

**O-095-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION 1399292  
IN THE NAME OF SDI (WIGAN) IP LIMITED  
FOR THE MARK:**



**AND**

**AN APPLICATION FOR REVOCATION THEREOF (NO. 500754)  
BY TRAVEL FOX INTERNATIONAL INCORPORATION**

## Background and pleadings

1) SDI (Wigan) IP Limited (“the Registered Proprietor”) is the proprietor of UK trade mark registration 1399292 for the trade mark shown below:



It was filed on 25 September 1989 and completed its registration procedure on 28 June 1991. It is registered in respect of the following goods:

**Class 25:** *Boots, shoes and sandals; all included in Class 25.*

2) By an application filed on 6 February 2016 Travel Fox International Incorporation (“the Applicant”) seeks revocation of the registration in respect of all of the goods for which it is registered. It bases this application on non-use under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”). The relevant time periods when the Applicant claims non-use are:

- i) under section 46(1)(a): 29 June 1991 to 28 June 1996 (“the first relevant period”);
- ii) under section 46(1)(b): 26 May 2008 to 25 May 2013 (“the second relevant period”).

Revocation is sought under section 46(1)(a) with effect from 29 June 1996 and under section 46(1)(b) with effect from 26 May 2013.

3) The Registered Proprietor filed a counterstatement, denying, in relation to all the goods, that there has been no use of the contested mark within the relevant periods. It states that it acquired the contested mark on 1 October 2012 and believes that the mark has been used by its predecessor in title in respect of part or all of the goods claimed by the registration, but is investigating such use by reference to its predecessor’s records. It filed evidence and written submissions. The Applicant filed submissions in reply. Neither party requested a hearing and, after the evidence rounds were closed, both parties filed written submissions in lieu of attendance at a hearing. I will keep in mind all the written submissions, and I refer to them, as appropriate, in my decision. The Applicant filed a late application to file evidence, and was informed of the Registry’s preliminary view that the request be refused, since it was not considered that the evidence would have a material effect on the proceedings. The Applicant made no challenge during the time allowed, and the evidence was not admitted.

## Legislation

4) 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.”

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.”

5) In *The London Taxi Corporation Ltd (t/a The London Taxi Company) v Frazer-Nash Research Ltd & Another* [2016] EWHC 52 (Ch) Arnold J summarises the law on genuine use. He says:

“219 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 Bunderversammlung 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]”.

## Evidence summary

6) In a witness statement of 24 June 2015 Mr David Michael Forsey states that since 3 March 2009 he has been a director of the Registered Proprietor, which is owned by the UK’s largest sports retailer, Sports Direct. He reproduces the contested mark at the beginning of his statement, identifying it thereafter in his statement as “the TRAVEL FOX registration”. He attaches as **Exhibit DMF-1** a witness statement of Fernando Cesaretti dated 27 May 2014, as submitted in opposition proceedings filed by the Registered Proprietor against the Applicant’s Community Trade Mark Application No. 011772811 TRAVEL FOX & Device, explaining the history of the creation and development of the TRAVEL FOX brand in the 1980s and 1990s. Mr Forsey explains how the “TRAVEL FOX brand” has been sold a number of times over the years, the contested mark being transferred in 2008 to JJB Sports PLC (“JJB”), which was, at the time, a leading UK retail business. He attaches as **Exhibit DMF-8** an extract from JJB’s 2009 Annual Report and Accounts, showing that JJB acquired the TRAVEL FOX brand in 2008 for £2,150,000.

**Exhibits DMF-3 – DMF-6**, consist of blog posts and articles discussing the use of the “TRAVEL FOX” brand on footwear during the first relevant period. **Exhibit DMF-7** is an article from the *Sunday Times*, dated 12 August 2012, in which “*travel fox trainers*” are referenced in connection with footwear worn at raves in the 1990s.

7) Third party articles in **Exhibits DMF-9 – DMF-11** reference the acquisition of the TRAVEL FOX brand by JJB in 2008. An article from the *Birmingham Post*, dated 17 April 2008, refers to a strategy of introducing “*new, higher margin own-brands, such as Champion and Travel Fox*”. An article from *The Independent*, dated 17 April 2008 talks of JJB “*increasing the focus on own-brand products, including the recently purchased Champion and Travel Fox labels ...*”. An extract from *Yahoo Finance* online, dated 7 March 2014, (but which relates to the period to the end of the 2012 fiscal year) mentions JJB selling “*its own brands such as ... Travel Fox ...*”. **Exhibits**

**DMF-24 and DMF-30** contain order forms and invoices showing JJB ordering various items of TRAVEL FOX branded footwear from its suppliers during the Second Relevant Period. **Exhibit DMF-13** is described by Mr Forsey as a non-exhaustive list of over 350 JJB stores that sold TRAVEL FOX branded goods during the second relevant period. These stores are located throughout the UK. To provide examples confirming the stocking of these goods by these stores Mr Forsey attaches Exhibits **DMF-15 to DMF-21**, consisting of various invoice forms for selected dates in 2009, 2010, 2011 and 2012, and showing the delivery of TRAVEL FOX branded footwear to various JJB stores in England and Wales. **Exhibits DMF-25 and DMF-27** contain documentation of actual sales of “TRAVEL FOX branded” footwear to the public in the form of return receipts and pick up receipts from various dates during 2010, 2011 and 2012. **Exhibit DMF-31** shows sales figures for TRAVEL FOX branded products for the Broughton Park store for week 22 of 2012. Further exhibits consist of documentation of price reductions of TRAVEL FOX branded items dated within the relevant period in JJB stores.

8) **Exhibits DMF-32 – DMF-44** consist of a BBC news article, design drawings, photographs of a trainer as sold, screenshots from online retail outlets, and sales figures, all of which are filed to support the claim of genuine use of the contested mark during the time after expiry of the second relevant period and before the application for revocation of the contested mark was made. It will be convenient to examine these exhibits in detail later in my decision, so I shall not summarise them further here.

9) In a witness statement of 24 October 2014 Mr Robert Cumming, states that he is Senior Associate at Appleyard Lees, an intellectual property firm assisting the Registered Proprietor with the gathering of evidence from JJB Sports PLC’s administrator in connection with “the trade mark TRAVEL FOX”. He attests to the difficulties of obtaining access to relevant documentation from JJB’s administrator.

### **Use in the first relevant period**

10) I accept the difficulties of gathering evidence that is over 20 years old, particularly where a registration has subsequently been assigned several times. Nevertheless, the evidence of use in the first relevant period is sparse. It contains no indication, for example, of the volume of sales achieved in the first relevant period. I consider that it does indicate that sales of trainers bearing a “TRAVEL FOX” brand of some description were made in the UK in the first relevant period in quantities sufficient to excite comment in blog posts and articles in *Footwear News* and the *Sunday Times*. Evidence in the form of blogs can be problematic. One can often not be sure of the provenance of the blogs or of the posts – by whom and how they were written. I bear in mind that a press article referencing the use of a “TRAVEL FOX” brand during the relevant period was published in a mainstream national newspaper. The case is very near the line but, viewing the evidence as a whole, I consider it would be just sufficient to support a conclusion of use of a “TRAVEL FOX brand in connection with trainers in the first relevant period. In order to establish genuine use of the contested mark, however, it would need to be shown that the “TRAVEL FOX” branding referred to in the evidence included appropriate and sufficient use of the contested mark as registered, or in a form which did not alter its distinctive character.

11) There are, however, no *direct* examples of, for example, footwear, packaging, UK advertisements or point of sale material bearing the contested mark (or any other TRAVEL FOX mark) during the first relevant period. Instead, Mr Forsey attaches as **Exhibit DMF-2** what he describes as “a TRAVEL FOX brochure which (on pages 7 onwards) demonstrates examples of advertisements and point of sale material from 1990-1996 inclusive, show [sic] a wide variety of footwear bearing the TRAVEL FOX brand.” He says these provide “examples of how the TRAVEL FOX brand appeared on the footwear and how the brand was promoted through advertising during that time period”. The nature and source of this document, by whom it was compiled, to whom it was distributed, and for what purpose, is not specified. It is described as demonstrating examples of advertisements and point of sale material, but it does not show precisely where these advertisements and material appeared. It contains captions in both Italian and English, suggesting a wider circulation than the UK. Mr Forsey states that the “TRAVEL FOX brand became prominent in the United Kingdom along with many other countries around the world, in the 1980s”. I am unable to say with confidence on the basis of the brochure whether any particular image appeared in the UK, or in what publication or outlet, or how often, or whether any particular item depicted was distributed in the UK.

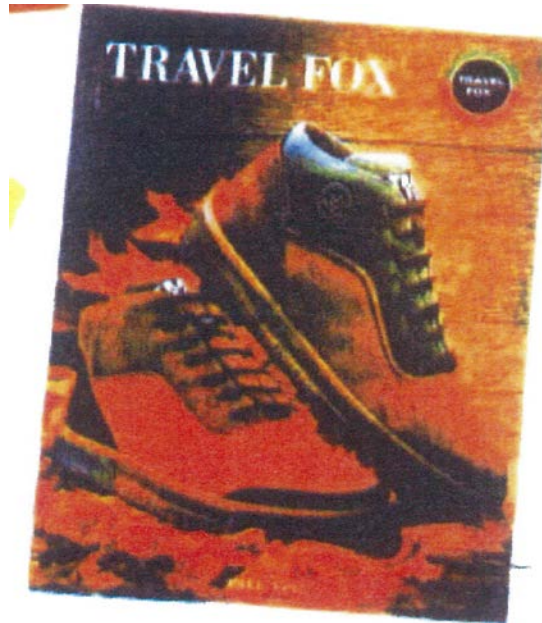
12) **Exhibit DMF-2** is reproduced in full as **Annex 1** to this decision. The images are often not clearly discernible. Often the words TRAVEL FOX (sometimes followed by the ® symbol) appear on their own (or with a descriptor) in a straightforward script – for example, as follows:



Sometimes a circular figurative element which is clearly not the same as that in the contested mark, for example ...



..., or a variant of it, appears to be used on its own, and sometimes in combination – as follows, for example



A couple of the images *may* possibly contain the figurative element which is contained in the contested mark, or an approximation of it ...



The above example, which is at the edge of discernibility, seems to consist of the words TRAVEL FOX followed by the ® symbol and, in smaller presentation below, what looks like a variant of the figurative component of the contested mark, followed by the word FOX, followed by the ® symbol. However, it appears on a page marked “1990” – before the first relevant period. In the following image, which appears on a page marked 1992, the words TRAVEL FOX are accompanied by what looks as though it may be the figurative component of the contested mark or a variant of it ...



... but the quality of the images is poor, and it is not possible to make it out clearly. Moreover, I do not consider that Mr Forsey’s statement is sufficiently precise to enable me to find with confidence that any one particular representation of the proprietor’s signs, including the one above, was used in the United Kingdom during the first



relevant period. On the other hand, as can be seen from **Exhibit DMF-2** as a whole (see **Annex 1**), the words TRAVEL FOX in varying, but usually perfectly straightforward (i.e. plain, or not markedly stylised) script feature repeatedly throughout the examples. Here again, bearing in mind the difficulties of gathering evidence that is over 20 years old, I consider that the evidence, viewed as a whole, is just sufficient to enable me to conclude that there was external (i.e. customer-facing) use of the words TRAVEL FOX in the UK by the Registered Proprietor's predecessors in title as an indication of origin in connection with trainers during the first relevant period (though I cannot conclude that the evidence demonstrates use of the mark as registered in this period).

13) The remaining question, therefore, is whether use of the words TRAVEL FOX in a straightforward (i.e. not strikingly stylised) script can constitute use of the contested mark in a form which does not alter its distinctive character. The contested mark, as registered, is:



14) In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under section.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."

15) The Registered Proprietor submits that "*use in word form is sufficient to constitute genuine use of the [contested mark]*", and cites the observations of Sir Martin Nourse in *Bud/Budweiser Budbrau* [2003] RPC 25 [12]:

"Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements..."

Having observed that, according to the case law, the word element of a mark is, as a rule, more distinctive than the figurative element, the Registered Proprietor submits:

“The primary distinctive component of the mark claimed under the Travel Fox Registration is the word element TRAVEL FOX. TRAVEL FOX is a fanciful juxtaposition of a verb (TRAVEL) and a noun (FOX) that is highly distinctive for the goods covered by the registration. It is the dominant part of the mark. The omitted device element, on the other hand, is merely a simple device comprising a line drawing of three triangles overlaid upon each other and part of a circle. Even if it is a recognisable element, on a global appreciation of the visual, conceptual and aural elements of the mark, the mark will be referred to by consumers verbally as TRAVEL FOX, and the words dominate the impression of the mark as a whole and designate the origin of the Goods. The device is not sufficiently significant to form a part of the mark’s distinctive character in light of the word element”.

The Registered Proprietor goes on to submit that an analogy can be drawn with a number of cases where the omission of a figurative element in the mark as used was held not to alter the distinctive character of the mark as registered, citing a decision of the OHIM Board of Appeal<sup>1</sup> and two decisions of the General Court<sup>2</sup>. In this regard I would observe that each case must be decided on its own facts. My task is to apply the principles enunciated in the case law to the facts of the present case.

16) I consider that most of the distinctive weight of the mark lies on the words TRAVEL FOX. I do not consider that the average consumer of the relevant goods will place any significant distinctive weight on the fact that the word *Travel* is written in title case and the word FOX in capitals. Writing both words in capitals or in title case, whether mildly italicised or not, will not, in my view, alter the distinctive character of the mark in this case. However, although I think that less distinctive weight will be placed on the figurative component of the mark than on the words TRAVEL FOX, I nevertheless consider that this figurative component is sufficiently significant to contribute to the distinctive character of the mark. It too will be regarded by consumers as serving the function of distinguishing the goods concerned from those of other undertakings, rather than having a mere decorative function. The elements of which it is composed are simple, basic geometric shapes, but they are combined in a way which, though uncomplicated, is nevertheless original and distinctive. Omitting this figurative element alters the distinctive character of the mark. I therefore find that use of the words TRAVEL FOX in plain script during the first relevant period did not constitute use of the contested mark in a form which did not alter its distinctive character. **Accordingly, I find that there was no genuine use of the contested mark during the first relevant period.**

### **Use in the second relevant period**

17) I consider that the items of evidence contained in **Exhibits DMF-23 – DMF-31**, including order forms, invoices, return and pick-up receipts for various dates, together with sample sales figures for a particular branch in a particular week in 2012, are, taken as a whole, sufficient to show that significant sales of “TRAVEL FOX branded”

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<sup>1</sup> Board of Appeal R 0578/2008-2

<sup>2</sup> *Xavier Grau Ferrer v OHIM T-543/12; Lidi Stiftung & Co KG v OHIM T-225/12*

trainers were made through various retail outlets throughout the UK over the period from 2009 to 2012, when JJB, the Registered Proprietor's predecessor in title, went into administration. However, the evidence does not contain a single direct example showing external (i.e. customer-facing) use of the contested mark in the form as registered, or in a form not altering its distinctive character – for example, on footwear or packaging, or in advertisements or point of sale material – during the second relevant period. Moreover, not even indirect evidence, (such as the “brochure” proffered in **Exhibit DMF-2** in respect of the first relevant period) is provided.

18) Even taking into consideration the problems of gaining access to relevant material from the administrator of JJB, this is a very serious deficiency in the evidence. The use of TRAVEL FOX in the invoices, return receipts, sample sales figures and other materials used in relation to the promotion and sale of “TRAVEL FOX branded Goods” contained in **Exhibits DMF-24 – DMF-31** is *internal* use. The third party articles in Exhibits **DMF-9 – DMF-11** and **DMF-32** and *LinkedIn* profiles of former JJB employees in **Exhibit DMF-12** simply confirm the existence of a JJB “own brand” referred to as TRAVEL FOX, rather than how this brand was presented to consumers. **Exhibit DMF-23** (on page 172) contains what Mr Forsey describes as “a *sheet of sales tag for goods sold by JJB*”. It is undated. It shows 24 small tags of the type which is attached to goods to provide a bar-code and certain basic identifying data. Besides the bar code and the basic style, size and colour (“JACKSON BLK/GOLD SIZE 9”) on one of them the words TRAVEL FOX appear in smaller type with a serial number. Unlike the tag shown in **Exhibit 38**, discussed below, the tag is not shown sewn into goods in a prominent position; nor is it shown stuck on packaging or the underside of a shoe, for example.

19) It might perhaps be argued (the Registered Proprietor made no explicit submission on this particular point) that, given my finding that there was external use of the sign TRAVEL FOX during the first relevant period, and given evidence that “TRAVEL FOX branded” goods were widely distributed in the UK in the second relevant period, it would be reasonable to infer that the sign TRAVEL FOX continued to be used externally during the second relevant period. It might be urged that the solitary undated tag in **Exhibit DMF-23** lends some limited support to this inference. Even if such an inference can justifiably be drawn, however, the Registered Proprietor has still not succeeded in showing genuine use of the contested mark in the second relevant period, because there is absolutely no evidence that the figurative element in the contested mark was included in the sign used by the Registered Proprietor during this period. I have already explained in paragraph 16 why I consider that the omission of this figurative component alters the distinctive character of the mark. **Accordingly, I find that there was no genuine use of the contested mark during the second relevant period.**

#### **Use from the end of the second relevant period to the date of the application for revocation**

20) Section 46(3) deals with the position where there has been five years' non-use but use of the mark is commenced or resumed prior to the application for revocation being made. Such commencement or resumption of use will save the mark from revocation as long as that use is genuine. The proviso to section 46(3) requires the

tribunal to disregard any such commencement or resumption of use after the five years of non-use but within the period of three months before the application for revocation is made, unless preparations for it began when the proprietor was unaware that the application for revocation might be made. In the present proceedings the second relevant period expired on 25 May 2013 and the application for revocation was filed on 6 February 2015, the Applicant having informed the Registered Proprietor on 20 October 2014 of its intention to seek revocation of the contested mark.

21) Mr Forsey explains that “*Rights to TRAVEL FOX marks, including the TRAVEL FOX Registration [i.e. the contested mark], were sold by JJB to SDI following JJB’s entry into administration on 24 September 2012*”. He states that a key component of the Registered Proprietor’s strategy is the acquisition and revitalisation of existing brands; that the Registered Proprietor purchases existing brands, such as TRAVEL FOX, and then develops product ranges bearing the brands to sell through its retail outlets, and to wholesale to other businesses, in some cases licensing the use of these brands to third parties. Following the acquisition of the TRAVEL FOX brand in November 2012, he says, the Registered Proprietor began developing products to be sold bearing this brand.

22) Mr Forsey states that the “*first sales of TRAVEL FOX clothing and footwear by SDI were in August 2013 through [www.sportsdirect.com](http://www.sportsdirect.com), <http://stores.ebay.co.uk/sportsdirectoutlet> and [www.amazon.co.uk](http://www.amazon.co.uk)*”, and that “*Sales of TRAVEL FOX branded goods through these outlets have been continuous since then*”. He further states that sales of the Registered Proprietor’s TRAVEL FOX clothing and footwear through [www.jjbsports.com](http://www.jjbsports.com) commenced in December 2013 and sales of TRAVEL FOX clothing and footwear through [www.lillywhites.com](http://www.lillywhites.com) (a group company of the Registered Proprietor) commenced in January 2014 and have been continuous since those dates. He points out that in **Exhibit DMF-5** a blog post at [garywarnett.wordpress.com](http://garywarnett.wordpress.com), includes a comment, dated 20 November 2013, stating “*I just walked into sports direct and to my amazement found them selling the white, green and red high top travel fox boots. I bought a pair for £29.99*”, and that this is a reference to the TRAVEL FOX “Troop” hi top footwear; but he makes no further reference to any sales through physical stores, and the figures in **Exhibit DMF-43** contains figures in respect only of online sales.

23) In **Exhibit DMF-34** Mr Forsey attaches design drawings for what he describes as variations of the Registered Proprietor’s *Troop hi top* and *TAL 14-0201* models of TRAVEL FOX branded footwear. The drawings constitute internal use, and the Registered Proprietor submits them as examples of preparations made to develop the footwear. They are dated November 2013 and February 2014 respectively. Mr Forsey says the second design drawing is for a variation of the “Troop” hi-top model as shown or referenced in **Exhibits DLMF 5, 34, 35, 36, 37, 38, 40 and 42** and that this model, which bears the contested mark (“*the TRAVEL FOX Registration*”), has been continuously sold in the UK since at least 22 August 2013. He attaches as **Exhibit DMF-35** images of the TRAVEL FOX “Troop hi top”, which he states were downloaded from the [www.sportsdirect.com](http://www.sportsdirect.com) online retail store on 22 August 2013, and show how the footwear was offered for sale in the UK on the [www.sportsdirect.com](http://www.sportsdirect.com) website as at that date. This exhibit is appended to this decision as **Annex 2**. Mr Forsey explains that **Exhibit DMF-38**, which is reproduced as **Annex 3** of this decision, contains photographs of Travel Fox Troop hi top footwear purchased from the

[www.sportsdirect.com](http://www.sportsdirect.com) website in November 2014, as proof of which he attaches as **Exhibit DMF-39** an email confirmation note from [sportsdirect.com](http://sportsdirect.com).

24) As can be seen from the images of the “Troop hi top” in **Exhibit DMF-38**, the label on the inside of the tongue shows the words TRAVEL FOX prominently in plain script capitals and, beneath them, a variant of the figurative element in the contested mark as registered:



I have already explained in paragraph 16 why I think that showing the words TRAVEL FOX in a plain capital script does not alter the distinctive character of the contested mark. There are some minor differences in the figurative element; the overlapping triangles of the logo are no longer complete, the final triangle is filled in, the orientation of the logo is different, appearing below, rather than to the side of, the words. The distinctive character of the mark as registered, however, consisting in its words and logo, remains unaltered. The same considerations apply in respect of the label on the innersole of the shoe:



Both constitute use of the contested mark in a form which does not alter its distinctive character<sup>3</sup>.

25) The purpose of the provision in section 46(2) of the Act, which avoids imposing strict conformity between the form of the trade mark used and the form in which the mark was registered, is to allow its proprietor in the commercial exploitation of the sign to make variations which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned<sup>4</sup>. It is common for producers of fashion clothing and footwear to integrate their trade marks and logos into the designs of their goods. With regard to the external appearance of the trainer, as can be seen in **Annex 2 (Exhibit DMF-35)** and **Annex**

<sup>3</sup> In an analogous case, *GfK AG v OHIM* Case T-135/04, the General Court found that a variant which altered the positions of the mark’s component parts did not to alter its distinctive character.

<sup>4</sup> See *Bernhard Rintisch v Klaus Eder* Case C-553/11 at paragraph 21, where the CJEU considered the provision of the directive on which section 46(2) of the Act is based

**3 (Exhibit DMF-38)** the images show the words TRAVEL FOX prominently displayed in plain capitals on the heel of the trainer, with a phrase in Italian in smaller print below. The words TRAVEL FOX are also displayed prominently in the same way on the tongue, the words of a phrase in Italian appearing on the fastening strip. The figurative component of the contested mark, in the slightly modified form described above, is shown prominently on the side of the trainer. Thus, both distinctive elements of the contested mark appear conspicuously on the outside of the trainer. Both elements will be perceived, and I do not consider that, in this case, the spatial separation of the word and figurative components alters the distinctive character of the mark; the manner in which they are deployed on the exterior of the shoe constitutes use of the contested mark.

26) **Exhibit DMF-36** is a printout from the online retail store [www.sportsdirect.com](http://www.sportsdirect.com), dated 7 March 2014, (redirected from the website [jjbsports.com](http://jjbsports.com) which, as explained by Mr Forsey, was also acquired by the Registered Proprietor) showing the TRAVEL FOX “Troop” style for sale in various colour variations. The quality of the reproduction is not good, and the images are much too small to make out the use of trade marks; but the descriptions “travel fox troop” are just legible, and the design can be seen to correspond to that in **Exhibit DMF-35**. **Exhibit DMF-37** consists of print-outs from the website [www.sportsdirect.com](http://www.sportsdirect.com) sourced from the Internet Archive Wayback Machine, showing how various colour variations of the Troop Hi tops, priced in pounds, were being offered for sale in the UK on the website as at 31 March 2014. Mr Forsey states that goods bearing the TRAVEL FOX brand are also sold through the Registered Proprietor’s USC branded online retail store, [www.usc.co.uk](http://www.usc.co.uk), and attaches as **Exhibit DMF-40** a print out from this website showing TRAVEL FOX Troop hi tops and TRAVEL FOX trainers for sale on this website on 18 December 2014. He states that the footwear bears the contested mark (“the TRAVEL FOX Registration”). The styles shown are Travel Fox troop and Travel Fox volley trainers. **Exhibit DMF-41** shows listings of Travel Fox products from third party sellers in 2014. Mr Forsey states that these include the “Jackson” style shown on the stock delivery forms in **Exhibits DMF-15 to 21** above, but omits to state that they bear the “TRAVEL FOX Registration”.

27) Mr Forsey states that the print-outs in **Exhibit DMF-42** show how products bearing “the TRAVEL FOX Registration” are currently sold via various websites from the Registered Proprietor and its related companies. They were downloaded in June 2015. Although dating from after the Applicant’s application to revoke the contested mark, Mr Forsey suggests that these print-outs demonstrate how the products remain continuously on sale, the continuous sales through various websites targeted at UK consumers demonstrating the continued use, development and expansion of the TRAVEL FOX brand which has been undertaken by the Registered Proprietor since 2013. I also note that customer reviews of the Troop style trainers dated September and November 2014 (at page 261), appear to indicate that these products were on sale during 2014 via the same web pages.

28) **Exhibit DMF-43** is a table setting out monthly retail sales figures for what Mr Forsey describes as “*SDI’s TRAVEL FOX clothing and footwear bearing the TRAVEL FOX Registration*” in EU countries for the period August 2013 to September 2014 through the relevant retail outlets (SportsDirect.com, Amazon.co.uk, ebay.com, jjbsports.com, lillywhites.com), giving country of sale for each entry. Sales are shown for the UK consistently each month, varying between £1,500 and £2,500 (over

£4,000 in December and January) for sportsdirect.com, and supplemented by further sales from ebay.com, amazon.com, jjbsports.com and lillywhites.com. Mr Forsey states that the total sales of TRAVEL FOX clothing and footwear for this time period in the UK were £44,114.13, and attaches in support **Exhibit DMF-44** summarising these figures by showing the total sales for TRAVEL FOX branded clothing and footwear in this period, broken down by country. However, sales are indicated in terms of quantity and order value, not in terms of particular items of footwear or clothing.

29) The Applicant points out: that the evidence (sales figures) in **Exhibits DMF-43 and DMF-44** is internal and unsupported by invoices or sale receipts, full accounts or other verification; that for such recent claimed use, the Proprietor should not have had any difficulty in obtaining supporting evidence from its current records; that a total sales figure of £44,114.14 over thirteen months (equating to average sales of only £3,393.40 per month) is not significant, considering the large number of stores the Registered Proprietor has across the UK, in addition to its online presence, through which it could sell products bearing the contested mark; that it is a low figure when considering (i) the total size of the footwear market in the UK, (ii) the fact that the relevant products are mass market goods, and (iii) the size of the Registered Proprietor's business. Furthermore, the Applicant points out that the figures submitted by the Registered Proprietor include clothing sales, which are irrelevant for the purposes of these proceedings; thus, given the lack of detailed figures it is impossible to determine how much of the total sales relates to footwear, making the figures even more unreliable in determining whether genuine use has been made of the contested mark.

30) In addition, the Applicant points out that the Mr Forsey has already noted in in his witness statement in these present proceedings that there are concurrent proceedings between the parties before OHIM. The Applicant says that all of the evidence of resumption of use before the date of the current revocation action submitted by the Proprietor is dated after the date of the proceedings before OHIM, which were commenced on 28 August 2013. Mr Forsey refers to concurrent proceedings, though he gives no date of commencement. He also states that the first sales of TRAVEL FOX clothing and footwear by the Registered Proprietor were in August 2013 and that the Troop Hi Top model, which bears the contested mark ("Travel Fox Registration") has been continuously sold since 22 August 2013. In any event, I think it must have been within the contemplation of the Registered Proprietor at the time the OHIM proceedings were begun that an application for revocation of the contested mark was on the cards.

31) I accept that the Registered Proprietor commenced use of the contested mark in August 2013. The first point to make is that this was well before the three month period preceding the application for revocation in the present proceedings on 6 February 2015 (and over thirteen months before the Registered Proprietor was informed on 20 October 2014 of the Applicant's intention to seek revocation of the contested mark), making the proviso in section 46(3) irrelevant. With or without the proviso, though, I consider that evidence suggesting that the Registered Proprietor was aware of a possibility that an application for revocation might be made may in principle be one factor, among all the others, which may legitimately be considered when assessing the evidence of genuine use.

32) The Registered Proprietor's evidence could certainly have been fuller, more focused, and more clearly and precisely presented. However, I must look at all the evidence submitted and, in doing so, I must not simply consider each item of evidence individually, but step back and consider the evidence as a whole to see what it establishes. In so doing, I think it fair to bear in mind that the contested mark had been newly acquired by the Registered Proprietor in November 2012 as a result the previous owner having gone into administration, so that a certain cautious or measured approach to the initial use of the new mark need not necessarily be surprising. Against this background I consider that the figures provided in **Exhibits DMF-43 and DMF-44**, modest though they are, especially considering that they include non-footwear items, nevertheless indicate a certain consistency over time. I consider that sale of the relevant goods, priced in pounds, through online retail outlets with national reach in the UK indicates a certain geographical coverage.

33) I bear in mind that the purpose of the requirement for genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade mark protection to the case where large scale commercial use has been made of the marks (*Sunrider v OHIM — Espadafor Caba (VITAFRUIT)* T 203/02, paragraph 38 and the case-law cited). I must also bear in mind, however, that not every proven commercial use of the mark may automatically be deemed to constitute genuine use. This is clear from the reasoned order of the Court of Justice of the European Union ("CJEU") in *Reber Holding & Co KG v OHIM* Case C-141/13 P<sup>5</sup>. The question I must address is whether the proven use was commercially warranted in the marketplace, taking account of all the relevant facts and circumstances of the case, which are interdependent.

34) Weighing the various interdependent factors involved, and viewing the evidence as a whole, I have reached the conclusion that the Registered Proprietor's use of the contested mark between August 2013 and February 2015 was commercially warranted in the marketplace, taking account of all the relevant interdependent facts and circumstances of the case. **Accordingly, I find that the Registered Proprietor has shown genuine use of the contested mark in respect of *trainers* during the time between the end of the Second Relevant Period and the application for revocation of the mark on 6 February 2015.**

### **A fair specification**

35) Having determined the goods for which the Registered Proprietor has shown genuine use, I must decide upon a fair specification. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as follows:

"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

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<sup>5</sup> Unfortunately, the text of the reasoned order is not available in English, but Prof Ruth Anand's analysis of this case, when sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* ("*STRADA*" O/528/15), showing how it reflects the established case law, was recently cited with approval by Arnold J in *The London Taxi Corporation Ltd (t/a The London Taxi Company) v Frazer-Nash Research Ltd & Another* [2016] EWHC 52 (Ch) at paragraphs 217-218.



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.”

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

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

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

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently

then proof of use in relation to only one or more of those sub- categories will not constitute use of the mark in relation to all the other sub- categories.

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

37) As can be seen from this, the case-law encourages the use of appropriate sub-categorisation. One should also avoid being picky or too narrow in choosing a fair description, and not strip the mark of protection for things which are not in substance different from other goods in the same category. However, the Registered Proprietor has shown genuine use only for the type of footwear described as *trainers*. *Boots* and *shoes* are clearly much broader categories with many possible sub-categories, and including, for example, such diverse items of footwear as riding boots and formal dress shoes. I have considered whether *casual boots and shoes* might be appropriate; but even this category might include items which a consumer would not normally bracket with *trainers*. I have come to the conclusion that *trainers* itself constitutes a coherent category of footwear recognised by consumers, and that *trainers (footwear)* is a fair specification of the goods for which the Registered Proprietor has shown use.

## Outcome

38) The Registered Proprietor has shown genuine use only in respect of *trainers*. It has shown no genuine use of any other goods of the registration for which the Applicant sought revocation in either of the relevant periods under section 46(1)(a) or 46(1)(b), or in the interval between the end of the second relevant period and the present application for revocation. **Accordingly, the registration shall be revoked with effect from the earliest date from which the Applicant sought revocation, namely 29 June 1996, save for the following goods. The mark shall remain registered for the following goods:**

**Class 25: *Trainers (footwear)***

## **COSTS**

39) The Applicant has succeeded only partially. The Registered Proprietor has retained the goods for which it has been using the mark. The result might be described as a “score draw”. Neither side will be favoured with an award of costs.

**Dated this 25<sup>th</sup> day of February 2016**

**Martin Boyle**

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

**ANNEX 1**

**Exhibit DMF-2 to the  
Witness statement of David Michael Forsey  
Dated 24 June 2015**

TRADE MARKS ACT 1994

IN THE MATTER of United  
Kingdom Trade Mark  
Registration No. 1399292  
TRAVEL FOX and device in  
class 25 in the name of SDI  
(Wigan) IP Limited

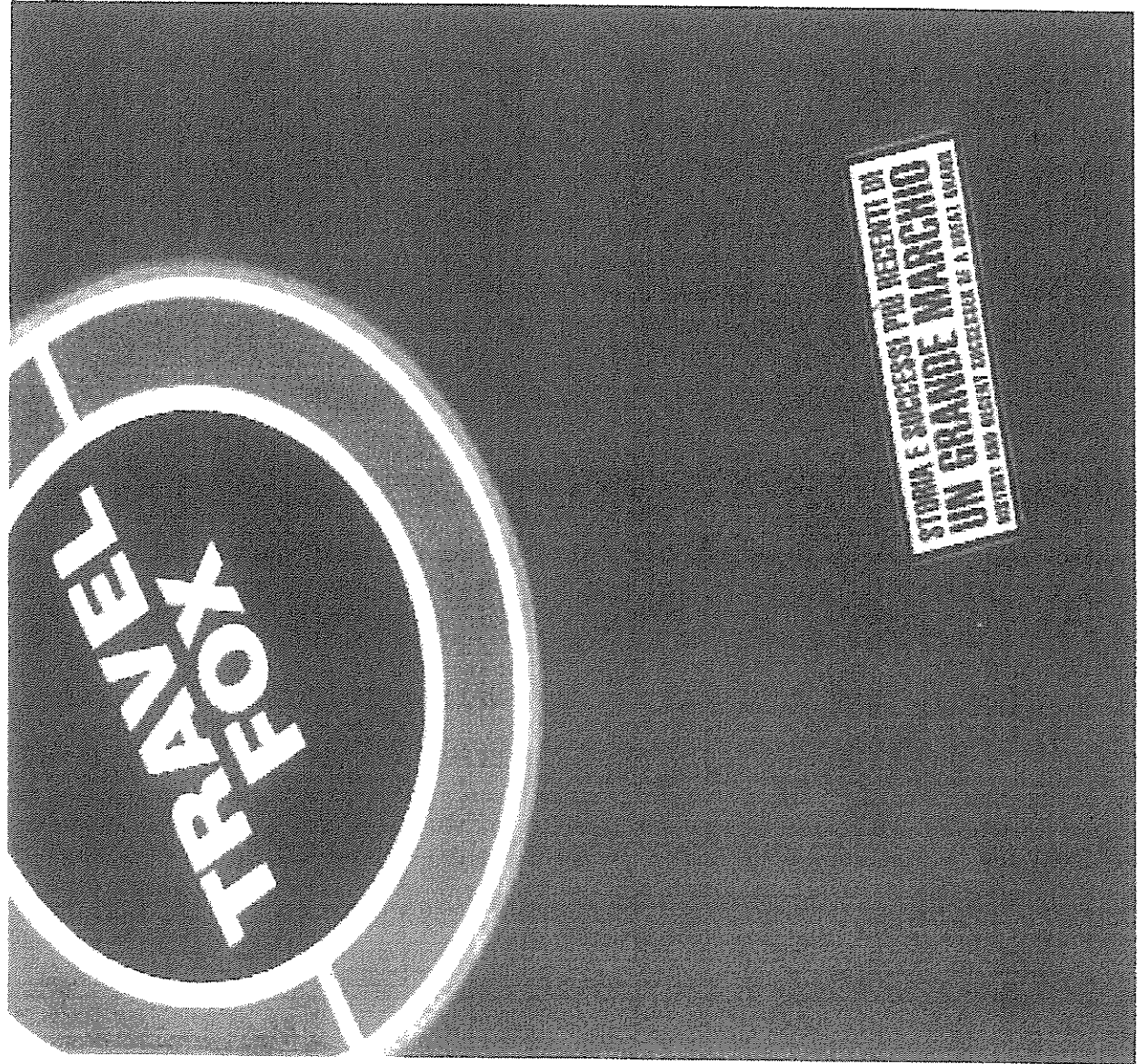
and

Revocation No. 500754 thereto  
by Travel Fox International  
Incorporation

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EXHIBIT DMF-2 TO THE  
WITNESS STATEMENT OF DAVID MICHAEL FORSEY  
DATED 24 JUNE 2015

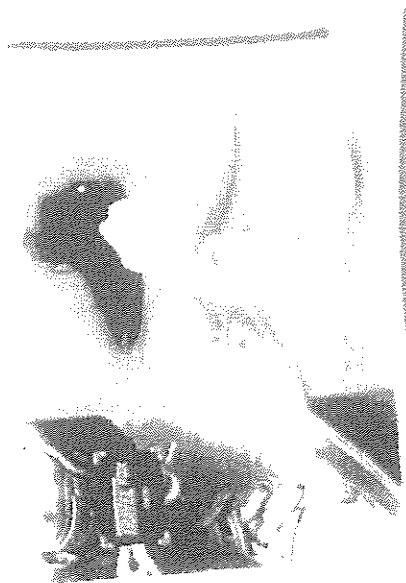
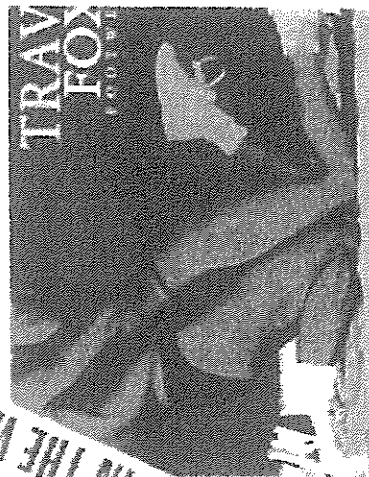
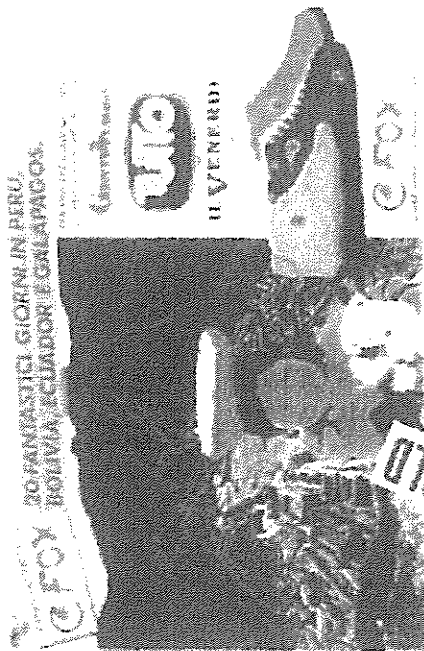
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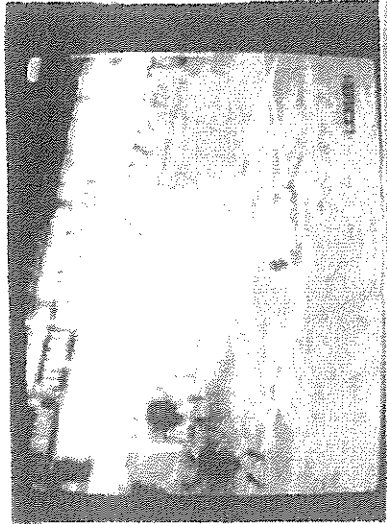
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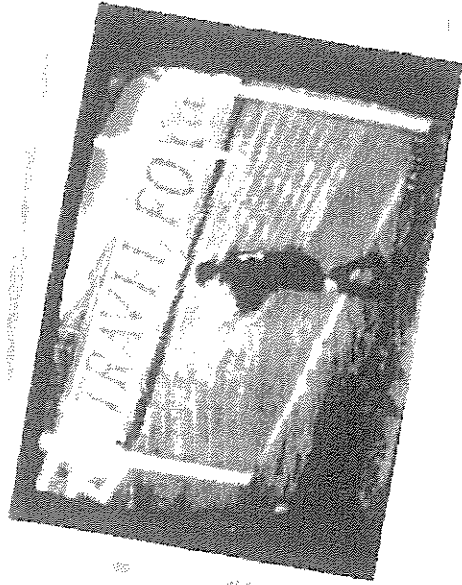




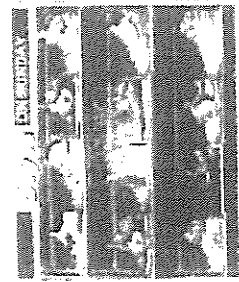


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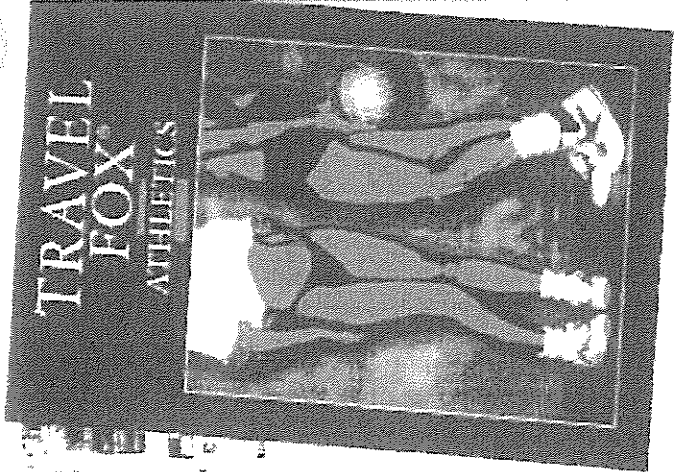
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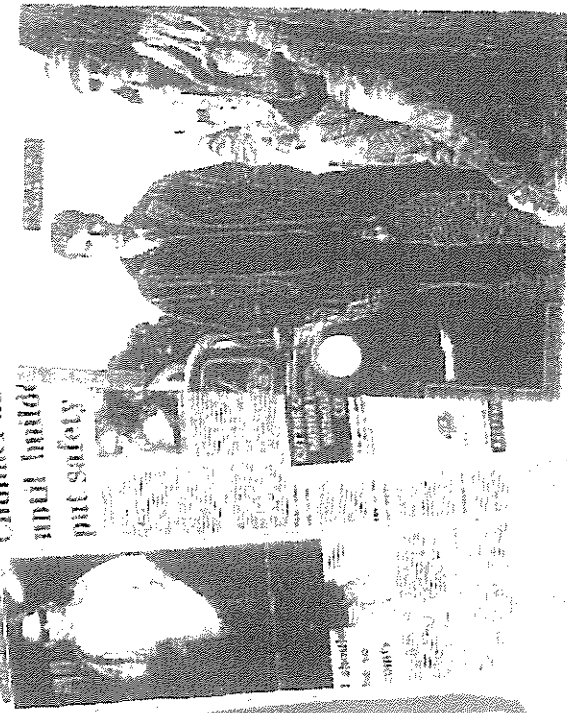


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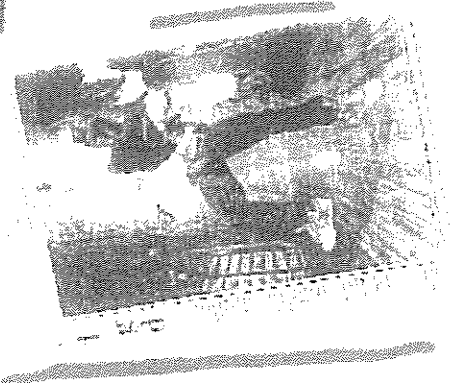
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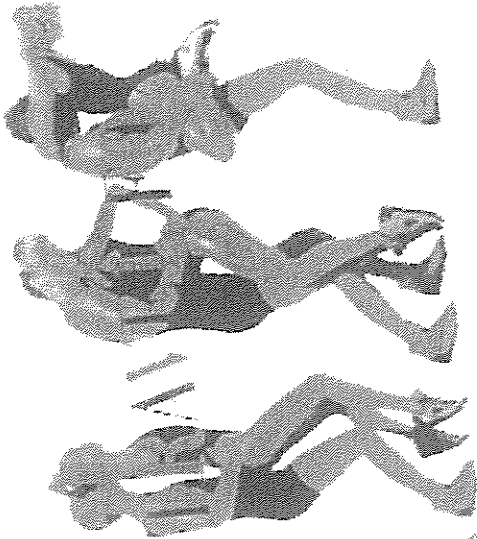


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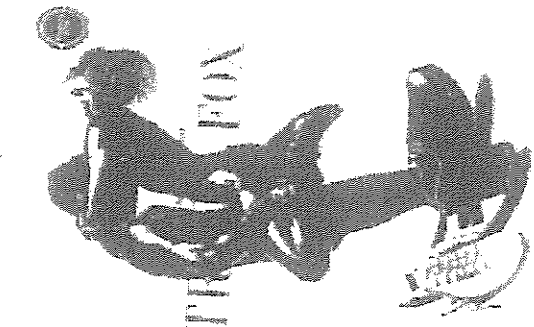
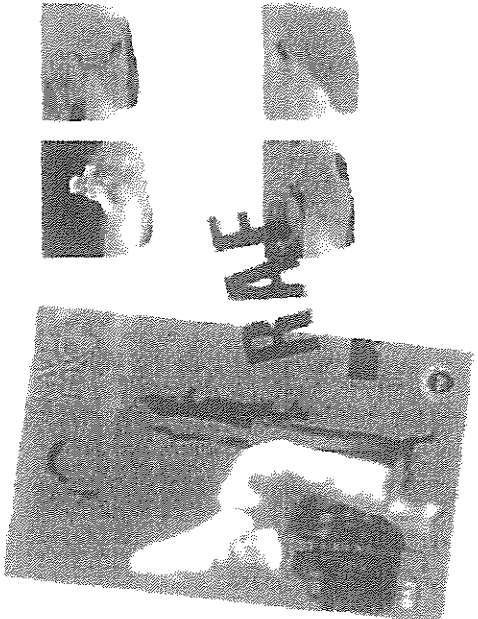


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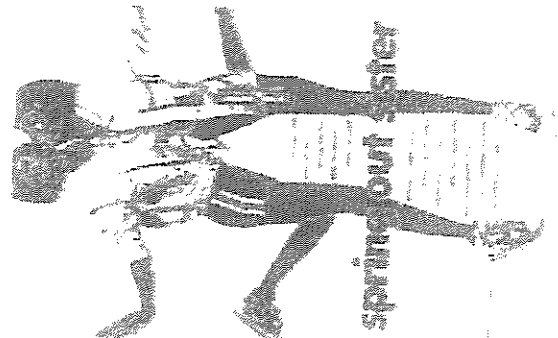




FOX APPEAL



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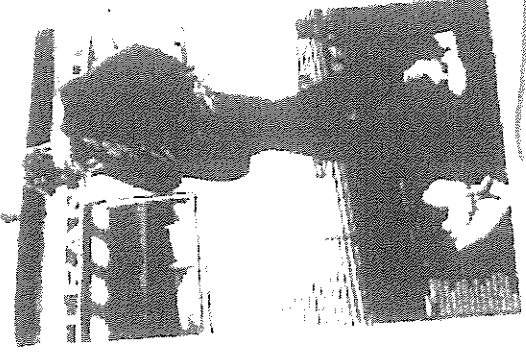


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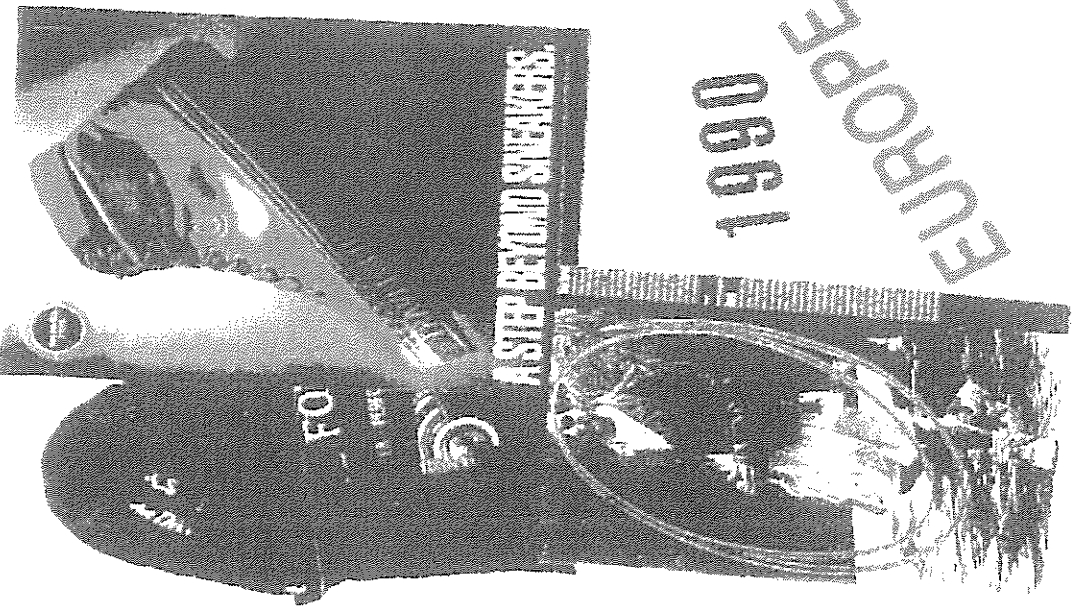


RAVEL FOX

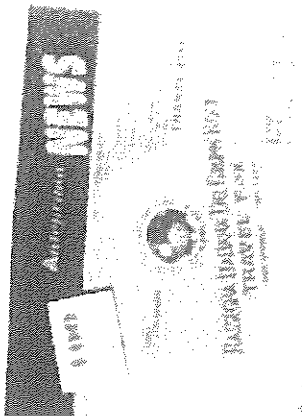
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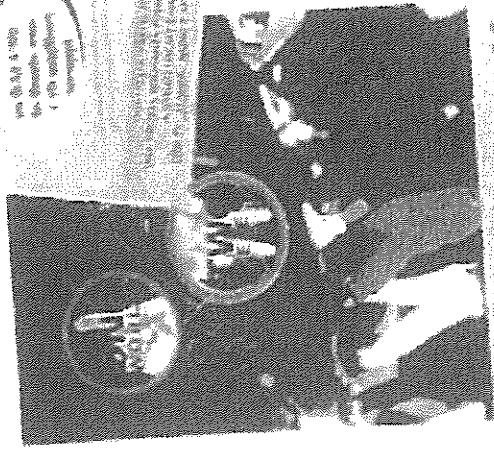
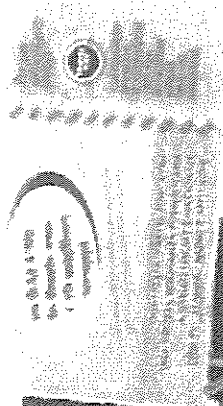




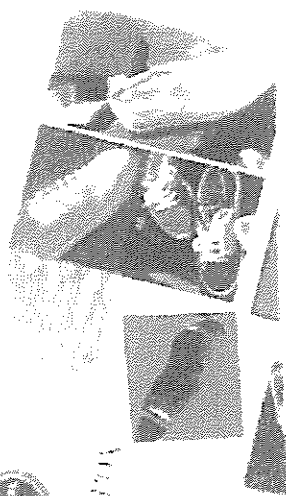
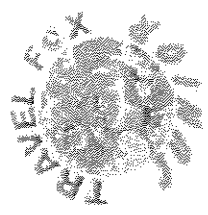


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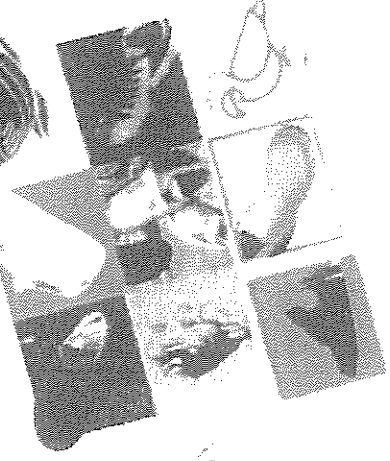
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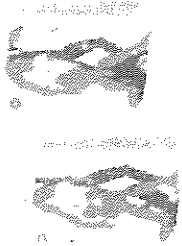
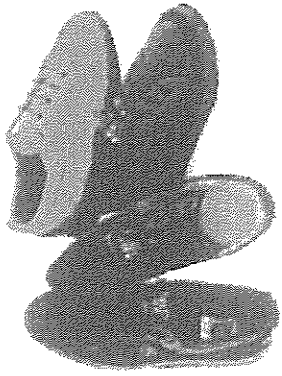
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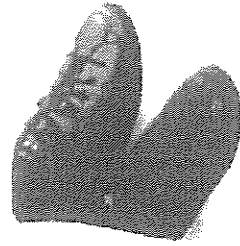
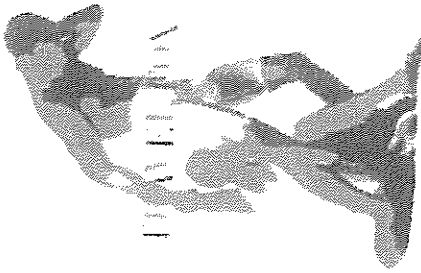


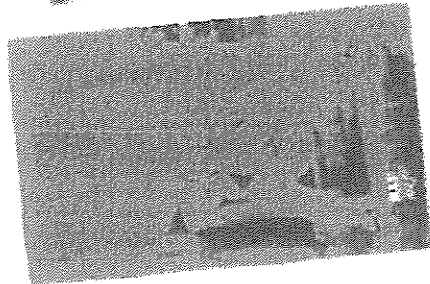
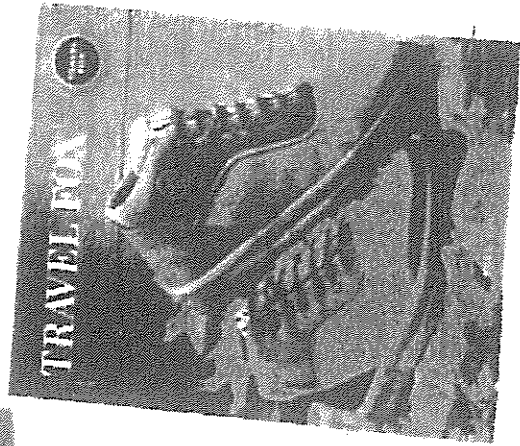
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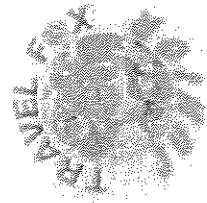
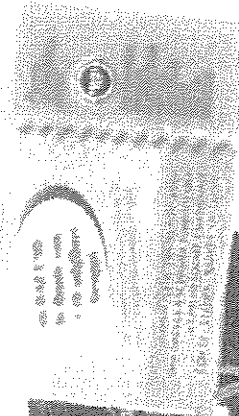
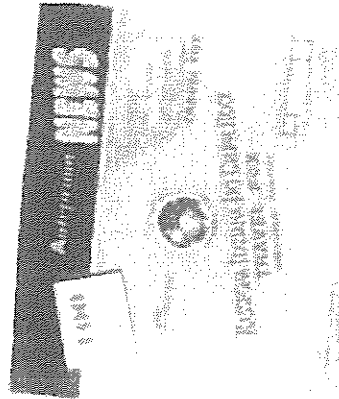
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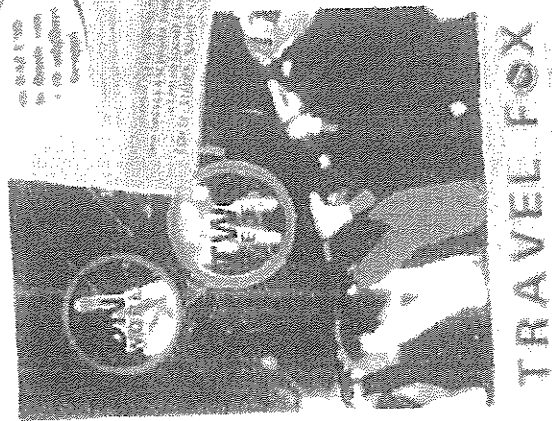


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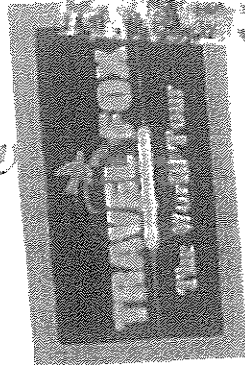
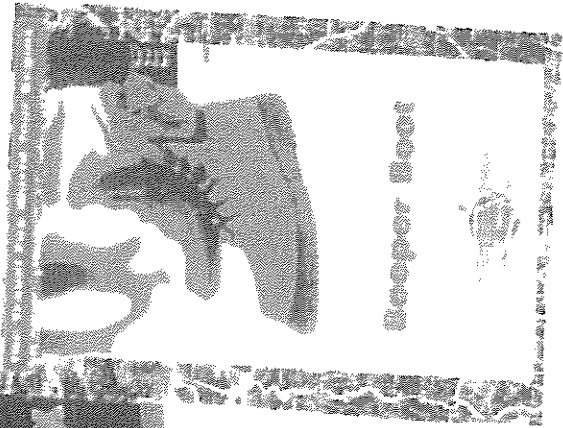
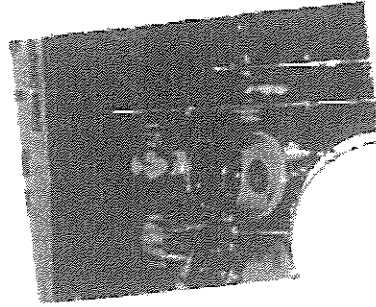
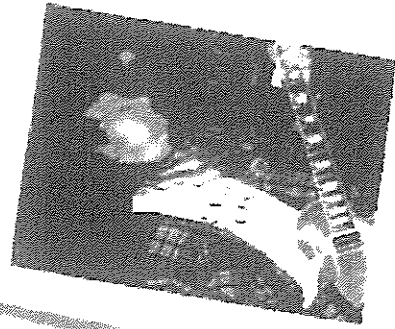
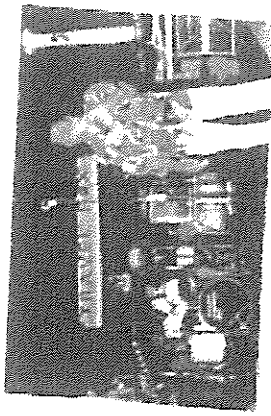
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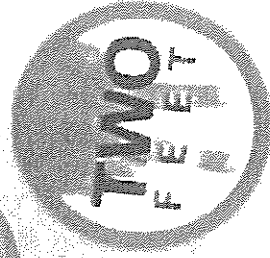
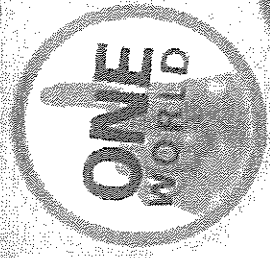




READY TO GO



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NEW FASHION



# BLAH

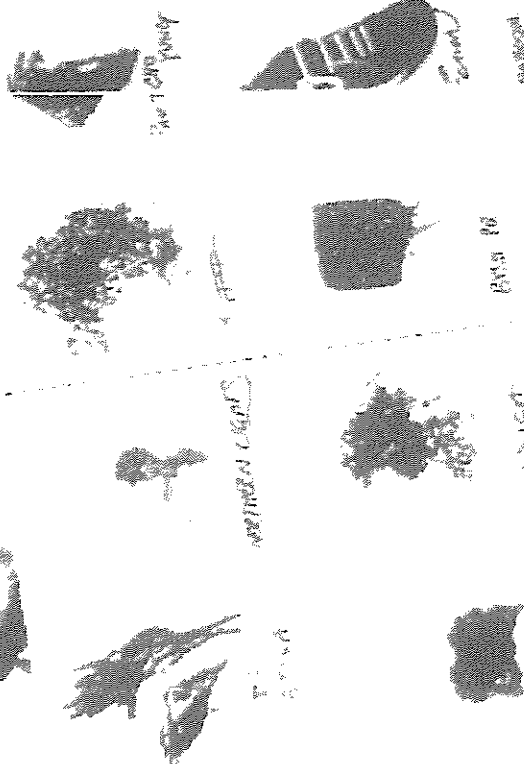
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# TRIE

# ADVERTISING



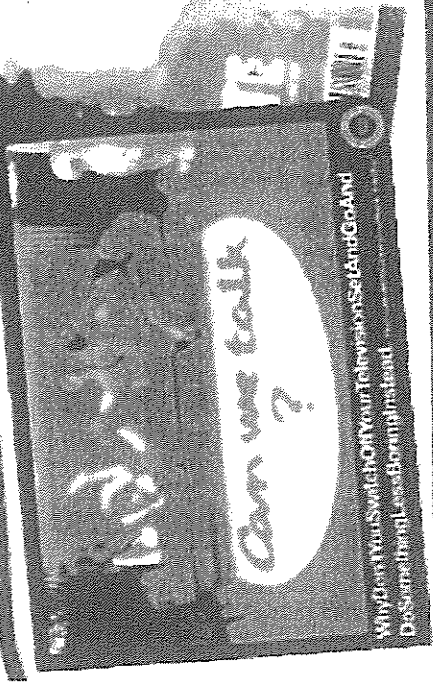
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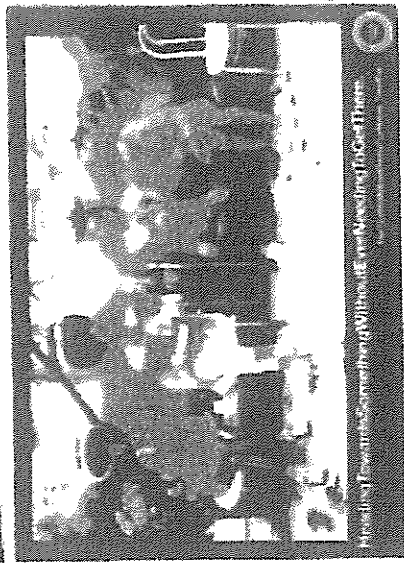
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© 1988 STANLEY J. GROSSMAN & COMPANY, INC. ALL RIGHTS RESERVED

# U-SPOT

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del comere.  
Beyond the norm



Why Don't You Switch Off Your Television Set and Go And  
Do Some Hand-Less Work Instead



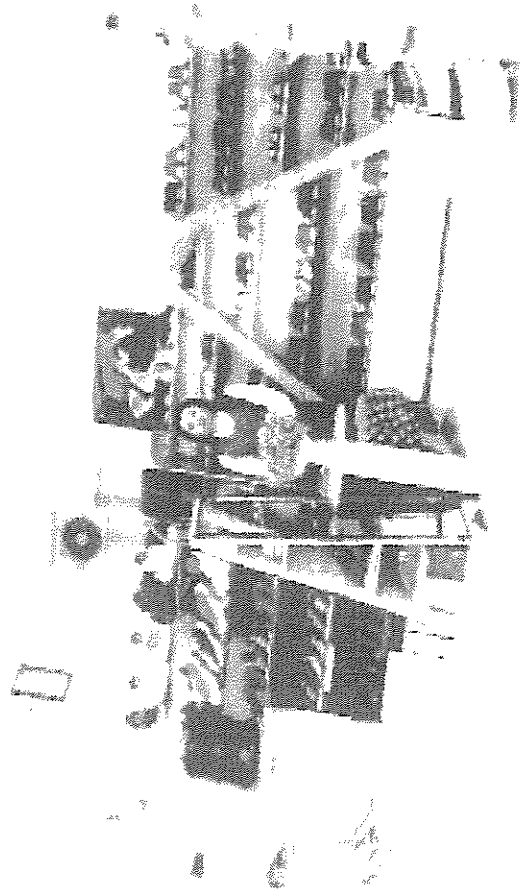
How Do I Earn My Money Without Being Needed To Get There?

# TRAVEL FOX



# RE-INVENTING A BRAND CONCEPT





**ANNEX 2**

**Exhibit DMF-35 to the  
Witness statement of David Michael Forsey  
Dated 24 June 2015**

TRADE MARKS ACT 1994

IN THE MATTER of United  
Kingdom Trade Mark  
Registration No. 1399292  
TRAVEL FOX and device in  
class 25 in the name of SDI  
(Wigan) IP Limited

and

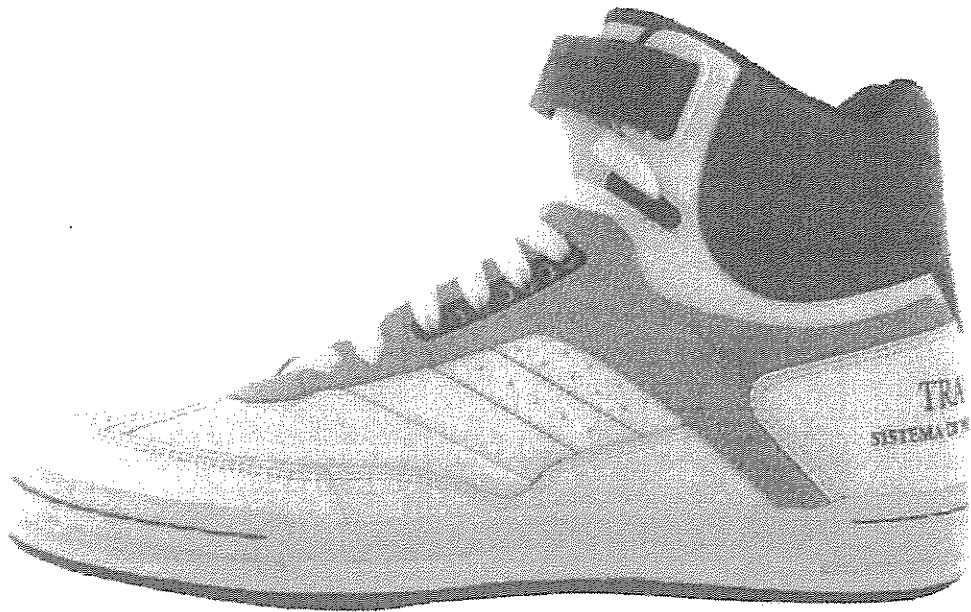
Revocation No. 500754 thereto  
by Travel Fox International  
Incorporation

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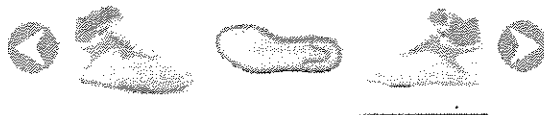
EXHIBIT DMF-35 TO THE  
WITNESS STATEMENT OF DAVID MICHAEL FORSEY  
DATED 24 JUNE 2015

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Travis Five Lines Men's Sneakers - 2015



Travis Five Lines Men's Sneakers - 2015

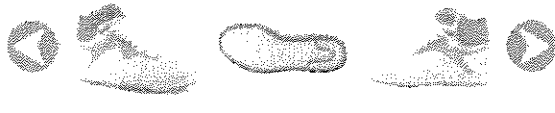


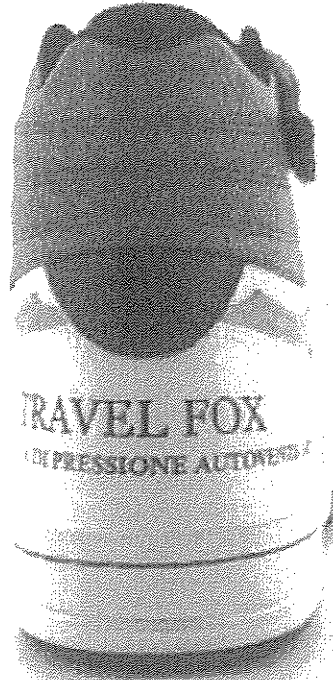




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Travel Fox Group No. 401 Fax 1/20/98

**ANNEX 3**

**Exhibit DMF-38 to the  
Witness statement of David Michael Forsey  
Dated 24 June 2015**

TRADE MARKS ACT 1994

IN THE MATTER of United  
Kingdom Trade Mark  
Registration No. 1399292  
TRAVEL FOX and device in  
class 25 in the name of SDI  
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and

Revocation No. 500754 thereto  
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Incorporation

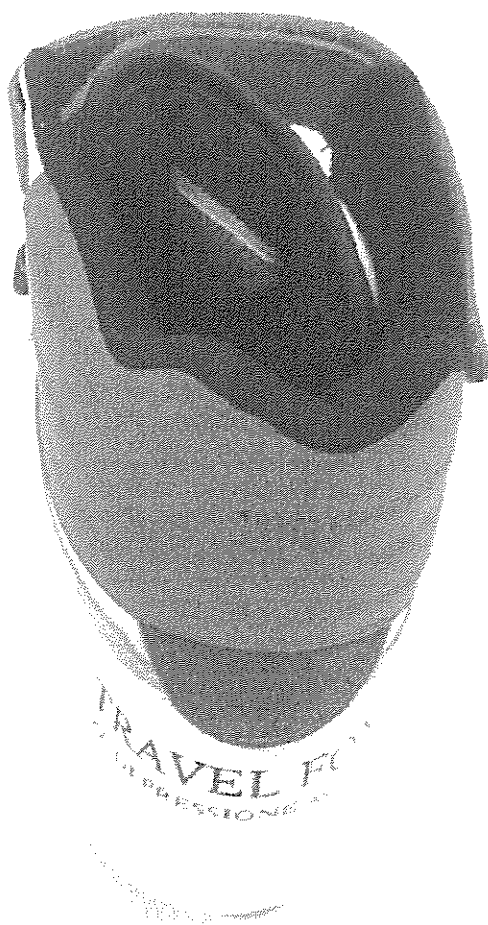
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EXHIBIT DMF-38 TO THE  
WITNESS STATEMENT OF DAVID MICHAEL FORSEY  
DATED 24 JUNE 2015

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Photographs showing TRAVEL FOX branding on TRAVEL FOX Troop Hi Top footwear

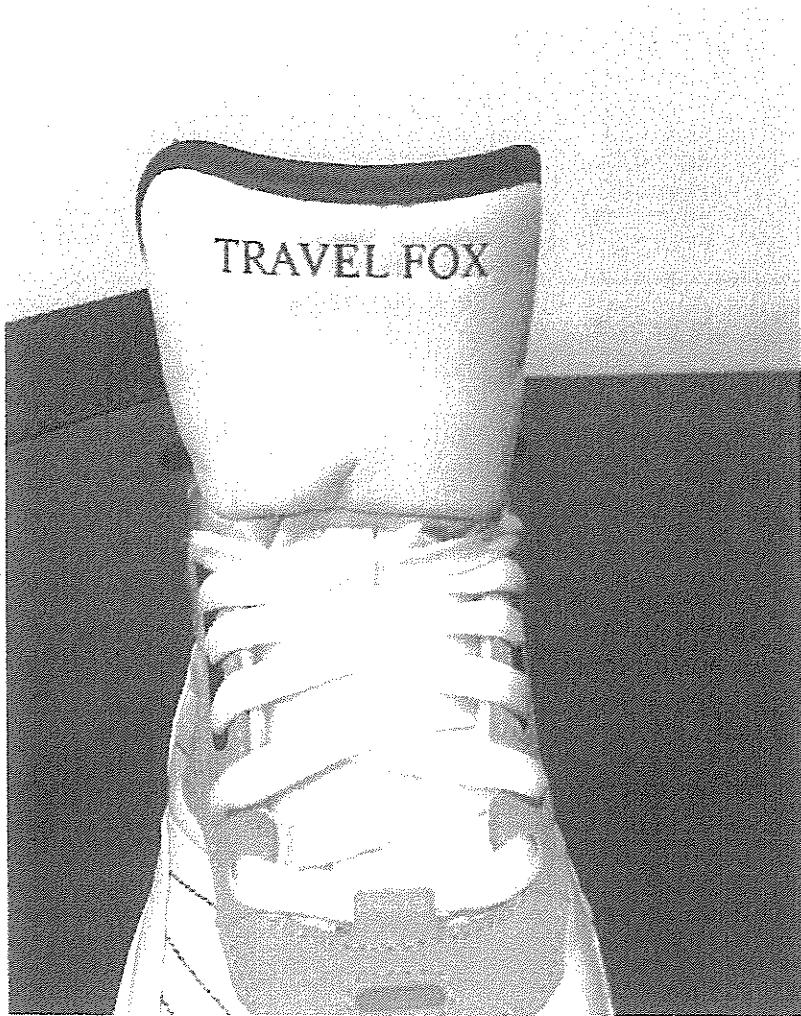


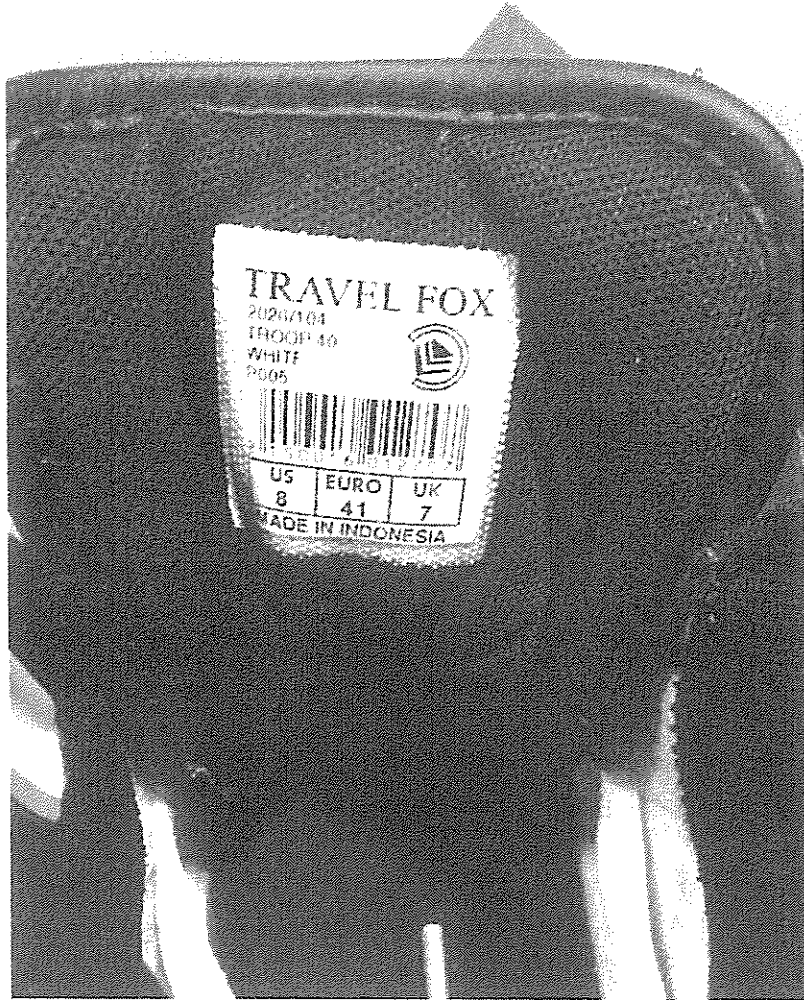










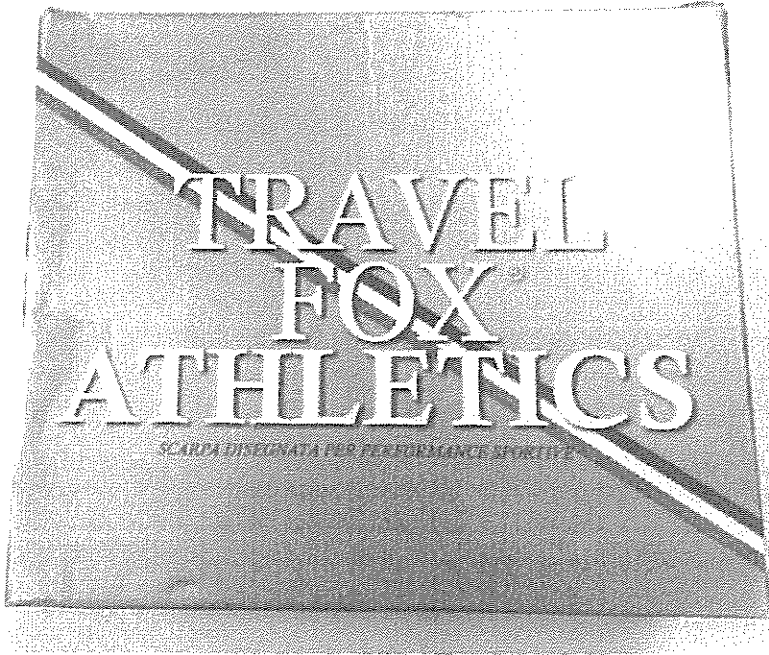


Label on inside of tongue



Label on innersole

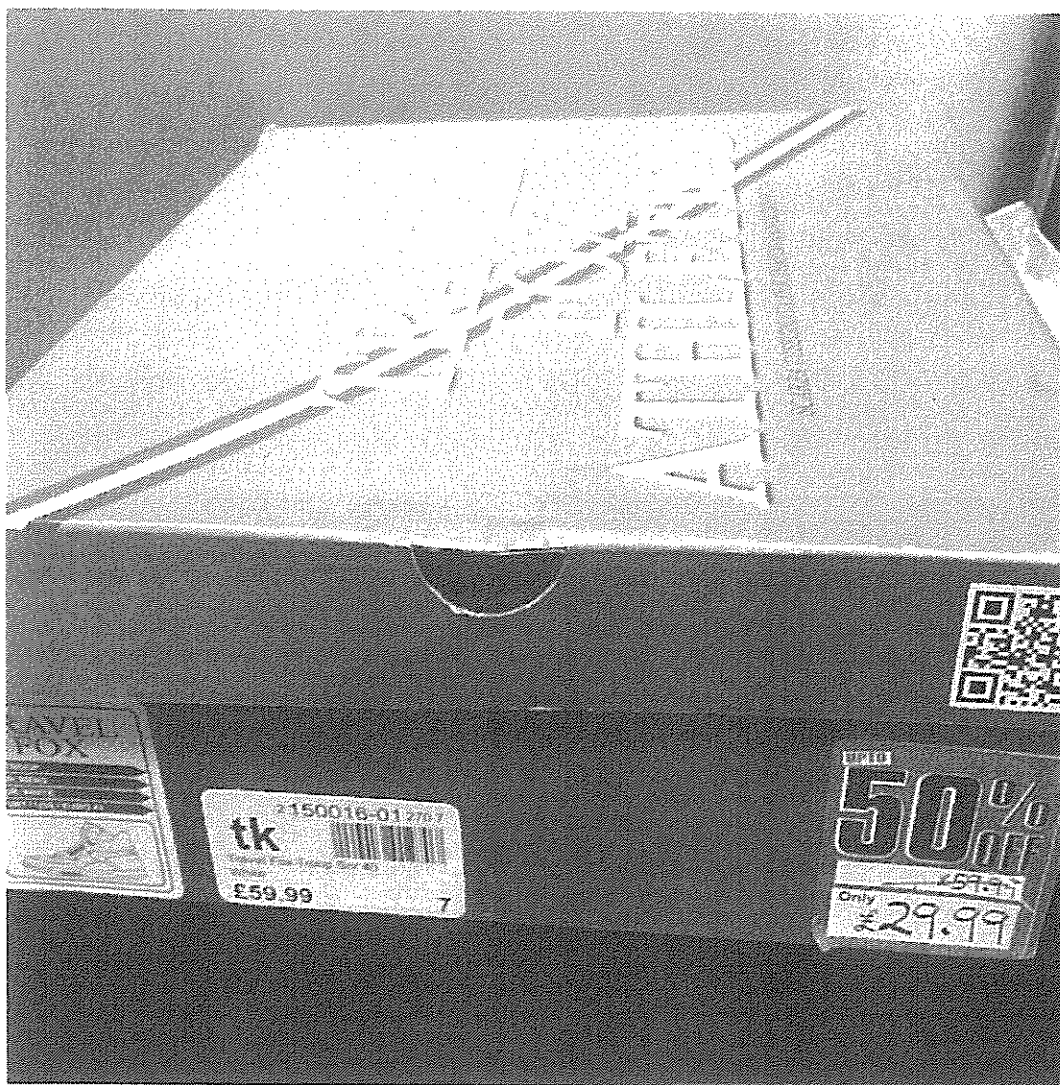
Photographs showing TRAVEL FOX branding on TRAVEL FOX Troop Hi Top footwear packaging

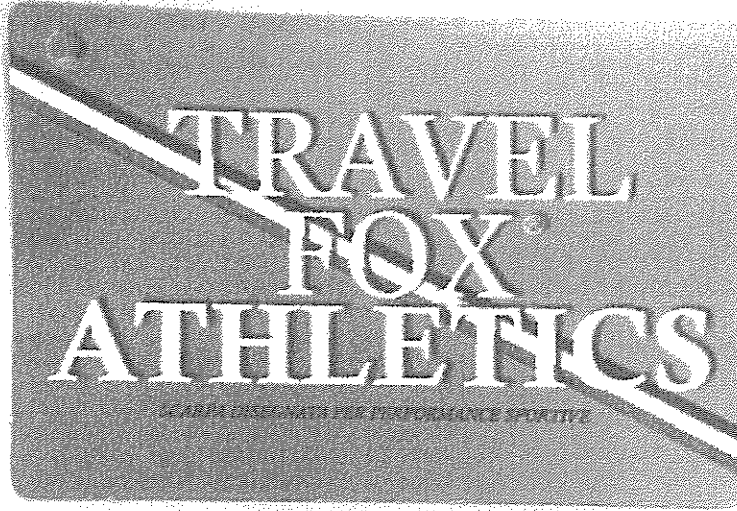


TRAVEL FOX Troop Hi Top footwear packaging – shoebox for TRAVEL FOX footwear



TRAVEL FOX Troop Hi Top footwear packaging – label on shoebox





Swing tag for TRAVEL FOX Troop Hi Top



TRAVEL FOX footwear packaging – tissue paper inside shoebox