

**O/667/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK REGISTRATION NO. UK00913573316**

**IN THE NAME OF  
IMOO INTERNATIONAL PTE. LTD**

**IN CLASSES 9, 14 AND 28**

**AND**

**AN APPLICATION FOR REVOCATION FOR  
NON-USE**

**THERE TO UNDER NO. CA000503839**

## Background and pleadings

1. On 10 May 2021, IMO Precision Controls Limited (“the cancellation applicant”) filed an application to revoke IMOO INTERNATIONAL PTE. LTD’s (“the registered proprietor”) earlier mark on grounds of non-use. The application for revocation is directed against all of the registered proprietor’s goods. Details of the registered proprietor’s mark are below.
2. Trade mark number UK00913573316, filed on 15 December 2014 and registered on 20 April 2015.

# IMOO

- Class 9      tablet computers; downloadable electronic publications; computer peripheral devices; computer programs [downloadable software]; electronic agendas; dictation machines; mobile telephones; portable media players; portable communications apparatus; battery chargers for use with telephones; electronic book readers; electronic language learning devices; cameras; measuring instruments; integrated circuits; remote control apparatus; spectacles; batteries; animated cartoons.
- Class 14     precious metals, unwrought or semi-wrought; jewelry boxes; jewelry chains; jewelry ornaments; watches; watch chains; watch bands; key rings [trinkets or fobs]; clocks; bracelets [jewelry].
- Class 28     apparatus for games; video game machines; toys; building blocks [toys]; board games; balls for sports; sports training apparatus; protective paddings [parts of sports suits]; christmas trees of synthetic material; fishing tackle.

3. The cancellation applicant seeks revocation of the contested mark under section 46(1)(a) and/or (b) of the Trade Marks Act 1994 (“the Act”).
4. Revocation is sought under section 46(1)(a) as a result of alleged non-use during the 5-year time period immediately following the date of completion of the registration procedure i.e. 21 April 2015 to 20 April 2020. On this basis, the cancellation applicant requests revocation of the contested mark with effect from 21 April 2020.
5. Alternatively, revocation is sought under section 46(1)(b) as a result of alleged non-use for the following 5-year periods:
  - a) From 20 August 2015 to 19 August 2020, with effect from 20 August 2020.
  - b) From 20 December 2015 to 19 December 2020, with effect from 20 December 2020.
  - c) From 10 May 2016 to 9 May 2021, with effect from 10 May 2021.
6. The registered proprietor filed a counterstatement denying the claims made by the applicant in respect of the following goods and services:  
  
Class 9     tablet computers; downloadable electronic publications; computer peripheral devices; computer programs [downloadable software]; mobile telephones; portable media players; portable communications apparatus; battery chargers for use with telephones; electronic book readers; electronic language learning devices; spectacles; batteries; animated cartoons.  
  
Class 14    watches; watch chains; watch bands.

Class 28 apparatus for games; video game machines; toys.

7. The cancellation applicant is represented by Dechert LLP and the registered proprietor is represented by Sipara Limited.
8. Both parties filed written submissions in lieu of a hearing which I have carefully considered.

### **Evidence**

9. The registered proprietor filed a witness statement from Xie Qidong, the registered proprietor's Account Manager, signed and dated 17 September 2021. Xie Qidong has been employed by the registered proprietor since 1 September 2020.
10. In the witness statement, Xie Qidong explains that the contested mark was assigned to the registered proprietor on 6 January 2021 from Guangdong Genius Technology Co., Ltd. This change of ownership is recorded on the IPO database on 14 September 2021, with an effective date of 6 January 2021.
11. Xie Qidong's witness statement is accompanied by Exhibits XQ1 to XQ11. Pages 97 to 101 of Exhibit XQ4 were also supplied translated into English as pages 97A to 101A.

### **The law in relation to revocation and genuine use**

12. Section 46 of the Act states that:

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

- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to

genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

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

(c)...

(d)...

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (“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 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.

[...]

(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.”

13. Section 100 of the Act is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

14. Although the UK has left the EU, section 6(3)(a) of the European Union (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 these proceedings continue to make reference to the trade mark case-law of EU courts.

15. In *Walton International Ltd & Anor v Verweij Fashion BV*, Arnold J. summarised the case law on genuine use of trade marks as follows:<sup>1</sup>

“114.....The CJEU [Court of Justice of the European Union] has considered what amounts to “genuine use” of a trade mark

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<sup>1</sup> [2018] EWHC 1608 (Ch)

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

115. The principles established by these cases may be summarized 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].”

16. In *Awareness Limited v Plymouth City Council*<sup>2</sup>, Mr Daniel Alexander, QC, sitting as the Appointed Person, observed that 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”.

17. It should be noted that the contested mark is a “comparable mark”. As such, Tribunal Practice Notice 2 of 2020 applies in that: “Where all or part of the relevant five-year period for genuine use under sections ... 46(1)(a) or (b), or 47 falls before IP Completion Day [31 December 2020], evidence of use of the corresponding EUTM in the EU in that part of the relevant period

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<sup>2</sup> Case BL O/236/13

before IP Completion day will be taken into account in determining whether there has been genuine use of the comparable trade mark. For that part of the relevant period, for the purposes of the genuine use assessment, the UK will be taken to include the EU.”

18. The period of non-use claimed under section 46(1)(a) is 21 April 2015 to 20 April 2020 (“relevant period one”). The periods of non-use claimed under section 46(1)(b) are as follows: From 20 August 2015 to 19 August 2020 (“relevant period two”), from 20 December 2015 to 19 December 2020 (“relevant period three”), and from 10 May 2016 to 9 May 2021 (“relevant period four”).
19. Because relevant period four runs up until the day before the cancellation application, section 46(3) of the Act is not engaged in this instance.

#### Form of the mark

20. Strictly speaking, the mark as registered is listed as a figurative mark, albeit it consists of the word “IMOO” in black block capitals on a white background.
21. In the evidence, the mark takes a variety of forms. It features as the plain word “imoo” or “Imoo”. It is also shown as the word “imoo” in very slightly stylised orange text. The mark is also presented as the same text in white, inside an orange box, or an orange circle.
22. Although the registered proprietor’s mark is technically a figurative one, the word “IMOO” is the overwhelmingly dominant and distinctive element of the mark. I consider that, in respect of the difference between the word element as registered, “IMOO”, and as used, the plain words “imoo” and “Imoo” and the slightly stylised version of “imoo”, I can be guided by the case law which says that use in different scripts (fonts or typefaces)<sup>3</sup> constitutes acceptable

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<sup>3</sup> Case T-364/04 *Sadas SA v. OHIM*

variance. Where the word appears in an orange box or an orange circle, as opposed to the as-registered white box, the colour and shape variances do not alter the distinctive character of the mark

23. For the registered proprietor's app, the slightly stylised "imoo" has the addition of telephone handset speech bubble icons. In this regard, I am mindful of *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 Court of Justice of the European Union found that (with my emphasis added):

"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 *Nestlé*, 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 by 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)".

24. When the word element of the mark is used in conjunction with the telephone handset and speech bubble icons, the mark continues to be perceived as indicative of the origin of its products. The icons allude to the telephone functionality of the registered proprietor's app – telephone connectivity with the registered proprietor's smart watch – and do not detract from the distinctive character of the mark.

25. Given the above, I consider that the mark is shown in use in acceptable variant forms.

### Sufficient use

26. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>4</sup>

27. In looking at the evidence, the four relevant periods in which use must be shown range from 21 April 2015 to 9 May 2021. Insofar as the evidence may show use in respect of goods during the most recent five-year period

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<sup>4</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

(relevant period four), the cancellation application will fail to that extent. It is also clear that the evidence of use in the EU and UK focuses on the later range of the dates. Since the contested mark is a comparable mark, I can take account of evidence of use in the EU up to and including IP Completion Day (31 December 2020).

28. Exhibit XQ1 consists of pages from imoostore.com setting out the history of the “Hybrid Smartphone and Wristwatch for Kids” beginning with the launch in June 2015 of the imoo smartwatch and then listing the development of various features of the watch. This exhibit does not show marketing of the goods being directed at the EU or UK, nor is such marketing indicated in the Xie Qidong’s witness statement.

29. Exhibit XQ2 shows extracts from imoostore.com sub-domains uk.imoostore.com and eu.imoostore.com. These extracts date from after the cancellation application was made. However, on uk.imoostore.com, there are reviews that are shown that are in-date which include references to the registered proprietor’s watches (which are shown as being sold with a charger) and its app. There are reviews from the following dates (where the number in brackets refers to those reviews that mention the registered proprietor’s app):

28 December and 4 January 2020, and 17 January (1), 10 February, and 14 March 2021.

30. An “imoo Ear-care Headset” is shown as currently available free of charge when you buy two watches and is also for sale separately, but the reviews make no mention of the headset. As such, it is not clear from the exhibit that a headset was available on the market during the relevant period.

31. On eu.imoostore.com, the majority of the reviews shown are admissible in that they fall within the relevant period and are dated on or before IP Completion Day. The reviews refer to the watch and the app. There are

smart watch reviews (with mentions of the registered proprietor's app in brackets) for the following dates:

17 November, 28 November, 9 December, 11 December x 3, 15 December x 7 (1), 16 December x 3, 18 December, 19 December, 25 December, 27 December, and 30 December 2020.

32. A charger and watch strap are currently shown for sale separately, but the evidence post-dates the cancellation application and these items are not referred to in the in-date reviews.
33. While Exhibit XQ3 post-dates the cancellation application in setting out the registered proprietor's website shipping policy to include shipping to the United Kingdom, the .uk domain evidence in Exhibit XQ2 shows that products were shipped to the UK during the relevant period.
34. Exhibit XQ4 includes pages from amazon.co.uk with imoo watches and its headset available for sale. Although these pages date from after the cancellation application was made, there are numerous reviews, most of which are in-date, which mention the watches and the charger that comes with them, as well as the app. All the reviews are headed "Reviewed in the United Kingdom". The reviews (with mentions of the app in brackets) are for the following dates:

19 March, 22 March x 2, 23 March, 24 March x 2 (2), 27 March, 28 March x 4 (3), 29 March x 2, 30 March x 2 (2), 31 March x 3, 3 April x 2 (1), 4 April, 5 April x 2, 6 April (1), 7 April, 8 April x 3 (1), 9 April x 2 (1), 12 April x 2 (1), 13 April, 14 April (1), 15 April x 2 (1), 18 April x 2, 19 April x 2, 20 April, 21 April, 24 April, 25 April, 26 April (1) 28 April (1), 29 April, 30 April , 1 May, 2 May 2021, 5 May, 6 May, 8 May and 9 May 2021.

35. Of the above 54 reviews, 22 are marked "Vine Customer Review of Free Product". While this means that the products were free of charge in these instances, this evidence can be seen as part of the registered proprietor's

efforts to create a market for its smart watches in the United Kingdom in that that such reviews on amazon.co.uk could generate sales.

36. The headset is not referenced in the reviews and the separate page offered in evidence from amazon.com featuring it as being able to be shipped to the UK post-dates the cancellation application.
37. Exhibit XQ4 also has a few pages from fnac.com/es, the Spanish website of a French retail chain, which have been officially translated into English. However, these pages post-date the cancellation application and do not assist the registered proprietor.
38. Taking all 80 of the admissible reviews into account that are referenced in relation to Exhibits XQ2 and XQ4, there are 19 mentions of the app, which indicates that it was available for free download to UK and EU consumers during the relevant period.
39. Xie Qidong’s witness statement at paragraph 7 details the following in terms of sales of IMOO smartwatches (“which include the smartwatch device, watch straps and a charger for the device”):

UK sales

Total units: 697

<b>Year</b>	<b>2020</b>	<b>January–July 2021</b>
<b>Approximate Sales Totals (£)</b>	£46,250	£21,500
<b>Total</b>	£67,750	

EU sales

Total units: 1202

<b>Year</b>	<b>2020</b>	<b>January-July 2021</b>
<b>Approximate Sales Totals (£)</b>	£128,850	£76,545
<b>Total</b>	£205,395	

40. From this evidence, in respect of the UK sales in 2021, I cannot be sure of the extent to which these sales may have been made in the ten weeks or so between the date of the cancellation application and the end of July. This is because the information is not broken down further in Xie Qidong's witness statement. (I note, however, that a number of reviews and an invoice elsewhere in the evidence show that at least some UK sales in 2021 were made within relevant period four.)
41. I cannot include the 2021 EU sales in my assessment. This means that there are £128,850 of relevant EU sales. If I take the above data and assume a standard price per unit, the number of units sold in the EU that I can take into account is approximately 754 ( $1202 \times 128,850/205,395$ ). Alternatively, the price of the smart watch on the invoices supplied in evidence is 219 euros which equates to £183.13, equating to approximately 703 units.
42. Exhibit XQ5 consists of 13 sample invoices, all of which fall within the relevant period. 12 are for addresses in the EU and date from 2020, before IP Completion Day: 9 are for Ireland and 1 each for Czechia, Hungary and Croatia. The other invoice is a UK one, dated 28 April 2021, to an address in Glasgow. All of the invoices are for smartwatches. This is an extremely small sample of invoices, and therefore evidence of the geographical distribution of the registered proprietor's products is minimal, albeit the invoices do show that the registered proprietor's smart watches were sold into the EU and the UK within the period under consideration.
43. Exhibit XQ6 contains extracts from app websites – the Apple AppStore and Google Play, both with the top-level domain suffix of .com. The extracts



contain references to the imoo Watch Phone app and reviews thereof. The AppStore extract contains four reviews, all in date. The Google Play extract has numerous reviews, all in date. The reviews do not include the geographical location of the reviewer. They simply show the reviewer's user name and an icon/photograph. While the overwhelming majority of reviews are in English, English is spoken widely outside the UK and the EU, so this makes it difficult to definitively say that a proportion of the reviewers are from the UK or the EU (although I note that UK and EU consumers are able to access the Apple AppStore and Google Play .com sites).

44. Exhibit XQ6 also features pages from the AppAnnie.com website. The pages feature a digest of App Store data, including characteristics of the imoo Watch Phone app and information about its performance. While the extract was created after the date on which the cancellation application was made, it shows a timeline for the sequential release of versions of the app, including dates which fall within the relevant time period. Xie Qidong's witness statement at paragraph 9 also confirms that the app was first launched in 2016 and has been continuously updated. Nevertheless, there is nothing in this exhibit or this witness statement that shows the app being specifically made available to UK or EU consumers and so this limits the evidential value.
45. There are no figures provided as to marketing expenditure, but a number of exhibits relating to marketing have been submitted.
46. Exhibit XQ7, produced after the cancellation application, consists of blogs from imoostore.com and eu.imoostore.com. The registered proprietor considers the blogs to be promotional activity as they detail the features and benefits of its smart watch that would be attractive to potential consumers, albeit they would need to find their way to the registered proprietor's website to see this material. In respect of the blogs on imoostore.com, although in-date, there is nothing on these web pages which indicates targeting of UK consumers. The blogs on eu.imoostore.com date from after IP Completion Day. Consequently, Exhibit XQ7 is of minimal evidential value.

47. Exhibit XQ8 covers the registered proprietor's Facebook, Instagram and YouTube presence and paragraph 10 of Xie Qidong's witness statement details the following:
- over 15,100 likes and over 15,400 followers on Facebook.
  - over 3,800 followers on Instagram.
  - over 5,200 subscribers on YouTube.
48. The above details are not segmented by market, so it is not known how many of the followers/subscribers are from the UK or the EU. However, there are a number of in-date Facebook posts in the exhibit and a number of YouTube GB pages which include videos that were uploaded in-date.
49. Exhibit XQ9 relates to market share information and references to the registered proprietor's brand in the years 2018-2021. Globally, the information in this exhibit is indicative of a significant market share of the smartwatch market, but there is no data as to the UK or EU market share. Consequently, this exhibit does not assist the registered proprietor.
50. Exhibit XQ10 consists of various photos of the mark (or acceptable variants thereof) on products and packaging. The photos are undated and there is no information as to which market the products were intended to be sold into. Xie Qidong's witness statement sheds no further light on this exhibit and so it does not assist the registered proprietor.
51. Exhibit XQ11 is a still from a promotional cartoon of a bunny with the mark in the top left-hand corner. Again, there is no date and no information as to the target market and again Xie Qidong's witness statement sheds no further light on this exhibit and so it does not assist the registered proprietor.
52. Looking in the round at the evidence supplied by the registered proprietor, it clearly has its limitations. It is apparent that its products were only launched into the relevant EU and UK markets in 2020. The only evidence of

marketing activity is in the form of blogs on its own website and social media posts. The market share information provided is not broken down to the UK or EU level. There is, however, solid evidence of sales during 2020 which continue into the relevant part of 2021.

53. I have taken account of the headline sales in terms of the amount of money and number of units and that they arise well into the relevant periods. While I recognise that they are small in the context of the smart watch market, they are not self-evidently tokenistic.
54. While not all of the 2021 UK sales are proven to be within the relevant period, there are corroborating reviews which point to at least a proportion of those sales taking place then. The reviews are of assistance in showing that the registered proprietor's smart watches were bought from its targeted website domains and via amazon.co.uk during that time.
55. The reviews also demonstrate that the registered proprietor's app was available to the EU and UK publics during the relevant period.
56. I regard the use shown to be more than merely token. The evidence shows continuing use of the mark beyond the point of the cancellation application and there is a pattern in the registered proprietor's trade in smart watches in the EU and the UK which denotes real commercial exploitation of the mark on the market for the relevant goods and use in accordance with the commercial *raison d'être* of the mark, which is to create an outlet for the goods that bear the mark. As such, I do not believe that the registered proprietor has engaged in the documented commercial activity merely to preserve the rights conferred by the registration of the mark.
57. Taken in the round, and conscious of the fact that the evidence presented is sufficient rather than overwhelming, I consider that it shows proof of genuine use of the mark in relevant period four i.e. the most recent 5-year period from 10 May 2016 to 9 May 2021.

## Fair specification

58. I must now consider whether, or the extent to which, the evidence shows use of the mark in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“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.”

59. 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."

60. Having reviewed the evidence, I am satisfied that use of the mark within the relevant time period has been established for smart watches.

61. The cancellation applicant points out that the Nice Classification places "smartwatches" in Class 9. However, the registered proprietor has no Class 9 term that neatly encompasses smart watches. They do, however, have "watches" in Class 14 and I am conscious of *Apple Inc v Arcadia Trading Ltd* [2017] EWHC 440 (Ch) where Arnold J (as he was then) supported the proposition that smart watches – as goods that are multipurpose products – are proper to Class 14 as well as to Class 9.

62. The evidence also shows use of the mark for chargers, albeit only as an item that is included in the box for the purpose of charging the registered proprietor's smart watch.
63. Use is also demonstrated for apps, but solely for an app that exists as an adjunct to the registered proprietor's smart watch, allowing a smart phone to be "paired" with the smart watch.
64. There was very limited evidence of watch straps being offered for sale separately (three screenshots), as opposed to them being an integral part of the smart watches being sold. This was undated evidence from the registered proprietor's EU sub-domain, downloaded/printed off after the cancellation application, with nothing to say that watch straps were offered for sale prior to IP Completion Day. Consequently, the registered proprietor cannot retain "watch bands".
65. The application for revocation on the grounds of non-use has been partially successful. The specification is to be limited to read as:

Class 9     Battery chargers for use with smart watches; computer programs [downloadable software] for use with smart watches.

Class 14    Smart watches.

66. Where I could find no evidence of use of particular goods during the most recent relevant 5-year period, this absence of evidence also applies to the earlier relevant 5-year periods, with the consequence that the registered proprietor's registration for the mark will be revoked, save for the goods mentioned above, with effect from 21 April 2020. It is of course also the case that the registered proprietor defended the non-use claim only in respect of some of its registered goods.

## CONCLUSION

67. The application for revocation on grounds of non-use against the registered proprietor's registration No. UK00913573316 has been partially successful. The registered proprietor's mark will be revoked, save for the goods listed in paragraph 65 above.

## COSTS

68. The cancellation applicant has had a significant degree of success in limiting the registered proprietor's specification, albeit the registered proprietor has retained some terms which give its mark protection in relation to its core business.

69. I award proportionate costs to the cancellation applicant in line with Annex A of Tribunal Practice Notice 2 of 2016, detailed below.

Preparing a statement/considering the other side's statement:	£200
Considering and commenting on the other side's evidence:	£750
Preparation of submissions:	£300
Official fees:	£200
<b>Total:</b>	<b>£1450</b>

70. I order IMOO INTERNATIONAL PTE. LTD to pay IMO Precision Controls Limited £1450. 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 8<sup>th</sup> day of August 2022**

**JOHN WILLIAMS**

**For the Registrar**