

BL O/991/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3655456
BY DEVINTEC, SAGL**

TO REGISTER THE TRADE MARK:

ATOPISAN

IN CLASSES 3 and 5

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60002147
BY PILI SIGLO XXI, S.L.**

Background and pleadings

1. On 15 June 2021, DEVINTEC, SAGL (“the applicant”) filed trade mark application number UK00003655456 (“the contested mark”) for the mark shown on the cover page of this decision. However, the application has a priority date of 05 November 2020.¹ The application was published in the Trade Marks Journal for opposition purposes on 15 October 2021, in respect of the following goods:

Class 3 Cosmetics; Cosmetic creams; Lotions for cosmetic purposes; Ethereal oils.

Class 5 Dermatological pharmaceutical products; Dermatological preparations; Sanitary products for medical use.

2. On 14 January 2022, PILI SIGLO XXI, S.L. (“the opponent”) filed a Fast Track opposition, opposing the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon its comparable United Kingdom trade mark (“UKTM”) number 905631742,² ‘ATOPISES’ (“the earlier mark”). The earlier mark was filed on 22 January 2007, and became registered on 23 January 2008, in respect of the following goods:

Class 3 Cosmetic preparations for skin care.

Class 5 Pharmaceutical skin care preparations.

3. In its notice of opposition, the opponent essentially argues that the marks at issue are highly similar, and the respective goods are identical, resulting in a likelihood of confusion.

4. The applicant filed a counterstatement in which it denies that there is a risk of confusion between the respective trade marks. However, it admits that some of the goods at issue do coincide.

¹ European Union Intellectual Property Office (EUIPO)(EM) 018332396

² On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number 005631742 being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and the original EUTM filing date remains.

5. The registration procedure for the earlier mark was completed more than five years prior to the filing date of the contested application. Therefore, it is subject to proof of use pursuant to section 6A of the Act. In its notice of opposition, the opponent made a statement of use and filed proof of use evidence in relation to the goods relied upon.

6. Rules 20(1)-(3) of the Trade Marks Rules (the provisions which provide for the filing of evidence) do not apply in fast track oppositions but Rule 20(4) does. It reads:

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

7. The effect of the above 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.

8. 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.

9. The applicant is represented by Lara Grant; the opponent is represented by Brand Murray Fuller LLP. As a hearing was not requested by the parties, nor were written submissions filed in lieu, this decision is taken following a careful review of the papers before me.

EVIDENCE

10. The opponent's evidence, consisting of three exhibits (Exhibit 1 – Exhibit 3), was filed at the same time as the form TM7F as per the fast track requirements. The contents of the exhibits are listed as follows:

Exhibit 1

- 41 invoices relating to the sale of 'ATOPISES' goods between 03/01/2017 and 25/08/2021. The delivery addresses shown on the invoices relate to

various countries in the EU, namely Spain, Portugal, Estonia, France, Poland, Romania, Ireland, Croatia, Germany, Sweden, as well as the UK.

Exhibit 2

- Printouts from websites ‘www.dermoventas.com’, ‘www.caretobeauty.com’, ‘www.promofarma.com’, ‘www.elcorteingles.es’, dated 01/07/2022, showing various products featuring the ‘ATOPISES’ mark.

Exhibit 3

- 5 photographs featuring in-store shelving display units containing various products. The ‘ATOPISES’ mark can only clearly be seen on one product in one of these printouts (1/5). These photographs are undated.

11. That concludes my summary of the opponent’s evidence, insofar as I consider it relevant. I will refer to it, where necessary, during this decision.

DECISION

Relevance of EU law

12. 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. This is why this decision continues to make reference to the trade mark case law of EU courts.

Proof of use

13. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

“6A (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)-(5A) [Repealed]

(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.”

14. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

15. Section 100 of the Act is also relevant, which reads:

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

16. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade mark was made within the relevant territory in the relevant period, and in respect of the goods as registered.

17. 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 Court of Justice of the European Union (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*, 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-9223, Case C- 495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Behher 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]."

18. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is 06 November 2015 to 05 November 2020.

19. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the UKTM, in the course of trade, sufficient to create or maintain a market for the goods at issue during the relevant five-year period. Given that the earlier mark is a comparable mark, the relevant territory during the five-year period is the UK, though use in the EU before IP completion day may be sufficient. In making the assessment, I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown;
- ii) The nature of the use shown;
- iii) The goods for which use has been shown;
- iv) The nature of those goods and the market(s) for them; and
- v) The geographical extent of the use shown.

20. Before assessing the opponent's evidence of use, I remind myself of the comments of Mr Daniel Alexander QC, sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*, where he stated that:³

“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.”

21. I also note Mr Alexander's comments in *Guccio Gucci SPA v Gerry Weber International AG*.⁴ Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition actions. 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”.”

³ Case BL O/230/13

⁴ Case BL O/424/14

22. The comments of Mr Geoffrey Hobbs QC in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, where he sat as the Appointed Person, are also relevant.⁵ He 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.

23. 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

⁵ Case BL O/404/13

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.”

23. I remind myself that 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 itself.⁶

24. In its counterstatement, the applicant criticised the opponent’s evidence as follows:

“Firstly, from the proof of use filed by the Opponent it is unclear to which goods it refers to, those in class 3 or those in class 5. Secondly, all invoices filed under Exhibit 1 are issued by an entity, Sedersma [Sesderma], S.L. from Spain which relationship with the Opponent is unclear to the Applicant. Thirdly, the sample invoices filed within the relevant period – that is within 04/11/2015 al 04/11/2020 (five years before the priority date of the Application) [sic] do not appear to support the sales figures indicated in years 2017-2020. Fourthly, Exhibit 2 consists of printouts of websites showing the product but are all dated on 7 January 2022 which is outside of the relevant period. Also some are untranslated (see pages 53 and 54 of the second part). Fifthly, Exhibit 3 consists of undated photographs of products displays in shops with no further information on the territory of use.”

25. On balance, I agree with the applicant’s viewpoint. It is important to recall that the onus is on the opponent to provide ‘sufficiently solid’ evidence in order to prove use. However, I find that there are numerous deficiencies within the opponent’s evidence provided.

26. Turnover for the ATOPISES mark between 2017 and 2021 is as follows:

Year	Turnover (€)
2017	324778.49
2018	3371579.74
2019	512278.5

⁶ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

2020	171242.51
2021	87089.02

27. The turnover figures are supported by 41 invoices (Exhibit 1), the majority of which are dated within the relevant period, spanning three years.

28. With regard to the invoices, while it is noted that the details of the invoices relate to the sale of products featuring the 'ATOPISES' mark, namely oils, bath gels and moisturising creams for the lips and body, in various EU countries, it is not clear which of the relevant goods listed in the invoices belong to *cosmetic preparations for skin care* (Class 3) or *pharmaceutical skin care preparations* (Class 5). Moreover, the invoices appear to originate from 'Sesderma, S.L.' and it has not been made clear what relationship this entity has with the opponent, 'PILI SIGLO XXI, S.L.'

29. The website printouts contained in Exhibit 2 are taken from various websites featuring products displaying the 'ATOPISES' mark, however it is noted that these printouts are all dated 7 January 2022, which is outside of the relevant period. Whilst it is presumed that this was the date the pages were printed from the websites, unfortunately these printouts only demonstrate that the mark was being used on various skin products on the date the pages were printed, and I am therefore unable to determine with any accuracy how the various websites looked during the relevant period.

30. The photographs contained in Exhibit 3 feature store shelving display units containing various products. However, the 'ATOPISES' mark can only clearly be seen on one product in one of the photographs (1/5). The wording shown on the products in the remaining photographs is so small that it is unreadable. Furthermore, the photographs are undated, and it is not clear where in the EU these products are being sold.

31. In addition, the opponent has not submitted any evidence or figures relating to the promotion of the goods at issue under the 'ATOPISES' mark.

32. Accordingly, while I acknowledge that the use of a mark does not have to be quantitatively significant to be genuine, the only possible evidence of any sales within

the relevant period takes the form of 41 invoices, the majority of which are dated within the relevant period.

33. However, as previously stated, it is not clear which of the relevant goods listed in the invoices belong to *cosmetic preparations for skin care* (Class 3) or *pharmaceutical skin care preparations* (Class 5), and moreover, the invoices appear to originate from 'Sesderma, S.L.' and it has not been made clear what relationship this entity has with the opponent, 'PILI SIGLO XXI, S.L.'. While I recognise that evidence of use may indicate that a third party has used the mark in question with the consent of the proprietor of the mark and that use with consent may be implied without explicit explanation,⁷ in the case before me, there is no evidence from which I can even infer use with consent.

34. Accordingly, I find that the opponent's evidence is insufficiently solid to adequately demonstrate that there has been genuine use of the mark in relation to the goods upon which the opponent relies. If the mark had been put to genuine use on the goods relied on in the EU, within the relevant period, then it should not have been a difficult matter for the opponent to show it. However, it did not.

Conclusion

35. The opponent has failed to establish genuine use of its earlier mark within the relevant period. The opposition falls at the first hurdle and is dismissed accordingly. Subject to appeal, the application will proceed to registration.

Costs

36. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice (TPN) 2/2016. For Fast Track opposition proceedings, costs are capped at £500, excluding the official fee. In the circumstances, I award the applicant the sum of £250, calculated as follows:

Considering the opponent's statement	£250
and preparing a counterstatement	

⁷ See *Makro Zelfbedieningsgroothandel CV and other v Diesel SpA*, Case C-321/08 and *INoTheScore Trade Mark*, BL O/276/09.

Total

£250

37. I therefore order PILI SIGLO XXI, S.L. to pay DEVINTEC, SAGL, the sum of £250. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 14th day of November 2022

Sam Congreve

For the Registrar