

**O/563/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. 2234217A  
IN THE NAME OF BRITISH BOXING BOARD OF CONTROL LIMITED  
FOR THE TRADE MARK**

**THE LONSDALE BELT**

**IN CLASSES 14, 16 AND 41**

**AND**

**THE APPLICATION FOR REVOCATION THERETO  
UNDER NUMBER 501927  
BY  
LONSDALE SPORTS LIMITED**

## Background and pleadings

1. The British Boxing Board of Control Limited (“the registered proprietor”) is the registered proprietor of trade mark registration No. 2234217A: **THE LONSDALE BELT**. The trade mark was filed on 26 May 2000 and completed its registration procedure on 23 May 2003. It is registered in respect of the following goods and services:

### Class 14

*Articles of precious metal or coated therewith; precious stones and imitations thereof; pearls and imitation pearls; jewellery; costume jewellery; necklaces, pendants, tie-pins, cuff-links, buckles, brooches, hat-pins, bracelets, chains; cigarette-cases, cigarette and cigar boxes, cigarette holders; ashtrays; trinket boxes, medallions, medals, badges, figurines, statuettes, keyrings, lighters; goblets; objects of imitation gold; goldware and silverware; belt-ornaments of precious metals; vases of precious metals; works of art; trophies; parts and fittings for all the aforesaid goods, included in Class 14.*

### Class 16

*Office requisites; stationery, diaries, address-books, photograph albums, notepaper, envelopes, postcards, greeting cards; gift tags, labels; wrapping and packaging materials; bags, carrier-bags; pens, pencils; paper napkins, paper or cardboard plates; table-covers (paper); playing-cards; advertising materials; instructional and teaching materials; paper-knives.*

### Class 41

*Music and theatre entertainment services; games, quizzes, concerts, audience participation events.*

2. On 27 December 2017, Lonsdale Sports Limited (“the applicant”) sought revocation of the trade mark registration on the grounds of non-use based upon sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”). The applicant claims that the trade mark was not put to genuine use in the United Kingdom by

the registered proprietor or with its consent in connection with the goods and services in respect of which it is registered for the following five-year periods:

<b>Start date</b>	<b>End date</b>	<b>Effective revocation date</b>
24 May 2003	23 May 2008	24 May 2008
24 May 2008	23 May 2013	24 May 2013
27 December 2012	26 December 2017	27 December 2017

3. The registered proprietor denies the claims.
4. The applicant filed written submissions on 5 September 2018. These will not be summarised but will be referred to as and where appropriate during this decision.
5. A hearing took place before me on 5 July 2019. The applicant was represented by Philip Harris of Lane IP Limited. The registered proprietor did not attend the hearing, but made written submissions on 3 July 2019. It has been represented by Stobbs IP throughout these proceedings.

### **Evidence**

6. The registered proprietor's evidence comes in the form of a witness statement from Mr Robert Smith, General Secretary of the British Boxing Board of Control Limited since 2008. His witness statement is dated 18 June 2018. Attached to it are 17 exhibits. The applicant submitted no evidence.
7. The evidence is lengthy and provides a detailed history of boxing in the UK. Much of it has little relevance for the present proceedings and so I shall restrict my summary to the facts that I consider are pertinent to the matter at hand.
8. Mr Smith explains that the Lonsdale Belt, originally named "The Lord Lonsdale Challenge Belt" after the National Sporting Club's then president, the 5<sup>th</sup> Earl of Lonsdale, is a trophy awarded to the British boxing champion in each of the

weight divisions. It was first awarded in 1909. Between 2002 and 2018, there were 347 British Championship fights that “involved” the Lonsdale Belt.<sup>1</sup>

9. The exhibits contain images of merchandising and promotional items that have been produced.<sup>2</sup> I shall consider these in due course.

## Legislation

10. Section 46 of the Act states that:

“(1) The registration of a trade mark may be revoked on any of the following grounds-

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

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

(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.

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<sup>1</sup> Witness Statement of Mr Robert Smith, paragraph 28.

<sup>2</sup> See Exhibits RS10, RS11, RS12 and RS14.

(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.”

## Decision

11. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

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

115. The principles established by these cases may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is

viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

12. The registered proprietor submits that it has shown genuine use of the mark in relation to the following goods and services “at the least”:

Class 14: *Cuff-links, medals, keyrings, goldware and silverware; belt-ornaments of precious metals; trophies.*



Class 16: Pens

Class 41: Audience participation events, relating to boxing.

It will be seen that this submission stops short of conceding there has been no use in relation to any goods and services.

13. The onus is on the registered proprietor to show use. Section 100 of the Act states:

“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.”

14. At the hearing, Mr Harris referred to the decision of Mr Daniel Alexander QC, sitting as the Appointed Person, in *Plymouth Life Centre*, BL O/236/13. I reproduce Mr Alexander’s comments on the requirement to provide evidence below:

“19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. Use should be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (to use the words of *Anheuser-Busch* – see above).

20. Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time to review the material that it has to prove use of it. ...

...

22. The burden lies on the registered proprietor to prove use. ... However, it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

15. I shall bear these comments in mind while making my assessment of the evidence.

#### **Class 14**

16. Exhibit RS11 shows a set of images depicting cufflinks. Mr Smith describes them as follows:

“... a pair of cufflinks sold by my Company during the relevant period clearly marked up with the words LORD LONSDALE BELT in the roundel around Lord Lonsdale’s face. In the region of 500 articles were made, mostly sold to the members of the public, some were given to the officials from various boxing bodies and some were given to overseas associates. The unit price for sale is £195.”

This is the sum total of Mr Smith’s statements about these particular goods. One of the images appears to be advertising material and comes from the registered

proprietor's website.<sup>3</sup> The page was printed on 14 June 2018, but is otherwise undated, and Mr Smith does not specify to which of the three periods listed in paragraph 2 he is referring. Nor is it clear how many of these items were actually sold, rather than given away. On none of the images is the phrase "LORD LONSDALE BELT" visible in the roundel around Lord Lonsdale's portrait.

17. One photograph depicts a certificate accompanying the cufflinks.<sup>4</sup> This describes them as being part of the "Lonsdale Belt Collection". On the advertising material, they are described as "The Lord Lonsdale Belt Collection Cufflinks". I find that the evidence supplied here is not sufficiently solid to show genuine use within any of the relevant periods, which, I recall, span 14 years. The registered proprietor has supplied me with nothing to indicate whether goods were sold in the first few months, or many years later. It should not have been difficult to provide information on how many items were actually sold and when.
18. Exhibit RS14 is a photograph of a key ring chain. Mr Smith states that the key ring chain was issued in 2009, which falls within the second relevant period. The front shows a portrait of Lord Lonsdale, while the back is marked with "CENTENARY OF LORD LONSDALE CHALLENGE BELT 1909-2009" and what appears to be a signature. He goes on:

"Approximately 1000 plus articles of the key ring exhibited here were produced and given away in 2009 and thereafter as they were made for the centenary of 'The Lonsdale Belt' and given away to the guests at the centenary event, and later on to other members of the public."<sup>5</sup>

It seems to me that the words on the back are commemorative and are not use as a trade mark. They describe why the item has been produced, rather than distinguish the undertaking responsible for its production. If all the articles were given away, as Mr Smith states, this is not trade mark use in any case. In

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<sup>3</sup> See page 304.

<sup>4</sup> Page 299.

<sup>5</sup> Witness statement of Robert Smith, paragraph 36.

*Silberquelle GmbH v Maselli-Strickmode GmbH*, Case C-495/07, the CJEU stressed that:

“It follows from that concept of ‘genuine use’ that the protection that the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison d’être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings (*Ansul*, paragraph 37, and *Verein Radetzky-Orden*, paragraph 14).”<sup>6</sup>

The proprietor was not seeking to create or maintain a market in key rings. I find that genuine use has not been shown here.

19. Photographs of “The Lord Lonsdale Challenge Belt”, the trophy awarded to a British boxer, are to be found in Exhibit RS16. The cancellation applicant submits that:

“The use of THE LONSDALE BELT as a trophy name is not use as a trade mark – it does not guarantee the origin of the trophy in a trade mark sense and the trophy is not a marketed product, consumers cannot buy or trade in it. It is an award bestowed, in essence, ‘internally’ on boxers regulated by the Proprietor. The term is simply an historical title.”

20. The registered proprietor, on the other hand, submits that:

“The Registered Proprietor has genuinely used the mark ‘THE LONSDALE BELT’ since 1909 to the present day for the core services of organising and administering the British Boxing Championships for which ‘THE LONSDALE BELT’ is awarded.”

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<sup>6</sup> Paragraph 18.

21. The essential function of a trade mark is to guarantee the origin of the goods and services by enabling the consumer to distinguish them from the goods and services of another undertaking. The evidence shows that the registered proprietor has a long history of organising and administering the British Boxing Championships. However, it seems to me that this is not the same as supplying *trophies* as goods to the consumer and the registered proprietor is not attempting to create or maintain a market for those goods. The same reasoning applies in the case of *belt-ornaments of precious metals*. Consequently, I find that no use has been shown for these goods.
22. The registered proprietor has adduced no evidence of marketing any of the remaining Class 14 goods. While Exhibit RS10 contains a photograph of a watch, Mr Smith admits that it “was a prototype not made available to the public as it did not meet our requirements.”<sup>7</sup>

### **Class 16**

23. In Exhibit RS12 can be found a photograph of a pen. Mr Smith says that this was “commissioned by my Company during the relevant period marked up with the words LORD LONSDALE BELT in the representation of the actual belt in the open lid of the box”.<sup>8</sup> I note that Mr Smith says the pen was commissioned, but does not give any information as to whether it was made available to the public and, if so, when and how many were sold. I am therefore unable to find genuine use for *pens*, even were I to find that “LORD LONSDALE BELT” is an acceptable variant of the registered mark.
24. There is no evidence shown of use on or in relation to any of the remaining Class 16 goods in the specification.

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<sup>7</sup> Paragraph 32.

<sup>8</sup> Paragraph 34.

**Class 41**

25. The registered proprietor submits that the revocation application should be refused with regard to *audience participation events, relating to boxing*:

“especially as the audience participate in the Championship event by cheering, jeering and shouting at the two fighters to mainly encourage them in a range of different ways, but who are never quiet.”<sup>9</sup>

26. By this reasoning, any event where an audience makes a noise intended to be encourage the performers might be classed an *audience participation event*. This would include rock concerts and football matches. However, I do not think that is how the average consumer would construe the term. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) considered the construction of terms in specifications for services at [19]:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

27. To my mind, the core of the possible meanings attributable to the term *audience participation event* is confined to events where the audience plays an active role, where the event could not take place without them. While the atmosphere would undoubtedly be different, it would be possible to stage a boxing match without a live audience. Consequently, I find that the registered proprietor has not shown use of the mark in regard to *audience participation events*. Neither has it provided any evidence in connection with *music and theatre entertainment services, games, quizzes or concerts*.

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<sup>9</sup> Page 7.

## Conclusion

28. The registered proprietor has not shown use of the mark in connection with any of the goods and services for which it is registered, and neither has it given any proper reasons for non-use. I am satisfied that the grounds for revocation existed at 24 May 2008 and so the mark is revoked in its entirety from this date.

## Costs

29. The applicant for revocation has been successful and is entitled to a contribution towards its costs. At the hearing, Mr Harris requested off-scale costs because of the extra work involved in considering what he viewed as excessive and unfocused evidence. Tribunal Practice Notice (TPN) 4/2007 states that the Tribunal may award costs off the scale when a party has behaved unreasonably. While I note that the registered proprietor's evidence was lengthy and that a large part of it was not directed at proving use, I also recall that, at the time the evidence was filed, this application for a revocation was consolidated with an opposition. The trade mark in those opposition proceedings was withdrawn on 14 February 2019. In these circumstances, I consider that the length and focus of the registered proprietor's evidence does not constitute unreasonable behaviour. In addition, as the applicant was professionally represented, it seems to me that the dismissal of much of it as irrelevant should not have substantially increased its costs. I have therefore calculated my award of costs based on the scale published in TPN 2/2016, as follows:

Filing the application and considering the counterstatement - £400 (includes £200 official fee)

Considering and commenting on the other side's evidence - £1000

Preparing for and attending a hearing - £800

**Total: £2200**

30. I therefore order The British Board of Boxing Control Limited to pay Lonsdale Sports Limited the sum of £2200. The above sum should be paid within 21 days

of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**24 September 2019**

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