

**BL O/924/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF UK REGISTRATION 2556421  
IN THE NAME OF BIP SOLUTIONS LTD  
IN RESPECT OF THE FOLLOWING TRADE MARK**

**Tendermatch**

**IN CLASSES 9, 35 AND 38**

**AND**

**THE APPLICATION FOR REVOCATION THEREOF  
UNDER NUMBER 504094  
BY  
OPPORTUNI AI LIMITED**

## **BACKGROUND AND PLEADINGS**

1. Trade mark number 2556421 shown on the cover page of this decision stands registered in the name of BIP Solutions Ltd (“the registered proprietor”). It was filed on 18 August 2010 and completed its registration process on 10 December 2010.
2. On 26 August 2021, Opportuni AI Limited (“the applicant”) sought revocation of the mark on grounds of non-use.
3. Under section 46(1)(b), the applicant claims that the mark has not been used during the period 26 August 2016 to 25 August 2021. The date on which it wants revocation to take effect is 26 August 2021.
4. The applicant requests revocation in respect of all of the goods and services for which the contested mark is registered, as follows:

### **Class 9**

Computer software, data recorded electronically from the Internet and data recorded in machine readable form from the Internet.

### **Class 35**

Online business intelligence service, provision of data relating to business opportunities and market news, market leads and market intelligence.

### **Class 38**

Online electronic mail services.

5. The registered proprietor filed a defence in which it submits the following:

*“We seek to defend our continued registration of the Tendermatch trade mark in all classes within which it is currently registered. Our defence is based on proper reasons for non use.*”

*We acknowledge that the mark has not been widely used in external marketing activity during the past five years. We have been developing a portfolio of services, individually branded, with the potential for these to sit under the umbrella brand of Tendermatch. Despite our recent non-use, given the tenure over which we have owned this mark we believe there is still inherent goodwill associated with it across the marketplace within which we operate.*

*The applicant operates in an identical market sector to ourselves; therefore we are concerned that should they be successful in their application to have this mark revoked (and subsequently registered for themselves, as per their separate application) there is a risk of confusion, particularly with our longer-standing client base which dates back over thirty years, compared to their much more recent introduction. We believe that their application to revoke and then register a mark with considerably more longevity than their own business is in effect a short cut to create brand recognition. We believe this is counter to the ethos of trade mark registration and the associated protection this provides. We note that Opportuni have begun to use the term 'Tender Match' in their online marketing activity even before a decision on revocation of the mark has been made by the IPO."*

6. The registered proprietor filed evidence regarding the question of use. This is provided by Grahame Steed, the registered proprietor's Content and Research Director. The witness statement is accompanied by three exhibits, which I will not summarise here, but will return to later in this decision.

7. The applicant did not file evidence but filed written submissions on 25 August 2022.

8. The registered proprietor is representing itself. The applicant is represented by Withers LLP.

9. Neither side requested a hearing. I make this decision following careful consideration of the papers.

## DECISION

10. 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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

11. Section 46 of the Act is as follows:

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

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

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

...

(2) For the purposes of subsection (1) 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 use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

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

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

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

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

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

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

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

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

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

12. Also relevant is section 100 of the Act, which 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.”

13. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV*.<sup>1</sup>

“114. The law with respect to genuine use. 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 Brandbeviliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *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 Bundersvereinigung 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 Marken 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 *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:

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<sup>1</sup> [2018] EWHC 1608 (Ch)

*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].”

14. In *Awareness Limited v Plymouth City Council*<sup>2</sup>, Mr Daniel Alexander Q.C., as the Appointed Person, provided guidance as to the kind and extent of the evidence required to discharge this burden. He said:

“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

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<sup>2</sup> BL O/236/13



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.”

### **Use of the mark**

15. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK during the relevant five-year period. In making my assessment, I am required to consider all relevant factors, including the scale and frequency of the use shown; the nature of the use shown; the goods for which use has been shown; the nature of those goods and the market(s) for them; and the geographical extent of the use shown.

16. In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd*,<sup>3</sup> Mr Geoffrey Hobbs QC, sitting 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] RPC 35:

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<sup>3</sup> BL O/404/13

‘[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.”

17. In other words, there is no requirement to produce any specific form of evidence, but I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark.

## Proprietor's evidence

18. The registered proprietor's evidence is provided by Mr Steed. His witness statement was filed with his counterstatement and is undated. The witness statement was filed on 27 January 2022. He states:

*“BiP Solutions registered the Tendermatch name in 2010. We have built up goodwill and association with the mark since before that time. ‘Tendermatch’ is used to describe the portfolio of contract tendering services that we provide to the market. Since we operate a number of separate brands, the use of this mark helps us demonstrate that we have multiple solutions. It is clear from the evidence demonstrated below that while we focus much of our branding activity on individual services such as Tracker and DCI, the Tendermatch name retains a significant degree of association with BiP Solutions.”*

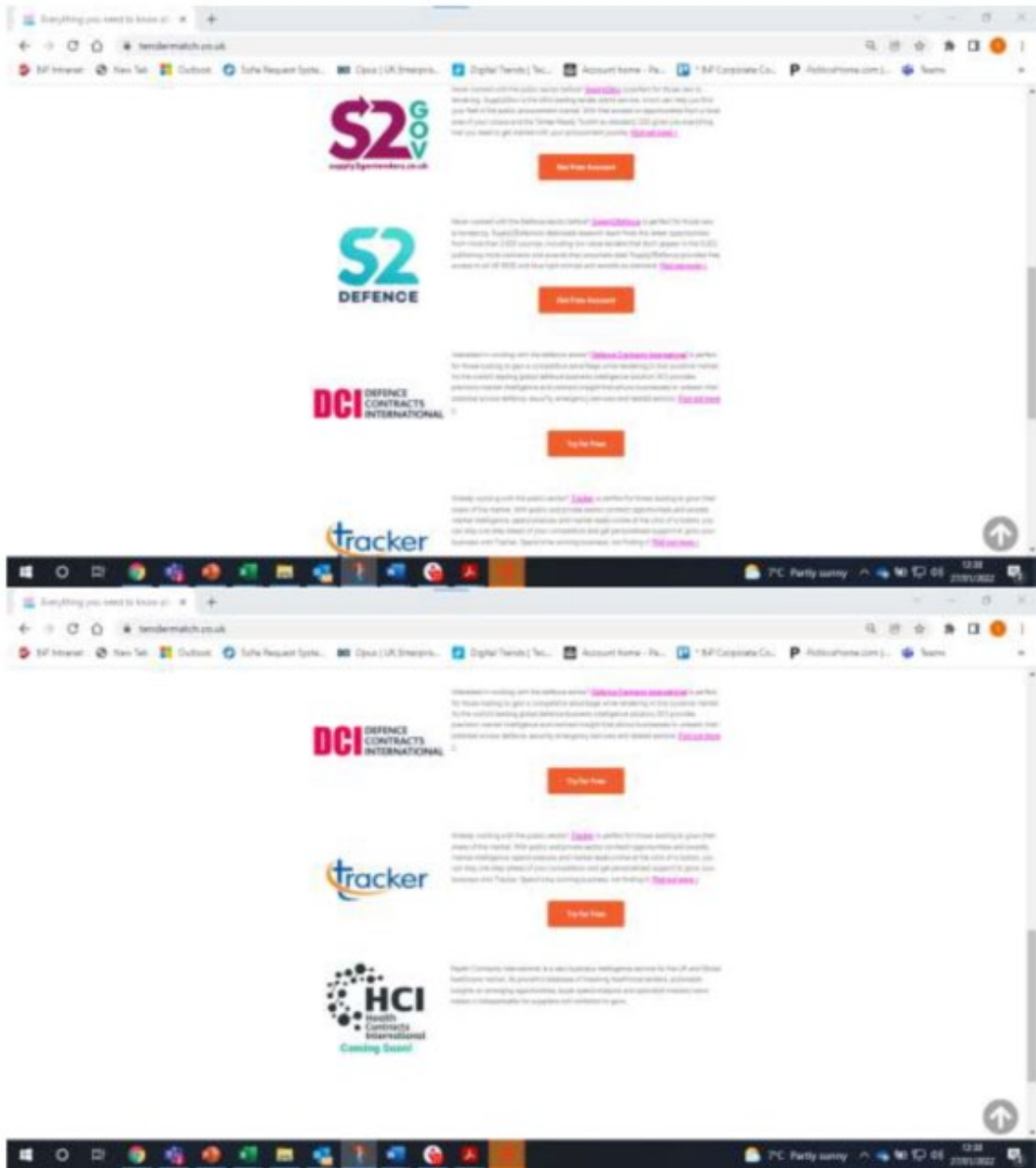
19. Mr Steed provides four exhibits.<sup>4</sup> The first exhibit is described as, “a screengrab of our [www.tendermatch.co.uk](http://www.tendermatch.co.uk) website...”. The exhibit appears to have been printed on 27 January 2022 and is as follows:<sup>5</sup>

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<sup>4</sup> The fourth exhibit is numbered exhibit 3, meaning that there are two different exhibits numbered ‘3’ in the evidence.

<sup>5</sup> I reproduce the exhibit as filed. I am unable to read the smaller text.

## 1. BiP promotion of the Tendermatch brand



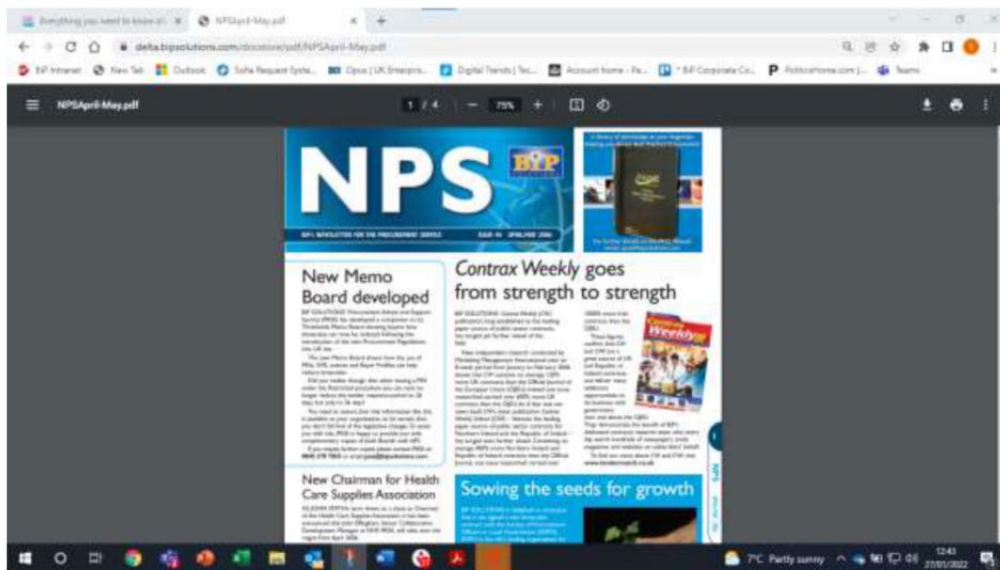
20. Mr Steed says of his second exhibit:

*“Our evidence in item 2 demonstrates that Tendermatch continues to be strongly associated with BiP Solutions and our contract services, such as Tracker.”*

21. The second exhibit appears to have been printed on 27 January 2022 and is as follows:<sup>6</sup>

<sup>6</sup> I am unable to read the smaller text in this exhibit.

2. Reference to BiP's use of the Tendermatch mark dating back to 2006:



22. The third exhibit filed by Mr Steed is titled, 'Third party promotion of the Tendermatch brand'. I cannot read the website from which the first page is taken. The top of the page has the words 'business start-up listings' and shows the word 'Tendermatch' with the registered proprietor's name and address below. The page was printed in 2022, after the relevant date.

23. The next article in the exhibit appears to be taken from 'The Drum' in April 2009 (outside the relevant period). It refers to the proprietor appointing a third party to devise a strategy to encourage visitors to sign up to the proprietor's tracker tool. It includes the sentence, "...having a tool such as tendermatch available to companies is invaluable".

24. The following page shown in the exhibit has a page location which is illegible. It looks as though it is a portal which enables people to sign up to alerts from a number of tendering companies, including the registered proprietor. Its email address is shown as www.tendermatch.co.uk. However, the page is undated and it was printed in 2022, after the relevant date.

25. The next example in the third exhibit is a directory listing taken from First Directory. The word 'Tendermatch' is shown on the page, with the registered proprietor's name and address shown below. It is not dated other than the page printing date, which is in 2022, after the relevant date.

26. The next screenshot in the exhibit looks to be a web analysis for tendermatch.com. The text is illegible and the web analysis itself is not dated. The page print date is 2022, after the relevant date.

27. The fourth exhibit, numbered '3', is a copy of the applicant's terms and conditions and is not relevant.

28. The sum total of the evidence filed is an exhibit printed after the relevant date which does not show any legible reference to the contested mark. A second exhibit, also printed after the relevant date, purports to show the registered proprietor's use of the Tendermatch mark in 2006. The two problems with that exhibit are firstly, that I cannot read any of the text of the exhibit, other than headings, and these do not refer to the mark; and secondly, that 2006 is several years before the registered proprietor's trade mark was applied for and registered and so falls well outside the relevant period for which proof of use evidence is required in order to maintain the proprietor's trade mark registration. A third exhibit comprises screen shots of claimed third party reference to the mark, all of which are outside the relevant period and primarily consist of directory listings.

29. As Mr Alexander said in the *Plymouth City Council* case referred to above, the burden is on the registered proprietor to show genuine use and they are in the best position to provide that evidence. The registered proprietor has not provided me with supporting narrative, turnover figures, invoices, examples of advertising or promotional material or in fact any evidence at all of a customer purchasing its goods or services during the relevant period. Clearly, the only conclusion I can reach is that the registered proprietor has not shown use in a commercial sense to create a market for the relevant goods in class 9 and services in classes 35 and 38 during the period claimed by the applicant.

30. Having reached this conclusion I will go on to consider the proprietor's case that they have proper reasons for non-use.

31. The registered proprietor does seem to have been alive to this issue in its counterstatement in which it said:

*"...Our defence is based on proper reasons for non use.*

*We acknowledge that the mark has not been widely used in external marketing activity during the past five years. We have been developing a portfolio of services, individually branded, with the potential for these to sit under the umbrella brand of Tendermatch..."*

32. And:

*"Despite our recent non-use, given the tenure over which we have owned this mark we believe there is still inherent goodwill associated with it across the marketplace within which we operate."*

33. In the judgment of the CJEU in *Häupl v Lidl Stiftung & Co KG*<sup>7</sup> it was stated:

"It follows that only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as 'proper reasons for non-use' of that mark."

34. The CJEU reaffirmed its position in *Il Ponte Finanziaria SpA v OHIM*<sup>8</sup> when it stated:

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<sup>7</sup> Case C-246/05, CJEU.

<sup>8</sup> Case C-243/06P [2008] ETMR 13, CJEU.

“The concept of “proper reasons”...refers essentially to circumstances unconnected with the proprietor of a trade mark which prevent him from using the mark...”

35. The registered proprietor’s reasoning for its claim to proper reasons for non-use seems to be that it was developing a portfolio of products to sit under the umbrella brand ‘Tendermatch’. There is no evidence of this, but even if there were, this is not a circumstance beyond the control of the proprietor, who has had the contested Tendermatch trade mark on the register since December 2010. There does not seem to be any reason why the registered proprietor has been unable to bring any of its products to market, nor was the development of such products prevented for reasons beyond its control.

36. The claim to there being proper reasons for non-use is rejected.

## **CONCLUSION**

37. The application has succeeded and the contested trade mark is revoked from 26 August 2021.

## **COSTS**

38. The applicant for revocation has been successful and it is entitled to a contribution towards its costs.<sup>9</sup> I make the award as follows:

Official fee:	£200
Preparing a statement and considering the other side’s statement:	£300
Considering evidence and preparing submissions:	£500

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<sup>9</sup> Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016.



Total:

£1000

39. I order BIP Solutions Ltd to pay Opportuni AI Ltd the sum of £1000. The above sum should 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 25<sup>th</sup> day of October 2022**

**AI Skilton**

**For the Registrar,**

**The Comptroller-General**