

On 15 November 2012, the Danish Patent and Trademark Office passed the following:

## **Decision - administrative revocation**

in the case, concerning the trademark SPINNING <w>, between:

**Applicant:     DANSK FIRMAIDRÆTS FORBUND**

**and**

**Proprietor:    Mad Dogg Athletics, Inc. a corporation of the State of California,**  
represented by: Johan Schlüter Advokatfirma I/S

### **DECISION**

**The Danish Patent and Trademark Office does not allow the application and the registration will be maintained.**

**This decision is passed in pursuance of section 28(2)(2) of the Danish Trade Marks Act.**

**1. Particulars of claim**

In a letter of 3 January 2011, DANSK FIRMAIDRÆTS FORBUND filed an application for an administrative revocation of the registered trademark SPINNING <w>, VR 1995 01058.

The applicant has referred to matter as one of trademark degeneration considering that the above term has become a generic term.

In this context, please see section 30(1) of the Danish Trade Marks Act, cf. section 28 28(2)(2) of Consolidated Act no. 90 of 28 January 2009.

In a letter of 21 March 2011, the applicant elaborates on the application for an administrative revocation and submits documentation in order to prove that SPINNING is used as a generic term.

On 18 July 2011, the proprietor, represented by Johan Schlüter Advokatfirma I/S, argues its case. The proprietor argues that the rule set out in section 28(2)(2) of the Danish Trade Marks Act is cumulative. Hence, the mark must have become a common name, and the degeneration must be a consequence of the proprietor's own use of the mark or a result of inactivity on the part of the proprietor. The proprietor attaches documentation in order to demonstrate that this is not the case. On 13 September 2011, the proprietor submits further argumentation and documentation.

On 7 December 2012, the Patent and Trademark Office considers the matter. During a review of the matter, the case worker finds that the applicant has not received sufficient guidance, and the Office therefore sends a letter to the applicant with additional guidance on 21 May 2012.

On 16 May 2012, the applicant replies and submits further documentation in order to prove degeneration of the mark.

The documentation is presented for comments to the proprietor, and on 27 August 2012 the proprietor submits further argumentation. The proprietor underlines once again that the mark first of all must have become a common name, and that the degeneration must arise out of the proprietor's own use or inactivity. Moreover, the proprietor is displeased that the case has been reopened.

The Patent and Trademark Office then considered the case for final judgment.

## 2. The legal framework

It is laid down in section 28(2)(2) of the Danish Trade Marks Act that

*A registration may also be revoked if*

*2) in consequence of the activity or inactivity of the proprietor, the trade mark has become the common name in the trade for the product or service in respect of which the trade mark is registered, or .....*

## 3. Assessment and conclusion

The proprietor's mark: SPINNING <w>, VR 1995 01058

Registration for: Class 28: Gymnastic and sporting articles, including stationary exercise bicycles. As well as the entire class 41.

The mark was registered on 10 February 1995, and in the course of the case at hand - that was filed in order to obtain an administrative revocation of the mark - no questions have been raised as to the original distinctiveness of the mark.

In the case at hand, the Patent and Trademark Office must merely consider the question of whether the registration of the trademark SPINNING <w>, VR 1995 01058 can be revoked as a result of degeneration of the trademark, cf. section 28(2)(2) of the Danish Trade Marks Act.

It appears from section 28(2)(2) of the Trade Marks Act that a trademark can be revoked in cases where the mark as a consequence of the activity or inactivity on the part of the proprietor has become the common name within the trade for the product or service in respect of which the trade mark is registered.

The first condition for applying the rule is that a mark that originally has distinctiveness and therefore is registered have become a common name within the trade for the goods and services for which they are registered. In this connection it should be noted that "the trade" mainly comprises consumers, however, depending on the market circumstances, it may also include all businesses in the trade (see C-371/02).

Another condition for applying the rule may be that the trademark proprietor is to blame for the degeneration. This may be in an active manner through generic use of the mark by the proprietor, or in an inactive manner where the proprietor does not take various measures to stop such generic

use. The requirement of inactivity on the part of the proprietor must be viewed and assessed in conjunction with the fact that the proprietor does not under the Trade Marks Act have an option to order others to discontinue non-commercial use of the mark.

By way of letters of 18 March 2011 and 16 May 2012, the applicant submitted documentation to the effect that the proprietor’s mark has become a common term within the trade. The material submitted includes among other things: The applicant’s own use of SPINNING in magazines etc., the use by other commercial undertakings of SPINNING (excluding the applicant and the proprietor), references to the proprietor’s use of SPINNING, print-outs from the Internet and Google, references to various for a where SPINNING is used.

The Office has reviewed the documentation material submitted by the proprietor in this case, and the material shows undoubtedly that the word SPINNING has been used by others than the proprietor. The Office finds that in some parts of the material, it is unclear whether the use is merely descriptive. See for instance the examples below:

<p><b>Spinning</b> . . . . .</p> <p><i>Indoor cycling, good exercise, great music and loads of sweat with no steep hills, headwind or rain.</i></p> <p>Are you into the latest trends? SPINNING is hot! Fantastic training for your blood circulation. A one-hour SPINNING class equals a long bicycle ride incorporating various degrees of complexity.</p> <p><b>Target group:</b> The course is for people interested in learning more about this new sport, and for people who want to take SPINNING classes. If you want to become a SPINNING instructor, this course is for you. On Saturday, we will look at both the theoretical and practical sides of this sport.</p> <p><b>Spinning in Hobro Helse Sport</b></p>	
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Other parts of the material shows that SPINNING to some extent is viewed and used as a designation of a generic form of exercise, e.g.:

<p><b>Which spinning technique is the best?</b></p> <p><b>ASK US:</b> I have noticed during spinning classes that the way people pedal is very different.....</p>
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SSK SPINNING MARATHON 2009



Do you dare take the challenge?

SPINNING 2010

It is time for spinning again ...

The Office has also reviewed the documentation material submitted in the matter in order to determine to what extent the proprietor should have used SPINNING as a generic term. The applicant has referred to the website [www.spinning.com](http://www.spinning.com), where the proprietor allegedly uses the mark in a generically descriptive manner. The applicant refers to the fact that the proprietor writes as follows at the website:

*"SPINNING® is the original and most popular kind of indoor cycling"*

*"the respected Spinning ® name and logo may only be used by an Official Spinning ® Centre"*

The Office finds that the examples given do not - as alleged by the applicant - constitute generic use but rather regular use under trademark law. Thus it clearly appears that it is a trademark, and that there is a right to use the trademark.

Equally, the remaining parts of the material submitted in relation to this case do not show examples of generic use of SPINNING by the proprietor. On the other hand, the proprietor has submitted quite a lot of material demonstrating that the proprietor and its Danish distributor have used SPINNING as a trademark.

Against this background, the Office finds that nothing in the documentation material submitted in this matter shows that the proprietor uses SPINNING as a generic term.

As regards the issue of potential degeneration of the mark SPINNING, it must also be assessed whether the proprietor has acted in an inactive manner, and that the proprietor therefore is to blame for such potential degeneration. As mentioned above, in order to establish whether the proprietor has acted in an inactive manner, it must be taken into consideration that the proprietor has had no opportunity to prevent non-commercial use.

Initially, the Office wishes to emphasize that both the proprietor and the applicant agree that the trademark SPINNING is no longer used by the 10 largest fitness chains in Denmark, e.g. SATS, FITNESS WORLD, EQUINOX and FITNESS.DK, and that this is a consequence of the proprietor's

acts prior to the submission of the request for an administrative revocation. This is deduced from the applicant's letter of 18 March 2011 and the proprietor's letter of 18 July 2011 and is furthermore substantiated by exhibits AC, AD and AE.

The proprietor's exhibits J-Å and exhibits AA, AB, AC, AD, AE, AF, AG, AH, AI and AJ all show that the proprietor has requested that others who use the trademark SPINNING discontinue such use. Furthermore, the documents show that the proprietor has protested against various media's incorrect use of the trademark SPINNING. The exhibits cover the years 1995, 2005, 2006, 2007, 2008, 2009, 2010 and 2011.

The proprietor has also submitted documentation dated after the submission of the request for an administrative revocation, including several correspondences with various dictionaries etc. The Office has - in the light of the dates - attached no decisive importance to this material in the assessment of whether the proprietor has remained inactive under section 28(2)(2) of the Danish Trade Marks Act, however, the material serves to prove a certain continuity in the proprietor's attempts to stop wrongful or incorrect use of the trademark SPINNING.

Against this background, the Office finds that the proprietor has contributed towards no degeneration, neither through its own use nor through inactivity. On the contrary, the material shows that the proprietor to a wide extent has reacted to wrongful use by third parties.

In conclusion, the Office therefore finds that the proprietor's mark cannot be revoked in pursuance of section 28(2)(2) of the Danish Trade Marks Act, regardless of whether certain parts of the documentation material shows use by a third party of the mark as designation of a generic type of exercise, as this cannot be attributed to the proprietor's business or inactivity.

The registration is therefore maintained in its entirety.

This decision is passed in pursuance of section 28(2)(2) of the Danish Trade Marks Act.

Høje Taastrup, 15 November 2012

**Tom Petersen**

**Legal consultant, Trademarks/Design, Master of Laws**