Case Note

PARTIAL NON-USE CANCELLATION OF TRADE MARK REGISTRATIONS

Maier v ASOS plc [2015] EWHC 220

This note explores the UK, Singapore and European Union ("EU") case law on partial revocation of a registered trade mark for non-use in light of the recent UK decision of *Maier v ASOS plc* ("*Maier*"). It shows that the UK and Singapore courts have hitherto, in determining whether a trade mark is subject to partial revocation for non-use, adopted an approach based on the "fair description" of the actual evidence of use, with only secondary emphasis on the actual terms of the specification. Conversely, it shows that the EU courts' approach has been to analyse the precise terms of the specification, albeit from the perspective of the average consumer of the goods/services in question. It argues that, despite achieving similar outcomes, there is a certain tension between these dissimilar approaches that may be of particular concern to intellectual property professionals seeking to frame their clients' cases in the most advantageous way. It submits that the recent case of *Maier* marks a step forward by unifying the more technical approach of the European courts with the common-sense approach adopted by the UK courts, as well as providing the opportunity for a timely review of the applicable principles.

Paul **MCCLELLAND**
LLB (Hons), LLM (University of Glasgow);
Trademark Executive, Drew & Napier LLC.

I. Introduction and background

1 The monopoly over use of a trade mark conferred by the public registration of that mark is necessarily limited in order to safeguard various competing interests.[1] Broadly, the extent of monopoly over use of a trade mark conferred and the restrictions placed on it are similar

1 See *General Electric Co Ltd (USA) v General Electric Co Ltd* [1972] 1 WLR 729; [1972] 2 All ER 507, *per* Lord Diplock.

worldwide.[2] Most, if not all, trade mark systems will not allow for registration of a descriptive mark;[3] other traders may need to use such a mark. Generally, registration will not be permitted where the mark may be misleading or deceptive;[4] misleading trade marks should not be afforded legal protection, and so forth. Perhaps more subtle, however, is the public interest in ensuring that the owner of a trade mark actually use the marks for which registration is sought. Put simply, if the marks are not used, a precious economic resource, which may be put to better use elsewhere, is unfairly trapped.[5]

2 In many jurisdictions, trade mark laws have been set out in similar ways in order to reflect these concerns. At the most basic level, the rights holders' interest is balanced against competing interests by limiting the sphere of the monopoly granted to the owner of a registered mark, which only extends to use of the mark in relation to certain goods/services. Further, to properly delineate the right which is to be conferred, applicants seeking registration of their mark are required to define the goods/services for which they intend to use (or have used) the mark in terms of certain very precise (if somewhat arbitrary) categories, agreed by an international group of taxonomists, that is, the Nice classification system.[6] "North Pole" for "bananas" seems to be the standard example for reasons unknown.[7] Despite unauthorised use of an identical or similar mark, there will be no case for infringement where competing use of the mark is made in relation to dissimilar goods or services:[8] for example, "North Pole" for "aircraft". Further, unless the mark *and* goods/services are identical, there must be similarity to such an extent that is likely to confuse the public.[9] In other words, traders are

2 Strengthened by the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), which is intended to create a "minimum level of trademark law" in each of the signatory jurisdictions (Peter Yu, *Intellectual Property and Information Wealth: Trademark and Unfair Competition Law* vol 3 (USA: Praeger Publishers, 2007) at p 311), as well as various other multinational treaties, protocols and agreements.

3 Trade Marks Act 1994 (c 26) (UK) s 3(1); Trade Marks Act (Cap 332, 2005 Rev Ed) s 7(1).

4 Trade Marks Act 1994 (c 26) (UK) s 3(3); Trade Marks Act (Cap 332, 2005 Rev Ed) s 7(4).

5 See comments of Jacob J in *Laboratoire de la Mer Trade Marks* [2002] FSR 790.

6 Trade Marks Act 1994 (c 26) (UK) ss 32(2)(c) and 34; Trade Marks Act (Cap 332, 2005 Rev Ed) ss 5(1)(*d*) and 6.

7 The example seems to have originated in *Bailey v Clark* (1938) 55 RPC 253, *per* Lord Maugham.

8 On the basis of identity/similarity of the goods and identity/similarity of the goods/services, and the likelihood of confusion thereby arising. There may be claims under other grounds: *cf* s 10(3) of the UK Trade Marks Act 1994 (c 26) and s 27(3) of the Trade Marks Act (Cap 332, 2005 Rev Ed).

9 See David Keeling *et al*, *Kerly's Law of Trade Marks and Trade Names* (London: Sweet & Maxwell, 15th Ed, 2011) at paras 14-081–14-093.

free to use "North Pole" for any other business opportunity sufficiently dissimilar from bananas, thereby alleviating some of the public interest concerns in allowing one individual or entity a monopoly over use of the mark (and marks which are confusingly similar).

3 The requirement that an applicant for registration of a trade mark specify the goods for which the trade mark is sought is, however, open to abuse by selection of an unnecessarily wide description in an attempt to secure the broadest protection.[10] As such, trade mark laws generally require the applicant to have already used the mark, or to state that there is a genuine intention to use the mark, for the goods registered.[11] However, even if there is genuine intent, the Registrar cannot be certain at the point of registration that use will in fact result. Most trade mark laws allow for a period during which no non-use cancellation proceedings can be brought against the mark.[12] After such a period, if there has been no genuine use made of the mark, the law reflects the public interest by making the registration vulnerable to challenge in order to make way for others.

4 For the most part, this is a question of fact, that is, whether the registrant has actually "used" the mark, given the definition of use in the context of the relevant legislation. However, the UK, EU and Singapore courts have significantly developed the concept of "use" of a mark. Generally, the approaches require that the "use" is (*inter alia*) genuine, non-trivial, consistent with the essential function of a trade mark and for the purposes of commercial exploitation.[13] If the owner cannot show that the marks have been used in the manner described, "proper

---

10 David Keeling *et al*, *Kerly's Law of Trade Marks and Trade Names* (London: Sweet & Maxwell, 15th Ed, 2011) at paras 10-095–10-097, suggests that "over-wide" specifications stem from three sources, which may broadly be summarised as: ingrained practice, registration procedure and non-use. In relation to this last item, it is questioned whether non-use is a source, *per se*, of overly wide specifications, rather than a symptom.

11 Trade Marks Act 1994 (c 26) (UK) s 32(3); Trade Marks Act (Cap 332, 2005 Rev Ed) s 5(1)(*e*).

12 Section 46 of the UK Trade Marks Act 1994 (c 26) and s 22 of the Singapore Trade Marks Act (Cap 332, 2005 Rev Ed) both allow for the period of five years from the date of completion of the registration procedure.

13 See *Ansul BV v Ajax Brandbeveilging BV* [2003] RPC 40; *Euromarket Designs Inc v Peterson* [2000] All ER (D) 1050; and *Glaxo Group v Dowelhurst Ltd (No 2)* [2000] FSR 529. The concepts and principles developed by the various courts to determine whether there has been "use" of a trade mark are outside the scope of this case note, which generally assumes that there has been "use" of the mark for at least some of the goods/services claimed in the specification. For further information, see, *eg*, David Keeling *et al*, *Kerly's Law of Trade Marks and Trade Names* (London: Sweet & Maxwell, 15th Ed, 2011) ch 9 and Tan Tee Jim & Ng-Loy Wee Loon, "Intellectual Property Law" (2003) 4 SAL Ann Rev 323 at 328–335, paras 16.28–16.47.

reasons" must be given in order to maintain the registration.[14] The above criteria ensure, *inter alia*, that the owner of a trade mark cannot claim use of the mark based on a technicality.

5 Provided that the specification is of "sufficient clarity and precision to enable the competent authorities and economic operators … to determine the extent of the protection sought",[15] the UK, Singapore and EU trade mark systems generally allow for the applicant to register their mark in respect of any and all items found in a single Nice class. All three systems also allow for one application to claim such descriptions in multiple Nice classes. In consequence, despite the above-mentioned requirement to state a *bona fide* intention to use the mark, it is conceivable that some specifications may be very wide indeed. Therefore, where there is genuine use of part only, it is reasonable for the law to provide a mechanism for unduly wide claims to be cut down by affected parties. As such, if one takes a hypothetical registration for "North Pole" and pretends that it covers all goods listed in the class heading of Class 31 ("Grains and agricultural, horticultural and forestry products not included in other classes; live animals; fresh fruits and vegetables; seeds; natural plants and flowers; foodstuffs for animals; malt"), which is ultimately used only on "bananas", it might be concluded that there is sufficient room for another entity to use the mark for, say, "cut flowers" without raising the possibility of confusion. Nonetheless, the trader of "cut flowers" would be in theory unable to do so because of the earlier registration.

6 The key question in such cases is, of course, where the line ought to be drawn. There is a natural tension in any trade mark regime between two competing interests. Taking an overly restrictive approach to the proper specification of goods/services may unduly limit the registrant's monopoly over the use of the mark and so undermine the purpose of laws provide protection to trade marks. Taking an overly broad approach may allow the applicant to manipulate the trade mark system unfairly, to the detriment of competition.[16] This case note investigates the courts' answer to the above question.

7 For practical reasons, this case note will be limited in scope to an investigation of the approaches taken by the UK, EU and Singapore courts as evidenced by the relevant case law and decisions of the respective trade mark authorities where available.

---

14 See generally David Keeling *et al*, *Kerly's Law of Trade Marks and Trade Names* (London: Sweet & Maxwell, 15th Ed, 2011) ch 14.

15 *Chartered Institute of Patent Attorneys v Registrar of Trade Marks* (C-307/10) ECLI:EU:C:2012:361 at [59].

16 See the discussion in *Total Ltd v YouView TV Ltd* [2014] EWHC 1963.

II. The UK approach

8 The first significant case dealing with the issue of partial non-use revocation under the UK Trade Marks Act 1994[17] ("UK Trade Marks Act") was *Premier Brands UK Ltd v Typhoon Europe Ltd*,[18] a decision of the Chancery Division of the High Court. In that case, Neuberger J, addressing the consequences of a conclusion that some (but not all) of the items in the specification had not been the subject of genuine use in the UK during the five-year period after registration, considered that the proper method was as follows:[19]

> It appears to me that one simply looks at the list of items on the register and asks oneself, in relation to each such item, whether or not the mark has been used 'in relation to' or 'in connection with' that item during the past five years. If the answer is in the affirmative, then the mark can remain registered in respect of that item; if the answer is in the negative then, subject to any question of discretion, the registration is revoked in respect of that item. One does not dig deeper and, as it were, narrow a particular category of item to reflect the extent of the goods to which the mark has been used.

This fairly simple approach was later compared to the "blue pencil" which is traditionally used in manuscript editing.[20] The "blue pencil" approach would seem only to permit deletion of items from the specification, as there is no scope for amendment. If the item cannot be deleted, for example, because there has been use of a subset of the item, the item should be allowed to stand in totality.

9 Neuberger J's approach was criticised in *MINERVA Trade Mark*,[21] where Jacob J noted that the learned judge had not been referred to the earlier case of *Mercury Communications Ltd v Mercury Interactive (UK) Ltd*.[22] In that case, albeit discussing the law under the old UK Trade Marks Act 1938,[23] Laddie J opined that an overly wide specification ("computer programs") could be partially cancelled.[24] However, Laddie J did not go so far as to say that the court had authority to rewrite the

17 c 26.
18 [2000] FSR 767.
19 *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 at 808.
20 See, *eg*, *THIRTYSOMETHING* (O/045/08); *TRADOCS* (O/205/13); *MINERVA Trade Mark* [2000] FSR 734; and *NIRVANA Trade Mark* (O/262/06).
21 [2000] FSR 734.
22 [1995] FSR 850.
23 c 22.
24 Laddie J speculated in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850 that similar wide specifications of goods may not be possible under the 1994 Act.

description contained in the specification of goods/services,[25] nor did he explain what method should be adopted to decide on the extent of cancellation.

10 Jacob J adopted Laddie J's view that it was, in appropriate circumstances, necessary to "dig deeper" into the meaning of the description when comparing it to the extent of use of the mark which had actually been made. He then extrapolated this line of reasoning to conclude that:

> [I]f non-use in respect of a significant subset of a wide general description is established, then I see no reason why the court should not eliminate that subset from the registration.

Regrettably, Jacob J again offered little guidance as to how the assessment of whether the description was "wide" or "general" should be made. Given the requirement that the unused subset must be "substantial", there is perhaps an implication that the balance should be weighted against partial revocation.

11 The level to which it was appropriate to "dig" was brought sharply into focus in *Decon Laboratories Ltd v Fred Baker Scientific Ltd*[26] ("*Decon Laboratories*"), where the court was asked not to partially delete but to amend the description of goods in Class 3 for a registered trade mark. Pumfrey J said:[27]

> In my judgment, the task is best performed by asking what would be a fair specification of goods having regard to the use that the proprietor has in fact made of the mark and assuming further that he will continue that use.
>
> …
>
> In arriving at a fair specification having regard to the proprietor's use, it is also necessary to remember that the effect of section 10(2) (and of 10(3), in limited circumstances) is to give the proprietor protection outside his specification of goods but in areas where he can demonstrate a likelihood of deception in the wide sense … There is no pressing need, therefore, to confer on the proprietor of a wider protection than his use warrants by unduly broadening the specification of goods. There is a balance to be held between the proprietor, other traders and the public having regard to the use which has in fact taken place.

---

25 Laddie J did suggest in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850 that the owner may be forced to amend down the specification of goods. It is argued nonetheless that his comments do not go as far as to suggest that the court had a general power to redefine the content of the specification.

26 [2001] RPC 293.

27 *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 293 at [23] and [24].

It is possible to identify three main concerns in the above passage. The first and primary consideration is factual, that is, what use has actually been made of the mark. The second consideration is contextual and factors in the legal implications of the decision, that is, the scope of the monopoly that would be conferred. The third and final consideration is the wider policy context in which the decision is made.

12 In *DaimlerChrysler AG v Alavi*,[28] Pumfrey J repeated the above test but indicated that the proper formulation of the assessment would be appropriate subject-matter for reference to the European Courts. While such a reference would no doubt have been illuminating, it appears that the parties decided not to pursue the question any further.

13 The *Decon Laboratories dicta* were cited with approval in *Thomson Holidays v Norwegian Cruise Lines*[29] ("*Thomson Holidays*"), where Aldous LJ elaborated on what would comprise a "fair description":[30]

> Pumfrey J in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus the court should inform itself of the nature of [the] trade and then decide how the notional consumer would describe such use.

Putting it more simply, the appropriate test was, "[h]ow would the average consumer describe the [goods and/or] services provided".[31]

14 It is suggested that Aldous LJ's approach represents a significant development from the previous authorities. Whereas Pumfrey J did not explicitly state the position from which the "fair specification" test was to be judged, Aldous LJ's incorporation of the "notional consumer" leaves no doubt that the test is an *objective* test, at least to an extent that is likely to be well understood by lawyers. However, as the editors of

28 [2000] EWHC 37.
29 [2002] EWCA Civ 1828.
30 *Thomson Holidays v Norwegian Cruise Lines* [2002] EWCA Civ 1828 at [31].
31 *Thomson Holidays v Norwegian Cruise Lines* [2002] EWCA Civ 1828 at [39].

Kerly's Law of Trade Marks note,[32] the role of the consumer in what is ultimately a technical matter of taxonomy is not beyond question. The principles used to determine similarity in infringement proceedings are not of general applicability to revocation/cancellation actions, and Aldous LJ's views were not supported by any direct authority. Nonetheless the "notional consumer" approach established in *Thomson Holidays* has since been followed in *West v Fuller Smith & Turner*[33] and subsequent cases.

15 The court in *H Young (Operations) Ltd v Medici Ltd*[34] ("*ANIMAL Trade Mark*") produced a somewhat sophistical explanation for the role of the "notional consumer" outside the context of determining the similarity of two marks. Firstly, Jacob J opined that:[35]

> The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so.

Nonetheless, Jacob J then held that an average consumer considering a fair description would need to be informed as to the purpose of the assessment in terms of trade mark law:[36]

> … [o]therwise they might choose something too narrow or too wide … The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.

As such, the "notional consumer" was at once required to resist being "pernickety" while at the same time taking into account the purpose and letter of trade mark policy. It is therefore suggested that *ANIMAL Trade Mark* gives an example of the awkward tension created by invoking the "notional consumer" outside of its normal contexts.[37]

---

32 David Keeling *et al*, *Kerly's Law of Trade Marks and Trade Names* (London: Sweet & Maxwell, 15th Ed, 2011) at para 10-103.

33 [2003] EWCA Civ 48.

34 [2003] EWHC 1789.

35 *H Young (Operations) Ltd v Medici Ltd* [2003] EWHC 1789 at [20].

36 *H Young (Operations) Ltd v Medici Ltd* [2003] EWHC 1789 at [20].

37 See David Keeling *et al*, *Kerly's Law of Trade Marks and Trade Names* (London: Sweet & Maxwell, 15th Ed, 2011) at para 10-103 for a short criticism of the UK approach, which in particular suggests that it "probably misuses the concept of the average consumer" and proposes that "a view from the trade will be much more informative".

16 In *NIRVANA Trade Mark*[38] and *Pan World Brands Ltd v Tripp Ltd*,[39] the appointed person (Richard Arnold QC), after having set out the cases above, held that there were differences between the UK approach to partial revocation and the European approach, but that such differences were "smaller than might appear" such that the two systems are "broadly similar". The inference of this statement is that the UK approach would not result in significant practical differences. While there is no real reason to doubt the insights of the experienced and learned counsel, it is respectfully questioned whether there is sufficient evidence to support such a claim. In that regard, this author is not aware of any substantial research or authority which has directly addressed that issue – particularly in light of Arnold J's comments in *Stichting BDO v BDO Unibank, Inc*.[40]

17 In summary, by and large[41] the applicable test in the UK under the UK Trade Marks Act has fairly consistently been – at least since the decision in *MINERVA Trade Mark* and up until recently – that of what might be considered a "fair description" of the use actually evidenced. More recently the assessment appears to have included the concept of the "notional consumer", albeit not without raising concerns. Notably, the actual terms of the specification have not played a particularly significant a role in the determination. First, the assessment is made of the actual evidence, properly and fairly characterised. Only as a secondary consideration is the specification reviewed in a technical manner in order to decide whether it is appropriate in light of the use evidenced, and cut down if not.

III. The Singapore approach

18 Regrettably, there is little case law on the topic in question from the Singapore courts. The only significant discussion of partial non-use cancellation in a Singaporean context[42] is found in *Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long*[43] ("*Bluestar*"). In that case, the applicant argued for limitation of the respondent's claim for "men's undergarments, briefs, socks, men's sports clothing, knitwear, singlets [and] swimwear" to only "socks, briefs, singlets, t-shirts and swimwear" (to the extent that the evidence of use was sufficient).

---

38 O/262/06.
39 O/161/07.
40 [2013] EWHC 418. See in particular *Stichting BDO v BDO Unibank, Inc* [2013] EWHC 418 at [59] *ff*.
41 *Cf WISI Trade Mark* [2006] RPC 580 and *Datasphere Trade Mark* [2006] RPC 590.
42 *Cf* Susanna Leong, *Intellectual Property Law of Singapore* (Singapore: Academy Publishing, 2013) at p 967.
43 [2003] 4 SLR(R) 92.

19 Delivering his judgment, Woo Bih Li J tacitly approved of the reasoning in the *Decon Laboratories* and *Thomson Holidays* cases.[44] Applying the reasoning in those cases to the matter before him, Woo J considered that the specification did not need adjustment as it was not "unduly wide", and emphasised the need to identify a "fair" specification rather than one which was "strict or narrow". Remarking on the underlying policy concerns, he added that:[45]

> … it was not in the interest of the public or the trade to try and narrow the description of the clothing in the respondents' classification further to those specific categories for which [their mark] was in fact used. To do so would result in confusion and invite litigation.

The approach of limiting the specification "so that it reflected the circumstances of the particular trade and the way that the public would perceive its use" was also mentioned with approval in *Weir Warman Ltd v Research & Development Pty Ltd*,[46] although in that case it was erroneously attributed to Woo J in *Bluestar* rather than its actual source (Aldous LJ in *Thomson Holidays*).

20 *Bluestar* was applied in *Capitol Records LLC v Steven Corp Pte Ltd*,[47] wherein the relevant test was characterised as "what is fair in the trade … as seen from the perspective of the average reasonably informed customer". Reflecting the wording of Woo J in *Bluestar*, the specification was again considered not to be "unduly wide".

21 While the evidence is limited, it would appear from the foregoing survey that, aside from adopting some slightly different terminology, the Singaporean practice is substantially the same as the law set out in the UK cases described above.[48]

IV. The community trade mark approach

22 The first significant European case to discuss partial revocation for non-use under the Community Trade Mark ("CTM") Regulations[49] ("CTMR") was *Reckitt Benckiser (España) SL v Office for Harmonisation*

---

44 *Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long* [2003] 4 SLR(R) 92 at [59].

45 *Bluestar Exchange (Singapore) Pte Ltd v Teoh Keng Long* [2003] 4 SLR(R) 92 at [60].

46 [2007] 2 SLR(R) 1073 at [112].

47 [2010] SGIPOS 14.

48 See Tan Tee Jim SC, *Law of Trade Marks and Passing Off in Singapore* vol 1 (Singapore: Sweet & Maxwell, 3rd Ed, 2014) at paras 9.146–9.162.

49 Council Regulation (EC) No 207/2009 (26 February 2009) (Community trade mark), then Council Regulation (EC) No 40/94 (20 December 1993) (Community trade mark).

in the Internal Market[50] ("*ALADIN*"). In that case, the Court of First Instance ("CFI") expressly rejected what this case note has termed the "blue pencil" approach discussed above.[51] However, rather than adopting a "fair description" test like that of the UK courts, the CFI instead took an approach that might be described as an exercise in taxonomy – not unlike the Nice classification system itself. In that case, the CFI considered that:[52]

> [I]f a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong.

However, the court pointedly asserted that the application of the above principle:[53]

> [M]ust not … result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner.

It is unclear what the CFI meant by the term "sub-category". The editors of *Kerly's Law of Trade Marks* seem to suggest that it was meant as a reference to the most granular description in the hierarchy of the Nice classification to which the item belongs. The judgment does not, however, call for the term "sub-category" to be understood in such a rigid manner.

23 The decision in *ALADIN* was considered in *Mundipharma AG v Office for Harmonisation in the Internal Market*,[54] where the CFI elaborated on the proper method for determination of what is considered a non-arbitrary subcategorisation:[55]

---

50 (T-126/03) EU:T:2005:288.
51 See para 9 above.
52 *Reckitt Benckiser (España) SL v Office for Harmonisation in the Internal Market* (T-126/03) EU:T:2005:288 at [45].
53 *Reckitt Benckiser (España) SL v Office for Harmonisation in the Internal Market* (T-126/03) EU:T:2005:288 at [46].
54 (T-256/04) EU:T:2007:46.
55 *Mundipharma AG v Office for Harmonisation in the Internal Market* (T-256/04) EU:T:2007:46 at [29].

> [S]ince 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 in question 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 sub-category of goods or services.

The approach under the CTMR therefore begins with what might be described as a technical exercise in taxonomy.[56] First, the assessment must be made by looking at the relevant specification and considering whether the categories or subcategories may be properly subdivided further – although this must be done from the perspective of the consumer. Only then is it necessary to consider whether the use evidenced is capable of amounting to the whole or part of the category as decided upon.

24 It would appear from the above discussion that, amongst UK, Singapore and EU law, there are at least two approaches currently in use to determine the appropriate scope of a registered trade mark in the context of its actual use. It was noted that the distinction has on occasion been downplayed, most notably by the appointed person Richard Arnold QC in *NIRVANA Trade Mark* and *Pan World Brands Ltd v Tripp Ltd*. To be fair, various decisions do suggest that, to the extent to which the approaches are different, there would be no practical difference between the outcomes under application of each test. However, it is observed that this assumption is not grounded in sufficient research or evidence.

25 In any case, it is suggested that the CTM approach described above is different (albeit subtly) from the UK/Singapore approach because it is primarily focused on the text of the specification, with only a secondary emphasis on the perception of the consumer. As such, there is a certain degree of tension between the EU and UK/Singapore courts as outlined above in terms of their conceptual approach to the issue. On a practical note, it might be thought that the CTM approach invites more legalistic arguments from the parties.

56 See Lionel Bently & Brad Sherman, *Intellectual Property Law* (Oxford University Press, 4th Ed, 2014) at p 1030 for criticism of this approach for treating the Nice categories "as representing some universal logic". David Keeling *et al*, *Kerly's Law of Trade Marks and Trade Names* (London: Sweet & Maxwell, 15th Ed, 2011) at para 10-104 similarly suggests that "the sub-categories listed under the Nice Agreement … are unlikely to suit all circumstances".

V. *Maier v ASOS plc*

26 With the above-mentioned approaches in mind, the recent decision in *Maier v ASOS plc*[57] ("*Maier*") will now be discussed. This case note proposes that, as a result of *Maier*, there may be some progress towards unification of the UK/CTM approaches. This effect is achieved by viewing the more technical approach of the European courts in light of the common-sense approach adopted by the UK courts, producing a synthesis of the two lines of case law.

27 The facts of *Maier* are as follows. On 30 June 2005, the respondents ("Maier") filed for registration of a CTM. Their application was opposed by the appellants ("ASOS") on the basis of their own CTM. The opposition was successful, and ASOS' CTM application was refused in respect of all goods, except for a limited number in Class 18.

28 Thereafter, Maier pursued ASOS for infringement and invalidation of ASOS' UK registration. In response, ASOS argued, *inter alia*, that Maier had not used its CTM for the relevant goods and services claimed at all material times, and counterclaimed for cancellation of Maier's CTM.

29 On the issue of the counterclaim, the trial judge, Rose J, found that Maier had not used the CTM for all of the goods claimed, and proposed to revoke the CTM in so far as it did not reflect Maier's actual use of the mark. She noted that Art 51 of the CTMR provided:

> **Grounds for revocation**
>
> 1. The rights of the proprietor of the Community trade mark shall be declared to be revoked … on the basis of a counterclaim in infringement proceedings:
>
> > (a) if, within a continuous period of five years, the trade mark has not been put to genuine use in the Community in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, no person may claim that the proprietor's rights in a Community trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application or counterclaim, genuine use of the trade mark has been started or resumed …
>
> …
>
> 2. Where the grounds for revocation of rights exist in respect of only some of the goods or services for which the Community trade

57 [2015] EWHC 220.

> mark is registered, the rights of the proprietor shall be declared to be revoked in respect of those goods or services only.

After a review of the authorities, she concluded that the proper test to be applied was:[58]

> … [H]aving regard to the use that has actually been made [of the] mark, would the average consumer consider that [the description] was a fair description of that use or would he or she describe the use as limited to some narrower category and, if so, what category? The average consumer is assumed to know that the purpose of choosing that description is to provide [Maier] with absolute protection against anyone using a similar mark for identical goods and additional protection for someone using a similar mark for similar goods if that was likely to lead to confusion. When considering the scope of use, the consumer would not simply look at the [Maier] goods in a vacuum but would consider other factors such as channels of sale and intended use.

It is suggested that the trial judges' characterisation of the appropriate test was accurate in the context of the previous UK authorities. However, it is notable that the test was applied in the context of a CTM, which is, of course, governed by the CTMR rather than the UK Trade Marks Act. Ignoring the impact of any differences between the EU and UK/Singapore tests for the time being, the result is something of a mixed metaphor. It is surmised that the trial judge, perhaps erroneously, did not consider that there might be any differences between the UK and CTM approaches.

30 The particular goods in question were "clothing, footwear and headgear" in Class 25. Applying the above-mentioned test, the trial judge considered that the evidence before her showed that while Maier had made extensive use of the mark in relation to specialist clothing for cyclists, only "relatively small-scale" use of the CTM had been made in relation to non-technical clothing. Further, she considered it relevant that Maier had confined itself to certain types of clothing, and had chosen to market its goods almost exclusively through specialist cycling shops and magazines. Noting nonetheless that some of the items marketed need not necessarily be used in relation to cycling, she therefore proposed to limit the specification of goods in Class 25 to:[59]

> … specialist clothing for racing cyclists and casual wear including track-suits, t-shirts, polo shirts, caps and jackets.

58 *Maier v ASOS plc* [2015] EWHC 220 at [43].
59 *Maier v ASOS plc* [2015] EWHC 220 at [51].

Subsequently, it was brought to the trial judges' attention that the word "including" rendered the proposed specification vague. As such, she proposed that the specification should not refer to any other "substantial categories" of clothes:[60]

> I am satisfied that the specification should not say 'including' those items, but should be limited to the specific items in relation to which the mark has been used. This would therefore list tracksuits, t-shirts, polo shirts, shorts, caps and jackets in addition to the specialist cycling clothes.

Under the circumstances, Maier appealed to the Court of Appeal, *inter alia*, on the basis that the trial judge had erred in restricting the specification in the manner that she did, which constituted an unfair and unjust limitation on the scope of goods for which Maier was entitled to claim, and further that the trial judge failed to take into appreciation the average consumer.

31 The leading judgment was delivered by Kitchin LJ, who after reviewing the trial judges' approach and the above-mentioned cases was, it is suggested, of opinion that the proper approach was a mix of both UK and EU practices. While Kitchin LJ's use of language suggests that the position adopted required no substantive change to the UK practice – as is all too often the case when the law is in fact advanced – the effect is to conflate the UK and EU approaches. He stated:[61]

> 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 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.

In the above passage, the non-arbitrary subcategory approach proposed by the Community courts is folded into the UK fair description test as

60 *Maier v ASOS plc* [2015] EWHC 220 at [52].
61 *Maier v ASOS plc* [2015] EWHC 220 at [64].

Published on e-First 14 March 2016

something to which the decision maker should have regard. It is a subtle but novel development.

32 Conversely, Underhill LJ did not directly engage with previous UK authority on the point. He stated that:[62]

> Proprietors should not be deprived of protection in respect of goods which are not 'strictly identical' to those in respect of which use is proved by arbitrarily putting them in separate categories from goods which are mere 'commercial variations' of such goods and 'not in essence different'. They should only lose protection where the goods in question are 'sufficiently distinct to constitute coherent categories or sub-categories'. But that guidance is, inevitably, at a high level of generality and leaves the courts to make a judgment in any given case as to what categories are indeed sufficiently distinct and not arbitrary. In making those judgments they should have regard to the perception of the average consumer in relation to the market in question …

Notably, Underhill LJ suggested that the EU approach is "high level".[63] He thereafter suggested that the courts enjoy a level of discretion, which should be exercised having regard to the perception of the average consumer. Thus, although not explicitly, his comments do support the hypothesis that *Maier* represents a synthesis of EU and UK approaches to the matter.

33 Finally, although dissenting as to the conclusion to be taken from the facts, Sales LJ also suggested that there are differences between the UK and EU approaches on the authorities, but that they nonetheless are compatible. Referring to *ALADIN* and *ANIMAL Trade Mark*,[64] he stated that:[65]

> … [t]he authorities in this area point to the same conclusion as consideration of the text and scheme of the Regulation …

The test for partial revocation in the UK after *Maier* therefore appears to be: whether a fair description of the use actually evidenced, *taking into account the categories for which the mark is registered and the extent to which those categories are described in general terms*, is use for the goods/services claimed in the registration. Under this approach, it is suggested that a fair description of the evidence of use is of equal importance in terms of assessment as the actual terms of the specification. *Maier* therefore marks a step forward for the law on this issue.

---

62 *Maier v ASOS plc* [2015] EWHC 220 at [182].
63 *Maier v ASOS plc* [2015] EWHC 220 at [182].
64 Discussed at para 15 above.
65 *Maier v ASOS plc* [2015] EWHC 220 at [234].

VI. Conclusion

34 The UK courts have hitherto adopted a test for partial revocation of a trade mark for non-use based on the "fair description" of the goods/services actually evidenced. The EU courts adopt an approach that assesses the proper subcategorisation of the specification in light of the perspective of a consumer. This case note has suggested that *Maier* merges these two approaches, such that the UK and EU approaches have now been effectively harmonised in so far as UK law is concerned. Such a conclusion is to be welcomed. While it has been said that there is minimal practical difference between the two approaches, the method of assessment necessarily has an impact on the daily practice of intellectual property professionals seeking to frame their cases in the most advantageous way.

35 It remains to be seen how the Singapore courts will handle partial revocation for non-use in light of the *Maier* decision from the UK. Given that both approaches are thought to produce largely the same outcomes, *Maier* represents somewhat of a semantic rather than sea change. As such, there is no particular reason why UK decisions on non-use cancellation ought to be considered any less persuasive in Singapore in light of recent developments.