

O/651/22

TRADE MARKS ACT 1994

IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL
REGISTRATION NUMBER WO1533014

AND THE REQUEST

BY

RATIONAL AKTIENGESELLSCHAFT

TO PROTECT THE FOLLOWING TRADE MARK IN THE UK
IN CLASS 11



(COLOURS CLAIMED BLACK, BLUE AND LIGHT BLUE)

AND THE OPPOSITION THERETO UNDER NUMBER 423244

BY

AMANDA DOUGLAS

Background and Pleadings

1. Rational Aktiengesellschaft (“the Holder”) is the holder of International Registration no WO1533014 (“the IR”) in respect of the trade mark as set out on the front cover page. It sought protection in the UK on 3 February 2020 claiming a priority date (from Germany) of 17 October 2019. It was accepted and published in the UK Trade Marks Journal on 13 November 2020 in respect of the goods as set out below:

Class 11: Combined hot-air and steam ovens; installations and apparatus for steam generation, cooking, refrigeration and ventilation for food treatment; cooking apparatus heated by means of pulsated air; high-performance electric deep fryers; high-performance saute pans, namely refractory commercial cooking appliances for short frying of food at high heat; pasta and rice steamers; stoves; stainless steel wash-hand basins [parts of sanitary installations]; all the aforesaid goods for use in large-scale kitchens.

2. On 15 February 2021, Amanda Douglas (“the Opponent”) filed an opposition to the application for designation, under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

3. For the purposes of her claim under section 5(2)(b) the Opponent relies on her earlier UK Trade Marks numbered 2640592 and 2640594 as set out below:

(i) UKTM no. 2640592 (“the First Earlier Mark”)

iZOnEo₃

Filed on 1 November 2012 and registered on 8 February 2013 for goods and services in classes 3, 5, 7, 11, 35 and 37.

(ii) UKTM 2640594 (“the Second Earlier Mark”)

The logo for iZOnEo₃ features the word 'iZOnE' in a bold, black, sans-serif font. The letter 'i' is lowercase, while 'Z', 'O', 'N', and 'E' are uppercase. The letter 'o' is lowercase and is followed by a subscript '3'. The 'i' and 'o' are colored in a vibrant green, while the remaining letters are black.

Filed on 1 November 2012 and registered on 19 April 2013 for goods and services in classes 3, 5, 7, 11, 35 and 37.

4. For the purposes of the Opponent's claim under section 5(2)(b) only the following goods in class 11 are relied upon:

Class 11: Apparatus for lighting, heating, steam generating, ventilating, water supply and sanitary purposes.

5. Under section 5(2)(b), the Opponent claims that the respective marks share the same initial 5 letters iZONE and are visually similar to a high degree "having in part the same colour differentiation to the letter "I" from the word zone in black". Furthermore it is pleaded that the opening part of the respective marks are phonetically identical and have overall the same number of syllables and very similar phonic cadence. The element iZONE it is said is the dominant element of both marks and is conceptually identical. It is claimed that the remaining elements in each are descriptive of an aspect of the products such that they will have limited capacity to distinguish the marks conceptually. Furthermore, the respective goods are identical or similar.

6. Under section 5(3) the Opponent relies only on the First Earlier Mark as already outlined in paragraph 3 claiming a reputation for "*Apparatus for water purification; apparatus for laundry disinfection; apparatus for air purification*".¹ It is claimed that the First Earlier Mark has been used for several years, such that it has developed a reputation in respect of "various sanitisation and disinfection products using ozone". The Opponent claims that the similarity between the respective marks and goods is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between them. This it is said will cause "loss of revenue ...and lost value to the earlier trade mark registration[s]". The Opponent claims that the contested registration will take unfair advantage of the Second Earlier Mark's reputation and be detrimental to its distinctive character.

7. The Holder filed a defence and counterstatement denying the grounds of opposition. Furthermore, in light of their registration dates the Holder has put the Opponent to proof of use of the earlier marks under section 6A of the Act.

8. In these proceedings the Opponent is represented by Sandersons, whereas the Holder is represented by Forresters IP LLP. Both parties filed evidence and in addition

¹ albeit that the mark's specification for which it is registered is drafted more broadly as set out in paragraph 4.

the Opponent filed submissions during the evidence rounds. Neither party asked to be heard on the matter and each party filed submissions in lieu of hearing. This decision is taken following a careful perusal of all the papers.

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. That is why this decision continues to refer to the case law of the EU courts on trade mark matters.

Evidence

10. Ms Amanda Douglas filed a witness statement dated 20 January 2022, accompanied by nine exhibits marked AD1-AD9. Ms Douglas is the director and shareholder of Laundry365 Ltd, who's trading activities were transferred from Laundry Installations and Maintenance Limited in 2017 ("the companies"). It is said that "both earlier marks have always been used under licence by these companies". The purpose of her evidence is to provide background information as to ozone technology and its capabilities, the inspiration for the name, evidence of use of the earlier marks and to demonstrate the reputation claimed. I shall refer to the evidence in greater detail later in my decision.

11. The Holder's evidence is provided by Ms Beate Schwarz-Lang dated 18 March 2022 accompanied by three exhibits marked BSL1-BSL3. Ms Schwarz-Lang is the trade mark department head at the Holder's company, a position she has held since 2015. This evidence sets out the Holder's business and how it markets and uses the IR that it seeks designation in the UK.

12. I do not propose to outline the evidence in full here but shall refer to the relevant parts of the respective statements where appropriate in my decision. Both parties also filed submissions. Again I do not propose to summarise these documents, but I have considered their content and shall refer to them where necessary later in my decision.

Decision

Sections 5(2)(b) and 5(3)

13. Section 5(2)(b) of the Act states as follows:

“5(2) A trade mark shall not be registered if because-

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

14. Section 5(3) of the Act reads as follows:

“5(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

Proof of Use

15. The relevant statutory provisions are set out in section 6A of the Act, which states:

“(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.”

16. By virtue of their earlier filing dates the trade marks relied upon by the Opponent qualify as earlier trade marks pursuant to section 6 of the Act. Since the Opponent’s marks completed their registration process more than five years before the priority date claimed by the Holder, pursuant to section 6A(1A) of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period ending with the priority date claimed by the IR, namely from 18 October 2014 to 17 October 2019.²

17. Section 100 of the Act states that:

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

18. What constitutes genuine use has been the subject of a number of judgements. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“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 Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-

² Section 1A

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.

115. 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].”

Genuine Use

Assessment of the evidence

19. Whether the use shown is sufficient for this purpose, will depend on whether there has been real commercial exploitation of both trade marks, in the course of trade, sufficient to create or maintain a market for the goods at issue during the relevant five-year period. In making the required assessment, I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;
- d. The nature of those goods/services and the market(s) for them;
- e. The geographical extent of the use shown.

20. Use does not need to be quantitatively significant in order to be genuine, however, proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is not genuine use.³

21. From the outset there are difficulties with the Opponent’s evidence. Ms Douglas has not filed any evidence of turnover or marketing/advertising spend. The only evidence of sales of goods under the earlier marks which relate to use, is in relation to the redacted invoices produced at exhibit AD8. Discounting duplicates, 32 invoices are produced in total between 5 December 2013 and 15 November 2021, issued by either Laundry Installations and Maintenance Ltd or Laundry 365. Only 25 of these invoices are within the relevant period, each showing the sale of 1 ozone unit per invoice (the invoices include the provision of installation kits/accessories and other branded goods). The goods relevant to this opposition are referred to within the description column of these invoices as “iZoneO3 Ozone Generators” and “lzone/lzone O3 Ozone Units”. The units are priced at between approximately £3,000

³ *Nike Innovate CV v Intermar Simanto (Jumpman)* O/222/16 Daniel Alexander sitting as the Appointed Person on appeal

to £6,000 per unit. The addresses contained within the invoices show sales predominantly in and around the London area, but do include sales to some customers in areas further afield, for example, Liverpool, Chester, Caerphilly and Southampton. No invoices are produced for 2014 or 2018. The invoices produced for 2019 (four in total) relate to rental agreements and therefore are of little evidential value given that not only is no further information provided as to the extent or period of the contracts entered into, but 'rental services' are not relied upon by the Opponent in this opposition. Taking these invoices as evidence of use/sales it appears that only 21 units were sold in total during the relevant period, the highest volume of sales being during 2016 and 2017, where 9 and 10 units were sold respectively in each year. Even taking sales after the relevant date (between 2020 and 2021) only an additional six units are shown as having been sold. In addition, a number of the invoices are addressed to the same customer and therefore the number of customers established as being exposed to the marks is less than 20 over the five year period.

22. Ms Douglas states that the use of the marks by the companies outlined are done under licence⁴ but no details are provided as to terms of licence or further details as to the financial arrangement between the Opponent and the companies.

23. Ms Douglas states that on 2 November 2012 the domain name "izoneo3.co.uk" was registered and a registration certificate issued by nominet.uk is produced.⁵ The website under this domain name is said to have gone live in 2014 and continues to be active today. In support of this statement two screenshots are produced retrieved using the internet archive Wayback machine website dated 24 September 2015 and 2 January 2019.⁶ The remaining screenshots produced (an additional four) display a print date of 19/20 January 2022 (outside the relevant period). References are made to both earlier marks within the website, in its figurative form displayed on what appear to be images of the apparatus units and within the body of the text. The mere existence of a website and copies of screen shots in isolation, however, are of little value evidentially without any supporting information such as an indication as to how many customers viewed the website, over what period, how many products were sold via the website and the volume of custom generated as a result.

⁴ Para 8 of witness statement

⁵ Exhibit AD1

⁶ Exhibit AD2

24. Ms Douglas states that the brand “iZoneO₃” was officially launched in 2014 at a trade show in Ascot, UK with the provision of four products. Two undated photographs are produced taken from the Opponent’s trade stand at this show.⁷ In the photograph a unit and a poster showing an image of a unit is displayed, each bearing the Second Earlier Mark. This evidence is of little assistance however to demonstrate use, as no further details are provided as to the number of people who visited the trade show, who the event was targeted at; whether it was to only members of the trade or whether it included members of the general public, nor the sales or orders generated as a result.

25. It is stated that “many products were acquired from manufacturers branded iZoneO₃ and then sold or hired to customers.” No details are provided however as to the number of customers, how many products or the income generated. It is said that installation and maintenance services have also been provided by the companies since the outset. However, the Opponent does not rely on services as part of the opposition and therefore this information is not relevant to the assessment.

26. Ms Douglas states that the products were actively marketed through direct mailshot and a UK dealer network. It is said that through this network, units have been supplied for various purposes including Culligan Water to assist in water sanitisation for kitchen use. A brochure dated 2015 is produced said to be used to market the Opponent’s ozone products⁸ and a further marketing brochure (undated) specific to the laundry sector is also produced.⁹ No details are provided as to how many direct mailshots were sent to corporate customers, the cost paid for supplying this service or the number of units supplied. In relation to the brochure again no information is provided as to the number of brochures printed; a breakdown as to the geographical extent of the circulation of the brochures; the number of brochures distributed to the individual dealerships or the number of brochures requested by potential customers. There is no information or figures whatsoever regarding circulation or the cost of producing such materials.

27. Ms Douglas states that the units under the mark were either sold or rented and produces a September 2016 rental price card which demonstrates iZoneO₃

⁷ Exhibit AD3

⁸ AD4

⁹ AD5.

products.¹⁰ The rental card shows the price list of various laundry appliances headed “washing machines, tumble dryers etc; price to rent 72 months effective 1st September 2016”.

28. The only reference to the Opponent’s products are on the last page which include rental prices for the iZone ozone Laundry Systems (Otex) set out as follows:

iZone Ozone Laundry Systems (Otex)

CD1400	1 Channel 4g/hr Output (Upto 30Kg Washer)	£125.00
CD2800	2 Channel 8g/hr Output (Upto 60Kg Washer)	£150.00
CD3120	3 Channel 12g/hr Output (Upto 90Kg Washer)	£175.00
CD4180	4 Channel 16g/hr Output (Upto 120Kg Washer)	£200.00

29. No details as to how many units were rented are produced or during what period or how much income was generated. It is noted that only four invoices are produced at AD8 showing rental agreements but they have not been described as sample invoices and if this were the case then they are not supported by additional financial information of the totals during the relevant period.

30. Ms Douglas states that [they] are a member of the European Ozone Trade Association. An invoice dated August 2015 is produced said to confirm this membership.¹¹ The document is addressed to iZone03, London and the fee is displayed as £300. It is unclear, however, whether this is an ongoing membership or only for the year in question as no further details are provided. Membership itself without further details is of little value in the proof of use assessment as it is unclear whether the membership alone is purely an accreditation indicator allowing the companies to use “ozone technology” or something more. Since no information other than an invoice is provided I am unable to place much weight on this evidence.

31. An extract taken from a HSE publication dated 2014 is produced setting out the common uses of ozone technology and extracts taken from various websites

¹⁰ AD6

¹¹ AD7

(unrelated to the Opponent) are also produced showing the use of ozone in kitchens.¹² No references are made to the earlier marks.

32. Whilst accepting that some use of the earlier marks is demonstrated, the matter I must determine is whether the evidence demonstrates sufficient use of the marks to create a market for the goods in accordance with the caselaw.

33. I am guided by the decision in *Awareness Limited v Plymouth City Council*, Case BL O/236/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. 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.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification.

¹² AD9

Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

34. Furthermore 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.”

35. The evidential burden of satisfying the tribunal as to whether genuine use of the marks at issue have been shown, falls with the Opponent. It is clear that no particular document is required for that purpose.

36. No evidence of the size of the relevant market or its share of the same is produced. There is no advertising spend or figures produced. The majority of the evidence appears to focus on the science being ozone technology and its widespread uses within a number of industries. It appears that the use demonstrated by the Opponent is for an apparatus which attaches to an industrial washing machine for sanitisation/disinfection purposes. No use has been shown by the Opponent for any other purpose/application.

37. Other than the invoices produced at Exhibit AD8 the Opponent’s customer base is limited to some 20 customers in five years. Accepting that the goods in question are not everyday purchases and are in a fairly niche market, nevertheless the sales volumes that have been produced are in my view insufficient to show that true exploitation has been made of the marks.

38. In *Memory Opticians Ltd’s Application*, BL O/528/15, Professor Ruth Annand, as the Appointed Person, upheld the Hearing Officer’s decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. In that case there had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and were localised to 3 branches. This level of use was held to be insufficient to create or maintain a market under the mark. Consequently, it was not genuine use.

39. I accept that according to the caselaw there is no quantitative threshold in this assessment and that sometimes even minimal use is sufficient in order for it to be deemed genuine.¹³ The assessment of genuine use is a global assessment which involves looking at the evidential picture as a whole not whether each individual piece of evidence shows use by itself. Whilst some use has been demonstrated, there is

¹³ *Naazneen Investments Ltd v OHIM*, Case T-250/13

very little evidence dated within the relevant period to support such a finding. I note that the Holder did not challenge the evidence by way of its evidence in reply, but at the same time neither did it accept that the Opponent had sufficiently demonstrated use although it did challenge the evidence in its submissions in lieu. Despite this, this does not mean that I can take the evidence at face value. It is still incumbent on me to assess the evidence as a whole and determine whether it has come up to proof. As Ms Emma Himsworth, sitting as the Appointed Person, stated in *Robot Energy Limited v Monster Energy Company*:¹⁴

“It is necessary to form a view as a matter of judgment whether the evidence is sufficient to establish the relevant fact which requires, as the Hearing Officer correctly said, the decision taker to consider the evidence as a whole.”

40. The burden lies with the Opponent to provide solid, cogent and specific evidence regarding the use of the marks and the extent of use.

41. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round- or lose it”” [original emphasis].

42. It is clear that the Opponent has a business in supplying laundry equipment to corporate customers which include ozone technology units however the use demonstrated of the specific goods in question is limited. The value and volume of the sales are minimal even accounting for the price per unit and that this is likely to be a niche market. Without further explanation or additional corroborative evidence the invoices alone are insufficient for me to reach the conclusion that the sales of 21 units

¹⁴ BLO/308/20

represents a substantial enough proportion of the market. The additional evidence lacks specificity to enable me to take this into account when looking at the picture as a whole .

43. In this regard I do not find that the Opponent has discharged the burden placed on it and that the sale of approximately 21 units over 5 years is insufficient in itself to show that commercial exploitation of the mark is real because the use would not be viewed as warranted in the economic sector concerted to maintain or create a share in the market for the goods protected by the mark. The Opponent has failed to demonstrate sufficient use.

Conclusion

44. Taking into account *Awareness Plymouth* and *Gucci*, in the absence of any other corroborative evidence, I am not satisfied that the Opponent has discharged the burden placed upon it, of demonstrating genuine use of its marks, for the goods relied upon, even accepting the relatively low threshold as set out by the caselaw. The consequence of this conclusion is that the Opponent cannot rely upon these registrations for the purposes of its claim under section 5(2)(b) of the Act and therefore the opposition under this ground fails at the first hurdle.

Other ground of opposition

Section 5(3)

45. For a claim under section 5(3) to succeed, given that the conditions under this section are cumulative, the Opponent must show, first of all, that the First Earlier Mark has achieved a reputation amongst a significant part of the public. Given that it relies upon a UK trade mark then the reputation must be established for UK consumers. In so far as this assessment is concerned, the relevant date is the date from which priority is claimed by the IR, namely 17 October 2019.

46. The Opponent relies upon the same evidence for its claim under section 5(3) as it did for its claim under section under 5(2)(b). As I have already outlined the evidence is limited – little or no evidence has been produced regarding market share, turnover figures, advertising expenditure or geographical extent. The invoices dated in the years leading up to the relevant date to establish a reputation, are minimal, no sales are shown for 2018 and the invoices relating to 2019 are for rental service agreements.

In 2020 only one invoice is produced showing one sale. The invoices are not described as illustrative samples and even if they were without turnover figures I can only ascertain, for sure, that in the years leading up to and after the relevant date, no sales were made in 2018, four rental agreements were entered into in 2019 and one sale was made in 2020. Despite 9 and 10 units respectively having been sold in the years 2016 and 2017 this volume is minimal in light of the threshold set out by the caselaw. In my view the numbers produced are insufficient by themselves to demonstrate that a significant number of relevant consumers within the UK have knowledge of the brand, either in the trade and/or the general public. The number of orders/sales are so minimal even given the price tag per unit, that they are insufficient to show the Opponent has acquired the requisite reputation.

47. Since the threshold for establishing a reputation is higher than that for genuine use, in light of my earlier assessment regarding the evidence filed, I consider that the Opponent has failed to demonstrate that it has a reputation amongst a significant proportion of the relevant public, for the goods relied upon, and sold under the mark, in the UK. Without being able to establish a reputation the Opponent's claim under section 5(3) also fails.

Conclusion

48. Subject to appeal, the opposition under sections 5(2)(b) and 5(3) of the Act fails in its entirety and the IR may proceed to designate for protection in the UK.

Costs

49. The Holder has succeeded and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I note that the Holder filed limited evidence which did not comment on the Opponent's evidence in chief nor was of great value to the decision in suit. The award of costs granted therefore shall reflect the limited value of this evidence. Taking this into account and applying the guidance, I award costs to the Holder on the following basis:

Considering the notice of opposition	£200
and preparing a defence and Counterstatement:	

Considering the Opponent's evidence	£300
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and preparing evidence:

Preparing submissions in lieu of hearing: £300

Total **£800**

50. I order Amanda Douglas to pay Rational Aktiengesellschaft the sum of £800 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 29th day of July 2022

Leisa Davies

For the Registrar