

O/078/21

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF
INTERNATIONAL TRADE MARK REGISTRATION NOS.
682040 AND 1042842
AND UK TRADE MARK
REGISTRATION 1436894**

**IN THE NAME OF
HUBER HOLDING AG**

FOR THE RESPECTIVE TRADE MARKS

SKINY

IN CLASS 25

SKINY

IN CLASSES 3 AND 25

And



IN CLASS 25

AND

THE APPLICATIONS FOR REVOCATION THERETO UNDER NOS.

503049, 503050 AND 503051


BY SOLOMON AND SILVER LIMITED

Background

1. Huber Holding AG (hereinafter “the proprietor”) is the holder of the following trade marks:

Number	WO0000000682040
Mark	SKINY
Date	Date of protection of the international registration in UK: 22 May 2003
Classes and Terms	Class 25: Clothing, including underwear and stockings.

Number	WO0000001042842
Mark	SKINY
Date	Date of protection of the international registration in UK: 25 February 2011
Classes and Terms	Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices. Class: 25: Headgear, footwear, socks, stockings, bras, lingerie, underwear.

Number	UK00001436894
Mark	
Date	Date of completion of registration process: 18 March 1994
Class and Terms	Class: 25: Waistcoats, shirts, collars, cuffs, vests, blouses, stockings, articles of under clothing, night-wear, dressing gowns, bathing suits, bathing caps, swimming trunks; all included in Class 25.

2. Solomon and Silver Limited (hereinafter “the applicant”) applied for the full revocation of said registered marks, on the grounds of non-use by the proprietor or with its consent, pursuant to Section 46(1)(b) of the Trade Marks Act 1994 (“the Act”).
3. In its application filed on 4 March 2020, the applicant claims that the use of the marks in the United Kingdom has been suspended for an uninterrupted period of five years from 31 October 2014 to 30 October 2019 (“the contested period”); and therefore claims an effective revocation date of 31 October 2019 under section 46(1)(b) of the Act.
4. The proprietor filed defences and counterstatements against all three applications (503049, 503050 and 503051), in which it denies all of the grounds of the revocation actions and; subsequently adduced evidence in support of its case: that use of its marks had not been suspended for the uninterrupted period as claimed by the applicant or at all. The proprietor also made an application to have the three actions consolidated; to which the Registrar acceded, pursuant to Rule 62(1)(g) of the Trade Marks Rules 2008. Therefore, this decision considers all three applications.
5. In these proceedings, the proprietor is represented by Page, White & Farrer Limited and the applicant is unrepresented. Only the proprietor filed evidence; neither party requested a hearing; and both filed written submissions in lieu of a hearing. I have reviewed all of the evidence and submissions and will, to the extent I consider necessary, refer to them later in this decision.

Preliminary Points

6. I note from the applicant’s written submissions that it relies on an EUIPO refusal record to argue that the proprietor’s mark is “laudatory, in the sense that it promotes a marketing message”. Although this information emanates from public records, which can be accurately and independently verified, it has not been formalised into evidence. The record, furthermore, is not

based on an adjudicated decision; and it also shows (at the time of writing this decision) that an appeal is pending. The issues to be addressed in these proceedings are not necessarily identical to those of the EUIPO application; and I am not bound to take the information at issue into consideration. I must address the case before me on its own facts and merits. To this end, I have borne in mind that a registered trade mark must be considered to have at least a minimum degree of distinctive character.¹ I will say more on this later.

7. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.
8. In its written submissions the applicant also argues that “the proprietor relies on evidence of use introduced by a putative licensee, Skiny bodywear GmbH & Co KG; and that “there is no evidence originating from the Proprietor of the Contested Marks showing that it has authorised Skiny bodywear to put those marks to use on its behalf”.
9. On these points I considered that it is not strictly necessary to exhibit any particular documentation, nor is there any established rule as to what level of evidence has to be provided, in order to prove authorisation to use the marks; particularly in circumstances where there is strong inferential

¹ This conclusion is supported by the CJEU’s ruling in Case C-252/12, *Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd, Specsavers Optical Superstores Ltd v Asda Stores Ltd*: At paragraphs 22 and 23 it was stated: “

For a trade mark to possess distinctive character for the purposes of Regulation No 207/2009, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings

That distinctive character of a registered trade mark may be the result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases, it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service at issue as originating from a given undertaking (see, by analogy, Case C-353/03 *Nestlé* [2005] ECR I-6135, paragraph 30).”

evidence pointing to consent. Furthermore, the applicant has not filed any evidence, nor requested cross-examination, to undermine the proprietor's evidence on this issue. The evidence shows that there is an economic link between the proprietor and Skiny bodywear GmbH & Co KG, which used the mark/s in the course of trade in relation to the goods of the relevant registration/s. I therefore accept that the evidence sufficiently demonstrates that Skiny bodywear GmbH & Co KG used the mark/s with the proprietor's consent.

Proprietor's Evidence

10. The proprietor's evidence consists of a witness statement in the name of Florian Neu, appending 3 exhibits. Mr Neu affirms that he is managing director of Skiny bodywear GmbH & Co KG (hereinafter "Bodywear Co"), a company "indirectly wholly owned by Huber Holding AG". He further asserts that Bodywear Co is "authorised by Huber Holding AG to use the SKINY Marks for the goods at issue". Mr Neu also contends that the marks have been used by Bodywear Co in the UK "for all kinds of clothing including bodywear, day wear, sleepwear, loungewear and swimwear since at least as early as 2015"; that they have "consistently been used in these forms, throughout the UK, since the date of first use", and during the alleged period of non-use.
11. Exhibit FN1 presents an organisational chart delineating the "legal structure" for Huber-Group, with Huber Holding AG atop a series of enterprises, including Bodywear Co.
12. Exhibit FN2 consists of twenty-nine (29) invoices, each headed with a representation of the mark SKINY, with the registered trade mark symbol ® at the bottom right of the mark; followed by the company name (Skiny bodywear GmbH & Co KG) and its address in Austria. The invoices, dated between 24 July 2015 and 13 September 2019, record delivery addresses within the UK. The customers identified from the invoices are four (4) commercial clients: True Love Lingerie Ltd; Fenwick Ltd; Mio Destino Ltd; and The Fitting Room.

The invoices also reference specific products; product codes²; item quantities; and prices in Pound Sterling. The prices are relatively low, with the majority of items at the £10 (or below) price point. The sums of the invoices vary; ranging from £18.33³ to £1,698.02.⁴ However, the majority of the invoices shows values above £200 and some record figures in excess of £500.⁵ The mark at the top of centre of the invoices appears as follows:

SKINY®

13. Exhibit FN3 comprises a selection of catalogues issued during the contested period. The dates range from “01.10”⁶ to “10.01.2019”⁷; and are shown as: “Delivery. 10.02.2019”⁸; or as “Trend Spring / Summer 2018”.⁹ According to the evidence of Mr Neu: “These catalogues are distributed to UK retailers [or] wholesalers [or] customers on a seasonal basis. Approximately 100 catalogues are distributed each season in the UK by post/email. UK customers rely on the catalogues to place their orders for SKINY products for new seasons. The catalogues also contain Point of Sale materials which can be ordered and displayed in store by UK retailers [or] wholesalers [or] customers to advertise the latest SKINY range of bodywear, day wear, sleepwear, loungewear and swimwear.”

14. The catalogue samples include photographic images of models wearing various items of clothing; photographs and drawings of some items; text in both English and German; and indices comprising of product codes, against the products and page numbers where those products can be found. The product codes in the invoices can be cross-referenced with the codes in the catalogues. However, it is difficult to match codes against actual product. For example, an invoice dated

² Mr Neu states that these correspond with the items offered for sale in catalogues, as evidenced under exhibit FN3.

³ See page 116 of FN2.

⁴ FN2, page 10.

⁵ See FN2, pages: 4, 14, 27, 30, 40, 112, 120.

⁶ See FN3, page 154.

⁷ FN3, page 9.

⁸ FN3, page 21; see also pages 47, 65, 118, 146 for additional dates.

⁹ FN3, page 50; see also pages 102, 118, and 141 for additional trend or seasonal issues.

24 August 2019 (at page 120 of FN2) shows the sale of item number 085450 (in black, in four different sizes). This is cross-referenced against the 2019 Spring/Summer catalogue (at page 7 of FN3), which shows this product code as: “085450 padded triangle | Triangel gepaddet”; and that that said item can be found at page 87 of said catalogue. However, page 87 of that catalogue has not been exhibited.

15. The marks appear as registered and/or in variant forms in the sample of catalogues. There is an example of the mark appearing on apparel. On page 140 of Exhibit FN3 the mark SKINY can be seen on the waistband of the underwear or swimming trunks worn by a model. Variant use of the mark/s is also evident on some of the goods, including: the mark SKNB on (swimming) shorts, (FN3, pages 23 and 92,); on boxers or swimming trunks (FN3, pages 33, 34, 45, and 97); and the mark SK8Y6 on sportswear (FN3, page 125).

16. Pages 57, 120, 127 of Exhibit FN3, show that the marks and/or variants of the marks have been used on hangtags. Those hangtags are displayed under the heading: “hangtag (example) / Preisanhänger (Beispiel)”.

17. I note Mr Neu’s representation of “[a]pproximate annual turnover figures for goods bearing the SKINY marks in the UK”, in Euros (€), as follows:

Year	Turnover (€)
2015	306,415
2016	143,202
2017	193,757
2018	165,791
2019	189,000

18. Mr Neu further declares in his witness statement that Bodywear Co promotes the SKINY marks through: its website, catalogues, social media platforms such as Facebook and Instagram; and search optimisation; and that it expends “approximately €5,000 each year on promoting and advertising the SKINY marks for the relevant goods”.

19. That concludes my summary of the evidence filed to the extent I consider it necessary.

PROOF OF USE/GENUINE USE

Legislation and Caselaw

20. Section 46 of the Act states:

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

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

(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 purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made. Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made 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 existed at an earlier date, that date.”

21. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) 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 Kameradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale

and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

22. 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.”

23. In considering the opponent’s evidence I remind myself of the comments of Mr Daniel Alexander Q.C., sitting as the Appointed Person in *Awareness Limited v Plymouth City Council*, Case BL O/236/13:

“22. The burden lies on the 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 skeptical 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.”

24. The comments of Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, are also relevant. He opined as follows:

“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.”

Considerations

25. As the above caselaw establishes, all of the circumstances of a case have to be taken into account in conjunction with each other in order to determine whether the mark in question has been genuinely used. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole; with regard to place, time, extent and nature of use. Therefore, a separate assessment of the various relevant factors, each considered in isolation, is not suitable.¹⁰

26. The proprietor’s case is that it has used its marks in the period relied upon by the applicant under section 46(1)(b) for the respective class 25 specifications under all of the marks at issue. It supports its defence against these revocation actions with evidence, including: a selection of invoices to UK-based commercial customers and sample catalogue evidence. For the class 3 specification (soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices) the proprietor makes clear in its submissions in lieu that: “No evidence of use has been filed for these goods”. I will therefore proceed on the basis that the proprietor concedes that no

¹⁰ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

genuine (or insufficient) use has been made of the mark/s in relation to the class 3 specification.

Form of the marks



27. In *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 s.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.”

28. In *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Professor Philip Johnson, sitting as the Appointed Person, found that the use of the mark shown below qualified as use of the registered word-only mark DREAMS. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

The image shows the word "dreams" written in a black, cursive, handwritten-style font. The letters are connected and have a fluid, flowing appearance.

29. The proprietor's evidence of use comprises use of the SKINY word marks and the SKINY logo mark. There are examples in the proprietor's evidence of the logo mark being used as registered. Clearly, these will be use upon which the proprietor may rely. It is also important to note that registration of a mark in black and white will cover use of that mark in any colour. Therefore, where the evidence shows the marks being used in different colours, this will be acceptable variant use of the mark/s upon which the proprietor may rely.
30. In its submissions in lieu, the applicant argues that: "The word SKINY is inherently non-distinctive in relation to goods in Class 25, as it serves simply to denote a characteristic of those products, namely that they are skinny fit. ... To the extent that the mark SKINY has been put to genuine use at all in relation to the Contested Goods (which is denied), use of the mark in plain font alters the distinctive character of the mark as registered and should not, therefore, be taken into account for the purposes of demonstrating use of UK Registration No. 1436894. Similarly, for the same reason all use of the word SKINY in stylised form should not serve to substantiate use of IR Nos. 682040 and 1042842, which comprise the word SKINY in plain font." I do not agree with the applicant.
31. By contrast, the proprietor submits "that use of the SKINY mark in block capital letters is use of the mark as registered and, in the case of the  mark ("the SKINY Logo Mark"), it is use in a form differing in elements which do not alter the distinctive character of the mark as registered. Similarly, use of the mark in the form  is sufficient to validate the registrations for the SKINY word mark. SKINY is distinctive for the goods at issue. The stylization of the SKINY Logo Mark comprises a simple geometric shape. The dominant and distinctive element of the SKINY Logo Mark is undeniably the word SKINY. The minimal stylization of the SKINY Logo mark does not alter the distinctive character of the word SKINY." I agree with the proprietor.

32. I find that the distinctive character of the registered marks is essentially derived from the word element itself. Further, the variant forms of the marks, appearing as: SKINY in word form and the stylized versions on a black background, do not alter the distinctiveness of the registered marks. Therefore, those forms of use are acceptable variants of the registered marks.
33. The evidence shows that the mark SKINY appeared on invoices issued by Bodycare Co during the relevant period. I note that the ® symbol appears at the lower right side of this mark; however, I find that this symbol would have little to no impact upon the average consumer's perception of the mark, so as to alter its distinctive character from the form in which it was registered. Although further relatively minute differences (in relation to typeface) are noticeable when that mark is compared with the marks as registered, this use is acceptable for the reasons explained in the *Dreamersclub* case.
34. Where the mark is used on a black or coloured background (with the word element unaltered, apart from its typeface), I find that these retain the distinctive character of the mark/s as registered. They therefore constitute acceptable use under the principles set out in *Nirvana*.
35. In considering variations of the marks appearing as SKNB, SK86 and SK8Y6, I find that the omission and/or replacement of letters from the registered mark/s (with the addition of numbers) amount to more than mere variations of the mark/s in the form/s as registered. These variations are significant deviations which alter the distinctive character of the mark/s. I find that these are unacceptable variations of the respective registered forms; and have therefore duly discounted them in my determination on genuine use.

Sufficient Use

36. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. My assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.¹¹

37. On the question of sufficiency of use, I consider that the proprietor’s case rests upon the evidence of the selection of invoices and turnover figures. On Mr Neu’s evidence, annual turnover of goods under the marks at issue has been relatively constant, albeit modest, throughout the relevant period. Following on from this, I find that the case for continuous levels of sales is supported by the selection of invoices, which show sales throughout the relevant period, for various quantities of low-priced goods to commercial customers in the UK. Bearing in mind the principle that weak evidence in relation to one relevant factor can be offset by solid evidence in relation to another factor, I accept that the relatively low annual turnover is reasonably counterbalanced by the low prices of the items and the continuous frequency of use, over the contested five-year period. Taking the evidence as a whole, I am satisfied that there have been sales which, while modest, are of a level sufficient to constitute genuine use.

38. On the additional evidence adduced to show genuine use in the form of catalogue samples, I found certain deficiencies. I agree with the applicant that it is difficult to consistently match invoice product codes against product in the sample catalogue evidence. For example, invoice dated 24 August 2019 (at page 120 of FN2) shows the sale of item number 085450 (in black, in four different sizes). This is cross-referenced against the 2019 Spring/Summer catalogue (at page 7 of FN3), which shows this product code as: “085450 padded triangle | Triangel gepaddet”; and that that said item can be found at page 87 of said catalogue. However, page 87 of that catalogue has not been exhibited. Having said that, I do not agree that it is

¹¹ See para. 6, page 11 hereinabove.

“not possible to determine with accuracy what category the products listed on the invoices fall under (the written descriptions being inadequate or vague) and whether, indeed, the Contested Mark is affixed to those goods”.

39. I must make clear, given the applicant’s latter point, that it is not necessary for the mark to be affixed to the goods themselves.¹² It is sufficient, provided there is a legitimate connection between the mark and the goods, for the mark to be used ‘in relation to’ the goods or services; such as on invoices and in catalogues. Further, I found that it is possible to categorise the products from the information given on the selection of invoices, as well as the descriptions in the (sample) catalogue evidence. The information provided on the selection of invoices, moreover, makes it possible to rule out token use for the sole purpose of preserving the rights conferred by the marks.

40. When considered as a totality, the evidence clearly demonstrates that in the relevant period, Bodycare Co, with the proprietor’s consent, made use of the marks SKINY presented as registered and in acceptable variant form in relation to some of the goods detailed in the respective class 25 specifications. Having identified that the trade marks have been used in relation to some of the goods in question, I must now go on and determine what constitutes fair specification.

Fair Specification

41. 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

¹² *Ludwig Schokolade v OHMI - Immergut (TrinkFix)* T-105/13. In fact, in order to establish genuine use within the meaning of Article 42(2) and (3) of Regulation No 207/2009, it is sufficient to demonstrate that the mark was used in a manner enabling the target public to see in the use of the mark an indication that the product comes from a specific undertaking.... Consequently, there is nothing to prevent OHIM from taking into account uses considered to be justified in the economic sector concerned in order to maintain or create market shares for the benefit of the goods or services protected by the mark, even if those do not involve the physical affixing of the mark on the products in question or on their packaging (para. 29).

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."

42. In *Polfarmex S.A. v EUIPO*, Case T-677/19, EU:T:2020:424, the General Court said:

“116. As regards the question whether goods are part of a coherent subcategory which is capable of being viewed independently, it is apparent from the case-law that, since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product or service at issue is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services (judgments of 13 February 2007, *RESPICUR*, T-256/04, EU:T:2007:46, paragraph 29, and of 16 May 2013, *Aleris v OHIM – Carefusion 303 (ALARIS)*, T-353/12, not published, EU:T:2013:257, paragraph 22). In contrast, the nature of the goods at issue and their characteristics are not, as such, relevant to the definition of subcategories of goods or services (see judgment of 18 October 2016, *August Storck v EUIPO – Chiquita Brands (Fruitfuls)*, T-367/14, not published, EU:T:2016:615, paragraph 32 and the case-law cited).”

43. The proprietor submits that it has made genuine use of the marks for all of the respective class 25 specifications; and puts forward a fallback position to limit the specifications, with the exception of IR 682040, in the event that use has not been established for every type of good listed (under UK Registration 1436894, and IR 1042842) as follows:

(a) UK Registration No. 1436894  covering, shirts, vests, blouses, stockings, articles of under clothing, night-wear, dressing gowns, bathing suits, swimming trunks; all included in Class 25.”


(b) IR Registration No. 1042842 SKINY covers “footwear, socks, stockings, bras, lingerie, underwear”.

44. The applicant similarly submits that “there is no evidence demonstrating that the Contested Marks have been used on waistcoats, shirts, collars, cuffs, bathing caps, headgear, footwear or socks”. I agree with these submissions.
45. The invoices do not make reference to waistcoats, collars, cuffs, bathing caps, headgear, footwear or socks. Therefore, there is inadequate evidence relating to any of these items. As far as the term “shirts” is concerned, I consider this to be too broad a term in light of the evidence provided by the proprietor; from which genuine use can realistically be taken to fall within two subcategories only. The invoice evidence shows that actual use in relation to shirts would be fairly described by the average consumer as shirts appurtenant to sleepwear and loungewear. It is therefore unreasonable to allow that mark to retain the extensive protection granted under the registered (broad) term “shirts”.
46. I also find that there is no evidence to establish genuine use in relation to stockings; none of the invoices make specific reference to any type of stockings. However, the invoices do indicate that there was an acceptable volume of sales in relation to leggings during the relevant period.
47. When considering use in relation to swimwear, I find that the only reference to swimwear (in the invoice evidence) relates to the sale of tunics, which are categorised as “Swimwear Accessories Women”. I also noted the use of the marks on swimming trunks, as displayed in the sample catalogue evidence; however, in the absence of sales of these items, I conclude that the evidence is insufficient to demonstrate genuine use of the marks in relation to any type of swimwear.
48. “Clothing” (as per the IR 682040 specification), covers a very wide spectrum of different sorts of garments. Whereas (in general terms), the evidence shows use of the marks in relation to an array of apparel, which, for the most part, can fairly be described as undergarments, sleepwear and to a lesser extent, loungewear. In light of my finding that use has been established in relation to only these core groups of garments, I do not consider clothing to be a fair specification.

49. Having applied the above guidance to the totality of the evidence provided, I am satisfied that the following represent fair specifications:

Number	WO0000000682040
Mark	SKINY
Classes and Terms	Class 25: Underwear; leggings.

Number	WO0000001042842
Mark	SKINY
Classes and Terms	Class: 25: Bras, lingerie, underwear.

Number	UK00001436894
Mark	
Class and Terms	Class: 25: Shirts (being sleepwear and loungewear), vests, leggings, articles of under clothing, night-wear, dressing gowns.

Conclusion

50. The trade marks will be partially revoked, with an effective date of 31 October 2019. They remain registered for the goods in the preceding paragraph.

Costs

51. Although both parties have achieved a measure of success, the applicant has been more successful than the proprietor. The proprietor's notices of defence were made in respect of all of the goods, including those in class 3. It was not until the end of the proceedings that it admitted there had been no use in relation to the class 3 goods. Bearing in mind the proportion of success for the registered proprietor, and that there were economies as a result of consolidation, I award costs to the applicant as follows:

Preparing a statement and considering the registered proprietor's statements x 3	£400
Official fee x 3	£400
Considering evidence	£500
Written submissions in lieu of a hearing	£200
Total	£1500

51. I order Huber Holding AG to pay to Solomon and Silver Limited the sum of **£1500**.

This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of February 2021

Denzil Johnson
For the Registrar