

O-202-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 500856
BY YOUR LEISURE KENT LIMITED FOR REVOCATION OF
UK TRADE MARK REGISTRATION NO. 2399009 IN THE NAME OF
MARTIN E EARL**

BACKGROUND & PLEADINGS

1. UK Registration No. 2399009 is for the trade mark:



It was applied for on 10 August 2005 and the registration procedure was completed on 17 February 2006. Although it is registered for a range of services in classes 35, 38, 41 and 42, these proceedings only concern the following services in class 41:

Provision of health club, sporting, gymnastic, recreation and tourist facilities; fitness studios/gyms; physical education services; provision of instruction in sport, health care and beauty.

2. For reasons which will become apparent later in this decision, it is important to keep in mind that the trade mark is also registered for a range of services in class 35 and for the following services in class 41 (neither of which are subject to attack):

Transferring and dissemination of entertainment information and data via computer networks and the Internet.

The trade mark is registered in the name of Martin E Earl (“the proprietor”).

3. On 26 May 2015, Your Leisure Kent Limited (“the applicant”) applied for revocation of the registration in respect of the services shown in paragraph 1 under the provisions of section 46(1)(a) of the Trade Marks Act 1994 (“the Act”). The applicant asks for the registration to be revoked with effect from 18 February 2011.

4. The proprietor filed a Form TM8 and counterstatement in which he states the trade mark has been used in the United Kingdom in relation to the services at issue.

5. Although only the proprietor filed evidence, the applicant filed written submissions during the evidence rounds. Whilst neither party asked to be heard, the applicant filed written submissions in lieu of attendance at a hearing. I will bear these submissions in mind, and refer to them, as necessary, below.

The proprietor’s evidence

6. This consists of a witness statement from the proprietor, Martin Earl. Mr Earl explains that the information in his statement comes from his own personal knowledge and from the records of his company Solo Design and confirms that he authorised to speak on his company’s behalf.

7. Mr Earl states that the trade mark was first used in the United Kingdom by him in 2006 and continues to be used. Paragraph 3 of Mr Earl's statement reads as follows:

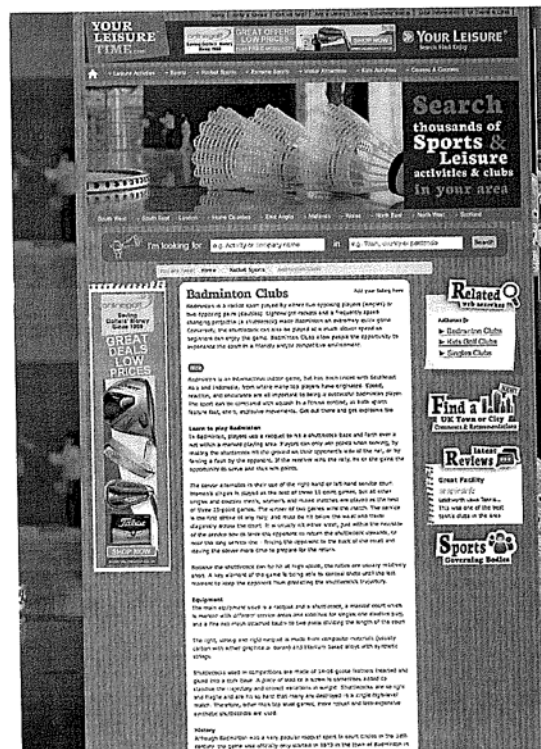
“The goods/services on which the mark has been used, and the date of first use, are as follows:- Exhibit YL-ITEM3 which is a copy of an industry standard quantitative statistical program running on the site “yourleisuretime.com” which is the product “Your Leisure”.

8. Exhibit YL-ITEM3 consists of a page obtained from “StatCounter” relating to the period 1 January 2008 to 31 January 2011. It consists of a range of data items relating to what Mr Earl states is the website “yourleisuretime.com”. Mr Earl notes that the website received the following number of page views:

Year	Annual page views
2008	258, 743
2009	333, 097
2010	254, 779
2011	259, 576

I note that the page contains further information relating to “Unique Visits”, “First Time Visits” and “Returning Visits”. “Total” and “Average” figures for all of these items are also provided.

9. Exhibit YL-ITEM4 consists of what Mr Earl describes as a “sample page of the online content for badminton clubs...” He states it is a “typical sports page, and one of over 70 on the site...”, adding that “this page has been online and viewed under the trade mark “Your Leisure” for not less than 8 years”. The page looks like this:



As one can see, the words YOUR LEISURE TIME.com appears at the top left of the page and the registered trade mark (albeit in black and white) and accompanied by the words SEARCH FIND ENJOY appears at the top right of the page. The following also appears:

“Search thousands of Sports & Leisure activities & clubs in your area”.

Other than the words “Badminton Clubs”, “Learn to play badminton”, “Equipment” and History”, the text in this part of the document is too small and indistinct to be discerned, although I note Mr Earl states the page provides:

“sport specific information by giving users information about the sport, how to play, what equipment is needed, health benefits, the history and where they can take part in sport in the UK.”

10. Exhibit YL-ITEM6 is, states Mr Earl, a copy of the current home page. He explains that:

“The design of the site has changed over the duration of the trade mark period, however the site content has remained the same for no less than 8 years.”

The page looks much like that shown above, there also appears text which insofar as it can be discerned reads:

“Welcome to YOUR LEISURE TIME
The largest dedicated UK Sports & Leisure Time Directory.”

At the bottom left of the page the following appears:

“FREE Listing Sports & Leisure activities and clubs”.

Mr Earl states this page demonstrates:

“...the leisure, entertainment and sporting content. The site provides users information and maps on all counties in the UK and brief summaries of over 3,000 towns and villages, and their relevant locations and landmarks...”

11. Exhibit YL-ITEM7 consists of an undated Google search for the term: “site:yourleisuretime.com”. Mr Earl states that this page shows that:

“...there are over 88,000 searchable pages on Google which serve to create brand awareness of the “Your Leisure” trade mark. Including the trade mark text and device in multiple locations on every one of these pages...”

12. Exhibits YL-ITEMS1, 2 and 5 consist of what Mr Earl states:

“...are copies of advertising which were created and distributed between 2006 and no later than 2011.”

The first of these exhibits contains, inter alia, the trademark the subject of the registration presented in black and white. Exhibits 1 and 2 extol the virtues of the proprietor's website with exhibit 1 containing, inter alia, the following text:

"3 easy steps to thousands of potential users"

And:

"Your Leisure has a range of advertising options available to make sure your facility, club or class is found by potential users"

And:


"The UK's largest dedicated sports leisure and entertainment and information directory".

Exhibit 2 contains, inter alia, the following:

"10 Great features of Your Leisure".

Exhibit 5 contains a range of screenshots all of which bear the trade mark the subject of the registration presented in black and white. The trade mark appears in the format shown below and is accompanied by wording which varies to reflect the activity in question i.e. badminton, squash, swimming and triathlon:

What to know about doing a Triathlon!



Your LEISURE presents free...
One-to-one Triathlon Advice

Get a personal, one-to-one consultation with a triathlon expert. We'll help you plan your triathlon, choose your gear, and get you started on your triathlon journey. With the support of our triathlon experts, you'll be able to plan your triathlon with confidence and ease.

Find out more about our triathlon advice service. We'll help you plan your triathlon, choose your gear, and get you started on your triathlon journey. With the support of our triathlon experts, you'll be able to plan your triathlon with confidence and ease.

Visit www.yourleisuretime/tcl-advice
for 'What to know' or call us on 07861 704 199

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13. Mr Earl concludes his statement in the following terms:

“5. I strongly believe that as a result of the use made of the trade mark “Your Leisure” and the continued investment in branding, the users of the site in the United Kingdom distinguish us as a sports, leisure and entertainment information brand under the trade mark “Your Leisure”. The service is a free service with the primary objective to provide information, advice and educate people on ways in which they may use their time to enjoy on cultural, sport and leisure activities that meet their needs. Tens of thousands of pounds have been spent on development and copywriting over the last 10 years and we will continue to drive this brand towards our goals, a service that educates and provides information on sport and leisure activities. We are currently investing considerable time enhancing the “Your Leisure” website and services for an updated look and feel targeted for launch at the beginning of 2016.”

14. That concludes my summary of the evidence filed, to the extent that I consider it necessary.

DECISION

The Law

15. Section 46 of the Act reads as follows:

“46.- (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) ...

(c)

(d)

(2) For the purpose of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

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

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

(4).....

(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.”

16. Section 100 of the Act is also relevant and reads:

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

17. The application for revocation is based upon section 46(1)(a) of the Act and that the relevant five year period is, therefore: 18 February 2006 to 17 February 2011.

The authorities on genuine use

18. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He stated:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundservvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].
- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].
- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].
- (7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19. The applicant’s view of the proprietor’s evidence can, I think, be best summed up by the following which appeared in its written submissions filed in lieu of attendance at a hearing:

“7...The applicant submits that it is self-evident from looking at the website that its purpose is to provide directory information about sports and leisure facilities provided by third parties and about sports and leisure activities in general and to provide advertising space for third parties. This does not amount to provision by the registered proprietor of the contested services under the registered trade mark. Such use falls squarely within class 35 and within “transferring and dissemination of entertainment information and data via computer networks and the Internet” in class 41.”

20. In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, stated:

“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.”

21. The proprietor's evidence indicates that his registered trade mark is used in relation to a website, the principal purpose of which, is to allow users to search for "thousands of sports and leisure activities and clubs" in the United Kingdom. No evidence has been provided which indicates that the proprietor has at any time attempted to create or maintain a market for the "provision of health club, sporting, gymnastic, recreation and tourist facilities, fitness studios/gyms; physical education services". Rather, what the proprietor does, is to provide users of his website with the means to search for unrelated third party undertakings in the United Kingdom which do provide such facilities and services. The application for revocation succeeds in relation to these named services.

22. That leaves the following services to be considered: "provision of instruction in sport, health care and beauty." Once again, no evidence has been provided which indicates that the proprietor has provided instruction in relation to "health care and beauty". There is, however, contained in exhibit 4 and in particular exhibit 5, evidence which suggests that during the relevant period the proprietor may have attempted to create a market for the "provision of instruction in sport" (in particular badminton, squash and triathlon). The proprietor's evidence indicates this service may be obtained by visiting a particular section of the proprietor's website or by calling a mobile telephone number. I have, however, no evidence which explains, for example, by what means and to whom this advertising was distributed or (if at all) the number of times this instruction service was actually used. I am, as a consequence, simply not in a position to conclude on the basis of the evidence provided, that any use the proprietor may have made of his trade mark in relation to this particular service would be considered warranted in the economic sector concerned (the market for which must, in my view, be not insignificant). The application for revocation also succeeds in relation to these services.

Conclusion

23. As a consequence of the conclusions I have reached above, the application for revocation succeeds in full in respect of all the services for which revocation has been sought i.e.

Provision of health club, sporting, gymnastic, recreation and tourist facilities; fitness studios/gyms; physical education services; provision of instruction in sport, health care and beauty.

Subject to any successful appeal, trade mark registration no. 2399009 will be revoked in relation to these services from 18 February 2011 under the provisions of section 46(1)(a) of the Act.

Costs

24. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the other side's statement:	£300
Considering the other side's evidence and filing of written submissions:	£400
Written submissions in lieu of a hearing:	£300
Official fee:	£200
Total:	£1200

25. I order Martin E Earl to pay to Your Leisure Kent Limited the sum of **£1200**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of April 2016

C J BOWEN
For the Registrar
the Comptroller-General