

**O/760/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. UK00001015449**

**IN THE NAME OF ERIC GUANGYU WAN**

**FOR THE FOLLOWING TRADE MARK:**

**CAMEL**

**IN CLASS 25**

**AND**

**AN APPLICATION FOR REVOCATION**

**UNDER NO. 502360 BY**

**WORLDWIDE BRANDS, INC. ZWEIGNLEDERLASSUNG DEUTSCHLAND**

## BACKGROUND AND PLEADINGS

1. The trade mark **CAMEL** (registration no. 1015449) (“the Contested Mark”) stands registered in the name of Eric Guangyu Wan (“the proprietor”). The Contested Mark was registered on 6 August 1973 for the following goods:

Class 25      Shirts made from man-made fibres and/or from cotton.

2. Revocation of the Contested Mark is sought by Worldwide Brands, Inc. Zweigniederlassung Deutschland (“the applicant”) on the grounds of non-use. Under section 46(1)(b) of the Trade Marks Act 1994 (“the Act”), the applicant claims non-use in eight separate periods:

a. Between 13 November 2005 and 12 November 2010, claiming an effective date of revocation of 13 November 2010;

b. Between 13 November 2006 and 12 November 2011, claiming an effective date of revocation of 13 November 2011;

c. Between 13 November 2007 and 12 November 2012, claiming an effective date of revocation of 13 November 2012;

d. Between 13 November 2008 and 12 November 2013, claiming an effective date of revocation of 13 November 2013;

e. Between 13 November 2010 and 12 November 2015, claiming an effective date of revocation of 13 November 2015;

f. Between 13 November 2011 and 12 November 2016, claiming an effective date of revocation of 13 November 2016;

g. Between 13 November 2012 and 12 November 2017, claiming an effective date of revocation of 13 November 2017; and

h. Between 13 November 2013 and 12 November 2018, claiming an effective date of revocation of 13 November 2018.

3. The proprietor filed a counterstatement defending its registration for all goods for which the Contested Mark is registered.

4. The proprietor is represented by Stobbs IP Limited and the applicant is represented by Kempner & Partners LLP. The proprietor filed evidence in the form of the witness statement of Emma Pettipher dated 17 May 2019. No evidence was filed by the applicant. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE**

5. As noted above, the proprietor's evidence consists of the witness statement of Emma Pettipher dated 17 May 2019. This was accompanied by 5 exhibits. Ms Pettipher is the trade mark attorney acting on behalf of the proprietor. I have read Ms Pettipher's evidence in its entirety and I will return to what the evidence shows below.

6. I have also read the written submissions filed by both parties. Whilst I do not intend to summarise those here, I have taken them into account and will refer to them below where necessary.

## **DECISION**

7. Section 46 of the Act states:

“(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;

[...]

(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.”

8. 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.”

9. 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 Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 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].”

10. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is not, therefore, genuine use.

11. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself<sup>1</sup>. I turn now to what the proprietor's evidence establishes.

12. Ms Pettipher has provided copies of the proprietor's 'Look Books'.<sup>2</sup> Some of these documents do not display shirts, which are the goods at issue in these proceedings. These documents do not, therefore, assist the proprietor. However, I note as follows:

a. Look Book dated 2016 to 2017 displays images of t-shirts and polo shirts. It displays the word CAMEL on the cover.

b. Look Book dated 2018 to 2019 displays images of shirts. It displays the word CAMEL on the cover.

13. The Look Book dated 2018 to 2019 clearly displays shirts. However, the 2016 to 2017 Look Book only displays use in relation to t-shirts and polo shirts. In my view, the term "shirts" will be viewed by the UK average consumer as a garment with both a collar and sleeves. I do not, therefore, consider that t-shirts fall within the meaning of this term. I accept that there is a greater possibility that polo shirts will be seen as falling within this meaning as they do have a collar and sleeves and may be seen as a less formal type of shirt.

14. Ms Pettipher has provided print outs from the Camel Crown Amazon store.<sup>3</sup> The print outs themselves are undated, although I note that there are product reviews which have dates visible. In any event, none of these postings relate to any products that could properly be described as "shirts" as covered by the specification of the Contested Mark. Consequently, they do not assist the proprietor.

15. Ms Pettipher has provided a print out from the Camel Direct Amazon store which lists orders placed for a range of jackets dating back to 27 March 2016.<sup>4</sup> However, as

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<sup>1</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

<sup>2</sup> Exhibit EP1

<sup>3</sup> Exhibit EP2

<sup>4</sup> Exhibit EP3



jackets do not fall within the meaning of the term “shirts”, these orders do not assist the proprietor.

16. Ms Pettipher has provided a selection of invoices dated between April 2016 and August 2018.<sup>5</sup> However, these invoices relate to shorts, jackets, t-shirts and trousers. For the reasons set out above, I do not consider t-shirts to fall within the meaning of the term “shirts” as covered by the specification of the Contested Mark. Clearly, shorts, jackets and trousers also do not fall within the meaning of that term. These invoices do not, therefore, assist the proprietor.

17. Ms Pettipher has provided a breakdown of the sales figures for several product ranges sold under the Amazon UK store.<sup>6</sup> She notes that this shows total sales of 1,300 products.<sup>7</sup> However, the products covered by this list of sales figures are jackets, shorts, trousers and t-shirts. For the same reasons set out above, sales relating to these products do not assist the proprietor in demonstrating genuine use of the Contested Mark for “shirts”. I note that there is one item listed in the sales figures which is a shirt i.e. “Camel Men’s shirt”. The launch date listed for the product is 25 May 2018 and the date of first order is 12 December 2018. The document confirms that 3 shirts have been sold.

18. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“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

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<sup>5</sup> Exhibit EP4

<sup>6</sup> Exhibit EP5

<sup>7</sup> Witness statement of Emma Pettipher, para. 13

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.”

19. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it”” [original emphasis].

20. The burden of proving use lies with the proprietor. The proprietor states in its written submissions that the Contested Mark has clearly been in use in the UK since at least 2015. Whilst that may be the case, the burden is on the proprietor to show that it has used the Contested Mark in the UK during the relevant periods in relation to the goods for which it is registered. Even if it is the case that the average consumer would consider polo shirts to fall within the term “shirts”, that means that there is only two Look Books that show use of the Contested Mark in relation to shirts. As the applicant notes, no information is given about distribution of these Look Books. The only sales information that the proprietor has provided in relation to “shirts” is evidence of 3 sales which took place in December 2018. These appear to relate to the order details provided relating to 3 shirts in December 2018 from the proprietor’s Amazon site.<sup>8</sup> As these revocation proceedings were commenced on 19 November 2018, these sales

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<sup>8</sup> Exhibit EP4

were made after these proceedings were issued and outside of the relevant periods. In any event, the sale of 3 items is not sufficient, in my view, to establish genuine use of the Contested Mark in relation to “shirts”. Taking the evidence as a whole, I am not satisfied that the proprietor has demonstrated genuine use of the Contested Mark during any of the relevant periods in relation to the goods for which it is registered.

## **Final Remarks**

21. Even if I am wrong in my finding that the UK average consumer would not consider t-shirts to fall within the meaning of the term “shirts”, the proprietor has provided only one invoice for £19.99 which relates to t-shirts.<sup>9</sup> The sales relating to t-shirts identified in the sales breakdown amount to only 1 product.<sup>10</sup> Even if t-shirts falls within the meaning of the term “shirts”, this would bring the total number of sales in relation to “shirts” as evidence by the proprietor to 4. This is not, in my view, sufficient to establish genuine use.

## **CONCLUSION**

22. The Contested Mark is revoked for non-use in its entirety.

23. The effective date of revocation is 13 November 2010.

## **COSTS**

24. As the applicant has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£950** as a contribution towards the costs of the proceedings. This sum is calculated as follows:

Preparing a notice and considering the proprietor’s counterstatement	£250
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<sup>9</sup>Exhibit EP4

<sup>10</sup> Exhibit EP5

Considering the proprietor's evidence and preparing written submissions in lieu	£500
Official fee	£200
<b>Total</b>	<b>£950</b>

25. I therefore order Eric Guangyu Wan to pay Worldwide Brands, Inc. Zweigniederlassung Deutschland the sum of £950. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated 12<sup>th</sup> December 2020**

**S WILSON**

**For the Registrar**