

BL O-645-17

TRADE MARKS ACT 1994

IN THE MATTER OF  
AN APPLICATION UNDER NO 501243  
BY SKY PLC  
TO CANCEL REGISTRATION NO 2379647  
IN THE NAME OF ESKY LEARNING LIMITED

## **Background**

1. Registration no 2379647 is for the trade mark ESKY which was entered in the register on 28 October 2005. On 30 April 2009, an assignment from Spark & Zoom Productions Limited, the original applicant for registration, to Esky Learning Limited, the current registered proprietor, was recorded.

2. On 20 June 2016, Sky plc (“the applicant”) filed an application seeking to cancel the registration in full on grounds under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”) claiming the mark should be revoked in full as it had not been used in the periods 29 October 2005 to 28 October 2010 (s46(1)(a)) and 29 October 2010 to 28 October 2015 and 17 June 2011 to 16 June 2016 (s46(1)(b)).

3. For reasons that I do not need to record here, other than to say they were due to errors which occurred when the assignment was recorded by him, the application for cancellation was not initially properly served on the registered proprietor by the registrar. It was later re-served and a period was set for it to file a Form TM8(N) notice of defence and counterstatement along with any evidence of use. Whilst a defence and evidence of use was filed within the period allowed, the required Form TM8(N) was not. The failure to file the form was not the fault of the registered proprietor itself but of its professional representatives. An explanation for this failure was later provided and the exceptional circumstances involved led to the registrar admitting a late-filed Form TM8(N) into the proceedings. Though the applicant made submissions as to costs, which I shall return to later in this decision, it did not disagree with this course of action.

4. The registered proprietor denied the grounds of the application for cancellation. It claimed the mark had been used within each of the periods mentioned above and for all services for which it was registered. Nevertheless, it later sought partial surrender of the registration. I shall return to this later in this decision.

5. Both parties filed evidence and written submissions which I have read and shall refer to as necessary in this decision. Neither sought to be heard. I therefore give this decision after careful consideration of all the papers before me.

## Decision

6. Section 46(1) of the Act states:

“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.”

7. Section 100 is also relevant and 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.”

8. 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:

“217. *The law with respect to genuine use.* 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. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

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].”

9. I remind myself that the periods within which genuine use of the mark must be shown are: 29 October 2005 to 28 October 2010, 29 October 2010 to 28 October 2015 and/or 17 June 2011 to 16 June 2016. As I indicated earlier, the registered proprietor voluntarily surrendered part of the registration. That surrender was recorded and has an effective date of 17 August 2017. As the dates for which revocation is sought pre-date that surrender, I have to consider the matter taking into account the specification of services for which the mark was registered at those earlier dates. Consequently, the relevant specification is as follows:

#### Class 41

Provision of training; provision of training courses and training information by electronic means including compact disks (CD), digital versatile disks (DVD), video cassettes and via the Internet; provision of interactive training courses; organising and running training courses.

#### Class 42

Provision of information relating to health and safety.

Class 43

Provision of information relating to food safety.

Class 45

Provision of information relating to fire safety.

10. The registered proprietor has filed evidence in the form of witness statements by Malcolm McLeod, Director of both the registered proprietor and Spark & Zoom Productions Limited and by Steven William Gee its professional representative.

11. Mr McLeod states the registered proprietor (and its predecessor) have provided training courses, and in particular interactive training courses, under the mark and did so throughout the relevant periods. He states that the registered proprietor:

“does not operate the training courses itself, but rather provides information, materials and data allowing its clients to undertake the desired training at their home or business location”.

12. Mr McLeod states the courses were originally certified as meeting the required industry standards by the Royal Institute for Public Health (“RIPH”-a now-defunct Government agency) but subsequently were certified by The CPD Certification Service. At MM2, he exhibits copies of certification documentation which refer to ESKY learning and issued by RIPH in September 2003, February and August 2005 and September and October 2007. At MM3 he exhibits similar documentation issued by CPD in June 2010.

13. Mr McLeod states that whilst it is “more difficult to determine the number of participants who have undertaken a Spark & Zoom or Esky training course [he is] able to...confirm that over 160,000” people have done so and estimates that “many tens of thousands” of people have undertaken one of the companies’ training courses in each of the relevant periods. The subject matter of the courses which have been provided are: food safety, fire safety, health and safety, hazard awareness, manual handling, licensing and VDU/DSE training as well as induction



training for food handlers, office staff, housekeeping, maintenance and factories and retail staff.

14. Mr McLeod gives details of turnover as follows:

Spark & Zoom (1<sup>st</sup> July to 30<sup>th</sup> June)

2005/6	£112,365.10
2006/7	£66,327.25
2007/8	£83,538.41

Esky (1<sup>st</sup> October to 30<sup>th</sup> September)

2008/9	£109,906.22
2009/10	£211,582.06
2010/11	£267,562.90
2011/12	£235,476.23
2012/13	£182,729.09
2013/14	£148,031.52
2014/15	£171,366.94

15. At MM4, Mr McLeod exhibits copies of certificates issued to individuals who have successfully completed one of the company's courses. There are three certificates, dated February 2005 (before each relevant period), April 2007 and November 2016 (after each relevant period).

16. At MM5, Mr McLeod provides example invoices. There are 11 invoices, all addressed to UK addresses. They are each on headed paper referring to ESKY, date from within each of the relevant periods and relate to the provision of health and safety, food safety, fire safety and manual handling courses. Those at MM5 pages 1 to 6 indicate they relate to "Esky e-learning web delivery".

17. Mr McLeod states that neither the registered proprietor nor its predecessor have undertaken specific advertising:

“...as we find that the website is the most cost-effective resource for attracting new clients. We have attended exhibitions but found them not to provide value for money. For recent years we have also used focussed e-mail campaigns using Campaign Monitor. We budget to spend around £2,500 each year upon these campaigns”.

No evidence has been filed which shows the content or reach of either the email campaigns or website views at any particular date nor is there any evidence of any specific exhibitions which may have been attended.

18. At his SCG2, Mr Gee exhibits copies of screenshots from the registered proprietor’s website retrieved from the Internet Archive and dating from December 2005, November 2010 and July 2011. They show the various courses available in each of the relevant periods and via e-learning which include food safety, health and safety and fire safety courses.

19. In her witness statement, filed on behalf of the applicant, Ms Pearson gives evidence of an Internet search she conducted, on 6 July 2017, of the registered proprietor’s website and, at MP-1, exhibits a printout from that website. She states that the website “purports to offer courses” in food hygiene, fire safety and health and safety including manual handling and first aid. She goes on to state that her search found “no information concerning the availability of the Courses via compact disks (CD), digital versatile disks (DVD), video cassettes or any other any other (sic) electronic means, as claimed” nor has it “revealed [any other] training courses, or any the (sic) provision of information pertaining to areas outside those described above”. She submits that the registered proprietor has not “satisfactorily demonstrated that it has genuinely used the ESKY name as a trade mark in the UK for the entire claimed list of services in the relevant periods” and further submits the registration should be revoked in its entirety.

20. Whilst the printout exhibited by Ms Pearson at MP-1 from the registered proprietor’s website was downloaded well after each of the relevant dates and does not necessarily reflect the position within any of the relevant periods, I note that under the heading “Brief History of Esky” is the following text:

“The first training programme we developed was a basic online food safety course in 2003, and since then we have added new courses year on year. Following the food safety certificate we developed our online fire safety course and health and safety courses. Due to demand from our diverse customer base we developed a DSE awareness course and a manual handling course. In recent years we have continued to grow our offering to include a wider variety of courses that cover inductions and refresher training. We continue to grow our training suite based on feedback from our customers...”

21. In his witness statement filed as evidence in reply, Mr McLeod exhibits, at MM7, screenshots taken from the Internet Archive. They show pages from the registered proprietor’s website as at May 2006, February 2007, May 2008, January 2009 and February 2009. With the exception of the latest of these which refers only to online courses, each offers training either online or via CD-Rom.

22. The evidence filed by the registered proprietor is not extensive. Some of it predates the relevant periods and some of it postdates them, however, when taken as a whole, I am satisfied that it shows genuine use of the mark over a number of years and in each relevant period. I go on, therefore, to consider on which services the mark has been used and what a fair specification is which reflects the extent of that use. In doing so, I take note of the comments of Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, where he stated:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

23. Further, in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation

to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them;

*Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.*”

24. In relation to the services as registered in class 41, the registered proprietor has accepted that it has not provided evidence of use in relation to *organising and running training courses* (the services which it has surrendered). The remaining services in this class are *Provision of training; provision of training courses and training information by electronic means including compact disks (CD), digital versatile disks (DVD), video cassettes and via the Internet; provision of interactive training courses*. The evidence shows the registered proprietor and its predecessors in business are training providers, however, I do not consider the evidence filed supports the retention of such a wide-ranging term as the *provision of training*. Whilst there is no specific evidence that the registered proprietor has provided training via each of the media for which it is registered, I am satisfied that the evidence shows it has provided training via a number of electronic means including online and by way of compact disks. The subject matter of the training provided is varied and, whilst the sample invoices exhibited at MM5 show it has been provided to people working in commercial settings (e.g. care homes, schools and charitable organisations), I do not think it appropriate to limit the specification in such a way. Mr McLeod has stated there is a “diverse” range of customers. He also goes to state that the registered proprietor’s courses allow “its clients to undertake the desired training in their own homes” (1<sup>st</sup> witness statement paragraph 7) and it seems to me that ordinary members of the public may also undertake such training (e.g. those who might be considering starting their own businesses or wish to enhance their employment prospects). Mr McLeod also states that the registered proprietor “does not operate the training courses itself but...provides information, materials and data” to its clients which, in the context of the other evidence provided, I take to mean that it has not organised and presented face to face training in a central location which clients attend in person but rather it provides the courses as distance learning via electronic means. Taking all matters into account, I consider that the following is a fair specification for the use made for services as registered in class 41:

*Provision of training courses and training information by electronic means; provision of interactive training courses.*

25. The services as registered in classes 42, 43 and 45, are each for the provision of information relating to specific topics (i.e. health and safety (Class 42) food safety (class 43) and fire safety (class 45)). Whilst, in his witness statement, Mr McLeod states the registered proprietor and its predecessor in business have provided “information, materials and data” to its clients which relate to these topics, there is no evidence that it has done so other than as part of a training course i.e. there is no evidence it has provided such information as a separate service. That being the case, I do not consider that it has shown it has made genuine use of the mark in relation to any of the services in classes 42, 43 and 45.

### **Summary**

26. The application for cancellation on the grounds of revocation fails in relation to the following services:

Class 41

*Provision of training courses and training information by electronic means; provision of interactive courses.*

27. The application for cancellation succeeds in relation to all other services and the registration will be revoked in respect of them from the earliest date sought which is 29 October 2010.

### **Costs**

28. The applicant has had the greater degree of success and is entitled to an award of costs in its favour. The applicable scale of costs is that set out in Tribunal Practice Notice 4/2007.

29. As set out in paragraph 3 above, the registered proprietor originally failed to file a Form TM8(N) within the period allowed to it. The applicant did not disagree with the registrar’s decision to admit a late-filed form but did file correspondence in respect of this. This correspondence takes the form of a letter of 19 April 2017. In terms of its

contents, the applicant set out (unnecessarily, in my view) a history of the proceedings, indicated it did not intend to request to be heard on the registrar's decision to admit the late-filed form and went on to say:

“However, the Applicant submits that the failure of the Proprietor (who is professional (sic) represented) to comply with the procedural time limits, notwithstanding that it had been aware of the Application from at least as early as September 2016, resulting in unnecessary delays in the proceedings, has unduly prejudiced the Applicant, particularly considering that the Application was now filed more than eight months ago. Moreover, it has seriously undermined the Office's overriding objective to ensure that proceedings are completed within a reasonable timeframe.

Under the circumstances, the Applicant respectfully requests that this procedural history be duly taken into account in any costs that may be awarded in these proceedings, and that such costs are weighted in the Applicant's favour.”

30. That there have been delays in these proceedings is not disputed. I have referred to the causes of those delays in paragraph 3 above. There is nothing to indicate that the delays were caused by the registered proprietor itself nor is there any indication that the applicant has been put to any extra, necessary expense as a result of them.

31. With all of the above in mind, and reducing it to take into account the application failed in respect of approximately 25% of the services for which the mark is registered, I make the award on the following basis:

For the preparation of a statement and  
considering the other side's statement: £200

For the preparation of evidence and  
commenting on the other side's evidence: £500

Official Fee:	£200
<u>Sub Total:</u>	<u>£900</u>
Reduction: 25%	£225
<b>Total:</b>	<b>£675</b>

32. I order Esky Learning Limited to pay Sky plc the sum of £675. This sum is to be paid with fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 14<sup>th</sup> day of December 2017**

**Ann Corbett  
For the Registrar  
The Comptroller-General**