

O-572-16

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**APPLICATION NOS 501044 and 501045 BY
ABANCA CORPORACIÓN BANCARIA, S.A.**

**TO REVOKE THE PROTECTION IN THE UK OF INTERNATIONAL
TRADE MARK REGISTRATION NOS 860632 AND 860561**

ABANKA

AND

ABANKA

OWNED BY ABANKA d.d.

AND

**THE REQUEST FOR PROTECTION OF INTERNATIONAL TRADE MARK
NO 1243627**

//ABANCA

IN THE NAME OF ABANCA CORPORACIÓN BANCARIA, S.A.

AND THE OPPOSITION THERETO UNDER NO. 405507 BY ABANKA d.d.

Background and pleadings

1. **ABANKA** and **ABANKA** are international trade mark registrations (numbers 860632 and 860561, respectively) in classes 35, 36 and 38, owned by ABANKA d.d. (“the proprietor”). The marks have been protected in the UK since they completed their registration procedures on 17 March and 24 March 2006, respectively. Their specifications are shown in the annex to this decision.

2. On 12 November 2015, ABANCA CORPORACIÓN BANCARIA, S.A. (“the applicant”) applied to revoke the protection of the registrations in the UK under section 46(1)(b) of the Trade Marks Act 1994 (“the Act”) on the grounds that they had not been put to genuine use between 7 May 2009 and 6 May 2014 and between 11 November 2010 and 10 November 2015, with effective revocation dates of 7 May 2014 or, alternatively, 11 November 2015. These pleadings are identical for the two non-use applications. The applicant notified the proprietor of its intention to seek revocation in the UK on 29 September 2015.

3. The proprietor filed defences and counterstatements in which it denies the grounds, stating that the marks have been in continuous use during the periods at issue.

4. The applicant also filed a request for protection in the UK of international trade

mark registration, 1243627, **//ABANCA**, on 2 October 2014, claiming priority in Spain from 8 May 2014, in classes 9, 16, 35, 36, 38, 40, 41, 42 and 45, published in the UK on 21 August 2015. The specification is shown in the annex to this decision. The proprietor opposes the request for protection in classes 9, 16, 35, 36 and 38 under section 5(2)(b) of the Act, claiming a likelihood of confusion with its earlier marks which are the subjects of the applications for revocation. The applicant denies the grounds, referring to its requests for proof of use and its applications for revocation of the earlier marks.

5. The proceedings were consolidated. The proprietor filed evidence, and the applicant filed written submissions. The matter came to be heard by video conference on 16 November 2016. Dr Duncan Curley of Innovate Legal Services Limited represented the proprietor, and Mr Tom Alkin of Counsel, instructed by Bear & Wolf IP LLP, represented the applicant. In its skeleton argument, the proprietor provided an unconditional restriction to the services in relation to which it claims it has made genuine use of its marks.

Relevant dates

6. The relevant dates for the applications for revocation are 7 May 2009 to 6 May 2014 and 11 November 2010 to 10 November 2015, with effective dates of 7 May 2014 or 11 November 2015. The relevant dates for proof of use are 22 August 2010 to 21 August 2015, under section 6A of the Act. The relevant date for consideration of the section 5(2)(b) ground is the priority date of international registration 1243627, which is 8 May 2014.

7. The interplay between the claimed revocation dates, 7 May 2014 and 11 November 2015 and the priority date of 8 May 2014, has a bearing on the effect of potential revocation and whether it will mean that the earlier marks, should they be revoked, can still be relied upon in the opposition. If revocation takes effect from 11 November 2015, the earlier marks would still have been in force on the applicant's priority date of 8 May 2014 and revocation would not have affected their validity as earlier marks for the opposition. However, if revocation takes effect from 7 May 2014, the proprietor's marks would not have been in force on 8 May 2014 and therefore cannot be relied upon as earlier marks for the opposition¹. I will look firstly at the revocation applications but, for these reasons, it may still be necessary to look at the proof of use requests and the opposition, depending on the outcome of the revocation applications.

¹ See the decision of Professor Ruth Annand, sitting as the Appointed Person in *Tax Assist*, BL O/220/12.

Proprietor's evidence

8. The proprietor is required to demonstrate genuine use in respect of the services shown in the annex to this decision. The evidence shows that the proprietor is a Slovenian bank. The following evidence summary does not include references to evidence which was not relied upon by Dr Curley at the hearing.

9. Evidence has been filed by Barbka Krumberger, who is the proprietor's Legal Advisor. Ms Krumberger exhibits² correspondence with UK-based entities regarding advanced payment guarantees, dated 13 May 2010, 28 December 2010, 20 May 2011, 29 June 2011 and 8 November 2011. An example is shown here:

ABANKA

ABANKA VIPA d. d. Slovenska 58, 1517 Ljubljana, Slovenija
T +386 1 47 18 100
F +386 1 47 18 492
Telex: 31 228 ABANKASL SWIFT: ABANSI2X
www.abanka.si Ljubljana, 13.05.2010

Manchester
Great Britain

Payment Guarantee No.: [REDACTED] for EUR [REDACTED]

We have been informed that you have concluded a Trade Agreement 2010 (hereinafter called 'the Contract') with Messrs. [REDACTED] Slovenija (hereinafter called: 'the Principal') for the continuous supply of:

1. WORKWEAR: Mascot workwear Young, Mascot Hardwear, Mascot Frontline, Mascot image light, safe image, Mascot basic and classic
2. WINTER WORKWEAR: Underwear, Winter workwear
3. MASCOT AQUA: Rainwear
4. MASCOT COMPLETE: Accessories
5. MASCOT FOOTWEAR: Safety footwear.

Furthermore we understand that according to this Contract, payment of the goods supplied, up to [REDACTED] shall be secured by a bank guarantee.

At the request of the Principal, we, ABANKA VIPA d.d., Slovenska cesta 58, SI-1517 Ljubljana, Slovenija, irrespective of the validity and the legal effects of the above mentioned Contract and waiving all rights of objection and defense arising from the principal debt, hereby irrevocably undertake to pay to you, upon your first demand, any amount up to [REDACTED] (in full letters: [REDACTED])

upon receipt of your written request for payment and your written statement stating that:

- a) you have supplied the Principal with the goods ordered in conformity with the terms of the Contract, and
- b) the Principal is in breach of his contractual payment obligations as you [REDACTED], Great Britain, have not received payment from the Principal, at the due date, i.e. at 60 (sixty) days after the shipment date, in the amount claimed under this guarantee.

Your written request for payment and your written statement have to be accompanied by a copy of unpaid invoice(s) indicating above described goods and that its payment is secured by Payment Guarantee No.: [REDACTED] a copy of Principal's order clearly related to the unpaid invoice and a copy of roadway bill (CMR), consigned to the Principal.

ABANKA VIPA d.d.

[Signature]

Company name and Registered office: ABANKA VIPA d.d., Slovenska 58, 1517 Ljubljana, Slovenija
The bank is legally registered with the District Court in Ljubljana under Reg. No.: 14032900,
Kriminalni sodnik: 30345/07/2010 EUR, Osn. No.: 5025024, Identification Number For VAT: S68297320

² Exhibit BRK1

10. Ms Krumberger states that the proprietor has issued cheques to various entities in the UK in both relevant periods. She states that the cheques are issued based on the order of a Slovenian company or a natural person, and the payment is made from their account with the proprietor to the account of the receiving party. The cheques are then sent to the UK entity, which then cashes the cheque with their own bank. Ms Krumberger states that there were 79 such cheques issued between 2010 and 2014, and two examples are shown in Exhibit BRK2 from the second relevant period. One is shown here:

ABANKA ABANKA VIPA D.D. Slovenska 58 1517 Ljubljana / Slovenia 58/S0	ABANKA	Ljubljana 28 th Jan. 2014
THE ECONOMIST NEWSPAPER LTD. PO BOX 471 HAYWARDS HEAT RH15 3GY UNITED KINGDOM	DEAR SIRS, PLEASE FIND BELOW CHEQUE N°	0017203 2500018130
FOR THE SUM OF <u>EUR 165,00</u>		
BY ORDER OF <u>FRANCE [REDACTED], K [REDACTED] 11, 1000 LJUBLJANA</u>		
BENEFICIARY <u>yourselves</u>		
DETAILS OF PAYMENT <u>payment for Economist (1 year at EUR 138,00 save 53%)</u>		

11. The proprietor's website address is abanka.si. Screenshots are provided at Exhibit BRK3 from within both relevant periods, taken from the Internet Archive (Wayback Machine). Ms Krumberger explains that the prints show the translated version (into English) of the website, accessible to UK users. There are links shown on the prints to personal and corporate banking. Ms Krumberger states that the English version of the website was accessed from users in the UK approximately 2600 times in 2013, 5600 times in 2014, and 6300 times in 2015.

12. Exhibit BRK4 concerns the issuing of credit and debit cards, which bear the mark ABANKA. This exhibit contains representations of cards, and an anonymized listing of cards provided to 83 UK customers. Exhibit BRK5 consists of a table of anonymized data showing transactions made with ABANKA cards in the UK during

both relevant periods. The figures Ms Krumberger gives are that there were at least 1,899,968 transactions, totalling more than 56,800,000 Euros.

13. Exhibit BRK9 consists of a press release screenshot, dated 4 December 2009, concerning the award given to the proprietor's predecessor (Abanka Vipava d.d.) for being Slovenia's Bank of the Year. The award was given by the UK magazine "The Banker". The award ceremony was held on 3 December 2009, in London.

14. Exhibit BRK10 consists of documents relating to the listing of the proprietor on the London Stock Exchange from 2009 to 2012. These comprise an information memorandum, a London Stock Exchange application form dated September 2009, a notice dated 29 December 2011, a bond payment dated 19 September 2012, examples of invoices issued by the London Stock Exchange in April and September 2012, and examples of individual deals.

15. Ms Krumberger filed a second witness statement to answer criticisms made by the applicant in its written submissions. The key points from her second statement are:

- Within the period 1 January 2010 to 31 December 2015, the proprietor has had 117 active clients resident in the UK, 43 of whom use the proprietor's online banking service accessed from the website.
- The list of transactions refers to transactions made with UK-based vendors, including purchases where the buyers were physically present, and ATM withdrawals from banks in the UK.
- Three UK-based financial institutions took part in the purchase of the bonds following the London Stock Exchange listing, with total investment amounting to 1.1 million Euros.

Revocation decision

16. Section 46 of the Act states:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that

paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that——

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) 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——

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

17. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

[218] ...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the

evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

18. The onus is on the proprietor to show use because Section 100 of the Act states:

“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.”

19. Mr Alkin submitted that the evidence provided by a proprietor must, given the burden, be taken as being the best evidence that the proprietor can show. In *Plymouth Life Centre, O/236/13* Mr Daniel Alexander QC, sitting as the appointed person, observed that:

“20. Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time to review the material that it has to prove use of it.

...

The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

20. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller-General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes

be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

21. The proprietor’s evidence can be grouped into six categories:

- (i) the advanced payment guarantees
- (ii) the cheques
- (iii) the website
- (iv) the credit and debit cards
- (v) the press release about the award
- (vi) the flotation on the London Stock Exchange

22. It is important to remember that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself³. I also bear in mind that the genuine use provision is not there to assess economic success or large-scale

³ Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”)* General Court (“GC”).

commercial use⁴, and 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. An assessment as to whether there has been real commercial exploitation therefore includes consideration as to the nature of the goods or services and the characteristics of the market concerned.

23. Dr Curley submitted that the advanced payment guarantees represent paradigm use of the trade marks because the proprietor is giving a guarantee of payment on behalf of one of its customers, to a third party in the UK. The trade marks appear on the guarantee, thereby guaranteeing the origin of the service in the UK. Mr Alkin submitted that this did not show either UK custom or a customer in the UK. The service is one that is provided to the proprietor's customer in Slovenia, in order to facilitate trade between the Slovenian customer and a third party in the UK. Similar submissions were made about the cheques. Dr Curley considered that the cheques are relied upon by UK-based entities which accept the cheques and cash them in their own banks, thereby relying upon the ABANKA trade marks as guarantees of origin and therefore of payment. Conversely, Mr Alkin submitted that the cheques are a service provided to a customer of the proprietor in Slovenia; e.g. when a cheque is made out to *The Economist* (exhibit BRK2). This is not a transaction with the magazine, but, instead, is a service provided to the Slovenian customer so that they can subscribe to the UK magazine. There is no meaningful reliance by *The Economist* on the fact that the cheque has ABANKA upon it; there is no guarantee of payment associated with the trade marks.

24. Mr Alkin referred to *Starbucks (HK) & Anor v British Sky Broadcasting Group PLC & Ors* [2015] UKSC 31 and to the decision of Professor Phillip Johnson, sitting as the Appointed Person, in *Johnny Rockets* (BL O/240/16) E.T.M.R. 37. Both of these cases concern territorial use of trade marks.

25. Mr Alkin's points were that for there to be goodwill in the UK, there must be customers in the UK; i.e. there must be commercial transactions with customers in

⁴ GC, Case T-334/01 *MFE Marienfelde GmbH v OHIM*.

the UK, and the same principle must be satisfied when assessing genuine use in the UK. He quoted the following from *Johnny Rockets*:

“The internet cases

27. There has been significant consideration by the courts as to whether the use of a mark on a foreign website (or in a foreign publication) is targeting the United Kingdom: see C-324/09 *L'Oréal SA v eBay International AG* [2011] ECR I-6011; [2011] RPC 27, at paragraph 61-65 (and the discussion in *Stichting BDO & Ors v BDO Unibank, Inc & Ors* [2013] EWHC 418 (Ch), paragraph 101 to 109). This line of cases, however, does not assist. A sale aboard a foreign ship in United Kingdom territorial waters is, at least geographically, a sale within the extent and application of the 1994 Act. The idea of “targeting” does not really affect this determination.

British customers

28. Before the Hearing Officer, the Appellant made the point that a not insignificant number of people from the United Kingdom will use the restaurant (see Decision, paragraph 17). In *Starbucks (HK) Ltd & Anor v British Sky Broadcasting Group PLC & Ors* [2015] UKSC 31, in discussing the creation of goodwill in the United Kingdom for the purposes of passing off, the Supreme Court said at paragraph 52:

The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant. ..

29. While the test for genuine use is different from that for establishing goodwill for the purposes of passing off, the central principle is the same. If customers buy services in the United Kingdom, which they enjoy outside the United Kingdom, such as hotel services, this is might be use in the United Kingdom. This point seems to have been taken for granted by the Court of Appeal in *Thomson Holidays Ltd. v Norwegian Cruise Line Ltd* [2002] EWCA Civ 1828 (more recently, see the decision of the registrar in *Raffles* (O/134/15) which is currently under appeal). Whether a dinner reservation made in the United Kingdom for a restaurant outside the United Kingdom is sufficient to be genuine use is more difficult. I am doubtful, for example, that a customer ringing from her home in London for a reservation at her favourite restaurant in New York would be sufficient in itself. What is clear is that however many thousands of British tourists visit a famous restaurant in New York, sales to those customers will never amount to use in the United Kingdom unless the particular commercial arrangement began in some way when the customer was in the United Kingdom.”

26. Paragraph 27 of the above quotation refers to the territorial significance of websites. In joined Cases C-585/08 and C-144/09, *Pammer v Reederei Karl Schlüter GmbH & Co. KG and Hotel Alpenhof GesmbH v Heller*, the CJEU interpreted the national court as asking, in essence, “*on the basis of what criteria a trader whose activity is presented on its website or on that of an intermediary can be considered to be ‘directing’ its activity to the Member State of the consumer’s domicile ..., and second, whether the fact that those sites can be consulted on the internet is sufficient for that activity to be regarded as such*”. The court held that it was not sufficient for this purpose that a website was accessible from the consumer’s Member State. Rather, “*the trader must have manifested its intention to establish commercial relations with consumers from one or more other Member States, including that of the consumer’s domicile*”. In making this assessment national courts had to evaluate “*all clear expressions of the intention to solicit the custom of that state’s customers*”. Such a clear expression could include actual mention of the fact that it is offering its services or goods “*in one or more Member*

States designated by name” or payments to “the operator of a search engine in order to facilitate access to the trader’s site by consumers domiciled in various member states”. Finally, the court concluded:

“The following matters, the list of which is not exhaustive, are capable of constituting evidence from which it may be concluded that the trader’s activity is directed to the Member State of the consumer’s domicile, namely the international nature of the activity, mention of itineraries from other Member States for going to the place where the trader is established, use of a language or a currency other than the language or currency generally used in the Member State in which the trader is established with the possibility of making and confirming the reservation in that other language, mention of telephone numbers with an international code, outlay of expenditure on an internet referencing service in order to facilitate access to the trader’s site or that of its intermediary by consumers domiciled in other Member States, use of a top-level domain name other than that of the Member State in which the trader is established, and mention of an international clientele composed of customers domiciled in various Member States. It is for the national courts to ascertain whether such evidence exists.”

27. The proprietor’s evidence shows that it has an English-language version of its website, which includes links to e.g. its personal and corporate banking services. Dr Curley submitted that the evidence shows that the English-language version of the website had been accessed by UK-resident clients of the proprietor using its online banking services. He said that there is no requirement that the users of the website, in the UK, must be UK nationals: it makes no difference whether they are Slovenian, or whether the bank accounts were opened in Slovenia. Mr Alkin agreed that the website is accessible from the UK, but maintained that this is not enough to show genuine use. He submitted that English is the international language of the West and so the mere fact that a section of it is available in English is not evidence that the website is targeted at UK customers. Further, Mr Alkin submitted that the customer opens the account in Slovenia, but then when in the UK remotely accesses

the bank's services via the website. Therefore, there is no transaction in the UK: the commercial relationship began in Slovenia.

28. The credit and debit cards, which bear the trade marks, are used by the proprietor's customers who are resident in the UK. Mr Alkin submitted that the point is the same as for the website; there is no evidence that the customers opened the account from the UK. Dr Curley submitted that the fact that the cards were sent to customers who are resident in the UK is evidence of genuine use in the UK. As with the cheques, they guarantee the origin of the service because the cards bear the trade marks.

29. In relation to the evidence showing use of the cards in the UK, Mr Alkin's position was that the figures given in the evidence about transactions (1,899,968 to the value of 56,800,000 Euros) are not tied to the 80 cards which were issued. There is no evidence showing that the 80 card holders were responsible for all, or any, of these transactions. He interpreted the evidence as showing that the transactions were undertaken by Slovenian customers (i.e. resident in Slovenia) who had travelled to the UK and used the cards whilst in the UK. As support for this contention, Mr Alkin pointed out that 56,800,000 Euros would, otherwise, be a large (and, therefore, unlikely) amount for 80 cardholders to spend.

30. Dr Curley submitted that the London Stock Exchange memorandum was evidence going to the services of 'recovering all kinds of monetary contributions and raising capital'. The marks would have been visible not only to those who bought bonds, but also to those who read the information but did not invest. Mr Alkin submitted that the memorandum, and other associated stock exchange evidence, merely showed the proprietor attempting to raise funds for itself, not providing a service to others.

31. As accepted by the applicant, the registered trade marks have, occasionally, been visible in the UK. However, this does not necessarily equate to genuine use. For example, the press release simply reports that the proprietor has won an award for being the Bank of the Year in Slovenia, in 2009 (right at the start of the first

relevant period). The press release does not refer to expansion elsewhere; the proprietor is a bank in Slovenia. Without other evidence which also ties the trade marks to use in the UK in order to create or preserve market share in the banking sector, this piece of evidence does not support the proprietor's defence.

32. Occasional visibility is, essentially, how Mr Alkin characterises the evidence. Dr Curley cautioned against adopting a *de minimis* test. He is correct in that. Minimal use may qualify if it is deemed to be justified in the economic sector concerned. The CJEU has also said, in *Reber*, that it is not the case that every proven commercial use of a mark may automatically be deemed to constitute genuine use. The evidence, as a whole, must present a picture of real commercial exploitation of the mark, which includes whether the use is warranted in the economic sector concerned to maintain or create a share in the market.

33. The present case is concerned with the UK banking sector. This is, self-evidently, a huge market. The proprietor is best placed to show evidence that, in the relevant periods, it was engaged in maintaining or creating a share in that market. However, the evidence which it has provided is patchy. For instance, the 80 card owners in the UK are not matched to the transactions, presumably because they are not, in fact, transactions wholly made by the UK card holders. If they were, the level of spend would be surprisingly large. Therefore, the transaction evidence has little, if any, relevance because it is impossible to know the proportion of it which relates to the UK card holders. The debit and credit card evidence comes down to 80 holders over 6 years. This is a vanishingly small amount of business in the sector concerned and begs the question as to how the proprietor has commercially engaged with those 80, and why there are not more than 80 card holders.

34. The answer to that question lies in the picture which emerges from the rest of the evidence. I have already mentioned the press release which refers to the proprietor as being the best bank in Slovenia (only). The flotation on the London Stock Exchange was to raise funds for the proprietor itself. The final page of the memorandum states that the proprietor derives its information for the memorandum from the Republic of Slovenia, the Slovenian banking market and its competitors.

These two pieces of evidence place the proprietor's business as being in Slovenia, rather than truly international (i.e. having a commercial presence) in other countries. All banks enable their customers to transact internationally, but that does not mean that they have a share in the international banking market. A customer using a debit or credit card abroad does not mean that the 'home' bank has a presence on the banking market wherever the card is used.

35. A good illustration of this point is the evidence and submissions relating to the advanced payment guarantees. These are sent by the proprietor in Slovenia to an entity in the UK, reporting that the UK entity has concluded a trade agreement with a party in Slovenia, "the Principal". The first guarantee in Exhibit BR1 states:

"At the request of the Principal, we, ABANKA VIPA d.d., Slovenska cesta 58, SL-1517 Ljubljana, Slovenija Hereby irrevocably undertake to pay to you, upon your first demand..."

This shows only that the provision of bank guarantees was a service provided to a banking customer in Slovenia by the proprietor. The service is not provided to the UK entity, which cannot even be termed as an end consumer. The consumer is the bank's customer in Slovenia. Similarly, I agree with Mr Alkin that the cheques are a service provided to a customer of the proprietor in Slovenia; a cheque is made out to a third party in the UK, but there is no meaningful reliance by the third party on the fact that the cheque has ABANKA upon it; there is no guarantee of payment associated with the trade marks. Neither the advanced payment guarantees nor the cheques show that the proprietor has engaged in real commercial exploitation of the marks, as warranted in the UK banking sector to maintain or create a share in the UK banking market.

36. The press release, cheque and payment guarantee evidence all points to a picture of a Slovenian bank providing services to its customers in Slovenia, where the commercial relationship is formed. This reinforces my view that the number of the proprietor's credit card holders resident in the UK is tiny because they are, in fact, Slovenians who have settled (whether permanently or temporarily) in the UK

and who continue to place their custom with the bank they used in Slovenia. Even if I am wrong about that, there were only 117 customers of the proprietor in the UK, and only 43 of those used the online banking service. This is an extremely small part of the UK market for banking services, online or otherwise. The evidence does not actually state that those 43 people used the English-language version of the website; they may have used the Slovenian version. These extremely low customer figures do little to support any claim that the English-language version of the website is an attempt to target UK consumers in what is such a large market. Just as it would be wrong to conflate the 1,899,968 credit card transactions as belonging to the 80 card holders, so too would it be wrong to conflate the English language website visit figures with either the 117 or the 43 customers.

37. Standing back from the evidence and looking at it in the round, despite there being some UK visibility of ABANKA, the evidence does not show me that the marks have been used in the UK banking sector for creating or preserving a share in that market. The proprietor has not shown that there was genuine use in the UK during the relevant periods. The international registrations are revoked in the UK.

Revocation outcomes

38. The outcome is that international registration numbers 860632 and 860561 are revoked in the UK with effect from 7 May 2014.

The opposition

39. Section 6A of the Act provides:

“(1) This section applies where—

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if—

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes—

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects—

- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or
- (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration)."

40. The proof of use dates differ slightly from the revocation dates in that the relevant period is 22 August 2010 to 21 August 2015. This date range is covered by the two revocation periods. Consequently, it follows that my decision in relation to the revocation applications must also apply to proof of use in the opposition. There was no genuine use of the marks within the relevant periods. The proprietor may not, therefore, rely upon its international registrations as earlier marks for the purposes of its opposition.

Overall outcome

41. Registration numbers 860632 and 860561 are revoked in the UK with effect from 7 May 2014, which predates the applicant's priority date (by one day). The International Bureau will be notified in accordance with paragraph 4 of Schedule 5 to the Trade Marks (International Registration) Order 2008. The opposition fails. Subject to appeal, the applicant's request for protection in the UK of international registration 1243627 is granted.

Costs

42. The applicant has been successful. Bearing in mind the consolidation, which will have reduced costs⁵, I order ABANKA d.d. to pay ABANCA CORPORACIÓN BANCARIA, S.A. the sum of £2300 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period. This sum is calculated as follows:

⁵ As per the scale set out in Tribunal Practice Notice 4/2007.

Official fee for forms TM26(N) (x2)	£400
Filing the revocation applications and considering the counterstatements	£400
Considering the opposition and filing a counterstatement	£200
Considering evidence and filing written submissions	£600
Preparing for and attending a hearing	£700
Total	£2300

Dated this 6th day of December 2016

Judi Pike
For the Registrar,
the Comptroller-General

Annex

The international registrations:

Class 35: Import-export agencies, commercial information agencies, rental of office machines and apparatus, preparation of statistical information, bookkeeping and accounting, drawing up of statements of accounts, auditing, business administration and office functions, preparation of tax returns, professional business consultancy, namely consultancy and mediation services relating to the purchase and sale of companies and other organizations on domestic and foreign markets, advisory services for business management, personnel management consultancy, business management consultancy, advertising mailing, dissemination of advertising material (leaflets, prospectuses, printed matter and samples), assistance in the management of industrial and/or commercial companies, updating of advertising material, efficiency experts, auctioneering, market research, evaluations relating to commercial matters, research for business purposes, business inquiries, advertising, marketing services and public relations services, dissemination of business advertisements; public relations, television advertising, economic forecasting, cost-price analysis, business information, opinion polling, computer file management, administrative processing of data, computer management of the database (administrative services); input and output of data in standardized form for replacement by relevant applications; data entry for statistics on input; monitoring of the status on the currency transactions account; accounts monitoring; preparation of account statement for currency exchange transactions; preparation of statement of commitments for foreign payment operations; input and output of data for replacement by relevant applications.

Class 36: Banking services, namely receiving deposits and all kinds of monetary contributions from natural persons and legal entities, services relating to deposits and deposit insurance; credit and granting of credit from these deposits for third parties, including consumer credit, mortgage credit, financing commercial transactions; financing; financial sponsorship; capital investment; collecting, analyzing and providing information relating to the creditworthiness of legal entities; mediation services relating to closing loan and credit deals; guarantees and bonds markets, namely commissioning and issuing of bonds, of guarantees and of other commitments; issuing and managing of payment instruments (payment cards, credit cards and debit cards, travellers cheques, tokens of value, cashiers cheques) redemption of cheques and cashiers cheques; cheque verification; management of financial instruments used; management of foreign means of payment, including foreign exchange transactions; financial services, including financial supervision, as well as relevant information and advice; financing services; savings; financial mediation services; customs brokerage; insurance and insurance mediation services, namely in the sale of insurance policies; life insurance; deposit insurance, property insurance and personal insurance; consulting and information concerning insurance; financial evaluations (insurance, banking, real estate); services relating to foreign and domestic security issuers (deposit, purchase, sale, operations); use of pension and investment funds; raising capital; financial analysis; securities brokerage; stock exchange quotation; factoring; pledge

loan; fiduciary services and fiduciary evaluations; financial leasing; financial evaluations; financial clearing operations (exchange); tax evaluations; advice and evaluations pertaining to tax authorities; real estate and property evaluations; real estate management; leasing of real estate; housing agencies (real estate); safe custody services; safe deposit services; management of safe deposit boxes and rental of safe deposit boxes; concluding deals relating to payment operations; charitable donation collections; organization of collections; rent collection; real estate rental services; electronic banking services for natural persons and legal entities, namely receiving all kinds of monetary contributions from natural persons and legal entities, concluding deals relating to payment operations, management of foreign means of payment, issuing and taking out of credits, redemption of cheques and of cashiers cheques, issuance of securities and of credit cards, purchase, sale and management of securities from domestic and foreign issuers, commissioning and issuing of bonds and guarantees, and adopting other commitments for clients themselves, which can be met by monetary means; credit purchase and recovery; funds transfers; internal funds transfers; monitoring of the current status of transactions on an account; statement and operation of transactions accounts; electronic funds transfer; electronic financial transfers, namely transfers of funds, of currencies and of disbursements; monitoring of transfers and of inflows; monitoring of transfers being processed; currency transfer from the currency transaction account; distribution of inflows; currency transactions account operations; drawing up of currency exchange lists and business exchange lists; all the above-mentioned services being provided on-line via computing bases and via the Internet; consultancy and information relating to the above-mentioned services.

Class 38: Transmission of messages; electronic transmission of data, namely the acquisition of information on the status and operations relating to current accounts operations and transactions via mobile telephone and SMS messages; telecommunications linked to the signalling systems and/or electrical and electronic goods, namely telecommunications services via mobile telephone communication, including telecommunications via computer terminals, telephones, mobile telephones, electronic mail, facsimile, telegraphy, telex, paging services and cable transmission; computer-aided transmission of messages; transmission of data, documents and messages via computer systems having electronic or telephone interconnection; integrated service delivery of services performable via digital telephone network, namely the transmission of speech, images, texts and data; communications via mobile or fixed-line telephone; telecommunications information services; rental of telecommunications apparatus; satellite transmission; digital network telecommunications services.

The request for protection in the UK for IR 1243627:

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for conducting, switching, transforming, accumulating, regulating and controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic recording media, sound

recording disks; cash registers, calculating machines, data processing equipment and computers; fire extinguishing apparatus; computer software for data processing; data processing software; computer software for controlling and managing access to server applications; credit review software; computer programs for financial management; computer software relating to e-commerce; programs for trading via a global communication network; computer programs for providing secure transactions using credit cards; computer programs for image processing; encoded cards for use in connection with the electronic transfer of financial transactions; credit cards, smart cards, encoded cards; marketing cards (readable by encoded machine); magnetic payment cards; card readers; terminals for electronically processing payments made with credit cards; credit card terminals; electronic payment terminals; mechanisms for coin-operated apparatus; image processing apparatus; readers (hardware), downloadable electronic publications.

Class 16: Paper, cardboard; printed matter; bookbinding material; photographs; stationery; adhesives and glues for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites except furniture; instructional or teaching material except apparatus; plastic materials for packaging not included in other classes; printing type; printing blocks; publications, magazines and books; user manuals; computer hardware user guide.

Class 35: Advertising; business management; business administration; office functions; accounting; preparation of tax statements; statistical information compilation services; commercial and business statistical information; preparation of statements of accounts; marketing studies; business information; payroll preparation; economic forecasting; book-keeping; commercial information agencies; cost price analysis; business management and organization consultancy services; compilation of data in computer databases; transcription of communications; telephone answering services for unavailable subscribers; advertising mail; organization of exhibitions for commercial or advertising purposes; arranging newspaper subscriptions (for others); on-line advertising of a computer network; account auditing, sales promotion for others; retail sale and wholesale services in stores and via global computer networks; public auction sale services; advice to companies relating to strategic marketing; data bank management; call center management for others; telemarketing; consulting in connection with business strategy, marketing and operations; organization, operation and supervision of customer loyalty schemes; management and compilation of computerized databases; business risk management services; recording of written communications and data.

Class 36: Insurance services; financial business services; monetary business services; hire-purchase financing; debt collection; banking services, financial information; credit and debit card services; financial database services; processing of electronic payments carried out by means of prepaid cards; financial evaluations; financial consulting and analysis services; financial risk management.

Class 38: Telecommunication services; communication services via computer networks; provision of access to a global computer network; communications by telephone; communications by computer terminals; electronic bulletin board services [telecommunications]; delivery of messages [telegrams]; information [news] agencies; electronic messaging; agencies for electronic transmission and reception of messages, faxes, texts, files, graphics and data via computer networks and computer terminals; online visual conference and data services; electronic transmission of data and documents via telephones and computers; storage of telecommunications such as messages, faxes, texts, files, graphics and data via computer networks and computer terminals; data storage [other than physical storage].

Class 40: Printing services; image processing; magnetic encoding of credit cards.

Class 41: Education, training and entertainment services; sporting and cultural activities; conferences, exhibitions for cultural and educational purposes; seminars; congresses; organization of competitions; publication and report services; translation and interpretation; game services; audio and video production and photography; sports and fitness services; training courses; organization of cultural events (shows); ticket reservation services and contracting for recreational, sporting and cultural entertainment.

Class 42: Development of computer programs; data storage services; computer consulting; application service provider (ASP) featuring software for use in connection with customer loyalty program management; application service provider (ASP) featuring software for use in database management; application service provider (ASP), namely, hosting of software applications of others; application service provider (ASP), access via the Internet to data for transactions with credit and debit cards for use in authorization and capture; computer services; provision of security services for computer networks, access to computers and computerized transactions; data encoding and decoding services; consulting relating to application system verification; technical consultancy services relating to information technology; professional consultancy relating to technology; consultancy services relating to computer networks; professional consultancy relating to computer programs and computers; creation and maintenance of web pages for others; recovery services for irreversible computer problems; excluding services suitable for those focusing on copyrights, industrial property, intellectual property and competition law.

Class 45: Legal services; security services for the protection of property or individuals; arbitration services; copyright administration; legal research services; software licensing (legal services); provision of information relating to legal services; advisory services relating to crime prevention; undertaking services; excluding services suitable for those focusing on copyrights; industrial property, intellectual property and competition law.