

O-540-20

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. 1255631

IN THE NAME OF SYKES-PICKAVANT LIMITED FOR THE TRADE MARK

The logo consists of the letters 'S' and 'P' in a large, bold, black, blocky font. The 'S' is on the left and the 'P' is on the right. Below the 'P', the word 'TOOLS' is written in a smaller, black, italicized, sans-serif font.


IN CLASS 8

AND

THE APPLICATION FOR REVOCATION THEREOF UNDER NO. 502862

BY KEVIN JOHN DAVIS AND ANTHONY EDWARD TUCKER

## Background and pleadings

1. Sykes-Pickavant Limited is the registered proprietor ('the proprietor') of UK trade mark registration no. 1255631 consisting of . The register shows a both a filing date of 3 December 1985, and records show a registration date of 19 February 1988. It is registered in respect of the following goods:

*Class 8: Hand-tools and parts thereof included in Class 8.*

2. Kevin John Davis and Anthony Edward Tucker (together 'the applicant') seek revocation of the trade mark registration on the grounds of non-use based upon Section 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (the Act). The revocation was filed by way of a TM26(N) document on 22 October 2019, and an amended statement of grounds on 6 November 2019.
3. Revocation is sought under Section 46(1)(a) in respect of the 5 year time period following the date of completion of the registration procedure, namely 4 December 1985 – 3 December 1990. Revocation is therefore sought from 4 December 1990 under this ground. Revocation is also sought under Section 46(1)(b) in respect of the time periods set out in the table below:

<b>From</b>	<b>To</b>	<b>Date from which revocation is sought</b>
4 December 1989	3 December 1994	4 December 1994
4 December 2004	3 December 2009	4 December 2009
22 October 2014	21 October 2019	22 October 2019

4. The proprietor filed a counterstatement denying that the use of the registration had been suspended for the uninterrupted period set out by the proprietor under Section 46(1)(a) of the Act. The proprietor's counterstatement further denies that the use of the registration was suspended and that there are no

proper reasons for non-use in respect of the uninterrupted periods set out under Section 46(1)(b) by the applicant. The proprietor denies that the registration should be revoked on either ground.

5. Only the proprietor filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. The applicant filed written submissions during the evidence round and both parties filed written submissions in lieu of a hearing. The submissions will not be summarised but will be referred to as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.
6. Both parties are professionally represented in these proceedings. The applicant is represented by Sergeants LLP, and the proprietor is represented by Barker Brettell LLP.

## Evidence

7. The proprietor filed evidence in the form of a witness statement in the name of Paul Archer, and Exhibits PA C1 – PA C11. The witness statement outlines that Mr Archer is the Managing Director of the proprietor, and that he has held that position since 22 May 2006. The witness statement explains the proprietor is “the manufacturer and distributor of an array of products in the automotive tool and handheld diagnostic equipment sector”. Mr Archer explains:

“Our products can be split into four categories, namely:

- **Break and Suspension** – Examples of products include but not limited to brake pipe flaring tools, coil spring compressors and ball joint separators.
- **Diagnostics** – Examples of products include but not limited to electrical function testers, cooling system pressure testers.

- **Engine Service Tools** – Examples of products include but not limited to valve spring compressors, engine timing and locking tools and transmission tools.
- **Body & Workshop Tools** - Examples of products include but not limited to cutting tools, torque wrenches and inspection tools.”

8. Mr Archer goes on to explain the products are suitable for a range of consumers in both the automotive and industrial sectors, and that they “also sell model-specific products for cars, vans, HGVs and coaches”.

9. Mr Archer explains that his company’s primary branding consists of the marks

 Sykes-Pickavant and , but that its  mark is used in relation to a specific product range.

10. **Exhibit PA C1** consists of what are described by Mr Archer in his witness statement as marketing flyers displaying the following products:

- Bearing Puller Pack;
- Puller Pack;
- Panel Pack;
- 1500 Pack;
- Slide Hammer Puller Pack.

11. These appear to be packs or sets each containing a range of items. Some of these packs appear to include complete tools, and some include individual parts that combine together to make the tools. The products included in each set are listed as described below:

**Panel Pack**

- Beater Standard Bumping Flat Face;
- Beater Standard Pein Crown Finish;
- Pry and Surface Spoon;
- Utility Dolly;

- Thin Curved Dolly;
- Heavy Toe Dolly

#### 1500 Pack

- Hydraulic Ram with Nose Piece;
- Twin Head;
- Triple Head;
- Ram Extension – 50mm;
- Ram Extension – 100mm;
- 3 x Leg – 150mm

#### Puller Pack

- Forcing Screw;
- Twin Head;
- Triple Head;
- Leg Assembly-Reversible;
- Forcing Screw;
- Twin Head;
- Triple Head;
- Leg Assembly – Reversible.

#### Bearing Puller Pack

- Hydraulic Ram With Nose Piece;
- Ram Extension – 100mm;
- Legs 150mm – Thin Jaw;
- Twin Beam;
- Separator 20-105mm;
- Main Rods;
- Extension Rods;
- Extension Rods 5 inch.

#### Slide Hammer Puller Pack

- Slide Hammer Puller Set;
- Split Collet Extractor 10 – 12mm;

- Split Collet Extractor 12 – 17mm;
- Split Collett Extractor 19-22mm;
- Split Collett Extractor 22-30mm;
- Adaptor

12. The flyers display a date of April 2019 and a copyright notice of April 2019.

The following is also displayed on the same:



13. The marketing flyers show images of the packs, displaying what appears to be the registered mark surrounded by a rectangle with rounded corners in the colours red, blue and black on the packaging of each, with the exception of the bearing puller pack which doesn't appear to display the mark on the packaging itself from the images shown, although it still features on the marketing flyer as shown in the top image above.

14. Photographs of the following products are also shown in this exhibit, which Mr Archer states are of "some of the product range":


- Universal Circlip Tool;


- Ball Joint Fork Separator;
- Mortorq ½” Push-thru Torque Wrench;
- Large Universal Internal / External Puller;
- 9 Piece Hook and Scraper Set;




15. The photographs are not dated but show the mark  on the




packaging, although the mark  features more prominently.


16. Mr Archer states that prior to April 2019, the  brand was “predominantly used in relation to a range of hand tools which typically make up a flaring kit. This would include turrets, screw clamps, crew clamps, shoulder bolt, dies, power handles, all of which are also available as spare parts under the brand”.


17. **Exhibit PA C2** includes brochures which Mr Archer states were distributed throughout the UK from the period of 22 October 2014 – 21 October 2019. The brochures are dated from 2014 – 2018. It is not clear from the evidence

within the exhibit alone where the mark  is used in the brochures, but Mr Archer has provided a table explaining where, when and how the mark is displayed. I have summarised this in the table below:







Brochure date / Page	Mark	Product
May – August 2018 / Page 18		270 Series brake pipe flaring tool kit containing pipes, flares, turrets, levers, screw clamps and associated fitting components.
January – April 2017 / Page 6	As above	As above but with the addition of a vice.
October – December 2016 / Page 18	As above	As above, with vice
April – June 2015 / Page 20	As above	As above, with vice
2014 / Page 34	As above	As above, with vice

18. **Exhibit PA C3** shows brochures which Mr Archer states were distributed throughout the United Kingdom during the period of 4 December 2004 – 03 December 2009. The brochures display dates in 2006, 2008 and 2009. Again,

use of the mark  is difficult to identify from the images alone, but Mr Archer has identified where, when and how the mark is used on the exhibit and in a table in his witness statement, which I have summarised below:

Brochure date / Page	Mark	Product
July – September 2009 / Page 3		270 Series brake pipe flaring tool kit containing pipes, flares, turrets, turret assembly, levers, screw clamps and associated fittings.



January – March 2009 / Page 7		Pressure Brake Bleeder – Economy Model and Pressure Brake Bleeder – Professional Model
Spring/Summer 2008 / Page 2		Brake Pipe Flaring Tool Kit comprised of turrets and flares.
2006 / Pages 62, 63 & 65	 / 	270 Series brake pipe flaring tool kit containing pipes, flares, turrets, turret assembly, levers, screw clamps and associated fittings – pages 62 & 63 (  )  Pressure Brake Bleeder – Economy Model and Pressure Brake Bleeder – Professional Model Page 65 (  )

19. **Exhibit PA C4** consists of brochure extracts which Mr Archer states were distributed throughout the United Kingdom during the period of 4 December 1989 – 3 December 1994. Mr Archer explains these have been sourced from internal archive records. The brochures are dated 1994 as is one price list, and the front and back pages of another price list are provided and dated 1993. This bears the statement “Effective from 1<sup>st</sup> February 1993 For use with Catalogue SP15, 1992”. The front and back pages of the 1993 price list




display the mark as registered, namely  but the contents of the

same has not been provided. The brochures and pages from 1994 use the














mark  in various colour combinations (black and white, blue and

red), as well as  on images of what are described as DIY & handboxes as well as toolboxes. Mr Archer has added detail in the form of a table identifying where, when and how the marks have been used. I note Mr Archer has stated that the mark “SP Tools” is shown where the mark used is



, and I have identified this below:



Brochure date / Page	Mark	Product
1994 / Front and back cover pages 1 & 2.	SP Tools (this is use of  )	Screwdriver sets
1994 / Front and back cover	SP Tools (This is use of  )	Micro puller and Valvemaster cylinder head service centre
1994 / Pages 1 and 2	SP Tools (This is use of  and its blue equivalent)	Micro puller
1994 / Front and back cover pages 1-5, 6 & 7, 9-13, 15 & 16.	 (This mark features on the products with  shown on the pages of the brochure)	Tools boxes
1994 / Front and back cover	SP Tools (This is use of  )	On the front and back cover of the Hand tools update II
1994 / pages 1 & 2 (flyer)	SP Tools (This is use of  )	Valvemaster cylinder head service centre

1994 / Pages 1 & 2 (flyer)	SP Tools (This is use of  )	Percussion puller
1994 / Pages 1 & 2 (flyer)	SP Tools (This is use of  and its white on black equivalent)	Pneumatic hinge pin tool
1994 / Pages 1 (price list)	SP Tools (This is use of  )	Price list
1993 / Front and back cover (price list)	 (This is use of this mark but using transparent letters on a black background)	Price list

20. **Exhibit PA C5** consists of marketing material including:

- A marketing bulletin dated March '89 describing the “NEW COMPONENTS AND SET – FUEL PRESSURE TESTER” detailing the product and its application on cars including various Ford brands in Europe;
- Marketing material showing the ‘318 Series’ Cap and Cooling System Testers and the various kits available with a copyright date of 1988;
- A marketing Bulletin for a “Stud Extractor” dated September 1987;
- A marketing Bulletin for an “Automotive Bearing Extractor Set” dated August 1987;
- A marketing bulletin regarding product improvements made to “MOTORQ TORQUE WRENCHES” dated August 1987;
- Marketing material detailing “1987 Promotion Packs” showing the Sheet Metalpack, the Multi-Pullerpack, the Front-End-Pack and the Motorq pack each detailing the various items contained within the same;


- Additional marketing material referencing the '319 SERIES' Cooling System Testers;
- Marketing material in relation to "KITS" with detail of the contents;
- Operating instructions for the "Cylinder Head Leak Detection Kit No. 031940";
- Marketing material about the "Circlip Plier Sets" and "Circlip Pliers" with a copyright date of 1987;
- Marketing information on the "Diesel Engine Compression Tester" including details of the contents and instructions with a copyright notice of 1987;
- Marketing information on the "Engine Support Beam No. 17900" including details of the contents and instructions with a copyright notice of 1987;

21. All of the above marketing material uses the mark  or  either on the page itself, on what appears to be a connecting page and/or on the product image. Mr Archer states in his witness statement that the pages are extracts from his company's brochures as distributed throughout the period of 4 December 1985 – 3 December 1990, and that the material has been sourced from internal archived records.

22. **Exhibit PA C6** consists of further brochures which Mr Archer confirms falls outside of the relevant time frames. The brochures fall between 1999 – 2014, but the proprietor states the 2013/2014 catalogue was distributed until 2016 at when it was updated. The catalogues use a variety of SP TOOLS marks, and the proprietor has identified where these marks are used on Brake Pipe Flaring Tool Kits, Brake Bleeders and a Heavy Duty Puller Kits.

23. Mr Archer has confirmed in his witness statement that, to the best of his knowledge, the proprietor's main annual company brochure has a print run of 50,000 copies and is distributed throughout the UK to a customer base

consisting of “anyone who needs specialist automotive and industrial tools and electronic service and diagnostic equipment” which can be made up of “both garages and private customers”. Mr Archer states this would have been the case since 2014, and that prior to this the print run would have been smaller “perhaps 25,000”. Mr Archer states there will be pages in each

brochure showing flaring tools and tool kits bearing the  mark.

24. Mr Archer also states within his witness statement that there would be a twice-yearly print run of leaflets such as those shown in Exhibit PA C1 at a rate of 50,000 distributed to the same consumers as mentioned above. Mr Archer confirms that the leaflets specific to the HERITAGE LINE only date from 2019, but that equivalent leaflets will have been run twice yearly “since at least 2010”.

25. Mr Archer states that he estimates his company “spends an average of £25,000 on printed advertising and marketing materials and has done so consistently for the last ten years”. Mr Archer states the majority of this spend would relate to the product catalogues as shown. Mr Archer states that for the period of 2006-2010 the advertising spend would have been higher as they looked to re-establish both the Sykes Pickavant and SP brand after purchasing the company. **Exhibit PA C7** includes invoices detailing the purchase of promotional brochures between April 2018 – October 2019. The invoices show the majority of the brochures to have been printed in the GBP version, with a small number printed in euros.

26. Mr Archer has included a screen shot within his witness statement, which he states is his company’s website. The screenshot is of the site sykes-pickavant.com, which provides some information about the company and shows the following at the bottom of the page:



27. Mr Archer states the earliest use of the mark on the website that he can verify is from February 2019, which he states coincides with the launch of the HERITAGE LINE. The screenshot itself is dated Wed 12 Feb, but does not reference a year. The witness statement is dated 10 March 2020, it is unclear when the screenshot dates from. Mr Archer states he believes that the mark would have appeared on images of tools on the website since 2010, but that these have not been captured by the archiving site WayBack Machine and so he cannot find further evidence in support of this.

28. Mr Archer states in his witness statement that the proprietor gets roughly 4 – 8 new enquiries through its website a day, and that it has a “longstanding and loyal customer base. **Exhibit PA C8** shows an image of a Service Kit bearing



the mark . Mr Archer explains the proprietor recently received an enquiry asking about replacement parts for this kit which he estimated dates back to 1990.

29. **Exhibit PA C9** shows the proprietors YouTube page. The exhibit shows videos uploaded by the proprietor under the following details:




**sykespickavant**


620 subscribers • 151 videos

Sykes-Pickavant has been manufacturing and

30. Mr Archer states the mark is present on the tools in the videos to varying extents.

31. Within his witness statement, Mr Archer has provided estimated sales figures for 2015 - 2019, based on his “best guess” that sales figures relating to the

mark  accounted for 2% of revenue prior to 2019, and 15% of the revenue in 2019 due to the launch of the HERITAGE LINE. The figures provided are copied below:

Year	Company Revenue £million	Estimated units sold bearing  mark	Calculated Revenue £000s
2019	£4,000,000	5000	£600,000
2018	£4,100,000	550	£82,000
2017	£4,900,000	626	£98,000
2016	£4,500,000	605	£90,000
2015	£5,100,000	731	£102,000

32. The figures provided appear to show total company revenue, rather than revenue specific to UK activity. I note this particularly due to Exhibit PA C7 showing that some brochures are printed in euros, indicating there may be trade outside of the UK.

33. **Exhibit PA C10** shows redacted invoices. Details of the customer and the majority of the invoice and delivery addresses have been redacted, leaving only references to the area such as Yorkshire, Halifax, Surrey, Kent and West Midlands. The unit price and invoice total have also been redacted. The product details and date remain. The invoices show the marks



. Mr Archer explains:

“...As can be determined from the substantiated brochures, item code 02700800 which related to a “flaring tool kit” will bear the SP Tools Brand, as would any product being an associated tooling or component parts of the flaring tool kit.”

34. Mr Archer also provides estimates in his witness statement of the total revenue under the “SP TOOLS brand” from 2011 – 2014. Mr Archer describes the figures as “a realistic guide” based again on 2% of allocated revenue. Again, these appears to relate to overall revenue rather than being UK specific. These are set out below:


Year	Company Revenue £million	Calculated Revenue £000s for SP Tools products
2014	£4,400,000	£88,000
2013	£4,700,000	£94,000
2012	£4,800,000	£96,000
2011	£4,100,000	£82,000

35. Mr Archer states that his company “has attended trade shows since at least as early as 2014”, and lists these as copied below:



- The Commercial Vehicle Show (NEC Birmingham) – April 2014
  - The Hillhead Show 2016 – June 2016
  - Mechanex Sandown Park – November 2016
  - Midlands Machinery Show – November 2016
  - LAMMA (Farm machinery, equipment and services show ) 2017 – January 2017
  - AUTOiNFORM Live Edinburgh – March 2017
- 
- The Commercial Vehicle Show (NEC Birmingham) – April 2017
  - Automechanika Birmingham – June 2017
  - Mechanex Sandown Park – November 2017
  - Midlands Machinery Show – November 2017
  - AUTOiNFORM Live Wolverhampton – November 2017
  - LAMMA (Farm machinery, equipment and services show) 2018 – January 2018
  - The Commercial Vehicle Show (NEC Birmingham) – April 2018
  - The Hillhead Show 2018 – June 2018
  - Group Auto Motor Factor & Garage Show – October 2018
  - Troy Means Business Show – October 2018
  - Mechanex Sandown Park – November 2018
  - Midlands Machinery Show – November 2018
  - LAMMA (Farm machinery, equipment and services show) 2019 – January 2019
  - Troy Means Business Show - March 2019
  - The Commercial Vehicle Show (NEC Birmingham) - April 2019
  - Group Auto Care Show - October 2019
  - Midlands Machinery Show - November 2019
  - Mechanex Sandown Park -November 2019



36. Mr Archer states that products bearing the  “would have been on display for anyone to see who attended the shows”.

37. The final exhibit provided is **Exhibit PA C11** which consists of various news articles commenting on the attendance turnout at various trade shows mentioned by Mr Archer above.

## Legislation

38. Section 46 of the Act states:

“46. - (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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless

preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that -

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.”

39. The onus is on the holder to show use because 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.”

40. 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 Bunderversammlung 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].”

41. The proprietor must show genuine use of its mark within the UK, within the relevant time frame, in respect of the goods as registered.

### **Preliminary issues**

42. Within its submissions filed during the evidence rounds, the applicant makes several criticisms relating to the proprietor’s evidence filed. These include submissions that the evidence does not show what it needs to, which I will address later in this decision. In addition, these submit that the evidence does not suffice to support the claims made by the proprietor in its witness statement. It seems the applicant submits that many of the proprietor’s statements cannot be relied upon without each assertion being supported by independent documentation.

43. The applicant’s submissions state:

“Exhibit PA C4 are extracts from the Proprietor’s brochures. All of these brochures are from 1993 and 1994. The Proprietor claims that they were distributed throughout the UK, however there is no evidence of this. It is not clear who the brochures or flyers were distributed to and if sales resulted from these. There is nothing to show that this evidence was anything more than internal use.”

44. The applicant goes on to make similar submissions in relation to Exhibit PA C5, stating it is “impossible to determine if the flyers etc were only used internally or if they reached the general public”, despite Mr Archer’s statement that they had been distributed throughout the UK between 4 December 1985 and 3 December 1990.

45. Further, the applicant states that Mr Archer’s claim that the mark has been used on the website since 2010 is not sufficient to show this is the case, and that the enquiry referenced cannot be included because there is “nothing in the evidence detailing the enquiry that the proprietor is referencing”, alongside a separate reason given that the mark used differs from the one registered. The applicant also goes on to say that there is no evidence that the mark was displayed at the trade events despite the proprietor claiming this is the case, and that the applicant questions that the mark “actually appears” in the YouTube videos referenced by the proprietor, despite Mr Archer stating it does within his witness statement.

46. On many occasions where Mr Archer has claimed something to be the case within his witness statement without corroborating this fully within the exhibits filed (or where it is viewed as such by the applicant), the applicant has stated that this should be discounted or disbelieved.

47. Guidance on the reliance on facts asserted in witness statements when assessing the use made of a trade mark registration has been addressed within the relevant case law. In *Dosenbach-Ochsner Ag Schuhe Und Sport v*

*Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

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

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

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



sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

48. The applicant has not provided me with any additional or specific reason that Mr Archer is not to be believed on any particular matter and has instead focused on the fact that some of the information in his witness statement is not separately confirmed within the exhibits filed. There has been no request for a hearing on this matter, or for cross examination of Mr Archer as a witness. On this basis, I find no reason to automatically discount or disbelieve each or any statement within Mr Archer’s witness statement without additional consideration. However, with reference to the guidance set out by Mr Geoffrey Hobbs Q.C. as the Appointed Person in *Dosenbach-Ochsner Ag Schuhe Und Sport* above, I also find no reason that I must rely too heavily on Mr Archer’s statements alone for the purpose of reaching my decision. Whilst I have considered the submissions made by the applicant in respect of what may, or rather what may not be relied upon within the proprietor’s witness statement, I find the question of whether Mr Archer’s statements are to be relied upon independently of additional evidence, or for the purpose of supplementing the exhibits provided ultimately falls down to the question of whether I am satisfied by the sufficiency of the evidence to show genuine use of the mark in question, when considered its totality, with reference to the specificity with which the actual use of the mark has been shown. It is on this basis that I will proceed with my analysis of the evidence filed.

### **Form of the mark**

49. Prior to conducting an analysis of the evidence filed in order to determine if there has been genuine use of the registered mark, it is necessary to review the instances where the proprietor has used variations of the mark, or used the mark in conjunction with additional elements, in order to determine if these instances should be classed as use ‘of the mark’ for the purpose of the assessment. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as

indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)".  
(emphasis added)

50. In respect of the use of the mark in a varying form to that which has been registered, *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting 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.”



51. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.



## **Variant 1 & Variant 2**

52. Within the evidence filed, the proprietor's states:

“The primary branding for my company is  and . The  brand relates to specific products and a specific product range and in this sense a level of dual branding occurs with the  brand and the  brand appearing alongside each other on the product, product packaging or marketing materials.”

53. From the statement made by Mr Archer above, it does not appear that the

proprietor is claiming the use of  or the  should be taken as use of the mark as registered. However, for the sake of clarity, I note here that I do not find these to be acceptable variants of the mark as registered. I find that the distinctive character of the mark as registered resides primarily in the letters SP, and the use of the same in its compressed square and blocky font. In addition, although I find the word TOOLS to be descriptive and to add little (if anything) to the distinctive character of the mark based on the use of the word only, I find the way this element has been neatly tucked under the larger letter ‘P’ rather than place besides this or below this (as would normally be expected) to add to the distinctive character of the mark. It is my view that the use of the rounded lowercase ‘sp’ blended into the outer perimeter of the circle, as well as the omission of TOOLS tucked into the same alter the

distinctive character of the mark as registered. I therefore do not find  or  to be acceptable variants of the mark as registered under *Nirvana*.

### **Variant 3 & Variant 4**

54. The proprietor references the use of the following variants of the mark as registered:



55. I find the mark as registered to be fully present within the marks above. I note the mark has been registered in black and white, but I find that the use of the blue colour does not alter the distinctive character of the same, and that notional and fair use of the mark as registered allows for variation from black and white to colour in this manner. Although the mark is used in conjunction with fairly elaborate decorative surroundings which appear to depict some sort of gauge, in addition to the wording 'Skyes-Pickavant' and 'England', I find the mark in the centre would still be viewed by the consumer as a trade mark in its own right, for the purpose of identifying the economic origin of the product. I therefore find the above variants to be acceptable in line with *Colloseum*.

### **Variant 5 and Variant 6**

56. The proprietor also shows use of the mark as registered within a rectangular boarder and in conjunction with the elements "since 1921" and sometimes "Quality Tools Since 1921", as shown below:



57. I find the additional elements to be simple promotional messages used alongside the mark itself, which remains unchanged and clearly still capable of being viewed independently by the consumer as indicative of the origin of the goods. It is my view that the use of the banal rectangular boarder makes no impact on the mark itself. I find the use in these formats to be acceptable

variants of the mark as registered in line with *Colloseum*. Further, the mark is also used in this format alongside other trade marks and decorative elements, such as below:



58. Again, I find the mark remains unchanged and capable of identifying the origin of the goods in this format, and I find this use of the mark is acceptable.

### Variant 7



59. The above mark is used in Exhibit PA C4, and referred to by the proprietor as 'SP TOOLS' within the table provided in Mr Archer's witness statement. As mentioned previously, I find the distinctive character of the earlier mark to reside primarily in the stylised and compressed square block letters SP, which are clearly present in this instance. However, I also found that the way the word TOOLS was is neatly tucked into the letter P added to the distinctive character of the mark. In this mark the word TOOLS has been set under the SP element, spaced out and sat between two lines. It is my view the change in positioning of the TOOLS element from tucked into the P to underneath the mark does alter the distinctive character of the same, if only slightly. I therefore do not find this to be an acceptable variant of the mark as registered in line with *Nirvana*. For the avoidance of doubt, I find the banal black square surrounding the mark does not alter the distinctive character of the same.

## Variant 8



60. This image of the mark is present within the proprietor's Exhibit PA C8. I find the fact that the letters SP have been shown in a differing stylisation, offset at different heights with alternate shades used does change the distinctive character held within the mark as registered. I therefore find this to be an unacceptable variant of the mark in line with *Nirvana*.

### **Evidence under Section 46(1)(b)**

61. The latest relevant time period for proving use under this ground is between 22 October 2014 – 21 October 2019. I will begin with an assessment of the evidence of genuine use of the mark provided in respect of this relevant period. If the evidence suffices to show genuine use has been made during this time in respect of all of the goods as registered, the provisions of 46(3) dictate that protection for the mark will be maintained and there will be no further requirement to examine the evidence in respect of earlier timeframes for which revocation has been sought. The proprietor must show genuine use of the mark within this timeframe, within the UK, in respect of the goods as registered, namely *Hand-tools and parts thereof included in Class 8*, in order to maintain its protection for the same.

62. As noted within the evidence summary, Mr Archer explains the activities of the proprietor within his witness statement. I will repeat these comments here alongside some additional comments made by Mr Archer in respect of the proprietor's activities under the registered mark, as I find his explanation to be helpful for establishing the asserted parameters of the use. At paragraph 3, Mr Archer states as follows:

“My Company is the manufacturer and distributor of an array of products in the automotive tool and handheld diagnostic equipment sector. Our products can be split into four categories, namely:


- **Brake & Suspension** – Examples of products include but not limited to brake pipe flaring tools, coil spring compressors and ball joint separators.
- **Diagnostics** – Examples of products include but not limited to electrical function testers, cooling system pressure testers.
- **Engine Service Tools** – Examples of products include but not limited to valve spring compressors, engine timing and locking tools and transmission tools.
- **Bodyshop & Workshop Tools** – Examples of products include but not limited to cutting tools, torque wrenches and inspection tools.

Our products are suitable for a range of consumers in both the automotive and industrial sectors. In addition to providing products according to the four categories above, we also sell model-specific products for cars, vans, HGVs and coaches.”

63. Mr Archer goes on to state at paragraph 6:

“In April 2019, my Company launched its HERITAGE LINE which includes a range of pullers and tools used in the body shop.”

64. At paragraph 7, Mr Archer submits:

“Prior to April 2019, the  brand was predominantly used in relation to a range of hand tools which typically make up a flaring tool kit. This would include turrets, levers, screw clamps, crew clamps, shoulder bolt, dies, power handles, all of which are also available as spare parts under the brand.”

65. The exhibits provided by the proprietor that are relevant during this period are as follows:

- Exhibit PA C1;



- Exhibit PA C2;
- Exhibit PA C7;
- Exhibit PA C8;
- Exhibit PA C9;
- Exhibit PA C10;
- Exhibit PA C11.

66. In addition, as outlined within the evidence summary, Mr Archer has provided estimated advertising spend and turnover figures for this period, an estimation of the number of brochures and marketing flyers distributed in this period, and a list of trade shows attended.

67. As mentioned, the marketing flyers relating to the Heritage Line<sup>1</sup> included a copyright date of April 2019, and these were supplemented with a launch date of April 2019 for the range given by Mr Archer in his witness statement. These flyers display variant 6 of the mark, which I found to be acceptable. In addition, undated images of tools that the proprietor describes as “some of the product range”<sup>2</sup> also display variant 6 of the mark, as well as identifying the type of tool shown. The flyers reference packs which appear to show various tools and their parts (the contents of which I have detailed within the evidence summary). Alongside this Exhibit, there is a statement from Mr Archer within his witness statement as follows:

“The HERITAGE LINE contains  branded items such as slide hammers, pullers for bearings, split collet pullers, bodyshop dollies, beating hammers and spoons...”

68. I find this exhibit, as well as Mr Archer’s statement useful for showing the mark (in an acceptable variant) used within the relevant timeframe, in respect of marketing material for the relevant goods. However, it is difficult to determine from this exhibit alone the extent or territory of the use, as no

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<sup>1</sup> Exhibit PA C1

<sup>2</sup> Exhibit PA C1

further context has been provided in this respect. The leaflets are printed in English and appear to show English contact details; however, they do provide both a UK telephone and fax number as well as an international dialling code. It appears likely that the leaflets are at least in part aimed at the UK consumer. I note this exhibit does not show that the products that are the subject to the flyers have been sold to consumers. However, I consider that each exhibit is not to be treated in isolation, and it is instead the full picture of all the evidence provided that must be assessed.

69. Brochures dated between 2014 and August 2018 have been provided.<sup>3</sup> Mr Archer submits these show variants 3 and 4 of the mark, but it is difficult to make this out from the images provided alone. I see no reason to doubt the proprietor's claim that these marks appear on the products where highlighted, and with the assistance of Mr Archer's images and references, I can see this is very likely the case, and in some cases I can just about make out the mark within the images. However, I note the applicant's criticism of this evidence as follows:

"The Proprietor states in paragraph 8 that the mark is not always clear from the photographs as the branding is too small. If this is the case it can be argued that the customer is very unlikely to notice the mark on the products. The use in this form seems to be the only use of the mark, therefore it is argued that it does not act as a brand of origin as the branding is so small it can not be associated with the products it is used on."

70. In one sense, I am inclined to agree with the applicant's submissions. I have no reason to doubt the proprietor's statement that the marks feature on the products shown in the brochures where referenced, but I cannot establish from this evidence that the bulk of this use would be seen or noticed by the consumer when viewing the brochures, as they would of course not receive the guidance provided by the proprietor as to where the marks are placed.

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<sup>3</sup> Exhibit PA C2

71. However, I am inclined to disagree with the applicant's apparent submission that this would mean the mark would also not be noticed by the consumer on the products themselves or that they do not "act as a brand of origin" on the same. Although the images are small on the brochures, it is clear from these images the marks are proportionate to the products, and so I find it too much of a stretch to say the consumer would not notice the mark on the same when handling these, particularly in relation to the flaring tool as shown below:


**Brake Pipe Flaring Kits - 270 Series** **INDUSTRY LEADING FLARING TOOL FOR OVER 30 YEARS**

**Brake flaring tool that produces both Convex and Double Lap flares to SAE & DIN standards**

- Metric & imperial pipe sizes
- Unique 'Dial-a-Size' Turret design
- Automatic punch extraction from flare
- From 3/16" to 1/2" / From 4.75mm to 12mm
- Lever cam operation for quick flaring
- Screw clamp for accurate die alignment


**Available Kits:**

Part No.	Suitable for brake pipe sizes	List Price	Save	Offer
02700100	SAE Single & Double Flares: 3/16" & 4.75mm	£185.00	<b>£31.00</b>	<b>£154.00</b>
02700200	SAE Single & Double Flares: 3/16", 4.75, 6, 8, 10mm DIN Single Flares: 4.75mm	£239.00	<b>£40.00</b>	<b>£199.00</b>
02700800	SAE Single & Double Flares: 3/16, 1/4, 5/16, 3/8, 1/2", 4.75, 6, 8, 10, 12mm DIN Single Flares: 4.75mm	£310.00	<b>£55.00</b>	<b>£255.00</b>
02700900	SAE Single & Double Flares: 3/16, 1/4" 4.75, 6mm DIN Single Flares: 4.75mm	£215.00	<b>£36.05</b>	<b>£178.95</b>



72. On balance, the images provided, along with the explanation given by Mr Archer including his reference to exactly where the marks are used and with what products, satisfy me that products bearing acceptable variants of the mark were available for sale within the relevant timeframe under this ground. I also find that, at least in respect of the flaring tool pictured above and the flaring tool kits (which are shown in the same form consistently throughout the timeframe), that the mark would be noticed by the consumer on the products themselves, even if they are not noticed within the brochures. Further, I find reference to prices using the currency GBP mean it is reasonable to conclude that these products are aimed at the UK consumer. However, I find this evidence falls short of showing these products were purchased by the UK consumer within the relevant timeframe.

73. Mr Archer submits that the proprietor's main annual brochure has a print run of 50,000 brochures which are distributed throughout the UK. Mr Archer

states that this has been the case since 2014. Mr Archer also states that they produce leaflets “such as those contained in Exhibit PA C1 for  HERITAGE LINE, at a rate of 50,000 leaflets twice a year.” Mr Archer goes on to say that the HERITAGE LINE leaflets themselves only date from 2019, but that their equivalent has run twice a year since 2010. At Exhibit PA C7 invoices issued to the proprietor from what appear to be UK based companies named Webmart and Mainstream Print Ltd are shown. Mr Archer confirms in his witness statement that Webmart is the company the proprietor works with to product its brochures, and that the invoices relate to various print runs. The invoices do appear to show the proprietors payment for various print runs of their brochures. The figures shown do not quite match the figures given by Mr Archer of 50,000 each year (or 50,000 twice a year for the leaflets), but they do show the following figures:

- 24 August 2018 – 43,000 copies of 2018 Promotional A4 Brochure (40,000 of which are described as GBP version) – Invoice total £5,200
- 13 December 2018 – 43,000 copies of 2019 Promotional A4 Brochure (40,000 of which are described as GBP version) – Invoice total £6,198
- 30 April 2018 – 40,000 copies of Q2 2018 Promotional A4 Brochures GBP – Invoice total – Invoice total £4,200
- 27 August 2019 – 43,000 copies of Q3 - 2019 Promotional Brochure (40,000 of which are described as the GBP version) – Invoice total £6,448
- 3 October 2019 – 1000 copies of Sykes-Pickavant Industrial Catalogue 2019 – Invoice total £3,262

74. It is not entirely clear which of these invoices (if any) relate to the print run of the leaflets relating to the HERITAGE LINE which the proprietor states was launched in April 2019, and as such it is not entirely clear which of the print runs will have included brochures with clear reference to the registered mark, or an acceptable variant. Further, it is clear that some of these brochures printed may have been distributed outside of the relevant timeframe. However, what is also clear is that the proprietor prints tens of thousands of

brochures each year, the majority of which are printed in GBP, indicating that the a significant number of the proprietor's target audience for the brochures is UK based, and supporting Mr Archer's statement that the brochures are distributed throughout the UK. This exhibit also shows that a smaller number of the brochures printed are issued in Euros, which indicates that the proprietor's trade is not limited exclusively to the UK.

75. Within his witness statement, the proprietor has claimed that variant 5 has been in use on the website on photos of tools since at least 2010, but that he has had trouble evidencing this using web archiving site the WayBack Machine. As mentioned in the preliminary issues, the applicant has been critical of various claims in Mr Archer's witness statement, and this claim did not escape that criticism. Whilst, as previously mentioned, I am not minded to disbelieve the statement made by Mr Archer, I am also not minded to rely on this statement alone in this instance, as I find the information provided lacks the specificity required. It is impossible to know what this use would have looked like, and if it would have assisted the proprietor's case, particularly as I have found variants used within this timeframe as unacceptable for evidencing use of the mark. Mr Archer has stated that the earliest date at which he can verify the use of the mark on the website is February 2019. Whilst a screenshot has been provided dated 12 February, no year is mentioned, and so again I do not know if it is this particular use that started in 2019. I am therefore reluctant to rely on this to show use within the relevant timeframe.

76. I find the information and evidence regarding the enquiry relating to a 1994 purchase<sup>4</sup> to be of little use under this ground, as not only does it relate to goods that would have been marketed and/or purchased prior to the relevant timeframe (and so it cannot be said to show the genuine use of the mark by the proprietor within the same), I have also found the variant shown on the product to be unacceptable for the purpose of showing use of the mark as registered.

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<sup>4</sup> Exhibit PA C8

77. In respect of the evidence showing the proprietor's YouTube channel page,<sup>5</sup> I note again the applicant has questioned whether the mark is indeed shown on the videos themselves. As I have said, I am not minded to disbelieve Mr Archer in his statement that the mark is shown on the tools in the videos. However, I cannot identify from the printed pages provided which of the videos show the mark, whether I find the variant used to be acceptable, whether these fall within the relevant time frame and whether this would be viewed and noticed by the applicant. I find these pages to be of little assistance to the proprietor's case in this instance.

78. The proprietor has provided a selection of invoices,<sup>6</sup> including a substantial selection dated from within this timeframe. The dates of the invoices are spread out consistently over the relevant timeframe, and also including several dated between April 2019 – 21 October 2019, after the launch of the Heritage Line. The invoices provided reference various products sold by the proprietor and show either the invoice location and delivery location, or just the delivery location. The details of the recipients and their addresses have been redacted, leaving only the details showing that the invoice/and or delivery addresses are various locations around the UK. The unit price and invoice totals are not shown on the documents. The registered mark (or an acceptable variant) is not featured on the invoices themselves.

79. Despite the obvious flaws in this exhibit, it is important that I do not dismiss these invoices without properly considering their merit in respect of the picture that the sum of the evidence creates. Within his witness statement, Mr Archer has stated:

“For obvious reasons, the invoices are redacted as I do not want to disclose my unit prices. As can be determined from the substantiated

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<sup>5</sup> Exhibit PA C9

<sup>6</sup> Exhibit PA C10

brochures, item code 2700800 which related to a “flaring tool kit” will bear the SP Tools brand, as would any product being an associated tooling or component parts of the flaring tool kit.”

80. As noted by Mr Archer above, the invoices contain reference numbers and descriptions of various goods, some of which can be matched to the items shown in Exhibits PA C1 and PA C2, including the 02700800 referenced by Mr Archer. I have outlined the references featured on invoices from within the relevant timeframe that clearly match with goods in PA C1 or PA C2.

81. The 2015 invoices include sales of the following goods:

- 02700800 – Flaring Tool Kit – Complete

This item is shown in the 2015 provided by the proprietor. Although the mark is not clear from the brochure, Mr Archer has identified where a mark that I have found to be an acceptable variant of the mark features on the product itself.

- 02729500 – F/Master Break Flare Kit 4.75mm

Although I cannot locate this item in the 2015 catalogue, it is shown in the 2016 catalogue provided by the proprietor. Again, the mark is unclear in the catalogue but the location of a mark which I have found to be an acceptable variant is identified by Mr Archer.

- 02700100 – Flaring Tool Kit-3/16” & 4.75mm

This item is shown in the 2015 catalogue provided by the proprietor. Although the mark is not clear from the catalogue itself, a mark which I have found to be an acceptable variant has been identified by Mr Archer on the product image.

82. The 2016 invoices include references to the following goods:

- 020725000 – Flaremaster2 – Flaring tool

This item is shown in the 2016 catalogue provided by the proprietor. Again, the mark is unclear in the catalogue but the location of a mark which I have found to be an acceptable variant is identified by Mr Archer on the image of the product itself.

- 02700800 – Flaring Tool Kit – Complete

This item is shown in the 2016 provided by the proprietor. Although the mark is not clear from the brochure, Mr Archer has identified where a mark that I have found to be an acceptable variant of the mark features on the product itself.

- 02830000 - Circlip Tool with Peg Set

This item is shown in the photograph at Exhibit PA C1 and on the invoice 18 April 2016. However, it is unclear from Mr Archer's statement if this product would have been packaged using the mark back in 2016, as Exhibit PA C1 appears to relate to the launch of a wider range in 2019.

83. The 2017 invoices include references to the following goods:

- 02700800 – Flaring Tool Kit – Complete

Although this item isn't shown in the 2017 provided by the proprietor, it is shown in various other brochures under the same product code during the relevant time. Although the mark is not clear from the brochure, Mr Archer has identified where a mark that I have found to be an acceptable variant of the mark features on the product itself.

84. The 2018 invoices reference to the following goods:

- 02700800 – Flaring Tool Kit – Complete

This item is shown in the 2018 brochure provided by the proprietor. Although the mark is not clear from the brochure, Mr Archer has identified where a mark that I have found to be an acceptable variant of the mark features on the product itself.

- 02729600 – F/Master Flare Kit 4.75 + 6mm



Although I cannot locate this in the 2018 brochure provided by the proprietor, this item is shown in the 2016 brochure provided. Although the mark is not clear from the brochure itself, Mr Archer has identified where a mark that I have found to be an acceptable variant of the mark features on the product itself.

85. The 2019 invoices reference the following goods:

- 66088700 - 9 piece hook and scraper set

This item is shown in the photographs provided at Exhibit PA C1 bearing an acceptable variant of the registered mark. It features on several invoices dated 16/05/19 & 20/03/2019 & 24/09/19

- 02700100 – Flaring Tool Kit – 3/16” & 4.75mm

Although this item doesn't appear to be shown Exhibit PA C1, images of the item from the 2018 catalogue show this item available. The mark is not very clear from the catalogue itself, but Mr Archer identified where mark is on product. This item appears on invoices of 4/03/19, 25/04/19, 23/03/19, 4/07 19 & 5/09/19.

- 02700900 – Flaring Tool Kit – 4.75 & 6mm

Although this item doesn't appear to be shown Exhibit PA C1, images of the item from the 2018 catalogue show this item available. The mark is not very clear from the catalogue itself, but Mr Archer identified where mark is on product. This item appears on invoices of 11/02/19, 23/03/19, 20/05/19, 10 06/19, 6/09/19 & 21/03/19.

- 02700800 – Flaring Tool Kit

Although this item doesn't appear to be shown Exhibit PA C1, images of the item from the 2018 catalogue show this item available. The mark is not very clear from the catalogue itself, but Mr Archer identified where mark is on product. This item appears on an invoice from 18 Oct 19.

- 02700200 – Flaring Tool Kit – Metric

Although this item doesn't appear to be shown Exhibit PA C1, images of the item from the 2016 catalogue show this item available. The mark is not very clear from the catalogue itself, but Mr Archer has identified where mark is on product. This item appears on invoices dated 9/01/19, 30/04/19 & 27/07/19.

- 02700000 – Flaring Tool Kit – Imperial

Although this item doesn't appear to be shown Exhibit PA C1, images of the item from the 2014 catalogue show this item available. The mark is not very clear from the catalogue itself, but Mr Archer has identified where mark is on product. This item appears on invoices dated 2/01/19, 25/03/19, 31/05/19, 24/06/19.

- 02830000 – Circlip Tool with Peg Set

This product is shown in the photographs provided at Exhibit PA C1, and shows use of variant 6 on the packaging. This product is included on invoices of 23/09/19, 11/09/19, 8/5/19, 29/03/19, 14/01/19 & 25/03/19.


86. Something I note is not shown from the invoices, which as I have mentioned include a good number from 2019, and several from between April 2019 – 21 October 2019 is that references to the products available under the Heritage Line do not appear to feature on the same. However, overall I find this exhibit, in conjunction with Exhibit PA C1 and PA C2 useful for showing that goods that Mr Archer claims bear the acceptable variants of the marks were sold to consumers within the UK, within the relevant time period.

87. In addition to the invoices provided, the proprietor has set out turnover figures as mentioned within my evidence summary above. The figures for this relevant period have been provided as below, with estimates that around 2% of revenue prior to 2019 “being attributable to tool products bearing the



mark”. Mr Archer states this figure is based on his understanding of the number of units sold. Mr Archer goes on to state that in 2019, the sale of the products bearing the mark account for “roughly 15% of the overall

revenue”. As set out within the evidence summary, the proprietor has submitted the table below based on these estimates:

Year	Company Revenue £million	Estimated units sold bearing  mark	Calculated Revenue £000s
2019	£4,000,000	5000	£600,000
2018	£4,100,000	550	£82,000
2017	£4,900,000	626	£98,000
2016	£4,500,000	605	£90,000
2015	£5,100,000	731	£102,000

88. The applicant makes the following comments on this point in its submissions:

“The proprietor has detailed the sales and turnover, however they have admitted that they can only guess as to the percentage of those sales that can be attributed to the mark subject to this matter. They are only able to provide estimated sales for products with the subject mark on, therefore this cannot be relied upon as evidence of use of the mark. The more limited the volume of sales of items bearing the mark, the more necessary it will be for the proprietor to produce additional evidence to dispel possible doubts as to the genuineness of the use of the mark in question (*CFL, 30 April 2008, Sonia Rykiel création et diffusion de modèles/OHIM – Cuadrado, T-131/06, paragraph 42*)”


89. I note the applicant’s concern that an over generous estimate of turnover in relation to the mark may unfairly inflate the proprietor’s chances of showing genuine use of the mark in question. There appears to be some objection from the proprietor that the applicant has described the figures as a “guess”, although I note that the wording “best guess” is used by Mr Archer, and so I do not view this description as unfair. However, I note that Mr Archer also describes these as estimates, and I believe this is a more appropriate description of the figures given considering the context. Whilst I acknowledge the applicant’s concerns, and in my view certainty would be preferable, I see no reason why Mr Archer’s estimates (or even his “best guess”) of sales should be so considerably skewed that they are not fall there or thereabouts,

considering Mr Archer's position in the company since 2006 and his undoubtable access to stock information, cost per unit and overall sales. I note that where Mr Archer cannot identify the units sold prior to 2014 (although the units sold after that are still described as estimates in the table provided), he has said so. However, I do consider these figures with both Mr Archer's uncertainty and the fact there may be a natural propensity to round up rather than round down when providing an estimate to assist one's case, firmly in mind. In the interest of fairness, I will consider the impact of these figures falling at a lower rate than the exact figures provided when assessing the picture the evidence has created, to allow for a margin of error in the circumstances. Further, as 2019 fell in part outside of the relevant time period, I find it is only the portion of 2019 until 21 October 2019 that will be relevant. As the first part of 2019 (at least until April) will not include additional sales for the Heritage Line, whereas the part of 2019 falling outside of the relevant time frame, namely from 22 October 2019 likely will, I consider that the percentage of sales falling within the relevant timeframe will very likely be lower than 15% of the revenue.

90. I note that there are also further gaps in the revenue information provided by Mr Archer. Firstly, there is no additional breakdown of the percentage of the figures that may be attributed to the UK. I find it likely from the additional evidence provided, including reference to a number of brochures being printed in euros, that a portion of these sales will be attributed to outside of the UK. Further, the split of sales and turnover that may be attributed to each of the products under the mark itself is not shown. However, overall, despite the lack of precise figures, I find this evidence may be useful for building a picture of the amount of activity under the mark each year.

91. As mentioned in the evidence summary, Mr Archer has commented on advertising spend estimating a £25,000 spend each year for the last ten years. Mr Archer claims the majority of this spend relates to the brochures provided. As I have found it difficult to make out the registered mark or an acceptable variant within these catalogues, I find this does little to assist the proprietor's case.

92. Mr Archer has gone on to identify a number of trade shows that the proprietor has attended over the past few years, including a list of 20 that safely fall within this period. The proprietor has also included a variety of press articles discussing the success and/or the footfall of the various events.<sup>7</sup> Within his witness statement, Mr Archer also states:

“Our products bearing the  brand would have been on display for anyone to see who attended the shows. The shows are an opportunity for customers, future customers and indeed competitors to see our brands and products.”

93. The applicant submits that, as there are no photos from the trade events, there is no evidence that the mark in question was displayed at these events. Whilst I have no reason to doubt the truthfulness of Mr Archer’s statements that the mark in question was on display at the events, I find that without being able to see the specifics of the use made of the mark at these events within the evidence filed, I cannot take much from the proprietor’s attendance at the same. I do note that where an address of the events has been confirmed, these have taken place within the UK, contributing towards the picture of the proprietor’s presence in the UK, but I find overall this exhibit contributes very little towards a picture of genuine use of the mark.

### **Genuine use**

94. As identified from the case law set out at paragraph 40, genuine use of a mark should be use by the proprietor (or an authorised third party), that is more than merely token and is consistent with the essential function of a trade mark. Use of the mark should be in respect of goods or services already marketed, or for which preparations have commenced, and be for the purpose of creating or preserving an outlet for the goods or services that bear the mark. All relevant factors and circumstances should be considered when assessing whether use is genuine, including the economic sector and market characteristics, the scale,

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<sup>7</sup> Exhibit PA C11

frequency and target of the use, the territorial extent of the use and the evidence the proprietor is able to provide. It should be considered that use need not be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services, but it is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use.

95. 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 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.”

96. The applicant has made the following submissions in respect of the proprietor's use of the mark:

“The applicant is not denying that the Sykes-Pickavant mark is used, the proprietor has provided sufficient evidence to show this, however there is minimal evidence to show use of the SP TOOLS mark within the requested periods of time. As a result of this, it can be concluded that the minimal use made is merely token use and cannot be considered genuine use. The

Proprietor has failed to provide any evidence showing the mark on sale, either in a shop or online. They have provided sales figures but failed to detail how these are sold. They have merely shown the mark on a product within a brochure or flyer, this is not evidence that the mark has been in use on the market place. Genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*GC, 19 April 2013, Luna International Ltd/OHIM-Asteris Industrial and Commercial Company SA, T-454/11, paragraph 29*)”

97. Within its final written submissions, the applicant states:

“The minimal evidence provided by the Proprietor does not amount to genuine use in the United Kingdom and therefore the mark should be cancelled. In light of the above, the applicant for revocation hereby contends that the mark should be revoked for reasons of non-use.”

98. Having conducted a full analysis of the evidence provided by the proprietor under Section 46(1)(b), I note that there is no single piece of evidence provided by the proprietor that alone has been able to satisfy me that there has been genuine use of the mark throughout the relevant time period. Further, I find the evidence provided is not without its flaws, often either having omitted, redacted, or simply failed to display one piece of the picture required to show use of the mark in respect of the goods, in the relevant time period, in the relevant territory. I do not therefore, prima facie, disagree with much of the applicant’s criticism of the evidence set out above. However, I find the criticisms of each piece of evidence on an individual basis falls short of where I must go when assessing the evidence provided. Although I should consider each piece of evidence individually, I must also go a step further prior to dismissing this, by way of considering the sum of the evidence and the picture this has created.

99. In my view, the sum of the evidence filed shows a picture of the consistent use of an acceptable variant of the registered mark by the proprietor on brake pipe flaring tool kits throughout the period of 2014 – 2019. Namely, this

picture has been constructed from the evidence including the brochures provided between 2014-2018 with the assistance of Mr Archer's statements as to the products on which the mark is featured throughout this time, the invoices bearing the codes referencing sales to UK addresses of the particular products which the proprietor has identified as bearing the mark (although I note some important information regarding customers and costs has been redacted), the invoices showing the number of these brochures being printed in GBP in 2018 & 2019 alongside Mr Archer's statement that these have been distributed throughout the UK (meaning the products bearing the marks were available for sale and advertised throughout this time), and finally the estimated turnover figures in respect of products bearing the mark (although I note there is room for a margin of error in the figures and also for some of these to be attributed to sales outside of the UK). It is my view that these elements, which both support and are supplemented by Mr Archer's claim in his witness statement that prior to April 2019 the mark was used predominantly used in relation to a range of hand tools that "typically make up a flaring tool kit" are together sufficiently solid and specific enough to satisfy me that mark (or an acceptable variant) was in use in respect of "brake pipe flaring tools" including parts of these tools within the "kits" within the UK, within the relevant time period. I would note at this point that it is not the feature of the acceptable variant of the mark within the 2014 – 2018 brochures themselves that I find to be use in this respect, as the evidence clearly shows this mark will be difficult for the consumer to make out. Rather, it is instead the picture created by the sum of the evidence that leads me to find the mark was featured on the brake pipe flaring tool kits as sold to consumers throughout the relevant time frame that I find to be use of the mark in respect of these goods.

100. I also find that the applicant appears to agree that at least minimal use has been shown in this context of Exhibit PA C2 (although it is noted that no concession has been made with regards to this being genuine use) stating:
- "All of the evidence in Exhibit PA C2 and Exhibit PA C3 shows the same product in each brochure through the years. This only appears on one page in



every brochure. There are no other products containing this mark. This is minimal use of the mark and therefore could be argued that it is not genuine use and is merely token use in an attempt to prevent the trade mark from being cancelled.”

101. I note Mr Archer’s statement about the launch of the HERITAGE LINE, and the detail of the products included within the brochures provided, which are very clearly being marketed under what I have found to be an acceptable variant of the mark as registered. Despite being provided with a number of invoices from 2019, as well as the apparent increase in 2019 revenue created by the launch, I have not been able to match the sales on these invoices provided with any of the products launched under the Heritage Line shown on the leaflets provided. I find this surprising. I find on the sum of the evidence, including the dated leaflets provided, Mr Archer’s statement regarding the launch of the line, and the estimated increase in the sales figures under the Heritage Line that at the very least, preparations to use the mark in the UK in respect of the hand tools (both complete tools and parts thereof) falling within the Heritage Line had begun within the relevant timeframe, in respect of the following goods:

- Bearing Puller Pack;
- Puller Pack;
- Panel Pack;
- 1500 Pack;
- Slide Hammer Puller Pack.

102. The contents of each pack are outlined within the evidence summary section of this decision.

103. In addition to this, I have matched items on the 2019 invoices both with various items shown in the earlier brochures<sup>8</sup> provided by the applicant where an acceptable variant of the mark has been pointed out as mentioned, as well

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<sup>8</sup> Exhibit PA C2

as with the photographs<sup>9</sup> provided which clearly display an acceptable variant of the mark. I find therefore that between the dated invoices<sup>10</sup> and the photographs<sup>11</sup> that use of an acceptable variant of the mark within the UK, within the relevant timeframe under this ground has been made, including use on the following goods items falling outside of the brake pipe flaring tool kits:

- 9 piece hook and scraper set;
- Universal Circlip Tool with Peg Set.

104. Now that I have established that the evidence shows some use of the mark within the UK, in respect of the goods, in respect of the relevant time frame under this ground, the question remains whether I find this to be genuine use for the purpose of maintaining a market share in respect of the goods in question, or whether I agree with the applicant that this is simply token use. As outlined above, the applicant submits that on the basis that the use of the mark is minimal, it can be concluded that it is token use, and cannot be considered as genuine use. I disagree with the absolute nature of the applicant's statement, as it is well established that there is no *de minimis* rule when it comes to proving use, although of course the extent of the use in the relevant context should be considered.

105. On this occasion, I am inclined to disagree with the applicant that the consistent use of the mark in respect of (primarily) one product or set of products is evidence that the use is for the sole purpose of preserving the rights conferred by the mark. Rather, I find that it is not uncommon for a mark, over time, to be used with only a select range of products, with a wider range falling under a different house trade mark. I can see no reason to find that the consistent use on selected products only indicates anything other than the use of a sub brand in this instance, which has predominantly been in use in respect of brake pipe flaring tools, which I note are sold in or with additional parts, rather than the proprietor's full range. Further, I have found there is also

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<sup>9</sup> Exhibit PA C1

<sup>10</sup> Exhibit PA C7

<sup>11</sup> Exhibit PA C1

some evidence of use on a wider range of products within the relevant timeframe for this ground, as well as at the least preparation for use in respect of further products within the relevant time period (albeit towards the end), and I find the picture of the use and expansion to appear genuine.

106. Whilst I have not been provided with the size of the market in this instance, which I note has been described by the proprietor as the “automotive tool and handheld diagnostic equipment sector”, I note that this is likely to be at least a medium sized market sector in the UK. I cannot determine the exact UK revenue or units sold under the mark, but I find from the estimated units sold under the relevant mark, (as well as the clear presence of the proprietor in the UK), that the share of that market occupied by sales under the registered mark is likely to be fairly small. When I consider that these sales relate fairly exclusively to brake pipe flaring tools prior to 2019, it is possible that the share of the market for specific goods will be more significant, but again, it is difficult to determine the exact share. However, although exact figures may be difficult to pin down, I find the sum of the evidence creates a picture of real, commercial exploitation of the mark in this instance, in respect of the goods previously mentioned. I therefore find that there has been genuine use of the mark during the most recent relevant timeframe under 46(1)(b).

### **Fair Specification**

107. I must now consider the extent to which the proprietor’s use justifies the specification of goods as registered, or if more limited protection would be appropriate based on my findings above. The registration currently covers the following goods:

*Class 8: Hand-tools and parts thereof included in Class 8.*

108. 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 in respect of a fair specification of goods 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 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.”

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

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

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

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

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to

all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

110. In this instance, I find that the goods covered by the registered mark are already a subcategory of the broader category of 'tools'. However, I find the application of tools, and as such the application of hand tools, to vary significantly, and that hand tools will encompass a broad range of goods. It is my view that hand tools (and accordingly, "parts thereof") may therefore be broken down into further subcategories. In this instance, I find the average consumer of the goods concerned to be both members of the general public including automotive hobbyists and enthusiast, as well as professionals such as mechanics, and those running or employed by garages and bodyshops. I find that the consumer would clearly identify that there are different categories of hand tools (and parts thereof). For example, I believe the consumer would view hand tools for construction as a different subcategory to hand tools for horticulture, and as different again to hand tools for use in beauty and nail care. I find these would all be viewed by the consumer as different again to automotive tools clearly shown in this instance. It is therefore my view that a fair specification of the goods in question would be as follows:

*Class 8: Hand tools for use with vehicles and parts thereof included in class 8.*

111. I note at this point that Mr Archer stated in his witness statement “Our products are suitable for a range of consumers in both the automotive and industrial sectors”. However, it is my view that the evidence provided during this timeframe does not show use for tools used within the industrial sector, and that this therefore should not be encompassed by a fair specification under this mark.

112. I find the registration may be maintained in respect in respect of Section 46(1)(b) for of the limited goods as outlined above.

### **Other relevant periods under 46(1)(b)**

113. As I have found that the use of the mark under the most recent period relating to 46(1)(b) is justified in maintaining the specification outline above, even if I find no use within the remaining relevant time periods, I would find that the use of the mark had been sufficiently resumed in respect of the goods outlined above for these to be maintained under 46(3) of the Act. However, as the protection for the mark has been limited, it is necessary to establish the date at which the protection should be limited to this extent.

114. Having reviewed the evidence filed, it is my view that there is no evidence justifying protection broader than that I have outlined above during the relevant period of 4 December 2004 – 3 December 2009. I do not therefore find that the protection should be maintained for a broader range of goods than those outlined above, on the basis of the evidence filed during this time period.

115. In respect of the period of 4 December 1989 – 3 December 1994, I note that the range of evidence filed is more limited, with only Exhibit PA C4 relating to this timeframe. No sales numbers or figures have been provided, but Mr Archer has confirmed that the brochures have been sourced from

internal archives, and that they were distributed throughout the UK during the relevant time. However, Exhibit PA C4 consists of flyers showing hand tools under variant 7, which I have found to be an unacceptable variant in this instance. I do not therefore, find protection should be maintained for a broader range of goods than those outlined above, on the basis of the evidence filed during this time period.

### **Ground 46(1)(a)**

116. Under this ground, the proprietor was required to show use within the time frame 4 December 1985 – 3 December 1990. Again, it is necessary to examine the evidence of use under this ground for the purpose of establishing the date at which the proprietor's protection should be limited to *Hand tools for use with vehicles and parts thereof included in class 8* as outlined above. One Exhibit has been filed under this ground, namely Exhibit PA C5, which consists of the marketing bulletins and brochures. There is consistent reference to the registered mark throughout this evidence, which Mr Archer has confirmed he has sourced from the proprietor's archives. Mr Archer also confirms the brochures were distributed throughout the UK within the relevant timeframe. I appreciate that the relevant time period under this ground began 35 years ago, and so extensive records and evidence from this time are likely more difficult to access. I note also that there is a reference under this ground to a slightly broader application of a "Diesel Engine compression tester" appearing on a leaflet with a copyright date of 1986. This leaflet references that the application of the compression tester is "For Trucks, Municipal, Agricultural, Marine, Plant & Industrial engine applications". However, I find there to be little else to indicate that the mark was in use relation to hand tools or parts thereof, outside of those for vehicles during this time. I therefore find no reason to find broader protection to be justified under this ground than that outlined under 46(1)(b).

### **Grounds 46(3)**

117. As mentioned in the evidence summary, the proprietor has provided evidence falling outside of the relevant time frames for use. The provisions of 46(3) state that should use of the mark resume following a period of non-use

and prior to the filing of the revocation action, protection for those goods for which genuine use has resumed may be maintained. This is relevant in this instance, as should the genuine use of hand tools or parts thereof outside of those for use with vehicles have been sufficiently resumed, the date at which the proprietor's protection should be limited may change. I have reviewed the evidence provided under Exhibits PA C6 consisting of brochures falling between 1999 – 2014, as well as the limited invoices provided falling within this period, and the following additional information provided by Mr Archer:

- Attendance at the Commercial Vehicle Show in April 2014;
- Estimated revenue figures;
- Estimated catalogue distribution;

118. On the basis of the evidence provided, it is my view that genuine use outside of *Hand tools for use with vehicles and parts thereof included in class 8* was not sufficiently resumed during this period in a manner that justifies the proprietor's original specification of *Hand-tools and parts thereof included in Class 8* to be maintained in full past the date of 4 December 1990.

### **Conclusion – Non use**

119. The revocation under 46(1)(a) and 46(1)(b) has achieved partial success, and the proprietor's goods will be limited to the following goods in class 8 from 4 December 1990:

*Class 8: Hand tools for use with vehicles and parts thereof included in class 8.*

### **Costs**

120. Both parties have achieved partial success in this matter, the extent of which appears to be fairly equal, with the proprietor having maintained protection for a subcategory of goods since the first relevant date, and the applicant having limited the protection from a broader category from the same



date. I find in the circumstances that each party should bear its own costs in these proceedings.

**Dated this 30th day of October 2019**

**Rosie Le Breton  
For the Registrar,  
The Comptroller-General**