

O-168-17

**TRADE MARKS ACT 1994
IN THE MATTER OF
REGISTRATION NO. 1313967
IN THE NAME OF HOLA S.L.
FOR THE TRADE MARK**

HOLA!

**IN CLASS 41
AND THE APPLICATION FOR REVOCATION THEREOF
UNDER NO. 501097
BY HELLOO S.A.**

Background

1. Hola S.L. is the registered proprietor of the trade mark HOLA! in respect of 'Publication of newspapers, books, magazines and of printed matter, all for others, all included in class 41'. The trade mark was filed on 24 June 1987 and completed its registration procedure on 20 October 1989.

2. Helloo S.A. ('the applicant') seeks revocation of the trade mark registration on the grounds of non-use based upon Sections 46(1)(a) and (b) of the Trade Marks Act 1994 ('the Act').

3. Under section 46(1)(a), revocation is sought in respect of the 5 year period following the date of completion of the registration procedure, namely 21 October 1989 to 20 October 1994, with a claimed date of revocation of 21 October 1994. Under section 46(1)(b), revocation is sought in respect of three periods, as follows: i) 31 December 2010 to 30 December 2015 with a claimed date of revocation of 31 December 2015; ii) 31 December 2005 to 30 December 2010 with a claimed date of revocation of 31 December 2010; and iii) 31 December 2000 to 30 December 2005 with a claimed date of revocation of 31 December 2005.

4. The registered proprietor filed a counterstatement in which it states it has put its trade mark to genuine use within each of the 5 year periods referred to above.

5. Only the registered proprietor filed evidence. The applicant filed submissions. A hearing took place before me at which the registered proprietor was represented by Ms Claire Evans of Fry Heath & Spence LLP; the applicant was not represented.

Evidence

6. The registered proprietor's evidence comes from two individuals: Javier Junco Aguado, legal representative of Hola S.L in Spain and Claire Evans of Fry Heath & Spence LLP, the UK representative of Hola S.L. in these proceedings.

7. Mr Aguado states, and provides, the following:

- Hola S.L. publishes the well-known Spanish celebrity news magazine **HOLA!** The first issue was published in 1944. Since 12 October 1999, HOLA S.L. also publishes an online magazine through the website www.hola.com. This website is in Spanish but is read by a large number of Spanish-speaking consumers based in the UK.
- Exhibit 1 is a table obtained from Google Analytics showing the monthly number of users from the UK accessing the website www.hola.com over the period from 24 May 2011 to 23 June 2016. The user figures for the period of 2011 to 2015 steadily increase every month from 9,276 in May 2011, 21,644 in April 2012, 34,011 in April 2013, 43,287 in April 2014, up to 105,126 in April 2015.
- When the website is accessed by a consumer in the UK, they are shown content which is specially selected for UK consumers such as advertisements in English for goods and/or services that only be of interest to a UK consumer.
- A UK consumer is offered subscriptions to HOLA! Magazine on a page with instructions in English.
- It has not been possible to obtain historic examples of screenshots from the website as they would have appeared when accessed by a consumer in the UK. However, Ms Claire Evans of Fry Heath & Spence LLP has obtained current examples of screenshots as they appear when accessed by a consumer in the UK which are exhibited to her witness statement.
- Similar advertisements and subscription offers to those shown in Ms Evans' evidence would have appeared in the past whenever the website was accessed by a consumer in the UK.

8. Ms Evans states, and provides, the following:


- Exhibits 2, 3 and 4 are screenshots from the website www.hola.com showing, what appears to be, magazine articles in Spanish. The subject matter appears to be in the form of entertainment news about celebrities. The signs



, hola.com and HOLA! are present at the top of the internet page in exhibits 2 and 3. Exhibit 4 only shows the sign HOLA.com. There are

advertisements on the website in the English language. The first is an advert from www.lastminute.com advertising spa days/breaks in the UK. The second is an advert from www.fisherinvestments.co.uk offering advice to UK retirees wishing to move abroad. The third is an advert from www.italia.com advertising flights from London to various cities around the world.

- Exhibit 5 is a screenshot from www.hola.com showing a page offering subscriptions to HOLA! Magazine. The magazine itself is in Spanish and the price is given in Euros. However, the instructions on the page are in English and the page shows that it is possible for a UK consumer to purchase a subscription to the magazine and have it shipped to the UK.
- Exhibit 6 is a further screenshot from www.hola.com showing part of an article

in Spanish. The page bears the signs hola.com and . Ms Evans states that the registered proprietor's name, Hola S.L, is present at the bottom of the page showing that it is the publisher of the website.

Legislation

9. Section 46(1) of the Act states:

“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;

(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) An application for revocation may be made by any person, and may be made 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.”

10. Section 100 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.”

11. 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 said:

“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 Bunderversammlung 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].”

12. The case-law concerning use of a trade mark on the internet is also of assistance in the present case. In joined Cases C-585/08 and C-144/09, *Pammer v Reederei Karl Schlüter GmbH & Co. KG and Hotel Alpenhof GesmbH v Heller* the CJEU interpreted the national court as asking, in essence, “on the basis of what criteria a trader whose activity is presented on its website or on that of an intermediary can be considered to be ‘directing’ its activity to the Member State of the consumer's domicile ..., and second, whether the fact that those sites can be consulted on the internet is sufficient for that activity to be regarded as such”.

13. The court held that it was not sufficient for this purpose that a website was accessible from the consumer’s Member State. Rather, “the trader must have manifested its intention to establish commercial relations with consumers from one or more other Member States, including that of the consumer's domicile”. In making this assessment national courts had to evaluate “all clear expressions of the intention to solicit the custom of that state's customers”. Such a clear expression could include actual mention of the fact that it is offering its services or goods “in one or more Member States designated by name” or payments to “the operator of a search engine in order to facilitate access to the trader's site by consumers domiciled in various member states”. Finally, the court concluded:

“The following matters, the list of which is not exhaustive, are capable of constituting evidence from which it may be concluded that the trader's activity is directed to the Member State of the consumer's domicile, namely the international nature of the activity, mention of itineraries from other Member States for going to the place where the trader is established, use of a

language or a currency other than the language or currency generally used in the Member State in which the trader is established with the possibility of making and confirming the reservation in that other language, mention of telephone numbers with an international code, outlay of expenditure on an internet referencing service in order to facilitate access to the trader's site or that of its intermediary by consumers domiciled in other Member States, use of a top-level domain name other than that of the Member State in which the trader is established, and mention of an international clientele composed of customers domiciled in various Member States. It is for the national courts to ascertain whether such evidence exists.”

14. The CJEU adopted a broadly similar approach in Case C-324/09 *L’Oreal v eBay (L’Oreal)* when asked whether goods bearing a trade mark and offered for sale on an online marketplace were being offered for sale in a particular territory. Paragraph 65 of the judgment reads:

“64 It must, however, be made clear that the mere fact that a website is accessible from the territory covered by the trade mark is not a sufficient basis for concluding that the offers for sale displayed there are targeted at consumers in that territory (see, by analogy, Joined Cases C-585/08 and C-144/09 *Pammer and Hotel Alpenhof* [2010] ECR I-0000, paragraph 69). Indeed, if the fact that an online marketplace is accessible from that territory were sufficient for the advertisements displayed there to be within the scope of Directive 89/104 and Regulation No 40/94, websites and advertisements which, although obviously targeted solely at consumers in third States, are nevertheless technically accessible from EU territory would wrongly be subject to EU law.

65 It therefore falls to the national courts to assess on a case-by-case basis whether there are any relevant factors on the basis of which it may be concluded that an offer for sale, displayed on an online marketplace accessible from the territory covered by the trade mark, is targeted at consumers in that territory. When the offer for sale is accompanied by details of the geographic areas to which the seller is willing to dispatch the product, that type of detail is of particular importance in the said assessment.”

Therefore use of a mark on the internet does not count as use in the UK unless it is targeted in some way at UK consumers.

Decision

15. First, I need to deal with the form in which the mark has been used. Whilst some of the evidence shows use of the mark Hola!¹, as registered, there is also use of




and HOLA.com. The applicant argues that the latter forms are not use of the registered mark. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s. 46(2) of the Act as follows:

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

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




16. The answer to the first question is  and HOLA.com. Insofar as the second question is concerned, the distinctive character of the registered mark, HOLA! lies, in my view, in the word HOLA with the exclamation mark being fairly banal. The difference between HOLA! and HOLA.com is that the exclamation mark is

¹ The applicant accepts this in its submissions of 15 September 2016. For example, it states that the mark Hola! is used on the magazine shown in the registered proprietor's evidence at exhibit 5. The relevant part of the applicant's submissions read: "Exhibit 5 [shows] a screenshot of the website www.hola.com, which allows to subscribe for the magazine Hola!"

not present in the latter form and is instead replaced with '.com'. Although the substituted element has the effect of creating a website address which is not present in the registered mark, trade marks are often presented in this manner and, as such, the average customer will be accustomed to picking out the distinctive trade mark



within them, which in this case is the word HOLA. Insofar as  is concerned, the difference between this sign and the registered mark is that part of the exclamation mark has been substituted by 'com'. Again, this will be perceived as a website address despite the vertical orientation of 'com' and I consider that the distinctiveness of this sign lies in the word HOLA. Bearing all of this in mind, I find that both forms of use do not alter the distinctive character of the registered mark.

17. The applicant makes a number of other criticisms of the evidence. It states that the evidence showing UK user numbers of www.hola.com only shows how many people visited that website and does not show what goods or services were marketed on the website. I consider this to be a somewhat blinkered view of the evidence, which is not the correct approach. I must have regard for the evidence as a whole, including whether individual exhibits corroborate each other. The other exhibits provided in the evidence show that www.hola.com is the website on which the proprietor publishes the Hola! magazine and, more than that, it shows that the website appears to be used solely for that purpose. I am therefore satisfied that the UK users listed in the table from Google Analytics will have visited the website www.hola.com to access the magazine.

18. The applicant also points out that the exhibits showing use of the proprietor's mark in Ms Evans' evidence are not from any of the relevant periods. That is true; they have all been downloaded in 2016. However, in his evidence, Mr Aguado explains that the proprietor has not been able to obtain historic examples of screenshots from the website. He goes on to explain that similar screenshots to those shown in Ms Evans' evidence would have been visible in the relevant periods. Ms Evans reiterated this at the hearing. I am satisfied that the use shown in Ms Evans' evidence is representative of the use which took place during the relevant periods.

19. The applicant also states that, as the website and magazine is in Spanish, this does not constitute genuine use in the UK. It is true that all of the evidence before me shows internet use on/in relation to a magazine in the Spanish language. In order to decide whether that constitutes genuine use within the UK, I must ask whether it is targeted in some way at the UK consumer. In this connection, I bear in mind the case-law set out earlier in this decision.

20. Despite the magazine itself and much of the website being in Spanish, the evidence also shows that there is a page on the website offering a subscription to *Hola!* magazine with instructions in the English language and that it is possible to have the magazine shipped to the UK. As I noted earlier, in *L'oreal* the court said that "When the offer for sale is accompanied by details of the geographic areas to which the seller is willing to dispatch the product, that type of detail is of particular importance in the said assessment." In addition, there are also advertisements on the website in the English Language which appear to be aimed at UK consumers. Furthermore, the print-out from Google Analytics shows a steady and consistent stream of UK users accessing the proprietor's website, www.hola.com, for the period between 2010 and 2015. The number of users is substantial and increases every month over that period, suggesting that there is a significant and growing number of Spanish-speaking UK consumers regularly visiting the proprietor's website to access the *Hola!* magazine. Taking the evidence in the round, and whilst I recognise that it is not without deficiencies, I find that it is sufficient to show that there has been genuine use of the contested mark in the UK during the period 2010-2015 (at least), which is the latest of the periods claimed by the applicant under section 46(1)(b).

21. In reaching the conclusion above, I should add that I have not overlooked the applicant's contention that the registered proprietor, under a daughter company (*HELLO Limited*), publishes a magazine by the name of "Hello" in the UK and that it is this magazine that is aimed at UK consumers. That may be true. However, there is no reason why both publications cannot be aimed at consumers within the UK; the two are not mutually exclusive.

22. I now need to frame a fair specification. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

23. Further, in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them;
Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46."

24. The specification of the registered mark is 'Publication of newspapers, books, magazines and of printed matter, all for others, all included in class 41'. This is very broad, essentially covering publication services at large. At the hearing, Ms Evans contended that the use shown is sufficient to retain that broad specification. I disagree. The use shown does not warrant retention of publication of all kinds of printed matter. In the alternative, Ms Evans submitted that the use would fairly be described as 'Publication of magazines, all for others,' I also do not consider this to be justified given the enormous range of magazine subject matter on the market. In his witness statement, Mr Aguado describes the publication as a 'celebrity news magazine'. This is consistent with the evidence which shows articles about, and photographs of, celebrities. It seems to me that 'celebrity news' is likely to be a recognised category within the relevant industry and that is how the average consumer is likely to perceive the use shown. A fair specification is therefore 'Publication of celebrity news magazines, all for others.'

Conclusion

25. The trade mark registration will remain registered for the following services only:

Class 41: Publication of celebrity news magazines, all for others.

Insofar as the other services covered by the registration are concerned, the trade mark is revoked under section 46(1)(a) with effect from 21 October 1994 (in accordance with section 46(6)(b)).

Costs

26. Both parties have achieved a measure of success in these proceedings, though it is clear that the applicant for revocation has been proportionally more successful than the registered proprietor. I estimate the ratio of success to be roughly 25%/75% in the applicant's favour. Awards of costs are governed by Annex A of Tribunal Practice Notice 4/2007 (which was in force at the time of commencement of these proceedings). I award the applicant for revocation costs on the following basis:

Official fee - £200

Preparing the statement of case – (£200 x 0.75) = £150

Considering and commenting on the other side's evidence – (£300 x 0.75) = £225

TOTAL: £575

27. I have made no award in respect of the applicant's submissions in lieu of a hearing as they were identical to those filed earlier in the proceedings. I order Hola S.L. to pay Helloo S.A. the sum of **£575**. 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 6th day of April 2017

**Beverley Hedley
For the Registrar,
the Comptroller-General**