



**OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET**  
(TRADE MARKS AND DESIGNS)

OPERATIONS DEPARTMENT  
Cancellation Division

C406B

Alicante, 31/07/2013

ROOTS IP B.V.  
P.O. Box 1050  
NL-4801 BB Breda  
PAÍSES BAJOS

**Notification of a decision to the CTM proprietor/IR holder**

*Invalidity number:* 000006699 C  
*Contested trade mark:* 008747636  
WALK IN THE PARK  
*Fax number:* 00 31-765232509

Please find attached the decision terminating the proceedings referred to above. The decision was delivered on 31/07/2013.

Please note that decisions of the Cancellation Division are not signed by the responsible officials but only indicate their full name and bear a printed seal of the Office in accordance with Rule 55(1) CTMIR.

Ingeborg Alme RASBERG



Enclosures (excluding the cover letter): 8 pages



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

Cancellation Division

**DECISION**  
**of the Cancellation Division**  
**of 31/07/2013:**

**IN THE PROCEEDINGS FOR A DECLARATION OF INVALIDITY**

OHIM reference number: 6699 C  
Community trade mark: 8 747 636  
WALK IN THE PARK  
Language of the proceedings: English

**APPLICANT**  
**The Backup Shoe Holding Company Limited**  
Athertonholme Mill, Railway Street,  
Stacksteads  
Backup, Lancashire QL13 OUF  
United Kingdom

**REPRESENTATIVE**  
**Wildbore & Gibbons LLP**  
Wildbore House 361 Liverpool Road  
London N1 1NL  
United Kingdom

**against**

**COMMUNITY TRADE MARK PROPRIETOR**  
**Fransiscus Cornelis Johannes Hoogeboom**  
Heusdenbaan 32  
9090 Melle  
Belgium

**REPRESENTATIVE**  
**Roots IP B.V.**  
Catharinastraat 21  
4811 XD Breda  
The Netherlands

### THE CANCELLATION DIVISION

composed of Gianluigi MANNUCCI, Ingeborg Alme RASBERG and Ioana MOISESCU, takes the following decision on 31/07/2013:

1. The request for a declaration of invalidity of Community trade mark No 8 747 636 is rejected in its entirety.
2. The applicant shall bear the costs of the Community trade mark proprietor.
3. The costs are fixed as follows:

The amount of costs to be paid by the applicant to the Community trade mark proprietor shall be EUR 450, corresponding to representation costs.

### FACTS AND ARGUMENTS

- (1) The Community trade mark No 8 747 636, (word mark) 'WALK IN THE PARK' ('the CTM'), was filed on 10/12/2009, published on 10/05/2010 and registered on 24/08/2010 for goods and services in Classes 18, 25 and 35, namely:

*Bags, belts (Class 18).*

*Footwear including boots; shoes, sandals, flip-flops; ballerina shoes and slippers; belts (sashes); scarves (Class 25).*

*Retail services for the sale of boots, shoes and other footwear and accessories, including belts, scarves and bags; collecting boots, shoes and other footwear and clothing accessories including belts, scarves and bags via the Internet and other sources (excluding the transport of these goods) in order to enable consumers to conveniently view and purchase these goods or order them via the Internet (Class 35).*

- (2) On 08/06/2012, the applicant filed a request for a declaration of invalidity against the CTM, on the basis of relative grounds, namely that the CTM is identical to, or confusingly similar with, the earlier mark of the applicant according to Article 8(1)(a) CTMR and Article 8(1)(b) CTMR, in conjunction with Article 53(1)(a) CTMR.
- (3) The applicant invoked the following earlier national trade mark registration:
  - United Kingdom trade mark registration No 2 410 069, (word mark) 'WALK IN THE PARK' filed on 23/12/2005 and registered on 09/06/2006 for goods in Class 25, namely

*Articles of clothing and footwear (Class 25).*

- (4) The application for invalidity is based on all these goods.

- (5) The applicant has shown evidence of its entitlement by filing the registration certificate of the earlier trade mark.
- (6) The applicant filed its request for a declaration of invalidity in respect of all of the goods and services covered by the CTM.
- (7) The CTM proprietor was duly notified of the invalidity application and the parties were given the opportunity to comment upon the observations made by the counterparty in accordance with the relevant provisions of the CTMR and the CTMIR.
- (8) As regards identity and likelihood of confusion pursuant to Article 8(1)(a) CTMR and Article 8(1)(b) CTMR, the applicant argues the following: there is identity and similarity of the goods and services. The signs are identical. Taking into account all the relevant factors, because of the identity of the marks and of the goods and services, or, alternatively, the similarity between them, there is a strong likelihood of confusion.
- (9) In its observations in response, the CTM proprietor requests that the applicant provides proof of genuine use of the earlier mark. Furthermore, the CTM proprietor argues the following: the earlier mark consists of common words (WALK IN THE PARK), which have no real distinctive character and the extent of protection of the earlier mark is limited. The goods and services are partially similar and partially different.
- (10) In reply, the applicant submits proof of use (listed below) of the earlier mark and argues the following: the mark has been put to genuine use in the relevant period for the relevant goods. The evidence shows that extensive use has been made of the earlier sign during the period 2007-2013 for clothing and footwear. The goods are sold through online retailers.
- (11) As regards the evidence of use, the CTM proprietor argues the following: the evidence submitted, as well as the approximate sales figures, does not prove genuine use. The exhibits show limited use in the relevant period. The evidence shows only a low frequency of use in the relevant period, not sufficient to prove genuine use. The use shown in the evidence is merely token use instead of actual use to create a market share for the goods that are protected by the mark. Furthermore, the use shown is not trade mark use.
- (12) On 12/07/2013, the parties were informed that the adversarial part of the proceedings was closed and that a decision would be taken in due course.

## GROUNDS FOR THE DECISION

### On the admissibility

- (13) The request complies with the formalities prescribed in particular in Article 56(1) CTMR and Rule 37 CTMIR and is, therefore, admissible.

### On the substance

*'Genuine use' of the earlier mark pursuant to Article 57(2) and (3) CTMR*

- (14) According to the combined provisions of paragraphs 2 and 3 of Article 57 CTMR, if the proprietor of the contested CTM so requests, the proprietor of an earlier Community or national trade mark, being a party to the invalidity proceedings, shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, provided that the earlier Community or national trade mark at that date has been registered for not less than five years, the earlier Community or national trade mark has been put to genuine use in the Community or in the Member State in which the earlier national trade mark is protected, or that there are proper reasons for non-use, in connection with the goods or services in respect of which the earlier right is registered.
- (15) If, at the date on which the application for the contested CTM was published, the earlier Community or national trade mark had been registered for not less than five years, the proprietor of the earlier Community or national trade mark shall furnish proof that, in addition, the conditions contained in Article 42(2) CTMR were satisfied at that date. In the absence of proof, the application for a declaration of invalidity shall be rejected.
- (16) The earlier mark was registered on 09/06/2006. The invalidity request was filed on 08/06/2012. Therefore, the earlier mark had been registered for more than five years prior to the request for invalidity, and, therefore, the request for proof of use is admissible. In the present case, the application for the contested CTM was published on 10/05/2010. Therefore, the earlier United Kingdom trade mark had not been registered for more than five years prior to the publication of the application of the contested CTM. Consequently, the applicant must prove genuine use of the earlier United Kingdom trade mark only for the period **08/06/2007–08/06/2012** (five years prior to the date of the application for invalidity).
- (17) According to Rule 22(3) CTMIR, which is applicable *mutatis mutandis* to invalidity proceedings by virtue of Article 40(5) CTMR, 'the indications and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered'.
- (18) Pursuant to Rule 22(4) CTMIR, 'the evidence shall be filed in accordance with Rules 79 and 79 (a) and shall, in principle, be confined to the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements, and statements in writing as referred to in Article 78(1)(f) of the Regulation'.
- (19) As regards the interpretation of the concept of 'genuine use', it is settled case-law that there is 'genuine use' of a trade mark where it 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.
- (20) Genuine use does not include token use for the sole purpose of preserving the rights conferred by that 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 use of the mark is real in the course of trade, 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. When it serves a real commercial purpose, in the circumstances cited above, even minimal use of the mark or use by only a single importer in the Member State concerned can be sufficient to establish genuine use (see judgment of 27/01/2004, C-259/02, 'Laboratoire de la mer', paragraph 27; and judgment of 08/07/2004, T-203/02, 'Vitafruit', paragraph 40).

*Assessment of the evidence of use of the earlier mark*

- (21) The earlier United Kingdom trade mark registration No 2 410 069, (word mark) 'WALK IN THE PARK', is registered for the following goods, for which proof of genuine use must be submitted:

*Articles of clothing and footwear (Class 25).*

- (22) The applicant submits the following evidence:

- Exhibit 1: Extract from [www.backupstore.co.uk](http://www.backupstore.co.uk) with general information about The Backup Shoe Holding Company, printout date 09/04/2013. The 'latest news' section of the website refers to a design award event in 2007/2008. Extract from Wikipedia dated 09/04/2013, which is outside the relevant time period, with information about The Backup Shoe Holding Company.
- Exhibit 2: Transcript from the Companies House website (<http://wck2.Companieshouse.gov.uk/compdetails>) regarding the applicant's company, The Backup Shoe Holding Company, and subsidiary companies. Extract from a newspaper article about the applicant, dated 05/10/2011.
- Exhibit 3: Printout from the online dictionary 'The Free Dictionary' showing search results for the word 'clothing'.
- Exhibit 4: Printouts from websites showing wellingtons for sale (eBay, Simplybe, GardenXL, Amazon). The printout date is 09/04/2013, which is outside the relevant time period. The web pages are not further dated.
- Exhibit 5: Copies of 12 invoices for WALK IN THE PARK-branded products between 2007 and 2012. Eight of these invoices fall within the relevant time period. Four of them fall outside the relevant time period (from May 2007 and from September 2012).
- Exhibit 6: Price list from 2008.
- Exhibit 7: Printouts from websites containing advertisements for wellingtons: [www.gooutdoors.co.uk](http://www.gooutdoors.co.uk) (1), [www.argos.co.uk](http://www.argos.co.uk) (1) and [www.groupon.co.uk](http://www.groupon.co.uk) (1). The years 2012 and 2012 have been written by hand on the printouts.
- Exhibit 8: Three screenshots from [www.web.archive.org](http://www.web.archive.org) of the websites [www.redfootshoes.uk](http://www.redfootshoes.uk), [www.groupon.co.uk](http://www.groupon.co.uk) and [www.prettypinktoes.co.uk](http://www.prettypinktoes.co.uk), all advertising wellingtons for sale. The screenshots show archived web pages from the relevant period.

- Exhibit 9: two purchase orders for WALK IN THE PARK footwear from the outdoor store called Go Outdoors. The orders were created on 14/11/2012 and 30/08/2012, which is outside the relevant time period.
  - Exhibit 10: a copy of a picture of a bag in which the WALK IN THE PARK footwear is packed. The picture is not dated.
- (23) The factor time of use requires that the applicant show genuine use of the earlier mark within the relevant time period (in this case, 08/06/2007–08/06/2012).
- (24) Some of the evidence falls outside the relevant time period (for example, some of the evidence in exhibits 1 and 5, exhibit 4, exhibit 9), some is not clearly or properly dated (exhibit 4, exhibit 7, exhibit 10) and some refers to the relevant time period (some of the evidence in exhibits 1, 2 and 5, exhibit 8). Therefore, overall, the Cancellation Division finds that the evidence gives some indications of use within the relevant period of time.
- (25) The factor 'nature of use' requires, *inter alia*, that the applicant show genuine use in respect of the goods for which the earlier mark is registered (and on which the invalidity claim is based). The applicant must show use for *articles of clothing and footwear* (Class 25).
- (26) The evidence in exhibit 3, and the transcript from the Companies House website in exhibit 2, gives no indications of the registered goods of the earlier mark. Exhibit 1, the newspaper article in exhibit 2 and exhibits 4–10 refer, either by illustration of the goods or by reference, to shoes/wellingtons/rain boots/boots.
- (27) Therefore, the Cancellation Division finds that the evidence gives indications of wellingtons/rain boots/boots but not of the remaining goods on which the invalidity application is based, namely *articles of clothing*.
- (28) Concerning the factor extent of use, it is settled case-law that account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (see, for example, judgment of 08/07/2004, T-334/01, 'Hipoviton', paragraph 35).
- (29) The European Court of Justice has held that 'use of the mark need not always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market' (see judgment of 11/03/2003, C-40/01, 'Minimax', paragraph 39).
- (30) Exhibits 4 and 7 (websites showing wellingtons for sale, advertisements) and exhibit 8 (websites containing advertisements for wellingtons for sale) indicate that the applicant's footwear has been advertised for sale on these websites. However, this evidence does not clearly indicate at which point in time such advertisement took place. Exhibits 1–3 and 6 give no indications or only marginal indications of the extent of use of the mark for the goods. Exhibit 9 indicates sales of rain boots, a total quantity of 49 pairs of boots for a value of approximately GBP 480, but the orders do not fall within the relevant time period and therefore cannot be given much weight as an indication of the

commercial volume and the extent of the use within the relevant time period. Exhibit 10 is not dated and does not give indications of the extent of use of the mark.

- (31) Therefore, the evidence which basically sheds light on the extent of the use of the mark within the relevant time period is exhibit 5 (the eight invoices) and exhibit 8 (the clearly dated screenshots from websites containing advertisements for wellingtons for sale). However, the invoices are very few (only eight within the relevant time), show a very limited quantity (only eight items) and amount to a very low value (approximately GBP 400 in total). Indeed, the applicant has provided sales and promotional figures for 'WALK IN THE PARK-branded products', which gives an indication of the extent of the use of the mark, but no objective evidence of actual sales (except the four invoices) has been submitted to verify these figures, nor any other supporting evidence, such as statistics or annual reports. Furthermore, it is not clear to which of the goods in the list of goods the sales and promotional figures refer. The evidence as a whole indicates that the proprietor has offered footwear for sale, but it gives no or very few indications of the exposure of the mark within the relevant public, the frequency and duration of the use and, not least, the commercial volume and the extent of the use.
- (32) Therefore, in relation to the factors nature and extent of use, the evidence provides no indications of the extent of the use for *articles of clothing* and very few indications of the extent of use of the mark for *articles of footwear* in the relevant period.

*Overall assessment of the proof of use*

- (33) In order to examine, in a given case, whether use of the earlier mark is genuine, an overall assessment must be made taking account of all the relevant factors in the particular case. That assessment implies certain interdependence between the factors taken into account. Therefore, a low volume of goods marketed under that trade mark may be compensated for by a high intensity or certain constancy in time of the use of that trade mark or vice versa (see judgment of 08/07/2004, T-334/01, 'Hipoviton', paragraph 36).
- (34) Although some of the evidence indicates that the mark has been used as a trade mark for some of the contested goods, it is not possible, based on the evidence submitted, to determine the extent of the use for any of the goods on which the application is based or if the use has been extensive enough to fulfil the criteria of genuine use for the contested goods within the relevant time period.
- (35) The factors time, place, extent and nature of use are cumulative (see judgment of 05/10/2010, T-92/09, 'STRATEGI', paragraph 43). This means that the evidence must provide sufficient indications of all these factors in order to prove genuine use. Therefore, since the applicant failed to provide sufficient indications of the extent of use for any of the goods of the earlier mark, the Cancellation Division concludes, after an overall assessment, that the applicant has failed to provide sufficient indications of genuine use within the relevant time period.
- (36) In the absence of genuine use of the earlier mark, the application must be rejected pursuant to Article 57(2) and (3) CTMR. Therefore, the Cancellation



Division will not proceed to the comparison of the marks under Article 8(1)(a) and 8(1)(b).

*Conclusion*

(37) It follows that the request for a declaration of invalidity, in the absence of valid evidence of genuine use, must be rejected.

**COSTS**

(38) Pursuant to Article 85(1) CTMR and Rule 94 CTMIR, the party losing cancellation proceedings shall bear the fees and costs of the other party. The applicant, as the party losing the cancellation proceedings, shall bear the costs of the CTM proprietor.



**THE CANCELLATION DIVISION**

<hr/> Gianluigi MANNUCCI	<hr/> Ingeborg Alme RASBERG	<hr/> Ioana MOISESCU
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**Notice on the availability of an appeal:**

Under Article 59 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 60 CTMR notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

**Notice on the review of the fixation of costs:**

The amount determined in the fixation of the costs may only be reviewed by a decision of the Cancellation Division on request. Under Rule 94(4) CTMIR such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2(30) CTMFR) has been paid.