

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for revocation of the registration of Trade Mark No. 155890 and in the matter of the Registered Proprietor's opposition thereto.

THE PROFESSIONAL GOLFERS' ASSOCIATION LIMITED

- Applicant for Revocation

LADIES PROFESSIONAL GOLF ASSOCIATION

- Registered Proprietor

The registered trade mark

1. Ladies Professional Golf Association, a corporation organised and existing under the laws of the State of Ohio, United States of America, of 2570 Volusia Avenue, Suite B, Daytona Beach, State of Florida 32114, United States of America, is the registered proprietor of the trade mark LPGA (and device), shown below, which is registered under No. 155890 in Class 28 in respect of golf clubs, golf bags and golf balls in that Class.



2. The application for registration of the mark was filed on 23 December, 1992 under the Trade Marks Act, 1963 and, by virtue of Section 27 (1) of that Act, the mark is registered as of that date, which is deemed to be the date of registration. Publication of the registration of the mark appeared in Journal No. 1748 on 30 November, 1994.

Application for revocation

3. On 28 November, 2003, The Professional Golfers' Association Limited, a British company, of Centenary House, The Belfry, Sutton Coldfield, West Midlands B76 9PT, England, applied under Section 51 of the Trade Marks Act, 1996 (the Act) for revocation of the registration of the mark and included with the application a statement of the grounds on which it was made.
4. On 6 September, 2004, the Proprietor filed a Notice of Opposition to the application together with evidence of the use that had been made of the mark. On 6 December, 2004, the Proprietor filed further evidence of that use.
5. The application for revocation became the subject of a hearing before me, acting for the Controller, on 3 July, 2006. The parties were notified on 21 July, 2006 that I had decided to allow the application and to revoke the registration of the mark. I now state the grounds of my decision and the materials used in arriving thereat.

Grounds of the application

6. In its Statement of Grounds in support of the application for revocation, the Applicant states that investigations conducted on its behalf failed to establish any use of the registered trade mark in relation to any of the goods covered by the registration. The Applicant therefore claims that,
 - (i) within a period of five years following the date of publication of the registration, the trade mark was not put to genuine use in the State, by or with the consent of the Proprietor, in relation to any of the goods covered by Registration No. 155890,
 - (ii) use of the trade mark in relation to the goods covered by Registration No. 155890 has been suspended for an uninterrupted period of five years prior to the date of the application for revocation,

and that there are no proper reasons for such non-use.

Notice of Opposition and evidence of use

7. In its Notice of Opposition to the application for revocation the Proprietor denies the claims made by the Applicant, including that the latter had any investigations carried out to establish whether the trade mark had been used, and asserts that the mark was, in fact, used within the relevant period. As evidence of that use, it submits the following materials:
- a Statutory Declaration (and Exhibits KJP1 and KJP2) dated 1 September, 2004 of Kenneth J. Pilkington, General Manager of Voco (UK) Limited of Palmer House, Plantation Road, Burscough, Lancashire, L40 8JT, United Kingdom,
 - a Statutory Declaration (and Exhibits JOD1 and JOD2) dated 3 September, 2004 of John O'Dwyer, co-proprietor of O'Dwyer Promotions of Unit 4/5 Clonmel Business Park, Clonmel, Co. Tipperary¹, and
 - a Statutory Declaration (and Exhibits DB1 and DB2) dated 16 November, 2004 of Douglas A. Buffington, President and Chief Operating Officer of Women's Golf Unlimited, Inc., a company organised and existing under the laws of the State of New Jersey, United States of America of 18 Gloria Lane, City of Fairfield, State of New Jersey 07004, United States of America.
8. In his Declaration, Mr. Pilkington says that Voco (UK) Limited distributes Square Two golf clubs in the United Kingdom and the Republic of Ireland, all of which bear the registered trade mark LPGA (and device). He exhibits photographs showing the mark applied to sample golf clubs, which he indicates are the AGREE, LIGHT&EASY XL and KATHY WHITWORTH models, and an invoice dated 18 December, 2001 in the amount of STG£264 addressed to Mr. O'Dwyer in respect of such clubs.
9. In his Declaration, Mr. O'Dwyer says that O'Dwyer Promotions imported golf clubs bearing the registered trade mark during the period 1999-2004 and that it sold such

¹ errors and omissions in which were corrected by Statutory Declaration dated 1 December, 2004

clubs through its retail outlet in Clonmel, Co. Tipperary. He also exhibits a copy of the invoice exhibited by Mr. Pilkington.

10. In his Declaration, Mr. Buffington says that, since 1981, Women's Golf Unlimited, Inc. has had a licence to use and sublicense the registered trade mark on golf equipment manufactured by it, including its Square Two golf clubs. He exhibits extracts from his company's websites showing the use of the mark together with the words "Official Licensee" and also including depictions of golf clubs that appear to bear the mark. Since 1 May, 2002, Women's Golf Unlimited, Inc. have sublicensed the use of the mark on golf clubs to Voco AG of Switzerland, parent of Voco (UK) Limited, which is authorised to distribute the clubs in the United Kingdom and Ireland and Mr. Buffington understands that sales of clubs bearing the mark have been made in the United Kingdom and Ireland. Women's Golf Unlimited, Inc. recognises that the registered trade mark belongs to the Proprietor and associates it exclusively with the Proprietor, which it believes controls a significant portion of the worldwide market share for women's golf-related goods and services.

The hearing and arguments of the parties

11. At the hearing the Applicant for Revocation was represented by Mr. Paul Coughlan, BL instructed by MacLachlan & Donaldson, Trade Mark Agents and the Proprietor by Mr. Jonathan Newman, BL instructed by Tomkins & Co., Trade Mark Agents.

12. Mr. Coughlan referred to the fact that the onus of proving that the mark had been used within the relevant period lay on the Proprietor² and asserted that the evidence furnished by the Proprietor failed to prove (i) that the mark had been used with the Proprietor's consent as a trade mark for the goods of the registration or (ii) that any use that may have been made of the mark was genuine use within the meaning of Section 51 of the Act. As to the first of these matters, Mr. Coughlan pointed to the fact that the evidence furnished on behalf of the Proprietor was to the effect that the trade mark had been applied to golf clubs which were not of the Proprietor's manufacture and which bore the trade marks of their manufacturers such that the use of the registered mark did not serve to identify the trade origin of the goods in

² Section 99 of the Act

question but may merely have served to indicate some form of endorsement of them. In the absence of a copy of the licence referred to by Mr. Buffington in his Statutory Declaration, which was not exhibited, it was not possible to conclude that the use of the mark on the goods was use in a trade mark sense, i.e., for the purpose of indicating or so as to indicate that the Proprietor of the mark exercised some control over the quality of the marked goods. With regard to the genuineness of the use that was claimed to have been made of the mark, Mr. Coughlan asserted that the Proprietor was under an obligation to explain why the use shown was so small (a single invoice in the amount of STG£264) and that the inference could legitimately be drawn from its failure to do so that there had, in fact, been no more than token use of the mark with a view to keeping the registration alive.

13. In reply, Mr. Newman argued that the evidence of use furnished on behalf of the Proprietor, when viewed in the round, proved that golf clubs bearing the registered mark had been imported into the State and sold on through at least one retail outlet within the relevant period. Mr. O'Dwyer's evidence was independent, third party evidence of the use of the mark and, while the use shown was admittedly limited in extent, nevertheless it must be seen as genuine in circumstances where it clearly involved sales of goods to a person entirely unconnected with the Proprietor. The use shown involved the actual application of the mark to the goods and there was no basis for finding that such use was not use in a trade mark sense or in keeping with the essential function of a trade mark.

The law and issue to be decided

14. Section 51 of the Act provides for the revocation of the registration of a trade mark if it has not been put to genuine use in the State, by or with the consent of its proprietor, in relation to the goods for which it is registered within five years following the publication of the registration or, alternatively, if any such use has been suspended for an uninterrupted period of five years. The publication of the registration of this trade mark occurred on 30 November, 1994 and the essential question is whether there was genuine use of the mark in the State between that date and the date of the present application for revocation, namely 28 November, 2003.

“Genuine use”

15. In Case No. C-40/01, Ansul BV and Ajax Brandbeveiliging BV, the European Court of Justice (ECJ) considered the question of what constitutes “genuine use” of a trade mark and observed that,

“.... there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.”

Facts shown by Proprietor’s evidence

16. The evidence filed on behalf of the Proprietor in this case is unsatisfactory in a number of respects. First of all, the Proprietor itself has given no evidence and there is, therefore, no averment from the Proprietor that the use that is claimed to have been made of the mark by those persons who did give evidence was use with its (the Proprietor’s) consent. That deficiency is compounded by the fact that the instrument by which the Proprietor is said to have given its consent for the use of the mark by another, i.e., the licence referred to by Mr. Buffington, has not been included in the evidence filed. Furthermore, the evidence is to the effect that the distribution arrangement between Women’s Golf Unlimited Inc. and Voco AG of Square Two golf clubs, which are said to all bear the registered trade mark, commenced only in May, 2002³ but the invoice from Voco (UK) Ltd (Voco AG’s subsidiary) to Mr. O’Dwyer, which is said to be in respect of golf clubs bearing the mark, is dated 18 December, 2001. Nor has any indication been given of the total value of sales of

³ paragraph 4 of Douglas A. Buffington Statutory Declaration

goods bearing the mark within the relevant period, the geographic extent of the distribution within the State of such goods or the amount spent on advertising and promoting such goods. All in all, I would characterise the Proprietor's evidence of use of the mark as scant, patchy and internally inconsistent and I think it is very sketchy evidence indeed on which to mount an opposition against an application for revocation of the registration of the trade mark.

17. Having said that, some evidence has been given and it would be incorrect in my opinion to focus solely on what the Proprietor has failed to say or prove and overlook the facts that have been established by the evidence. Shortly stated, those facts are that the Proprietor has licensed the use of the trade mark on golf equipment to Women's Golf Unlimited Inc, which in turn has sublicensed the use of the mark to Voco AG, the subsidiary of which, Voco (UK) Ltd., supplied during the relevant period two sets of golf clubs⁴ to a retail outlet in Clonmel, Co. Tipperary from which they were sold on to customers. Mr. Newman suggested at the hearing that I might assume that there were, in fact, further sales of goods bearing the mark within the relevant period but that Mr. O'Dwyer may not have had the relevant invoices to hand at the time that he made his Statutory Declaration and that he may not have been particularly highly motivated to look for them given that he has no direct stake in the fate of the Proprietor's trade mark registration. I do not accept that suggestion as it requires me to assume that there has been use of the trade mark in circumstances where the Proprietor has had an opportunity to give evidence of such use and has not done so. None of the persons making Statutory Declarations has said that there is any difficulty in retrieving records of sales of goods bearing the mark or that the invoice exhibited is merely a sample of many such invoices that exist but could not be located. All that has been stated is that golf clubs bearing the mark were imported into the State and sold on within the relevant period and the evidence given in respect of that assertion is the single invoice for STG£264. That is what has been shown and no more.

⁴ each consisting of 4-iron-sand wedge and 1, 3, 5, 7 and 9 woods, making 13 clubs, which, together with a putter, constitutes a set of clubs, being the maximum number of clubs permitted to be carried in a competition

Whether genuine use shown

18. The fact of the Proprietor having licensed the use of the mark to Women's Golf Unlimited Inc. and the fact of the latter having sublicensed the use of the mark in the United Kingdom and Ireland to Voco AG do not, of themselves, constitute evidence of use of the mark within the State. Licensing and distribution arrangements of this nature are a normal part of the exploitation of brand names but their existence alone does not mean that goods bearing a particular mark have actually been put on the market. Nor does the existence of the websites which display the mark that were referred to by Mr. Buffington constitute evidence of use of the mark in relation to the goods for which it is registered. There is no evidence that the material in question ever came to the notice of any consumer within this jurisdiction during the relevant period.

19. The height of the Proprietor's evidence is that two sets of golf clubs bearing the mark were sold through a retail outlet in Clonmel, Co. Tipperary during the relevant period. In the words of the ECJ in *Ansul*, that cannot be regarded as "real" commercial exploitation of the mark in the sense that it could not have had the effect of creating for the Proprietor a share in the market for the goods for which the mark is protected. In order to create and maintain a share in the very substantial market that exists for golf clubs and related goods, the Proprietor or its agents would have had to supply a sufficient quantity of marked goods such that there was a real possibility that the average consumer of those goods might be exposed to them and might have the opportunity to acquire them. In fact, the only consumers that might ever have been exposed to goods bearing the mark were those customers of Mr. O'Dwyer who frequented his premises during the time when the two sets of clubs bearing the mark were on sale there. Having regard to the size of the relevant market, that represents such a limited number of people that there was never any real possibility of goods bearing the mark securing or maintaining a share in that market. For that reason, the use of the mark shown by the Proprietor was not real commercial use and was not, therefore, genuine use within the meaning of Section 51 of the Act. It follows that the application for revocation of the registration of the trade mark must succeed.

20. In reaching this conclusion, I have not had to address the argument made on behalf of the Applicant at the hearing to the effect that the very limited nature of the use shown

by the Proprietor carried the implication that the use in question was token use and that, absent an explanation to the contrary, it should be treated as not being genuine use for that reason. The fact is that the use of the mark shown by the Proprietor was so limited that it was not commercially real and I find it unnecessary to speculate on whether or not the invoice addressed to Mr. O'Dwyer was part of an elaborate plot to stave off an application for revocation of the registration.

Whether partial revocation might have been warranted

21. The Proprietor having failed to show that it made any genuine use of the trade mark within the relevant period, the registration must be revoked in its entirety. I wish to briefly address the question of whether partial revocation might have been warranted if the mark had been found to have been used on some only of the goods for which it is registered, i.e., golf clubs. This question arose at the hearing and both Counsel made submissions on it so I take the opportunity to express my opinion even though it does not affect the outcome of this application.

22. As I have already noted, the trade mark in question in this case is registered in respect of golf clubs, golf bags and golf balls included in Class 28 and the application for revocation of that registration was advanced on the basis that the mark had not been put to genuine use in the state in respect of any of the goods for which it is registered. The Proprietor did not offer evidence of any use of the mark on golf bags or golf balls and it would seem that, even if I had accepted that the mark had been used in relation to golf clubs, then the application for revocation should succeed in respect of the former goods and that the registration should be partially revoked. At the hearing, Mr. Newman referred to the fact that the question of partial revocation was not specifically pleaded in the application for revocation and asserted that proven use of the mark on any of the goods of the registration should be enough to defeat an application for revocation grounded on an allegation that there had been no use of it at all. In this regard, he referred to my own remarks in the matter of Trade Mark Registration No. 159959 *LELLIKELLY* in the name of Stefcom S.p.a. and an application for revocation thereof by Travel Hurry Projects Ltd.⁵, in which case I allowed a registration in respect of “*clothing, including boots, shoes and slippers*” to

⁵ paragraph 24 of decision dated 21 March, 2005

remain unaltered notwithstanding that use of the mark had been proven in relation to items of footwear only. In reply, Mr. Coughlan referred to the provisions of Section 51(5) of the Act to the effect that, where grounds for revocation exist in respect of some only of the goods or services for which a mark is registered, revocation shall relate to those goods or services only. In his submission, the effect of that provision was that the onus lay on the Proprietor to prove use of the mark in relation to all of the goods of the registration and that the registration had to be revoked in respect of any goods for which use was not shown, regardless of whether or not partial revocation was specifically sought by the Applicant for revocation.

23. In my opinion, that is the only logical interpretation of Section 51 of the Act and there is no requirement on an applicant for revocation to specifically request revocation in respect of each and every one of the goods/services for which a mark stands registered or risk seeing the application fail if the proprietor proves that the mark was used in relation to one only of those goods/services. The combined effect of Sections 51 and 99 of the Act is that, by making an application for revocation, an applicant puts the onus on the trade mark proprietor to prove that he has used the registered mark in relation to the goods/services for which it is registered and, if the latter fails to do so in respect of any of the relevant goods/services, then the registration must be revoked to the extent that it covers such goods/services. Of course, an application for revocation may, at the option of the applicant, be specifically limited to certain of the goods/services covered by a registration but if it is not so limited then it must be understood as relating to all of the relevant goods/services and the possibility of either full or partial revocation is immediately opened up. In *LELLIKELLY* the specification of goods for which the mark was (and is) registered was such that I found it reasonable, in the circumstances of the case, to allow the registration to stand unaltered but that does not imply an interpretation of the relevant provisions of the Act other than that which I have just set out. Accordingly, even if I had accepted the Proprietor's evidence as showing genuine use of the trade mark in relation to golf clubs, I would have revoked the registration to the extent that it covers golf bags and golf balls, in respect of which goods no evidence of use was given.

Effective date of revocation

24. Subsection (6) of Section 51 provides that, 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 the date of the application for revocation or, if the Controller is satisfied that the grounds for revocation existed at an earlier date, from that date. In the present case, the earliest date on which grounds for revocation could have existed was 1 December, 1999, i.e., upon the expiry of the period of five years following publication of the registration. It follows from my finding that the Proprietor has failed to show that there was ever any genuine use of the mark in respect of any of the goods covered by the registration that the grounds for revocation did, in fact, exist on that date and that the revocation must take effect from that date.

Tim Cleary

Acting for the Controller

11 August, 2006