

**o/037/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 2485130**

**IN THE NAME OF ICE BLUE SKY LTD**

**FOR THE TRADE MARK**

**ICE BLUE SKY**

**AND THE APPLICATION FOR REVOCATION THEREOF ON**

**GROUNDS OF NON-USE**

**UNDER NO. 501240**

**BY SKY PLC**

## Background

1) Ice Blue Sky Ltd ('IBSL') is the registered proprietor of trade mark registration No. 2485130 for the mark ICE BLUE SKY. The registration procedure of that mark was completed on 27 February 2009. It is registered in respect of the following services:

Class 35: Marketing services; public relations services; promotional services; business advisory services relating to event sponsorship and franchising; arranging business meetings; writing of advertising copy; but not including any such services provided to the financial services industry.

Class 41: Organisation of recreational activities and parties; arranging of business conferences; but not including any such services provided to the financial services industry.

Class 42: Graphic design services; commercial packaging design; design of exhibition stands; creating and maintaining websites for others; but not including any such services provided to the financial services industry.

2) Sky Plc seeks revocation of the trade mark registration, in full, on the grounds of non-use under Section 46(1)(a) and/or (b) of the Trade Marks Act 1994 ('the Act'). The section 46(1)(a) claim is based upon the five year period following registration i.e. 28 February 2009 to 27 February 2014, with a claimed date of revocation of 28 February 2014. Under section 46(1)(b), the claim is based on the five year period 17 June 2011 to 16 June 2016 with a claimed date of revocation of 17 June 2016.

3) IBSL filed a counterstatement stating that it has used the trade mark in the UK, in relation to all of the services for which it is registered, and subsequently filed evidence to support that claim. Sky Plc filed submissions only. Neither party requested to be heard; only Sky Plc filed written submissions in lieu. I now make this decision after careful consideration of the papers before me.

## **Evidence of IBSL**

4) This takes the form of two witness statements from Charlotte Elizabeth Graham-Cumming, joint Managing Director of IBSL and exhibits CEGC1 – 12 thereto.

5) Ms Graham-Cumming states that the mark has been used continuously in relation to all of the services covered by the registration since 2007 and that IBSL's annual turnover in the following years was:

Year	Turnover (£)
2008	166, 192
2009	319, 335
2010	219, 916
2011	338, 399
2012	315, 886
2013	288, 296
2014	308, 622
2015	308, 451

6) Ms Graham-Cumming says that Exhibit CEGC5 shows use of the mark ICE BLUE SKY within the relevant periods in relation to all of the class 35 services of the registration. The exhibit consists, for the most part, of various invoices spanning the period from November 2009 to February 2016. Most of the invoices spanning 2009 – July 2014 bear mark 1, shown immediately below (with the exception of one invoice which bears mark 2, shown below):

Mark 1



7) All of the invoices spanning November 2014 – February 2016 bear mark 2, shown below:

Mark 2



8) A number of the invoices list, under the heading 'Description', services such as 'Marketing support services', 'Internet marketing service – survey', 'Internet marketing services – promotional costs', 'Telemarketing Costs', 'social promotion – advertising', 'Design for Chocolate Bar Wrapper and Notebook'.

9) Ms Graham-Cumming says that Exhibits CEGC6, 6A and 6B show use of the mark ICE BLUE SKY within the relevant periods in relation to the class 41 services of the registration. There are six invoices in CEGC6 spanning March 2013 to December 2015. The invoices from 2015 bear mark 2; the others bear mark 1. The services in the invoices are described as 'Event management for Employee Conference', 'Data Protection Workshop' and 'pre-event management and production and delegate coordination etc.' Exhibit CEG6A contains a number of blog posts, an advertisement and articles which are said to relate to the aforementioned invoices. The blog posts talk of successful launch events for clients. There is an advert for 'Business Venue Finding' bearing mark 1 which states 'Let us take the effort out of organising your next meeting, event or conference'. An article dated 24 November 2010 states that a Technology services firm named IFS appointed 'Ice Blue Sky' to plan and arrange a conference for 200 delegates. Another dated 12

October 2011 refers to a software firm named Qliktech hiring 'Ice Blue Sky to produce a one-day conference for 500 delegates'. Exhibit CEGC6B is a presentation which is said to have been used during a business conference held in May 2009; it appears to have been given by Ms Graham-Cumming on the subject of effective marketing activity. Mark 1 is present in the slides.

10) Ms Graham-Cumming states that Exhibit CEGC7 shows use of the mark ICE BLUE SKY in relation to the class 42 services of the registration in the relevant periods. There are a number of invoices in the exhibit spanning February 2009 to May 2016. All of the invoices dated October 2014 onwards bear mark 2; some of the invoices prior to October 2014 also bear mark 2 and others bear mark 1. The description in the invoices is such that the nature of the services being provided is not always clear such as 'event support' and 'website – final payment' and 'Hosting'. Other descriptions include 'Website design and development', 'Graphic Design', 'Memorial Book Design and Layout', 'Artwork', 'Internet Marketing Service', 'Design and produce infographic', 'Telemarketing costs', 'marketing data', 'Designs for box vinyls', 'Artwork two stands', 'Frames, print and delivery for 2 roll up stands'. 'Rework content [of spring customer magazine] for UKRC'

11) Ms Graham-Cumming provides a list of various events which she says she has attended as a speaker, promoting the services of IBSL between 2014 and 2016. These talks appear to have been on the topic of 'marketing' and the benefits of using printed materials. There are also details of awards that IBSL has achieved between 2010 and 2011 in the field of marketing.

12) Exhibit CEGC12 is an invoice bearing mark 2, dated March 2013 entitled 'Sponsor Feb 7 event'. The services are described as 'email creation – add marketing logo to email and landing page...', 'online-web development...' and 'online –email creation...'

13) Ms Graham-Cumming states that IBSL changed its financial systems in 2011 and therefore advertising and marketing spend figures are only available from that date. She states that in the period between June 2011 and June 2016 the amount spent on marketing/advertising was £10, 816.41.

**Decision**

14) Section 46(1) of the Act states that:

“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.”

15) Further, Section 100 of the Act 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.”

16) 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 Bunderversvereinigung 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].”

17) The first issue that I need to address is whether use of the variants constitutes use of the registered mark. The two variants are:

Mark 1:



Mark 2:



18) Sky Plc submits that use of neither variant constitutes use of the registered mark. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) 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."

19) The mark, as registered, is ICE BLUE SKY (word-only); its distinctiveness lies solely in the combination of the words themselves. I consider it to be a mark with an

average degree of distinctiveness. The difference between the registered mark and mark 1 is that, in the latter, the words are presented in blue and red/orange and appear stylised, as if written with a paint brush. I do not consider that the colour combination alone would alter the distinctiveness of the registered mark, however, I find that the paint-brush effect creates a striking visual difference between mark 1 and the registered mark. To my mind, the stylisation of mark 1 is such that it has a different, and greater degree of, distinctive character than the word-only registered mark. It follows that the distinctive character of mark 1 differs from the mark in its registered form. Consequently, IBSL cannot rely upon use of mark 1 as use of the registered mark under section 46(2) of the Act.

20) Turning to mark 2, the differences between this mark and the registered mark are that the former is presented in lower case letters, the three words are conjoined and there is a full-stop at the end of the mark whereas the registered mark is presented as three separate words in block capitals without a full-stop. The dot above the 'l', the word 'blue' and the full-stop in mark 2 are also presented in blue. I do not consider that the visual differences between mark 2 and the registered mark are such as to alter the distinctive character of the latter. I find that IBSL is entitled to rely upon use of mark 2 as use of the registered mark as per section 46(2) of the Act.

21) I now turn to assess whether the evidence of use of mark 2 is sufficient to constitute genuine use in relation to the services covered by the registration. In doing so, I take account of Sky Plc's criticisms of the evidence. These are, in summary, that:

- A number of exhibits are either undated or do not fall within the relevant periods.
- Some exhibits do not clearly identify the nature of the services purportedly offered under the mark.
- Some of the services appear to have been provided to the financial services industry which is specifically excluded in the specification of the registered mark.

- No evidence has been adduced in respect of “organisation of recreational activities and parties’ and only limited evidence had been adduced in respect of the remaining services.
- Some exhibits do not show evidence of use of the mark in the course of trade.
- The mark has not been used to a sufficient extent so as to be deemed genuine. Notably, the turnover and advertising/promotional figures are not broken down to show the proportion attributable to each category of services covered by the registered mark.

22) I also remind myself that in *Awareness Limited v Plymouth City Council*<sup>1</sup>, Mr Daniel Alexander Q.C. sitting as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

It is not, therefore, essential to provide particular types of evidence, but the evidence must, when considered as a whole, show that the mark at issue has been put to genuine use within the UK. I will address each class in turn, as Ms Graham-Cumming has done in her evidence.

---

<sup>1</sup> Case BL O/236/13

*Class 35: Marketing services; public relations services; promotional services; business advisory services relating to event sponsorship and franchising; arranging business meetings; writing of advertising copy; but not including any such services provided to the financial services industry.*

23) I am satisfied that the mark has been used in the UK in relation to marketing services and promotional services (but not including any such services provided to the financial services industry). Ms Graham-Cumming has provided a list of awards that IBSL has won in the field of marketing. There are also numerous invoices, bearing mark 2, spanning the relevant periods, which were issued to various UK addresses. On those invoices are descriptions of services such as 'Internet marketing services-survey' and 'telemarketing costs' etc. and, what appears to be, services in the nature of promotional services. Whilst I agree with Sky Plc that at least some of these appear to have been provided to the financial services sector, this is not (clearly) the case for other invoices. As for the remaining services in class 35, I agree with Sky Plc that the description of other services on the invoices is such that it is often unclear as to the precise service being offered and Ms Graham-Cumming's evidence-in-reply does little to clarify matters. I find that the evidence before me is insufficiently solid and specific in respect to the remaining services in class 35. I therefore find no genuine use for those services.

*Class 41: Organisation of recreational activities and parties; arranging of business conferences; but not including any such services provided to the financial services industry.*

24) Although, as Sky Plc submits, some of the evidence in exhibit CEG6A appears to relate to the organisation of events to promote the IBSL's own marketing services, there is also evidence to suggest that IBSL has been paid to arrange business conferences for a number of third parties (not including the financial services industry). It is true that the evidence is minimal and could have been better marshalled. Nonetheless, I find that it is sufficient to show, on the balance of probabilities, that there has been genuine use in relation to arranging of business conferences. I agree with Sky Plc that there is nothing to show that there has been genuine use in relation to 'organisation of recreational activities and parties'. This is

because the events shown in the evidence do not fall within the meaning of that phrase in class 41 as being in the nature of entertainment/recreation; rather they appear to be in the nature of promotional events for business purposes or other conferences for businesses purposes. I find no genuine use in respect of 'Organisation of recreational activities and parties'.

*Class 42: Graphic design services; commercial packaging design; design of exhibition stands; creating and maintaining websites for others; but not including any such services provided to the financial services industry.*

25) Taking the evidence in the round and bearing in mind, in particular, that the evidence shows that mark 2 has been used on invoices issued to various customers in the UK (not including the financial services industry) over the relevant period in relation to services described as, for example, 'website design and development', 'design of a chocolate bar wrapper and notebook', 'graphic design', 'Artwork two stands' and 'Frames, print and delivery [of stands]', I find that there has been genuine use of the mark in relation to all of the services in class 42.

26) Having reached the above conclusions, and bearing in mind relevant guidance on the matter of determining a fair specification<sup>2</sup>, I find that the use shown would fairly be described by the average consumer of the services concerned, as:

Class 35: Marketing services; promotional services; but not including any such services provided to the financial services industry.

Class 41: Arranging of business conferences; but not including any such services provided to the financial services industry.

---

<sup>2</sup> *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10; *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220 [63-65].

Class 42: Graphic design services; commercial packaging design; design of exhibition stands; creating and maintaining websites for others; but not including any such services provided to the financial services industry.

## **Conclusion**

27) The mark is revoked with effect from 28 February 2014 **except** in relation to:

Class 35: Marketing services; promotional services; but not including any such services provided to the financial services industry.

Class 41: Arranging of business conferences; but not including any such services provided to the financial services industry.

Class 42: Graphic design services; commercial packaging design; design of exhibition stands; creating and maintaining websites for others; but not including any such services provided to the financial services industry.

## **Costs**

28) Given the degree of success enjoyed by each party, I make no order as to costs.

**Dated this 17<sup>th</sup> day of January 2018**

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