

O/454/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003514590

BY CURB MASK LTD TO REGISTER THE FOLLOWING TRADE MARK:

The image shows the word "curb" in a lowercase, rounded, brown font. The letters are thick and have a slightly irregular, hand-drawn appearance. The 'c' is a simple curve, the 'u' has a small bump at the top, the 'r' has a thick vertical stem and a curved top, and the 'b' has a thick vertical stem and a rounded bottom.

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600001596 BY KEVIN CHEESMAN

Background and Pleadings

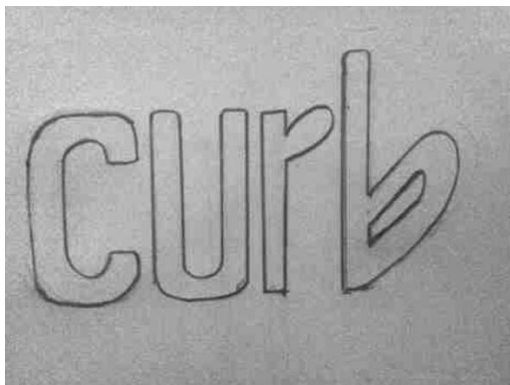
1. On 22 July 2020, Curb Mask Ltd ('the Applicant') filed an application to register the trade mark shown on the cover page of this Decision, number UK00003514590. The application was published for opposition purposes in the *Trade Marks Journal* on 30 October 2020. Registration is sought in respect of:

Class 25

Garments for protecting clothing; Head wear; Headgear; Headgear for wear; Menswear; Outer clothing; Outerclotthing; Outerclotthing for boys; Outerclotthing for girls; Outerclotthing for men; Ready-to-wear clothing; Womens' outerclotthing; Children's clothing; Childrens' clothing; Children's headwear; Children's outerclotthing; Children's wear.

2. On 27 January 2021, the application was opposed by Kevin Cheesman ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the application.
3. The Opponent relies on the following earlier trade mark registration for its section 5(2)(b) ground:

UK00002622968



Filing date: 30 May 2012; Date registration completed: 12 October 2012

Registered in respect of the following class 25 goods:

Underwear, swimwear and sportswear for men.

4. The Opponent claims that there is a likelihood of confusion under section 5(2)(b) and makes the following comment at Q12 of its statement of grounds:

Head wear;Headgear;Headgear for wear covers items I already sell; face mask. Menswear and Ready-to-wear clothing covers items I already sell; underwear, swimwear, socks, t-shirts, tops, gloves, sportswear. Outer clothing;Outercloting,Outercloting for men covers items I already sell; swimwear, t-shirts, tops, sportswear.

Our trademark 'Curb' is clearly identified by a logo, on products in class 25, including, but not limited to, underwear, face coverings, swimwear, t-shirts, shorts and protective gloves. The word / trademark 'Curb' is recognised with products in class 25 and has been in active use since 2012 and will continue to be in use for the future.

The trademark 'Curb Ltd' application is in direct conflict with our trademark(s) as they feature the word 'Curb' on items sold under class 25. It is also worth noting, our trademark 'Curb' is used on face coverings since April 2020 and on protective gloves since 2012.

Our brand 'Curb' is also referenced as 'Curb' across our social media, invoices, shipping labels and advertisements in the UK and has been since 2012. Our customers also reference the brand as 'Curb' in conversation (online and offline). 'Curb' is used in our acquisition of organic searches by customers on Google leading to direct search sales. Branding their products with the text 'Curb' has created confusion with my branded products also called 'Curb' and further use of the text 'Curb' on their other class 25 products will create more confusion.

5. The Opponent has claimed use of its mark for the following goods throughout the UK:

Goods under Class 25 including men's underwear, face coverings, swimwear, tops, shorts and protective gloves.

The evidence pertinent to the issue of use has been appended to the Opponent's statement of grounds.

6. The Applicant has filed a defence and counterstatement, denying that there is a likelihood of confusion, in which:

- The Opponent is put to proof of genuine use of its mark in relation to all goods in respect of which it is registered (para [4]);
- It is alleged that the marks used by the Opponent differ in form from the mark as registered to the extent that the distinctive characters of the latter are altered (paras [9]-[12]);

- It is conceded that the Applicant's goods under *Menswear* and *ready-to-wear* are identical to the Opponent's goods (para [25]);
- It is stated that the remainder of the Applicant's goods 'are either dissimilar or similar to a low degree' (para [25]);
- It is conceded that the marks are: visually similar to a very low degree; and aurally and conceptually identical. The Applicant argues that 'accordingly, the marks are similar to a low degree' (paras [29] – [32]).

7. Neither party has filed written submissions.

8. Each party represents itself.

9. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Marks Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

10. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

11. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary.

Relevant dates

12. The Opponent's earlier mark had been registered for more than five years on the date on which the contested application was filed. It is, therefore, subject to the

proof of use provisions under section 6A of the Act, and the Applicant has requested such proof. The Opponent has made a statement that it has made genuine use of all of the goods for which its mark is registered. The relevant time period for this purpose is the five years prior to and ending on the application date of the applied-for mark: 23 July 2015 – 22 July 2020.

Preliminary Issues

13. Goods for which use of the earlier mark is being claimed

The Opponent has stated, in its second paragraph under Q12 of its statement of grounds, that: 'Our trademark 'Curb' is clearly identified by a logo, on products in class 25, including, but not limited to, underwear, face coverings, swimwear, t-shirts, shorts and protective gloves'. [my underlining].

14. Where section 6A of the Act is engaged, and proof of genuine use of the earlier mark has been requested, the Opponent may only rely on evidence of use in relation to the goods or services or in respect of which its mark has been registered¹, i.e. in the instant case: *Underwear, swimwear and sportswear for men*. I note that the Opponent has claimed the term *face coverings* in its statement of use. In my view, this term does not fall within the Opponent's *underwear, swimwear and sportswear for men*. Consequently, this Tribunal is unable to consider Exhibits 2 and 3, concerning use of the mark in relation to face coverings, in its assessment of whether genuine use of the mark has been proven.

¹ Section 6A 3(a) of the Act provides that:

(3) The use conditions are met if –

(a) within the relevant period 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 [my underlining]

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

15. Reference to use outside of the relevant period

The Opponent has, at Q12 of its statement of grounds (reproduced in full above at [4]), made several references to use of its mark 'since 2012'. When determining whether or not genuine use of the mark has been proven, the Tribunal can only consider evidence relating to use within the relevant period i.e. 23 July 2015 – 22 July 2020. Any use pre or post that period is irrelevant for the purposes of that assessment.

16. Reference to actual confusion

The Opponent has, at Q12 of its statement of grounds, commented that

“‘Curb’ is used in our acquisition of organic searches² by customers on Google leading to direct search sales. Branding their [the Applicant’s] products with the text ‘Curb’ has created confusion with my branded products also called ‘Curb’ and further use of the text ‘Curb’ on their other class 25 products will create more confusion [sic]’

17. The Opponent has not adduced any evidence to support these statements.

Consequently, the Tribunal cannot take these statements into consideration.

18. Representation of the earlier trade mark

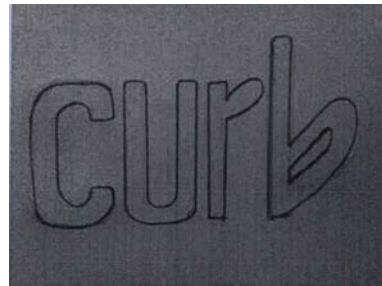
The Opponent has included the following two representations of its mark with its statement of grounds. (I label them ‘a’ and ‘b’ for ease of reference):

² From my own general knowledge, I understand that ‘organic searches’ refers to online traffic that has come to a site through unpaid search engines such as Google, Yahoo or Bing.

a)



b)



19. I note that representation b) is the form of the mark as registered.

Opponent's evidence

Proof of Use

20. The Opponent's evidence comes from Kevin Cheesman. Sales figures have been provided, together with 13 exhibits.

21. The following sales figures have been provided:

- Q7. Please provide details of the number of sales achieved under the mark in the UK (or in the EU if the earlier mark is registered or protected at Community level) during the relevant period. These figures should, if possible, be provided on an annual basis and, if possible, be split in relation to each of the goods/services for which use of the mark is claimed; estimates should be provided if exact figures are not readily available.

Note: You may provide financial turnover figures to illustrate the level of sales under the mark, but if you do please also provide an indication of the typical unit price for the product or service.

2013 £40,545. Typical Unit Price £9.29.
2014 £42,386. Typical Unit Price £9.24.
2015 £51,002. Typical Unit Price £8.20.
2016 £60,246. Typical Unit Price £7.82.
2017 £45,041. Typical Unit Price £8.18.
2018 £30,351. Typical Unit Price £9.12.
2019 £26,260. Typical Unit Price £8.73.
2020 £36,645. Typical Unit Price £10.34.

All class 25 goods. Approx figures for the UK sales.

22. The sales figures for 2013 and 2014 fall outside of the relevant period and cannot, therefore, be considered by the Tribunal. There is no month-by-month breakdown of the sales figures within each year. From the figures provided, it is therefore not possible to discern what proportion of the figure for 2015 is

referable to the part of that year falling within the relevant period, i.e. from 23 July until 31 December 2015. Similarly, it is not possible to discern what proportion of the figure for 2020 is referable to the period 1 January – 22 July 2020.

23. The text beneath the figures reads ‘All class 25 goods’. There is no breakdown of the figures to show the respective proportions of revenue attributable to men’s underwear, swimwear and sportswear. The Tribunal therefore cannot ascertain to which goods the typical unit prices relate.

24. The figures for 2016 - 2019 indicate a notable decline in sales revenue. Between 2016 and 2018, revenue has dropped by approximately £15k with each successive year. Figures appear to be climbing again in 2020 but, as noted, it is not possible to discern the revenue generated in the period 1 January – 22 July 2020.

Exhibits

25. **Exhibit 1** – comprises a single photograph of a male modelling a pair of briefs. The ‘CURB’ logo can be seen on the left-hand side of the briefs (shown below). I note that the version of the mark shown is the other iteration of the mark³ included in the Opponent’s Notice of Opposition, rather than the mark as registered.



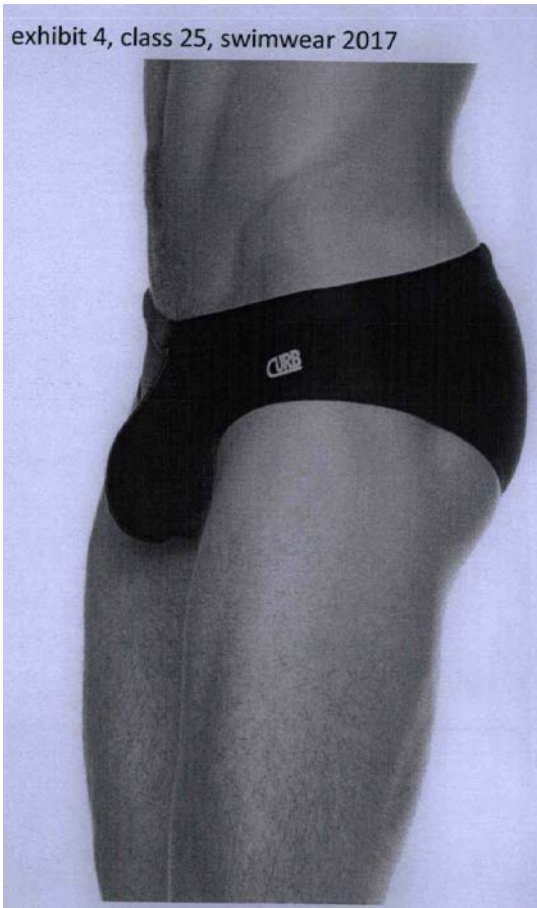
³ Referred to as ‘mark a’) at paragraph [19].

26. The document into which the photograph has been inserted is titled 'exhibit 1, class 25, mens underwear 2018'. However, it cannot be ascertained from where the photograph has been taken i.e. whether it featured in a 2018 catalogue, advertising campaign, product listing etc. Aside from the aforementioned wording, there is no text to accompany the photograph. The photograph does not, on its own, demonstrate that the goods are being held out for sale.

27. **Exhibits 2 and 3** – Each exhibit comprises a single photograph of a fabric face mask bearing the 'CURB' mark. The exhibits are virtually identical, albeit the 'CURB' mark is clearer in exhibit 3. For the reasons provided above, at [14], this evidence is irrelevant to the Tribunal's assessment of whether genuine use of the earlier mark has been proven.

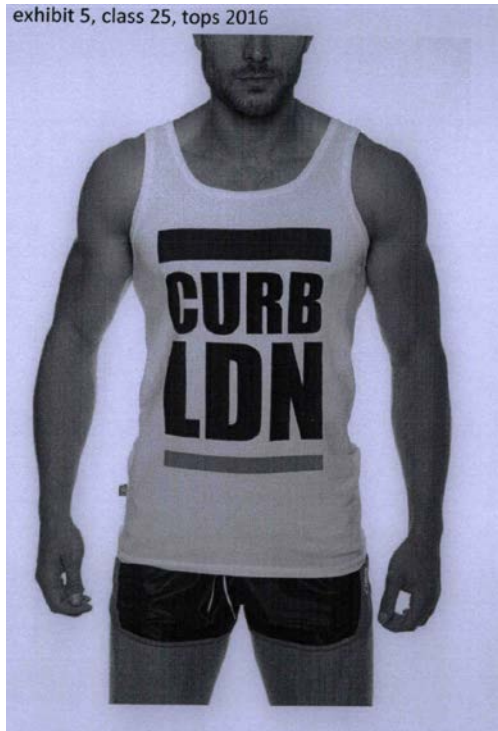
28. **Exhibit 4** - comprises a single photograph of a male modelling a pair of swimming trunks or briefs. The page on which the photograph appears is titled 'exhibit 4, class 25, swimwear 2017'. No other text is provided. It is not apparent from where the photograph is taken. The 'CURB' mark can be seen on the side of the trunks/briefs. I note that the version of the mark shown is the other iteration of the mark⁴ included in the Opponent's Notice of Opposition, rather than the mark as registered:

⁴ Referred to as 'mark a)' at paragraph [19].



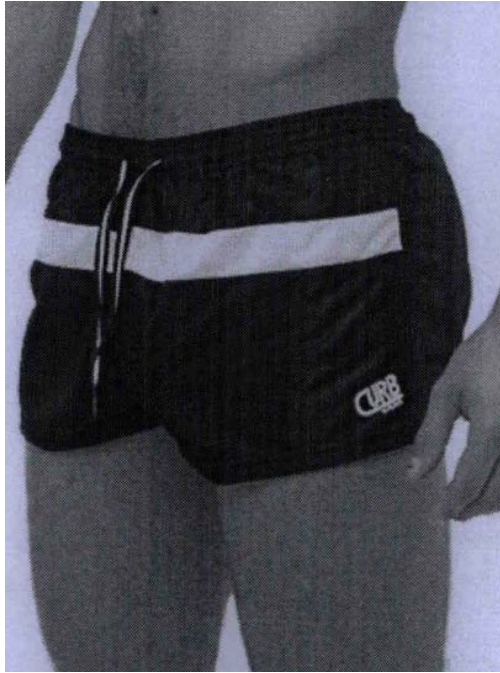
29. As with the previous exhibits, it cannot be ascertained: from where the image is taken or whether the goods are being held out for sale.

30. **Exhibit 5** - comprises a single photograph of a male modelling a vest and shorts. The vest bears the text 'CURB LDN' in large emboldened lettering. The page on which the photograph appears is titled 'exhibit 5, class 25, tops 2016'. No other text is provided. As with the previous exhibits: it cannot be ascertained from where the image is taken or whether the goods are being held out for sale.



31. **Exhibit 6** - comprises a single photograph of a male modelling a pair of shorts. The page on which the photograph appears is titled 'exhibit 6, class 25, shorts 2018'. No other text is provided. Upon magnification, the 'CURB' logo can be seen on the left-hand side of the shorts. I note that the version of the mark shown is the other iteration of the mark included in the Opponent's Notice of Opposition⁵, rather than the mark as registered:

⁵ Referred to as 'mark a)' at paragraph [19].



32. I include a magnified screenshot for clarity:



33. **Exhibit 7** - comprises a single photograph of a male modelling a pair of what appear to be protective gloves used for exercise or certain sports. Each glove bears the 'CURB' mark, albeit the other iteration of the mark included in the Opponent's Notice of Opposition⁶, rather than the mark registered.



⁶ As above.



34. The page on which the photograph appears is titled 'exhibit 7, class 25, gloves 2016'. No other text is included. As with the previous exhibits: it cannot be ascertained from where the image is taken or whether the goods are being held out for sale.

35. **Exhibit 8** – comprises the following image of an unused shipping label:

Exhibit 8, class 25, order shipping label 2020

1st Class	Delivered By  Royal Mail
	Postage on Account GB
	Letter
	100g
AA-000 000 0000-000 BBB CCC	
	
Customer Name Address City Postcode	Return Address 29A High Street RYE TN317JG
Customer Reference: 1001 / ORDER	CURB

36. The 'CURB' mark can be seen clearly in the bottom right-hand corner, albeit the other iteration of the mark included in the Opponent's Notice of Opposition⁷, rather than the mark registered. Although the exhibit has been titled 'Exhibit 8, class 25, order shipping label 2020' the precise date in 2020 has not been provided. It therefore cannot be ascertained whether this piece of evidence relates to the part of 2020 within the relevant period i.e. a date before or on 22 July 2020. A franked shipping label would have been more informative.

37. **Exhibit 9** - comprises a photograph of men's underwear or swimming trunks, and vests, on hangers displayed on what appear to be rails in a shop. The 'CURB' mark appears prominently on the wall above the goods, albeit the other iteration of the mark included in the Opponent's Notice of Opposition⁸, rather than the mark as registered:

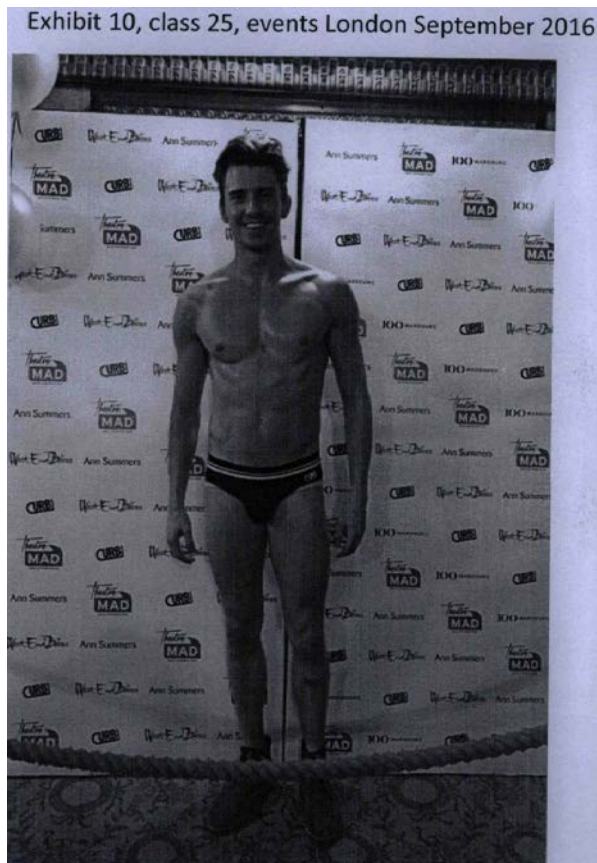


⁷ Referred to as 'mark a)' at paragraph [19].

⁸ As above.

38. The exhibit is titled 'exhibit 9, class 25, shop display in London 2019'. The identity of the shop has not been provided.

39. **Exhibit 10** - comprises a single photograph of a male modelling a pair of briefs or swimming trunks. The backdrop against which the model is standing features what appear to be various brand logos, repeated in a pattern, including 'CURB'.



40. The backdrop is the sort often used at promotional events, where the sponsors' (or beneficiaries in a charitable cause) marks are displayed. The exhibit is titled 'exhibit 10, class 25, events London September 2016'. No other details are provided e.g. the name of the event, precise date it took place, purpose of the event.

41. **Exhibit 11** - comprises a single photograph of a shop called 'Prowler'. The presence of the street sign with the post code 'W1' indicates that the shop is located on a London street in the UK:



42. The photograph shows the shop window displaying an array of 5 mannequins modelling briefs or swimming trunks with tops, set against a background of images of male models in either swimwear or underwear. Beneath each mannequin, the 'CURB' mark is displayed by way of a banner across the bottoms of the windows. The exhibit is titled 'exhibit 11, class 25, advertising in London 2018'.

43. **Exhibit 12** - comprises a copy of a single invoice dated 18 March 2020 to 'Prowler' in Soho, London UK. The 'CURB' mark is displayed prominently at the head of the invoice:

INVOICE



Billing Address

ABS Holdings Unit B
Stirling Business Park
6 Nimrod Way, East Dorset Trade Park
Wimborne, Dorset, BH21 7SH
UK

Delivery Address

Prowler Soho
5-7 Brewer Street
London
W1F 0RF
UK

Date 18/03/20
Buyer Jon Davis

Order # PO 100077 / 003136PS
Invoice # KPC000452

Range	Style	Colour	Code	S	M	L	XL	Qty	Unit £	Total £
Underwear										
Beyond	Brief	Black	BY01005					0	6.85	0.00
	Brief	White	BY01115					0	6.85	0.00
	Brief*	Leopard W	BY01515	4	6	4		14	6.85	95.90
	Brief	Leopard O	BY01535					0	6.85	0.00
	Thong	Black	BY11005					0	7.05	0.00
Blimey	Brief	Navy	BB01415					0	7.00	0.00
	Brief	Red	BB01615					0	7.00	0.00
Crown	Brief	Black Modal	CR01005	4				4	7.25	29.00
	Trunk	Black Mesh	CR18005					0	7.50	0.00
	Jock	Black Mesh	CR09005					0	7.00	0.00
Enhance X	Lo-rise Brief	Navy-White	EE07415					0	5.75	0.00
	Lo-rise Brief	Flame Red-N	EE07645					0	5.75	0.00
Enhance Smart	Trunk	Navy-Blue	ES08425					0	7.65	0.00
ID Blow	Brief	Black	ID010B5					0	7.00	0.00
	Jock	Black Mesh	ID39015			4		4	7.35	29.40
ID Bottom	Jock	Black	ID390B5					0	6.95	0.00
ID Power Bttm	Brief	Black	ID010P5					0	7.00	0.00
	Jock	Black	ID390P5					0	6.95	0.00
	Jock-Brief	Red	ID34645					0	6.45	0.00
ID Top	Brief	White	ID011T5					0	7.00	0.00
ID Versatile	Jock	Navy	ID03435					0	6.95	0.00
ID Submissive	Jock-Brf Sub	Blue	ID34405					0	6.45	0.00
ID Code	Jock	Black-Blue	ID39045					0	6.85	0.00
	Jock	Black-Red	ID39065					0	6.85	0.00
	Jock	Black-Yellow	ID39075					0	6.85	0.00
Star	Brief	Black Navy	ST10045					0	7.05	0.00
Super	Brief	Blue	SU01425					0	6.85	0.00
	Brief	Yellow	SU01775					0	6.85	0.00
	Brief	Grey Marl	SU01995		6			6	6.85	41.10
	Brief	Dark Teal	SU01505					0	6.85	0.00
	Brief	Navy	TB01455					0	6.85	0.00
	Jock	Pink	SU03665					0	6.55	0.00
Tops										
ID Singlets	Total Top	White	ID21046					0	8.95	0.00
	Power Bttm	White	ID21166					0	8.95	0.00
	Blow Me	Black	ID21096					0	8.95	0.00
	Wrestle Lond	White	ID21106					0	8.95	0.00
Mesh Singlets	Brit	Black Mesh	BR02076					0	9.25	0.00
	Curb	Black Mesh	PR02056					0	9.25	0.00
T-Shirt	Sexy Boy	White	CW0T106					0	9.95	0.00
	Local Boy	White	CW0T146					0	9.95	0.00
	Power Bttm	White	ID0T106					0	9.95	0.00
	Good Boy	White	ID02136					0	9.95	0.00
	More Bottom	White	ID02126					0	9.95	0.00
Shorts and Swim										
Running Shorts	Shorts	Black-Red	SR01066					0	7.95	0.00
	Shorts	Black-Blue	SR01046					0	7.95	0.00
80s Shorts	Shorts	Black	S801006					0	7.50	0.00
	Shorts	White	S801116					0	7.50	0.00
	Shorts	Blue	S801446					0	7.50	0.00
	Shorts	Red	S801666					0	7.50	0.00
CU	Swim Brief	Black-Aqua	SW01044					0	11.00	0.00
Accessories										
Socks	CU	White	ST47147					0	3.00	0.00
Totals								28		195.40

Please pay via **bank transfer**

Bank Account Name Kevin Cheesman VAT #155 0118 43

Bank HSBC Waterlooville 312 London Road PO7 7DX IBAN [REDACTED]

Swift Code [REDACTED] Account Number [REDACTED] Sort Code [REDACTED]

Email info@curbwear.com Address 29A High Street, RYE, East Sussex TN31 7JG

Total ex-VAT	£195.40
Delivery	£2.95
Subtotal	£198.35
VAT @20%	£39.67
TOTAL TO PAY	£238.02

44. The format is such that goods are listed under headings according to the type of garment i.e. 'Underwear', 'Tops', 'Shorts and Swim' and 'Accessories'. Under these headings, the goods appear to sub-divided further according to the particular product line or product e.g. some goods under 'tops' are categorised as 'T-shirt', whereas some other goods are given a name that might be presumed to be a particular line or range e.g. 'Enhance X', 'Enhance Smart'. 28 items of underwear have been purchased amounting to £238.02. Prices are expressed in pounds (£). Although 51 products are listed, the order relates to only 4 of those products; it is therefore presumed that the full list is a 'standard' list automatically included on the invoice where figures are inserted beside the goods ordered. 32 of the 51 products listed are items of underwear; 11 are tops; 7 are swimwear or shorts; 1 item for socks.

45. **Exhibit 13** - is titled 'exhibit 13, class 25, website May 2020' and comprises 6 images of a male clad in underwear. For each image, a year is featured in the bottom right-hand corner of the photograph, and a logo is displayed in the bottom left-hand corner, for example:



46. The 5 subsequent images bear the years 2018, 2017, 2016, 2015 and 2014, respectively. According to the labelling of the photographs in the Exhibit, these images were posted on a website on 19, 20, 21 and 22 May 2020. However, no print-outs (either contemporaneous or obtained via Wayback Machine, for example) of the original web pages themselves have been provided. The photograph bearing the year 2014, and the 'pics and stories' from that year alluded to in the accompanying text, fall outside the relevant period, in any event.

47. I note that the mark in the left-hand corner is neither the mark as registered, nor the other iteration of the mark included in the Opponent's Notice of Opposition; the mark might be taken to be 'CU' or the letter 'C' coalesced with the letter 'W':



48. It is not possible to discern from where the images originate; neither web page addresses nor links to the site have been provided. It appears that the images, together with a small amount of text, have simply been extracted from the source and inserted into a Word document.

49. The following Decision has been made after careful consideration of the papers before me.

Decision

Genuine Use

50. Section 6A of the Act provides that:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) 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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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 European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

51. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch)

Arnold J summarised the law relating to genuine use as follows⁹:

⁹ Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

52. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29];

Centrotherm at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

53. The onus is on the Opponent, as the proprietor of the earlier mark, 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.”

54. 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 itself¹⁰.

¹⁰ Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, GC.

55. My global assessment has determined that the totality of the evidence presented fails to demonstrate that the Opponent has made genuine use of its mark during the relevant period. The body of evidence adduced is very thin; to the extent that, where a particular piece of evidence has evidential shortcomings, other pieces of evidence have insufficient corroborative weight to 'fill in the gaps'. For example, none of the photographs adduced have been shown on their original web-pages or in the publications in which they appeared. In my view, it would not have been onerous for the Opponent to have exhibited the photographs 'at source' i.e. as part of a screenshot from a web-page (whether contemporaneous or in the form of a Wayback print¹¹); or as a print from the page of the catalogue or magazine, as the case may be, in which they were printed.

56. The Opponent has alluded to the existence of its webpage, for example in exhibit 13, in which a series of photographs said to chronicle the brand over the period 2014 – 2020 have been provided. It has also referred, at Q12 of its statement of grounds, to use of its mark across its 'social media'. However, the Opponent has failed to provide the addresses of any websites or social media accounts, or screenshots or print-outs of its webpages. Each photograph exhibited appears to have been copied from its source, pasted into a Word Document and manually annotated with a date. This method of presenting photographs to support proof of use, is, in my view, more cumbersome than simply providing a print-out or screenshot of the webpage in question. If the Opponent was able to extract these photographs from their original sources, it should have been able to provide evidence of those sources.

57. It is accepted that the Opponent has, in fact, made some sales within the relevant period; this has been demonstrated by the invoice dated 18 March 2020 for the sale of 28 items of underwear to a third-party retailer, 'Prowler' whose shop displaying the Opponent's products is shown in the photograph in Exhibit 11. . However, a single invoice is insufficient to demonstrate the frequency or geographical extent of those sales, or the demand for the Opponent's products,

¹¹ A print of a webpage obtained via the web archiving company, Wayback Machine.

across the relevant period. It would not have been onerous for the Opponent to have adduced a selection of invoices for a spread of dates across the 5-year period, because it has provided sales figures amounting to several tens of thousands of pounds (albeit it cannot be discerned to which goods these sales figures relate, given the Opponent's assertion that it has sold class 25 goods beyond the scope of the mark's registration). As the evidence stands, the Opponent has only provided evidence of a single transaction, for an order of men's underwear, on one date in the relevant period.

58. The evidence provided does not include the retail prices of the goods sold. The Opponent could have strengthened its evidence by providing product listings from its own websites and the sites of third-party retailers. The sales figures would have been of more probative value if they had been broken down by month and refined according to the product type or, the terms within the Opponent's specification i.e. *Underwear, swimwear and sportswear for men*.

59. Consequently, the earlier mark may not be relied upon to support the Opponent's claim under s5(2)(b) of the Act. The Opposition therefore fails.

60. Variant Use

Although I have found that the Opponent's evidence has been insufficient to demonstrate genuine use, I address the matter of variant use, which has been raised by the Applicant, for completeness. As already noted above at [18] and [47], the versions of the mark that have appeared in the Opponent's evidence are as follows:

- Exhibits 1, 4 and 6 – 12:



(referred to as mark a) at [19])

- Exhibit 13:



Mark c)

61. Section 6A(4)(a) of the Act provides that “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....”.

62. The test for whether variant use of a mark constitutes use of the mark as registered was summarised by Mr Richard Arnold Q. C. (as he then was) in *Nirvana Trade Mark*, BL O/262/06:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

63. The mark shown in Exhibits 1,4 and 6-12 differs from the mark as registered to the extent that all letters are upper case and the lower curve of the 'C' is

elongated to form an underline for the remaining letters. One further difference is that the rounded part of the 'b' in the mark as registered has been flattened and angled at approximately 45 degrees. In my view, these differences do not prevent the variant of the mark, featured in Exhibits 1,4 and 6-12, from functioning as an indicator of the origin of the goods in respect of which it is registered. The distinctive character of the registered mark resides in the word 'Curb'; the stylisation of the 'C' described does not prevent immediate recognition of the word.

64. I now consider the variant mark shown in Exhibit 13. In my view, this mark will be perceived as either the letters 'CU' or the letter 'C' coalesced with the letter 'W'. In either case, I consider that the variation from the mark as registered is so great that the distinctive character of the registered mark has not translated into the variant used in Exhibit 13. Consequently, I find that this variant does not amount to genuine use of the mark as registered.

Conclusion

65. The opposition fails in its entirety. Subject to any successful appeal against this Decision, the application may proceed to registration for the full range of goods applied for.

COSTS

66. The Applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in fast track proceedings are governed by Tribunal Practice Notice 2/2015¹² according to which costs awarded are capped at £500.

67. The Applicant has filed a Tribunal Costs Proforma in which it states that its costs amount to £3,816. The Applicant refers in its cover email, as well as in the costs proforma, to legal representation. I note, however, that there is no legal

¹² <https://www.gov.uk/government/publications/tribunal-practice-notice-22015/tribunal-practice-notice-22015>

representative on record as acting for the Applicant, the Applicant having filed its Defence and Counterstatement, and corresponded with the Office, on its own behalf. The Tribunal is therefore unable to award any costs in respect of legal representation. There were no written submissions. Consequently, I award the sum of **£200** to the Applicant in respect of considering the notice of opposition and filing a counterstatement.

68. I therefore order Kevin Cheesman to pay to Curb Mask Ltd the sum of **£200**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 16th day of June 2021

Mx N. R. Morris
For the Registrar,
the Comptroller-General