

O-214-15

TRADE MARKS ACT 1994

**CONSOLIDATED APPLICATIONS 84341, 84342, 84343, 84379,
84380, 84382, 500268, 500269 & 500270**

BY LAMBRETTA S.r.l. , HERITAGE LICENSING S.A. & GLOBALOCITY BV

TO REVOKE TRADE MARKS 2122788, 2107935 & 2134922

FOR THE WORD MARK 'LAMBRETTA'

IN THE NAME OF SCOOTERS INDIA LIMITED

FOR NON-USE

Final decision

1. On 6 March 2015, I issued a provisional decision on behalf of the Registrar of Trade Marks in these consolidated revocation proceedings between Lambretta S.R.L., Heritage Licensing S.A. & Globalocity BV (“the applicants”) and Scooters India Limited (“Scooters”) in which I found that:

- Scooters had shown genuine use of LAMBRETTA in the UK in relation to clothing, namely jackets, knitwear, sweatshirts, shorts, shirts, polo shirts, T-shirts, jeans, scarves, socks and shoes, during the 5 year periods relevant for the purposes of s.46(1)(b).
- No genuine use of the mark has been shown in the UK in relation to watches.
- Trade mark registration 2107935 should therefore remain registered for ‘clothing, all for leisurewear, but not including underwear; footwear’ in class 25.
- Trade mark registration 2122788 in class 14 should be revoked for non-use under s.46(1)(b).
- Trade mark registration 2134922 should be revoked for non-use under s.46(1)(b) in relation to ‘watches and parts and fittings for watches’, but should remain registered in class 25 for ‘clothing, but not including underwear; footwear’.
- Having regard to the mixed outcome of the proceedings, I would direct that each side should bear its own costs.

2. There was an outstanding issue; namely, what to do about Scooter’s belated objection that Lambretta’s applications for revocation under s.46(1)(a) of the Act were *res judicata* following an earlier final decision in revocation proceedings between Scooters and Brandconcern BV¹. However, as I found that this could only affect the date of revocation of trade mark 2122788, and the date of partial revocation of trade mark 2134922 in relation to watches, I thought it possible that Lambretta would not pursue the applications under s.46(1)(a) and the question of whether the applications were *res judicata* in that respect would become academic.

¹ It is submitted that Lambretta is a privy of Brandconcern.

I therefore directed that:

- Lambretta should indicate within 21 days of the date of the provisional decision if it wished to pursue its applications under s.46(1)(a) in relation to watches.
- If it did, I would issue a final decision covering the applications under s.46(1)(b), including costs, and exercise the registrar's power under Rule 62(1)(h) to direct that the proceedings under s.46(1)(a) should continue as separate proceedings. In that event, I would direct what evidence was required and set a timetable for filing it.
- If either party objected to that course they should say so in writing within the same period, and explain why.
- If no request was made by Lambretta within the period specified above to pursue the applications under s.46(1)(a), I would issue a final decision as per paragraphs 63 – 68 of the provisional decision leaving undecided Lambretta's applications for revocation of the marks under s.46(1)(a).

3. I subsequently received a letter dated 11 March from Swindell & Pearson, the applicants' representative, which suggested that the applicants had not been given an opportunity to make submissions on appropriate specifications of goods in class 25 for trade marks 2107935 and 2134922 which reflected my findings of fact as to the actual clothing and footwear items in relation to which the marks had been put to genuine use. It was therefore submitted that I should now give the parties an opportunity to make such submissions.

4. I replied drawing the applicants' representatives' attention to a submission made at the hearing on this point, but not developed. I therefore rejected the suggestion that the applicants had been denied the opportunity to make submissions on a specification which fairly reflected the use shown in the evidence. However, given that my provisional decision was not final, and the registrar was not therefore *functus officio*, I permitted the parties to make further written submissions on this matter.

5. I subsequently received written submissions filed on behalf of the applicants in which it was contended that, without prejudice to the applicants' right to argue on appeal that the marks should be wholly revoked, my findings of fact about the use made of trade marks 2107935 and 2134922 only justified the retention of those marks in respect of 'clothing, all for leisurewear, but not including underwear; shoes'.

6. No further submissions were received about Lambretta's applications under s.46(1)(a). I assume this to mean that the applications under s.46(1)(a) are no longer

pursued. They will therefore remain undecided as indicated in my provisional decision.

7. I received written submissions from counsel for Scooters to the effect that:

- The applicants' submission made no attempt to identify why my provisional judgment about the appropriate wording for the specifications in class 25 was in error.
- The use shown covers tops, bottoms, outer garments and accessories, appropriately described as 'clothing'.
- The use shown covered items, such as 'swim shorts' and 'track sweat jackets' that could be worn as 'sportswear' and other items, such as check or stripe long sleeve shirts, which could be worn as formal or office wear.
- Where the use shown covered a range of different types of clothing items and styles, a narrower classification than 'clothing' would not be fair.
- The applicants' submission gave no credit to my finding that there was use of the marks in relation to 'socks' as well as 'shoes'.
- Footwear is an appropriate term to describe these items.

8. My attention was drawn to the judgment of Birss J. in *Thomas Pink Ltd v Victoria's Secret UK Ltd*² in support of the point made in the fourth bullet above.

9. Since the date of my provisional decision, the Court of Appeal gave judgment in *Maier v ASOS*³. Kitchen L.J. described the relevant enquiry in a case like this as follows.

"64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in

² [2014] EWHC 2631 (Ch)

³ [2015] EWCA Civ 220

general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that 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 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. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

10. Despite the judge’s general preference for categories or sub-categories of goods/services over lists of precise goods/services, I note that Kitchen L.J. ultimately upheld the decision of the judge at first instance in that case to restrict the disputed part of the specification of goods to ‘track-suits, t-shirts, polo shirts, caps, jackets and shorts’ rather than casual wear at large. By contrast, Sales L.J. took the view that ‘casual wear’ was a more appropriate description. Underhill L.J. was uncomfortable with both descriptions as potentially too narrow or too wide, but could not identify a middle course and ultimately preferred L.J. Kitchen’s approach to that of L.J. Sales. Counsel for Scooters submitted that this case shows the essentially imprecise nature of the task at hand and urged me to maintain the judgment I made in my provisional decision.

11. I find that, with the exception of scarves and certain types of shirts which might be worn more formally, all of the clothing items for which the marks have been used are intended for use as leisurewear or sportswear. Permitting registration 2134922 to stand for clothing *per se* (other than underwear) would cover categories of formal clothing for which no use was shown. I find that ‘all for leisurewear or sportswear’ accurately describes all of the goods for which use is shown, except for scarves and shirts, the latter of which may be put to other uses.

12. As regards the applicant’s complaint that ‘footwear’ is too broad a description of shoes, on reflection I agree. As has been pointed out on behalf of Scooters, the use shown also includes socks, which are also footwear. However, it does not cover

boots or slippers, which are further sub-categories of footwear. I therefore find that 'shoes and socks' is an appropriate and fair description of the use shown.

13. Consequently, I find that:

- Registration 2134922 should be revoked with effect from 3 February 2012, except in relation to 'Clothing, all for leisurewear or sportswear; shirts; but not including underwear; scarves, socks and shoes'.
- Registration 2107935 should be revoked with effect from 3 February 2012, except in relation to 'Clothing, all for leisurewear, but not including underwear; socks and shoes' in class 25.
- Trade mark registration 2122788 in class 14 should be revoked with effect from 3 February 2012.

Costs

14. Scooters asks for a contribution towards the cost of making additional written submissions in this matter. It says that the applicants' post hearing submissions about the appropriate list of goods in class 25 could and should have been made at the hearing. I agree. Notwithstanding that I have changed my provisional decision in this respect as a result of submissions made on behalf of the applicants, I will therefore order the applicants to make a contribution towards the additional cost to Scooters of dealing with the belated submissions. This is because the actual goods in class 25 for which the marks might be found to have put to genuine use were clear from the evidence. There was no reason why the applicants could not make specific submissions at the hearing as to an appropriate specification in the alternative to its primary submission that no genuine use had been shown.

15. I therefore order Lambretta S.R.L., Heritage Licensing S.A. & Globalcity BV to pay the Scooters India Limited the sum of £300 towards the cost of making post hearing written submissions. Subject to appeal, this should be paid within 14 days of the end of the period allowed for appeal or, if there is an appeal, within 14 days of the conclusion of these proceedings.

Dated this 11th Day of May 2015

Allan James
For the registrar