

O-395-18

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3206440
BY TIGER MUAY THAI TRADING CO., LTD
TO REGISTER**



**AS A TRADE MARK
IN CLASSES 25 & 28**

**AND OPPOSITION THERETO (UNDER NO. 409182)
BY
NFL PROPERTIES EUROPE GMBH**


Background & pleadings

1. Tiger Muay Thai Trading Co., Ltd ('the applicant') applied to register the trade mark outlined on the title page on 13 January 2017. The mark was published on 3 February 2017 for the following specifications in classes 25 and 28:

25: Clothing; tee-shirts; hoods; tank tops; sweat pants; headgear for wear; shorts; gloves; rash guards; footwear

28: Shin pads.

2. NFL Properties Europe GmbH ('the opponent') opposes the mark under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of their EU trade mark outlined below. This mark is registered in classes 9, 16, 25 and 41 but the opponents have stated that they are only relying on some goods in class 9 and class 25 in these proceedings.

EU TM 3347119	Goods relied on:
 <p>Filing date: 4 September 2003 Date of entry in register: 26 November 2004</p>	<p>Class 9: football helmets</p> <p>Class 25: Clothing; footwear; headgear; men's, women's and children's clothing, namely fleece tops and bottoms, caps and headwear, T-shirts, sweatshirts, shorts, tank tops, jeans, sweaters, trousers, jackets, turtlenecks, jumpsuits, golf shirts, woven shirts, knitted shirts, jerseys, wristbands, warm up suits, swimwear, wind resistant jackets, raincoats, parkas, ponchos, gloves, ties, braces, cloth bibs; sleepwear, namely robes, night shirts, pyjamas; mittens; knitted hats and caps; scarves; aprons;</p>

	headbands; ear muffs; underwear in class 25.
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3. The opponent's trade mark is an earlier mark, in accordance with Section 6 of the Act. As it completed its registration procedure more than 5 years prior to the publication date of the applicant's mark, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

4. The applicant filed a counterstatement in which it denied the grounds of opposition under section 5(2)(b). Whilst the applicant did not tick the relevant box in Section 7 on the form TM8 to indicate that proof of use was requested, the accompanying statement of grounds made it clear (and which was later acknowledged by the opponent) that the opponent was being put to 'very strict' proof of use of the earlier mark it relied on.

5. The applicant filed nothing beyond the counterstatement whilst the opponent filed a witness statement and two exhibits in addition to written submissions in lieu of a hearing. I do not summarise that evidence here but will refer to it as necessary later in this decision. As no hearing was requested, I now make this decision from the papers before me.

6. The applicant are represented by Trademark Eagle Limited in these proceedings and the opponent by White & Case LLP.

Proof of use

7. The first issue is to establish whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

"Raising of relative grounds in opposition proceedings in case of non-use

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 period of five years ending with the date of publication.
- (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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be

construed as a reference to the European Community.

(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”.

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

“100. 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”.

9. 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:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch); [2013] F.S.R. 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G&D Restaurant Associates Ltd (SANT AMBROEUS Trade Mark)* [2010] R.P.C. 28 at [42] of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [EU:C:2003:145]; [2003] E.T.M.R. 85, *La Mer Technology Inc v Laboratories Goemar SA* (C-259/02) [EU:C:2004:50]; [2004] E.T.M.R. 47 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C495/07)[EU:C:2009:10]; [2009] E.T.M.R.28 (to which I added references to *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-416/04 P) [EU:C:2006:310]). I also referred at [52] to the judgment of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV* (C149/11) EU:C:2012:816; [2013] E.T.M.R. 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-141/13 P) EU:C:2014:2089 and that Order has been persuasively analysed by Professor Ruth Annand sitting as

the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15) [2016] E.T.M.R. 8.

218. [...]

219. 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 *Bundervsvereinigung 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]”.

10. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] 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.”

11. Furthermore in *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. 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.”

Opponent's evidence

12. The opponent submitted a witness statement and two exhibits from Marcus L. Collins, a senior associate solicitor at White & Case LLP, the opponent's representative.

13. Exhibit MLC1 is a schedule of clothing items available to purchase in the UK in the five years prior to publication of the applicant's mark, namely 3 February 2012 to 2 February 2017 ('the relevant period'). The schedule of clothing items includes the dates when these items first became available to purchase in the UK. The dates range from 2014 to 2016 so are within the relevant period. I note that only some of the items, namely a baseball cap (first available April 2014), a hooded sweatshirt (first available November 2016), a knitted hat and glove set (first available July 2015) and a vest (no date given) show the device only earlier mark. The remaining items show the device with a stylised letter B or the words 'Bengals', 'Cincinnati Bengals' and 'football'. The exhibit also comprises a selection of screenshots dated 18 September 2017 (which is outside the relevant period) from the Amazon retail website, usasports.co.uk and the nflshopuk.com retail websites showing images of

the clothing items available for purchase and their corresponding prices in pounds sterling.

14. Exhibit MLC2 consists of a copy of a 2015 decision from EUIPO concerning the parties in relation to opposition proceedings for the same contested mark but for services in class 41. I do not intend to take account of this decision, and therefore this exhibit, as it was delivered in a different jurisdiction and was based on services and not goods, as in these proceedings.

Decision

15. Following my consideration of the above evidence, I find the opponent has not discharged the onus on it to prove use of the mark relied on. The only evidence filed consists of a single witness statement. The declarant, Marcus Collins, is not an officer of the opponent company nor does he state he has any direct knowledge of any trade under the mark in the UK but is a senior associate solicitor in the employ of its legal representatives.

16. Mr Collins states that “the facts contained in this witness statement are within my own personal knowledge or have been ascertained through online enquiries made on the internet”. He does not say which ‘facts’ are from within his own knowledge or how he came to be aware of them, though for reasons which will become clear, nothing rests on this.

17. Mr Collins’ witness statement is brief. He has not provided any breakdown of e.g. turnover, volume of sales or advertising expenditure under the mark relied upon. Neither has he provided any examples of e.g. invoices for sales made or any advertising or marketing materials. The only material he has filed is exhibited at MLC1. This exhibit consists of 17 pages. The first 4 pages are in the form of a list which consists of some 13 entries showing pictures of various items of clothing. Alongside each is one of three different website addresses. Some, but not all, of the entries include a date the particular clothing article is said to have been first available. The remaining 13 pages are printouts from the websites mentioned, showing the goods listed being offered for sale. All of the printouts were downloaded

on 18 September 2017, the date of Mr Collins' witness statement, and so cannot be relied upon to show what the position might have been within the relevant period.

18. In my view the evidence provided falls far short of the sufficiency and solidity needed to meet the standards of proof required. If the mark had been put to genuine use on the goods relied on, in the UK and within the relevant period, then it should not have been a difficult matter for the opponent to show it. It did not. Accordingly, the earlier mark may not be relied on to support the opponent's claim under section 5(2)(b) of the Act and as this was the only ground of opposition relied upon, the opposition fails.

Outcome

19. The opposition fails in its entirety.

Costs

20. As the applicant has been successful, it is entitled to a contribution toward its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs to the applicant as follows:

£400 Considering the Notice of Opposition and filing a defence.

21. I order NFL Properties Europe GmbH to pay Tiger Muay Thai Trading Co., Ltd the sum of £400. 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 27 day of June 2018

June Ralph

For the Registrar

The Comptroller-General

