

**O-385-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK REGISTRATION NOS. 1481028 & 1498716  
IN THE NAME OF SOCIETE INTERNATIONALE DE TELECOMMUNICATIONS  
AERONAUTIQUES  
FOR THE TRADEMARKS**

**SKYFORM**

**IN CLASS 09**

**&**

**SKYFORM**

**IN CLASS 38**

**AND THE APPLICATIONS FOR CANCELLATION THEREOF  
UNDER NOS. CA501238 & 501239  
BY SKY PLC**

## **BACKGROUND AND PLEADINGS**

1. Societe Internationale de Telecommunications Aeronautiques ('SITA') is the Registered Proprietor for UK Trade Mark registration nos. 1481028 and 1498716. Both are for the following trade mark:

### **SKYFORM**

2. Trade Mark no. 1481028 was registered on 2 January 2000 for the following services in Class 38:

Telecommunication services relating to the exchange of commercial information between airlines, airline manufacturers and their suppliers.

3. Trade Mark no. 1498716 was registered on 20 October 1995 for the following goods in Class 9:

Telecommunications and data processing apparatus; computer software; parts and fitting for all the aforesaid goods; all included in class 9.

4. Sky Plc ('Sky') seeks revocation of the registered marks, in full, on the grounds of non-use based on Section 46(1)(a) and (b) of the Trade Marks Act 1994 ('the Act').

5. With regard to 1481028, the section 46(1)(a) claim is based on the five year period following registration: i.e. 3 January 2000 to 2 January 2005, with a claimed revocation date of 3 January 2005. Under section 46(1)(b), the claim is based on the following five year periods:

- a) 3 January 2005 to 2 January 2010
- b) 3 January 2010 to 2 January 2015
- c) 17 June 2011 to 16 June 2016

The respective claimed revocation dates are

- a) 3 January 2010
- b) 3 January 2015

c) 17 June 2016

6. With regard to 1498716, the section 46(1)(a) claim is based on the five year period following registration: i.e. 21 October 1995 to 20 October 2000, with a claimed revocation date of 21 October 2000. Under section 46(1)(b), the claim is based on the following five year periods:

- a) 21 October 2000 to 20 October 2005
- b) 21 October 2005 to 20 October 2010
- c) 21 October 2010 to 20 October 2015
- d) 17 June 2011 to 16 June 2016

The respective claimed revocation dates are:

- a) 21 October 2005
- b) 21 October 2010
- c) 21 October 2015
- d) 17 June 2016

7. SITA filed counterstatements stating that they have used the trade mark registrations in the UK in relation to the goods and services set out above during the relevant time periods and subsequently filed evidence to support that claim. Sky also filed submissions.

8. Neither party requested to be heard, so the following decision is taken after consideration of all the papers before me. SITA's evidence will be summarised as necessary and Sky's submissions will be borne in mind.

## **SITA'S EVIDENCE**

9. SITA's evidence takes the form of a witness statement made by Andrew Hawley, a senior associate at Marks and Clerk who are the Registered Proprietor's legal representatives. Mr Hawley has also appended one exhibit, MC1.

10. Mr Hawley states that the SKYFORM trademarks have been in use in the UK since at least 2005 and that SITA provide 'various goods and services for the

aviation and air travel industry, including integrated software solutions and telecommunication services’.

11. With regard to the SKYFORM mark in particular, it is stated that the mark has been used in the UK aviation industry in relation to ‘integrated software applications’ and that “the services provided by the Registered Proprietor are provided at many UK airports”.

12. In addition Mr Hawley states that SITA

“...also uses the name SKYFORM in correspondence with the other parts of the SITA business as the goods and services used under this mark form part of an overall software solution...”

13. Exhibit MC1 consists of six pages of information which are stated to be:

“... examples of literature that has been provided by the Registered Proprietor to customers at the MRO Europe and MRO & Operations IT (Aircraft Commerce) trade shows, which are held in London on an annual basis and which the Registered Proprietor regularly attends...”

14. The literature consists of, what appears to be, two advertising/information leaflets (although this is not entirely clear). They provide details about the registered proprietor’s “SITATEX product portfolio”. SKYFORM is described as an optional add-on to SITATEX Online. It is noted that the first leaflet provides details of the service that the registered proprietor provided to a customer based in the US. It states that “Magee Plastics, a US based Manufacturing company selected SKYFORM Online to efficiently manage incoming orders from its airline customers”. On one of the leaflets it states that “In 2013, we had consolidated revenues of US \$1.63 billion.” It is not clear what goods, services or trade marks that revenue relates to (whether it relates to SITATEX, SKYFORM or both). Both leaflets describe SKYFORM as an “end-to-end managed service for simplified and fast exchange of commercial information between airlines...”. The contested mark is used on pages 4, 5, 6 and 7 with the

word 'online'. The mark SKYFORM solus appears once on page 7. The mark does not feature at all on pages 8 and 9.

15. The literature which forms exhibit MC1 is largely undated. The reference on page 5 to a 2013 company revenue of \$1.63 billion indicates that the document was produced at some point after that date. On page 7 in the bottom left corner there is a copyright symbol © and the year 2012, from which I conclude that the document was produced at or around this date. There is also a similar copyright symbol plus year on page 9. However that page does not feature the mark at issue so cannot be considered relevant to this decision.

## **LEGISLATION**

16. Section 46(1) of the Act states that:

“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)...

(d)...

(2) For the purpose 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 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. Section 100 is also relevant, which reads:

“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.”

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

“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 Bunderversammlung 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].”



## DECISION

19. It is clear from the guidance given above that I must take into account a number of factors when assessing whether sufficient and genuine use of the mark has been shown from the evidence provided.

20. Firstly I note that the witness statement is not in the name of an employee of the Registered Proprietor, but instead in the name of their trade mark agent. Sky have also noted this point as significant in terms of the weight the evidence should be given. It is clearly preferable that evidence of use be provided by an individual with first-hand knowledge of the proprietor's business. It is not clear to me that Mr Hawley has such knowledge.

21. Furthermore I note that much of Mr Hawley's witness statement is based on his understanding and opinions. By way of an example he states that:

“... In my opinion the majority of professionals in the aviation field in the UK and the rest of the EU are familiar with the SKYFORM trade mark...”

However there is no further evidence to confirm this opinion, for example by means of statements from trade associations or aviation industry specialists.

22. There are a number of other information deficiencies within the evidence provided, namely a lack of turnover figures resulting from sales of the goods and services in the UK, a lack of advertising expenditure figures from promoting the goods and services in the UK, no details as to the spread of customers purchasing the goods and services in the UK and no indication of market share held in the UK by the Registered Proprietor.

23. With regard to the exhibit MC1, as noted above, the information is not clearly dated. In addition, although it was stated that the information consisted of literature provided at a trade show, there was no supplementary information given as to the dates of these shows, the number of attendees and the nature of their business. Nor was a reason given for handing out such information, e.g. did the Registered

Proprietor have a stand at the trade show. Moreover Sky have criticised the exhibit as follows:

“...They do not show use of the mark in the relevant territory, namely the UK. On the contrary, the exhibit refers to a US customer and express the Proprietor’s 2013 company revenue in US Dollars, suggesting that the documents are directed at the US market...”

I agree that there is a lack of UK specific information and evidence. Although Mr Hawley states that the registered proprietor has provided services “at many UK airports” there is no indication of the number of airports the services were provided to, the dates they were provided nor any other information such as invoices which may shed light on this.

24. A further problem for the registered proprietor is that although the witness statement states that SKYFORM is used on ‘integrated software applications’ which would be proper to class 9 of the Nice Classification system, the exhibit states on page 6 that:

“...SKYFORM Online is an end-to-end managed service for simplified and fast exchange of commercial information between airlines, aircraft manufacturers and their suppliers and complies with the SPEC2000 XML industry standard for electronic trading...”

This appears to be a Software as a Service (SaaS) arrangement which is not proper to class 9 nor 38 of the Nice Classification system. No further evidence was provided to support the specific goods and services of the registered specifications, and there were no further references to the goods and services provided under the mark in the witness statement so I am not satisfied that there has been genuine use in relation to these goods and services.

## **OUTCOME**

25. I find the evidence provided in pursuit of this case by the Registered Proprietor to be insufficient and the application for revocation on the grounds of non-use succeeds under both section 46(1)(a) and 46(1)(b). Consequently mark no. 1481028 is revoked under section 46(6)(b), the effective date of revocation being 3 January 2005 and mark no.1498716 is revoked under section 46(6)(b), the effective date of revocation being 21 October 2000.

## **COSTS**

26. As the applicant has been successful, they are entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4/2007. Bearing in mind the guidance given in TPN 4/2007, I award costs on the following basis:

£200 Application fee

£200 Preparing a statement and considering the counterstatement

£300 Preparing submissions

**£700 Total**

27. I order Societe Internationale de Telecommunications Aeronautiques to pay Sky PLC the sum of £700. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23<sup>rd</sup> day of August 2017

June Ralph

For the Registrar

The Comptroller-General

