence, in the absence of any proper identification, it cannot be assumed from the CAD drawings themselves that the branded goods shown on the drawings were actually marketed or distributed to a potential clientele by the Registered Proprietor or by any third party with his consent. The only information available on the pages on which the drawings are illustrated is that 'all designs are owned by the Juice Corporation and protected by copyright'. We note that no explanation has been offered in the Witness Statement of Robert James Hawley as regards the identity of Juice Corporation and in the absence of any clear information, we are unable to make the link with the CAD drawings and the invoices issued in the name of Hornby Street Limited, particularly as the trade mark CATWALK is not identified on the invoices. In terms of actual use of the CATWALK mark, the documentation supplied is not only limited but also inconclusive.

It is also relevant to note that a number of alternate names or brands have been listed on the invoices issued by Hornby Street Limited to identify the items of clothing. These include names such as Mary Lou, Lulu, Hawk, Godiva, Magna, Hyacinth, Devona, Pinky, Jodie, Jordon, Lorna, Lady etc. but we note that there are no entries for the CATWALK brand. This would appear to point to the fact that the clothing items identified on the invoices of Hornby Street Limited are sold under these alternate names or brands and not CATWALK. We submit that although some of the product codes (not all) coincide with the style numbers on the pages on which the CAD drawings are illustrated, there is no clear evidence that the sales transactions shown on the invoices of Hornby Street Limited relate to the CATWALK

brand illustrated on the CAD drawings. We submit that even if genuine use of the CATWALK mark is established, the evidence filed by the Registered Proprietor raises questions as to whether the use was by or with the consent of the Registered Proprietor to justify retention of the Registered Proprietor's mark for the goods registered.

- 8. In response the Proprietor filed a second witness statement of Robert Hawley with 5 exhibits dated 16 August 2011 and a witness statement of Tesneem Ahmed with 1 exhibit dated 20 September 2011. Both witnesses stated that the information in their statements 'comes from my personal knowledge or has been provided to me by the Registrant. I am authorised by the Registrant to execute this Witness Statement and, to the best of my knowledge and belief, all the information contained herein is true and correct'. They did not distinguish between the information in their witness statements which they were purporting to verify on the basis of 'personal knowledge' and the information outside their 'personal knowledge' which had been 'provided' to them by someone else.
- 9. Mr. Hawley observed that 'Juice Corporation' was 'the trading name of a fashion house' with the same 'Head Office' address as the Proprietor. He said it had been confirmed to him that the fashion house was 'connected with and under the control of' the Proprietor. He sought to overcome the Applicant's attack upon the adequacy of his evidence as to use of the CATWALK trade mark by stating as follows:
 - 7. The [written submission of the applicant for revocation] also calls into question whether any of the products featured in the CAD drawings were ever marketed in the UK under and/or by reference to the CATWALK trade mark. In which regard, I refer the Registrar to the material comprising *Exhibit RJH-02*

to the Registrant's original Witness Statement, from which it can be seen that the 'Style No.' appearing in certain of the CAD drawings correspond with the 'Product Code' listed in the copy invoices. There is now produced to me and marked **Exhibit RJH-C** a table identifying instances where these codes cross-reference one another.

- 8. As can be seen from both the CAD drawings and the copy invoices, the products in question were designed and sold, under and/or by reference to, the trade mark CATWALK during the five year 22 November 2005 to 21 November 2010. The Registrant therefore contends that the material in question unequivocally demonstrates that its registered trade mark was used during that period and thus should not and cannot be revoked under the provisions of section 46(1)(b) of the Act.
- 10. Tesneem Ahmed confirmed that she was Head of Ladies Wear for Hornby Street Ltd, which she defined as 'My Role'. Her evidence with regard to use of the **CATWALK** trade mark was as follows:
 - 2. My Role includes responsibility for managing the CATWALK brand of Continental Shelf 128 Limited and the products sold under that trade mark. I have undertaken this particular function since such company acquired the CATWALK trade mark in 2007, and I am fully-conversant with how and by whom the brand is used and in respect of which products.
 - 3. To which end, I hereby confirm that since at least as early as July 2007 Hornby Street Limited has used the trade mark CATWALK with the express permission of and under an implied licence from Continental Shelf 128 Limited. I further confirm that during this period the trade mark CATWALK has been extensively used throughout the UK in respect of a broad range of clothing products.

As well as omitting to provide any substantiation for her assertion that 'the trade mark CATWALK has been extensively used throughout the UK in respect of a broad range of clothing products', she neither confirmed what Mr. Hawley had said with reference to the CAD drawings and invoices in his Exhibit RJH-02 nor provided any evidence of her own as to the production or sale of any garments physically replicating the appearance of those pictorially represented in the CAD drawings.

- 11. The application for revocation succeeded in its entirety for the reasons given by Ms. Judi Pike on behalf of the Registrar of Trade Marks in a written decision issued under reference BL O-138-12 on 26 March 2012. The registration was revoked with effect from 5 April 2002 and the Proprietor was ordered to pay £900 to the Applicant as a contribution towards its costs of the proceedings in the Registry.
- 12. The Hearing Officer concluded that there had been use of the mark CATWALK by or with the consent of the Proprietor in relation to women's clothing in Class 25, but that the use had consistently and exclusively been use in the stylised form shown in the CAD drawings (see Annex A to this Decision) and not use of the mark as registered in ordinary letterpress.
- 13. She determined that the mark as used was the word **CATWALK** in a form differing in elements which altered the distinctive character of the mark as registered and which was therefore not an immaterial variant for the purposes of Section 46(2). Her reasons for so deciding were as follows:
 - 21. As is the case with all word-only marks, the distinctiveness of the word-only mark CATWALK lies in the

word itself as there is no element of stylisation or device which affects its inherent distinctiveness. A catwalk is the long raised platform along which models walk in order to show off the clothing collections of fashion designers. Used in relation to clothing, footwear and headgear, CATWALK is suggestive of clothing which has been modelled or is part of a designer collection of clothing, e.g. "hot off the catwalks of Paris/London/Milan" etc. Although CATWALK for these goods has a tangential relationship with clothing, it is not descriptive. The mark, as registered, has a reasonable degree of inherent distinctive character.

22. The next part of the enquiry is to determine the differences between the marks in the form used and in the registered form. These are set out in the table below:

Registered form	Form which has been used
CATWALK	CATWALK

There are a number of differences between the marks. Although the spelling of the word is the same in each mark, the differences in the form as used are that:

- (i) the word is set on a rectangular background, split between black and white shading;
- (ii) the wording is in black or white depending upon which part of the split shading that the letters appear, so that the C appears as a black letter on white shading and the letters ATWALK appear as white lettering on black shading;
- (iii) The letters all have dots inside them; white dots inside the black C and black dots inside the white letters ATWALK.
- 23. Having established (i) the way in which the mark has been used; (ii) the distinctive character of the registered mark; and (iii) what the differences are between the registered mark and the mark used, the final analysis is to decide whether those differences alter the distinctive character of the mark in its registered form. Phonetically and conceptually, the marks are no different. However, visually, the mark, as used, has substantial differences to the word-only form of CATWALK. Those differences are the layered effect of the black and white elements and, further, the split

shading which has the effect of highlighting the letter C because it is singled out compared to the rest of the mark. My conclusion is that the visual differences have altered the distinctive character of the mark in its registered word-only form. The differences have turned a word-only mark into a stylised mark which has a greater degree of inherent distinctive character.

- 14. The Proprietor appealed to an Appointed Person under Section 76 of the 1994 Act contending in substance that the Hearing Officer had erred: (1) by not noticing that the CAD drawings in Exhibit RJH-02 included drawings in which the word **CATWALK** was graphically represented with relatively little stylisation; (2) by not accepting that use of the word **CATWALK** as graphically represented in stylised from in Exhibit RJH-02 constituted use of the mark as registered; (3) by proceeding to determine that there had been no use of the mark as registered in circumstances where the Proprietor had not been warned or informed by the Applicant or the Registrar that there was any issue or concern with regard to the applicability of Section 46(2) to the stylised form of the word CATWALK graphically represented in Exhibit RJH-02; (4) by not recognising and giving effect to the probability that there would have been use of the mark CATWALK in non-stylised form contemporaneously with use of it in the stylised form graphically represented in Exhibit RJH-02. The Proprietor maintained that the application for revocation should have been dismissed insofar as it related to "women's clothing" in Class 25.
- 15. The Applicant filed a Respondent's Notice under Rules 71(4) to (6) of the Trade Marks Rules 2008 contending in substance that the Hearing Officer's decision should additionally or alternatively be upheld on the basis that the witness statements filed on

behalf of the Proprietor were not sufficient to demonstrate that clothing products had been sold under and/or by reference to the **CATWALK** trade mark.

- 16. I begin by observing that the question for determination by the Registrar was whether the witness statements filed on behalf of the Proprietor were sufficient 'to show' (as required by Section 100 of the Act) that there had been genuine use of the **CATWALK** trade mark as registered (or an immaterial variant of it) in relation to goods identifiable as articles of clothing marketed in the United Kingdom by or with the consent of the Proprietor during the relevant 5 year period.
- 17. The Hearing Officer certainly cannot be criticised for considering as part of the required assessment whether the word CATWALK graphically represented in the stylised form shown in the CAD drawings in Exhibit RJH-02 satisfied the criteria for recognition as an immaterial variant of the Proprietor's CATWALK trade mark as registered. She was bound to consider that question in the proper performance of her duties under the applicable legislation. It is nothing to the point that either or both of the parties may have overlooked or ignored the existence of that issue in relation to the stylised form shown in the evidence which the Proprietor had chosen to file in defence of its registration. It was also no part of her role as a decision taker in adversarial proceedings to warn or inform the Proprietor that its attempt to rely on use of the word CATWALK in stylised form was subject to the operation of Section 46(2). Still less was it any part of her role to warn or inform the Proprietor that it ought to adduce evidence of use of word CATWALK in the form in which it was registered if it was able to do so.

- 18. The stylised form of the word **CATWALK** is indeed a variant of the word **CATWALK** as registered. The way in which the former individualises the latter may perhaps be analogised to the way in which a signature individualises the name it represents. It appears to me that in terms of its visual impact, there is visual individualisation to a degree which causes the stylised form of the word **CATWALK** to differ distinctively from the word **CATWALK** in ordinary letterpress. I agree with the Hearing Officer in thinking that the stylised form was not an immaterial variant of the mark as registered for the purposes of Section 46(2) of the Act.
- 19. There is substance in the Proprietor's contention that the Hearing Officer failed to notice that among the CAD drawings in Exhibit RJH-02 there were three in which the word **CATWALK** was graphically represented with relatively little stylisation. These were:
- (i) Style No. H642036TJ/Design No. JODIE 31701V2;
- (ii) Style No. H646441TJ/Design No. PINKY 60945D1;
- (iii) Style No. H646442TJ/Design No. JORDAN 60587V2.

However, by pursuing this point the Proprietor has to a corresponding degree reinforced the Applicant's contention that the CAD drawings in Exhibit RJH-02 were not shown by evidence of any real and sufficient probative value to be depictions of garments physically sold or supplied by or with the consent of the Proprietor. That is because there do not appear to be any cross-references to those particular Style/Design Numbers in any

of the invoices in Exhibit RH-02 cf Exhibit RJH-C to Mr. Hawley's witness statement dated 16 August 2011.

- 20. The Respondent's Notice proceeds upon the premise that it is permissible (as indeed it is) for the Applicant to question the probative value of the witness statements filed by the Proprietor without adducing evidence to contradict the contents of the statements.
- 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] R.P.C. 35:
 - 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. As to which see paragraphs [17] to [19] and [24] to [30] of the Decision of Mr. David Alexander QC sitting as the Appointed Person in PLYMOUTH LIFE CENTRE Trade Mark (BL O-236-13; 28 May 2013).
- 23. Whilst there is no bar to a witness giving evidence as to the existence or occurrence of matters that are not within his or her own knowledge (Sections 1 and 11 of the Civil Evidence Act 1995; CITYBOND Trade Mark [2007] RPC 13 at paragraph [32]) the weight to be given to such evidence remains to be assessed with due regard for the provisions of Section 4 of that Act:

Considerations relevant to weighing of hearsay evidence.

- (1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.
- (2) Regard may be had, in particular, to the following -
- (a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

- (b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;
- (c) whether the evidence involves multiple hearsay;
- (d) whether any person involved had any motive to conceal or misrepresent matters;
- (e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;
- (f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.

The reliability of reported information and the reliability of the manner in which it has been collated for use as evidence are both relevant considerations for the purposes of Section 4.

- 24. If the Hearing Officer had applied these principles to the witness statements filed on behalf of the Proprietor in the present case, she would have found it necessary to address the shortcomings of the evidence which had been presented. I shall refer to the principal shortcomings sequentially, although their impact on the required assessment of probative value was cumulative.
- 25. First, Ms. Ahmed was clearly well-placed to give evidence of 'how and by whom the brand is used and in respect of which products' (paragraph 2 of her witness statement). It would have been reasonable and practicable for the Proprietor to have adduced first-hand evidence of such matters from her. That did not happen. No reasons were identified for the Proprietor's failure to adduce such evidence either from her or

from anyone else who may have provided Mr. Hawley with the information reported in his witness statement.

- 26. Second, Mr. Hawley's evidence with reference to the CAD drawings and invoices in his Exhibit RJH-02 could only support the Proprietor's claim that 'the trade mark CATWALK has been extensively used throughout the UK in respect of a broad range of clothing products' (paragraph 3 of Ms. Ahmed's Witness Statement) if it provided a reliable basis for extrapolation from the particular (i.e. the exhibited invoices) to the general (i.e. the claim for extensive use throughout the UK). However, the information in his witness statements was put forward without any attempt by him or Ms. Ahmed to demonstrate the reliability of it or the reliability of the manner in which it had been collated for use as evidence.
- 27. Third, the Proprietor's evidence as to the actuality of use of the **CATWALK** trade mark in relation to clothing products was tangential and lacked specificity in key respects. Thus, the evidence of its trade mark attorney was apparently intended to establish three important propositions:
- (1) that garments physically replicating the appearance of those pictorially represented in the CAD drawings in Exhibit RJH-02 had been manufactured in substantial quantities. However, there was no evidence as to when, where, how, by whom, on what scale or with what frequency any of the designs recorded in the CAD drawings had (if they actually had) been put into production;

- that the finished garments had been marketed under and by reference to the CATWALK trade mark. However, the CAD drawings containing graphic representations of the word CATWALK appeared to be internal documents and there was no evidence as to when, where, how, by whom, on what scale or with what frequency the word CATWALK had (if it actually had) been used 'to guarantee the identity of the origin' of any garments in the course of any marketing or promotion carried out by way of trade in the United Kingdom;
- that both of the foregoing propositions were demonstrated by the fact that some of the sales invoices in Exhibit RJH-02 contained references to 'Product Codes' corresponding to the 'Style Nos' in some of the CAD drawings. However, the sales invoices contained no references to the **CATWALK** trade mark and none of them contained references to 'Product Codes' corresponding to any of the three 'Style Nos' identified in paragraph [19] above.
- 28. It appears to me that the evidence adduced on behalf of the Proprietor was altogether too deficient in too many respects to 'show' that during the relevant 5 year period there had been genuine use of the **CATWALK** trade mark either as registered or in the form of any variant of it graphically represented in the CAD drawings. I accept the contention to that effect advanced on behalf of the Applicant in its Respondent's Notice.

Conclusion

29. The Proprietor's Appeal is dismissed. There is no challenge to the Hearing Officer's order for costs in relation to the proceedings in the Registry. I understand that

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the parties are content for me to deal with the costs of the Appeal by making an award in

accordance with the usual practice in inter partes proceedings before the Appointed

Person. On that basis I direct the Proprietor to pay £1,500 to the Applicant as a

contribution towards its costs of the Appeal. In arriving at that figure I have allowed for

the fact that the appeal proceeded to a hearing in connection with which both sides

engaged the services of counsel, whereas the case was determined in the Registry on the

basis of the papers on file without recourse to a hearing. The sum of £1,500 is to be paid

within 21 days of the date of this Decision. It is payable in addition to the sum of £900

awarded by the Hearing Officer.

Geoffrey Hobbs QC

9 September 2013

George Hamer instructed by Mathys & Squire LLP provided written submissions on

behalf of the Proprietor.

Denise McFarland instructed by Reddie & Grose LLP appeared on behalf of the

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Applicant.

The Registrar was not represented at the hearing and took no part in the Appeal.

ANNEX A



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