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TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION UNDER NO 2618238
IN THE NAME OF UPDATA INFRASTRUCTURE UK LTD

AND

OPPOSITION THERETO UNDER NO 103930 BY UPDATA LTD

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I write following the Case Management Conference (“CMC”), which took place before me on 14 June 2013. Mr Linton represented the opponent, Mr Murphy of TMT Legal, represented the applicant. Given Mr Linton’s reply to my question indicating that he had not previously attended a CMC, I briefly explained the procedure to both parties.

Having reviewed all of the papers before me and heard submissions from both parties, I determined that the opposition would be struck out. This letter sets out my reasons for so doing.

Notice of opposition was filed by the opponent on 9 October 2012. Opposition was sought under grounds founded on sections 5(2)(b), 5(3) and 5(4) of the Trade Marks Act 1994. In support of the objections under sections 5(2) and 5(3), the opponent relied on its earlier trade mark No 1481681. In respect of the objection under section 5(4) of the Act, the opponent relied on use of the unregistered trade mark Updata which it claimed had been use in relation to the provision of “Software, Computer Services, Internet and data Services”.

Attached to the notice of opposition was, I believe, a brochure. In a letter dated 19 October 2012, the Registrar acknowledged receipt of the notice of opposition but returned the attachment to the opponent. The letter advised the opponent that if it wished to file such material to support its case, it should file it at the appropriate time and in the correct format i.e. under cover of a witness statement, affidavit or statutory declaration in line with section 69 of the Act and rule 64(1)(a) of the associated rules. This means that material which is filed in any other manner will not be regarded as ‘evidence’ and will not be taken into account. The letter further advised that a period for the filing of opponent’s evidence would be provided at a later point in the proceedings.

The applicant filed a counterstatement which was subsequently amended and in which, in line with the provisions of section 6A of the Act, it requested that the opponent prove use of the earlier mark it relied upon. As I explained, this means that the opponent has to show, through the filing of evidence, what use has been made of its trade mark in order to support the objections made under section 5(2) and 5(3) of the Act. In relation to the objection under section 5(4) of the Act, the opponent has to prove, in the first instance, that it has goodwill under the right or sign relied upon which, again, is something that can only be established by the filing of suitable evidence.

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A period for the filing of the opponent's evidence was set and expired on 23 January 2013. On that date, submissions and a witness statement were received from the opponent. The witness statement was that of David Linton. The witness statement made references to trade marks not the subject of these proceedings. It also gave details of the opponent's website address but did not exhibit any material e.g. in the form of print outs from that website. There were two exhibits attached to the witness statement. The first is a copy of an email sent on 9 November 2012 from a Michelle Robinson from a named junior school requesting an electronic copy of a presentation she had attended. The subject of the email is given as "PSN For Buckinghamshire Schools" and it shows it was sent to "Updata TA" but it is otherwise silent as to parties or trade marks. The second exhibit is an extract from the Wikipedia website showing a partial extract headed "Updata". It is not dated and appears to relate to the applicant company.

Mr Linton states in his witness statement that his company is "well known for its services in the computer industry in relation to the provision of information", that it "provides software, data services and educational courses" and that its "staff run educational training courses and members of Updata staff lecture at UK universities including the London School of Economics" but gives no information of the marks under which these services may have been supplied or when, or any other evidence which in any way supports these claims. Mr Linton refers the reader to the company's website "for further information".

That witness statement was admitted into the proceedings but, by way of a letter dated 31 January 2013, the opponent was advised that its acceptance "should not be taken as an indication that it will be given sufficient weight to prove the opponent's case". Furthermore, the letter advised that no research about the opponent's company would be undertaken e.g. by reviewing websites and that any information that a party wishes to have taken into account must be filed by way of evidence i.e. included in or as an exhibit to a witness statement, statutory declaration or affidavit.

The opponent was given 7 days to confirm whether its evidence was complete or not and was also advised that if it wished to file more evidence, given that the period for filing of its evidence had already expired, it should file a request by way of Form TM9 seeking a retrospective extension of time for doing so. No request for any extension of time was received, nor was any further evidence filed. Indeed no response to that letter was received.

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As nothing further was heard from the opponent, a period was set for the applicant to file its evidence or written submissions. In the event, it filed written submissions. As the applicant had not filed any evidence of fact, the parties were advised by way of a letter dated 16 April 2013 that the evidence rounds were complete and the proceedings were ready to be determined. Before arrangements were made for that to be done, however, a further letter was received from the opponent. The letter, somewhat confusingly, bore two dates: 9 May 2013 and 14 February 2013. The letter was received by fax on 9 May and acknowledged the receipt of the applicant's submissions received 14 April and therefore I take it that the reference to the February date was included in error. The letter included the following:

“we hereby notify the Registry that we intend to file further evidence of fact in reply within the next 30 days”.

In an official letter dated 14 May, the parties were advised that, given the applicant had not itself filed any evidence, there was nothing to which the opponent could reply. In response, the opponent filed another letter which also bore two dates (14 February 2013 and 17 May 2013) and again, I assume that the earlier date was included in error. This letter indicated that the opponent had misread earlier letters and requested to be allowed to file evidence. At this point, the CMC was arranged.

At the CMC, Mr Linton accepted that the official letter of 31 January had clearly advised what was required of the opponent and also accepted that the opponent had made no response to that letter. Despite being given the opportunity, he did not give any explanation for this failure to respond. Other than Mr Linton's witness statement, no evidence had been filed. He accepted that his witness statement had not included any evidence of use of his company's mark relied on in these proceedings. Mr Linton gave no indication that any attempts to prepare additional evidence or specific evidence of use had been made nor did he give any indication of why this was so. He accepted that the letter of 19 October had advised the opponent of the need to file evidence of use at the allotted time and in the prescribed way and further accepted that the opponent had failed to file any such evidence. He did not give any explanation for this lack of action and did not request or give any reasons to support a request to be allowed to file any other evidence.

As I indicated above, the applicant put the opponent to proof of use of its mark. Section 100 of the Act is relevant and reads:

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“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

The leading authorities on the principles to be applied in determining whether there has been genuine use of a trade mark are: *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. The general principles were summarised by the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd (Sant Ambroeus Trade Mark)* [2010] RPC 28 as follows:

“(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark,

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including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06, the GC stated:

“32 To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned in order to maintain or create a share in the market for the goods or services protected by the mark (*VITAFRUIT*, paragraph 27 above, paragraph 42, and *LA MER*, paragraph 26 above, paragraph 57; see, by analogy, *Ansul*, paragraph 24 above, paragraph 39, and the order in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 21).”

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There is, therefore, no de minimis level of use to establish genuine use (also see inter alia *Sonia Rykiel création et diffusion de modèles v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-131/06* and *The*

Sunrider Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-416/04 P). In *Ajax Brandbeveiliging BV v Ansul BV Case C-40/01* the Court of Justice of the European Union (CJEU) held that it is necessary to establish whether the 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 the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark”.

In *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-234/06 P* the CJEU stated:

“73 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The frequency or regularity of the use of the trade mark is one of the factors which may be taken into account (see *Sunrider v OHIM*, paragraph 71; see also, to that effect, *La Mer Technology*, paragraph 22).”

I also note the case of *MFE Marienfelde GmbH v OHIM (HIPOVITON) Case T-334/01* where it was stated:

“37. However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness.”

As indicated above, the opponent filed a single witness statement. That statement was given and signed by Mr Linton who accepted that it did not contain any evidence of use of the earlier trade mark or earlier right relied on in these proceedings. No Form TM9 seeking an extension of time for filing such evidence had been sought and, even if one had been filed, no reasons have been provided which would have justified its grant. Absent the filing of evidence of use of the marks relied upon, the grounds of opposition founded on sections 5(2)(b), 5(3) and 5(4)(a) of the Act were struck out.

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As there are no other grounds of opposition, the opposition must fail.

As the opposition has failed, the applicant is entitled to an award of costs. Despite the somewhat unusual nature of the CMC and the findings that flow therefrom, there is nothing in these proceedings which suggest to me that the applicant will have incurred anything other than the usual costs. Its involvement has been limited to filing a counterstatement (subsequently amended) and, relatively brief, written submissions along with attendance at a short CMC. In such circumstances, I do not consider it reasonable or proportionate to invite specific submissions on costs but will make an award to the applicant in the sum of £500 as a contribution to towards its costs.

I order Updata Limited to pay Updata Intrastructure Limited the sum of £500. This sum is to be paid within seven days days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of July 2013

Ann Corbett
For the Registrar
The Comptroller-General