

O-783-18

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO 3234045
BY SHINING STONE LTD
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 43**



AND

**OPPOSITION THERETO (NO. 410660) BY
CHABOBA LIMITED**

Background and pleadings

1. On 30 May 2017 Shining Stone Ltd (“the applicant”) applied to register the trade mark shown above (“the applied for mark”) for services in class 43. The application was published for opposition purposes on 11 August 2017.
2. Chaboba Ltd (“the opponent”) oppose registration under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon UK Trade Mark 2566322 (“the earlier mark”) registered for “Bar services” in class 43. The earlier mark is the word mark “Bubble Waffle” which was filed on 6 December 2010 and registered on 22 April 2011.
3. The opponent’s notice of opposition and statement of grounds was filed on 31 October 2017. The applicant filed a notice of defence and counter statement on 5 January 2018. By way of a letter dated 22 January 2018 the applicant was invited by the Registry to file an amended counterstatement by 12 February 2018 as the Registry did not consider that the applicant had adequately set out whether it admitted or denied the opponent’s claim and the basis for doing so. The applicant filed an amended defence and counterstatement on 1 February 2018. The applicant requires the opponent to provide proof of use of their earlier mark.
4. On 3 April 2018 the opponent filed its evidence, comprising a witness statement from Helen Hong Sin Chan together with accompanying exhibits. On 17 May 2018 the applicant filed its evidence, comprising a witness statement from Chuanbao Qiu with accompanying exhibits. This was sent to the opponent under cover of a letter dated 31 May 2018 informing the opponent it had until 2 July 2018 to inform the Registry whether it intended to file further evidence of fact in reply, and thereafter, until 31 July 2018 to serve such evidence.
5. No further evidence was filed by the opponent and on 17 August 2018 the Registry wrote to the parties informing them that the evidence rounds were complete. The

parties were given until 31 August 2018 to request a hearing and until 14 September 2018 to file any further written submissions.

6. Neither party requested a hearing or filed any further written submissions. This decision is therefore reached following a careful consideration of the papers.
7. The applicant is self-represented. The opponent is represented by Lawdit Solicitors.

Evidence

8. The opponent's evidence consists of a statement by Helen Hong Sin Chan dated 26 March 2018 with 9 exhibits attached. She states:

"1. I am a director of Chaboba Limited, the Opponent, which is a private limited company and have held this position since the Opponent was incorporated on 22 July 2010. I am authorised to make this Witness Statement on behalf of the Opponent. The information contained in this Witness statement is based on records of the Opponent, to which I have full and unrestricted access, and on my own knowledge.

2. ...I am also aware that, in the Applicant's Amended Counterstatement, the Applicant has requested proof of use in the United Kingdom, in relation to:

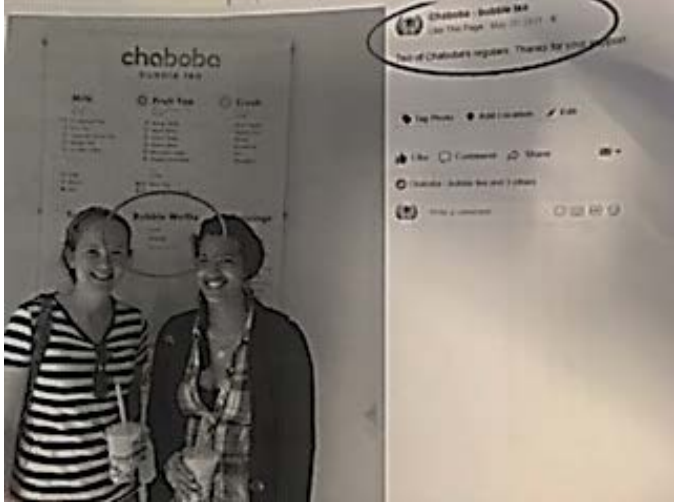
Class 43: Bar Services.

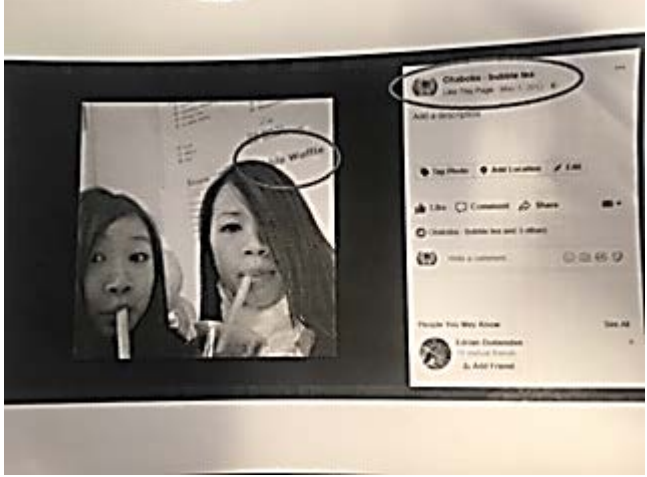

3. I can confirm that the Opponent has been using the Bubble Waffle mark, as a trade mark, in the UK since at least October 2011. By virtue of this longstanding continuous use, I consider that the

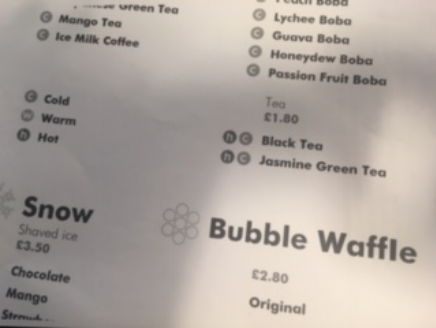


Opponent's use is strongly associated with bar services, for which it has been registered in the United Kingdom.


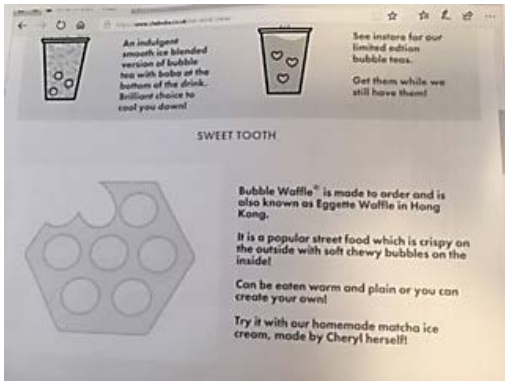
4. *The Opponent's Bubble Waffle trade mark has been in continuous use since 2011, I am now shown the attached Exhibit marked "HC1" consisting of a Facebook post that was posted on 31 October 2011..."*


9. Ms Hong Sin Chan's statement then exhibits the following:

Exhibit	Date	Comments
HC1	Facebook post dated 31 October 2011.	A Facebook entry posted by Chaboba – bubble tea displaying a photograph of two females holding a drink and the comment "Delicious!". The earlier mark does not feature in the exhibit at all.
HC2	Facebook post dated 30 May 2011.	 <p>A Facebook entry posted by Chaboba- bubble tea, displaying a photograph of two females holding drinks standing in front of a menu. The menu is headed Chaboba bubble tea. Approximately half way down the menu Bubble Waffle is displayed as an item on the menu for purchase. The Facebook</p>

		<p>post comments “two of Chaboba’s regulars. Thanks for your support.”</p>
<p>HC3</p>	<p>Facebook post dated 1 May 2012</p>	 <p>A Facebook entry posted by Chaboba – bubble tea. The photograph shows two females standing in front of a menu drinking drinks. Again, Bubble Waffle would appear to feature as an item on the menu albeit only “ble Waffle” is visible as the first part is obscured by a head.</p>
<p>HC4</p>	<p>Facebook post, dated 20 May. The year of the entry is cut off but the subsequent Facebook comments would appear to date it as 2012 and Ms Hong Sin Chan’s statement also confirms that date.</p>	 <p>A Facebook entry posted by Chaboba - bubble tea. The photograph shows two women holding drinks standing inside some premises. Behind them the door or wall displays in large letters a stylised</p>

		<p>“Chaboba” and underneath it the words “bubble tea.” Below this is displayed a list of 5 products: milk, fruit tea, crush, snow, bubble waffle.</p>
<p>HC5</p>	<p>Extract from a menu which is itself undated. Ms Hong Sin Chan states at paragraph 8 of her statement that this is the menu from February 2013.</p>	 <p>The menu extract has as an item for purchase of a Bubble Waffle at a cost of £2.80 for an “original”.</p>
<p>HC6</p>	<p>Facebook post, dated 18 October 2017</p>	<p>A Facebook entry posted by Chaboba-bubble tea dated 18 October 2017. The text of the entry states:</p>  <p>The photograph shows three food products in a paper cup labelled Chaboba bubble tea which look as follows:</p> 
<p>HC7</p>	<p>Paragraph 10 of Ms Hong Sin Chan’s</p>	<p>This is an image of what appears to be a menu in a plastic see-through stand. The top of the menu</p>

	<p>statement states that this is a Google image that was posted in October 2017</p>	<p>features in large type face the words “BUBBLE WAFFLE” followed by “TM” in small type. There are then different menu options for flavouring and toppings for the bubble waffle:</p> 
<p>HC8</p>	<p>Paragraph 11 of Ms Hong Sin Chan’s statement states that this is a screen shot from the opponent’s website www.chaboba.co.uk. She does not provide a date for when the screen shot was taken.</p>	<p>This appears to be a snapshot extract from a website as follows:</p> 
<p>HC9</p>	<p>Paragraph 12 of Ms Hong Sin Chan’s statement states this is a screen shot from the opponent’s</p>	<p>This appears to be an extract from a menu as follows:</p>

	<p>current menu from its website. She does not provide a date the screen shot was taken but her statement is dated 26 March 2018.</p>	
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10. The applicant’s evidence is from Chuanbao Qui in a statement dated 17 May 2018. It is supported by 10 exhibits appended to the statement. Mr Qui states that he is a director of the applicant and has held this position since it was incorporated on 15 January 2016. He confirms the information in his statement is based on the applicant’s records and his own knowledge.

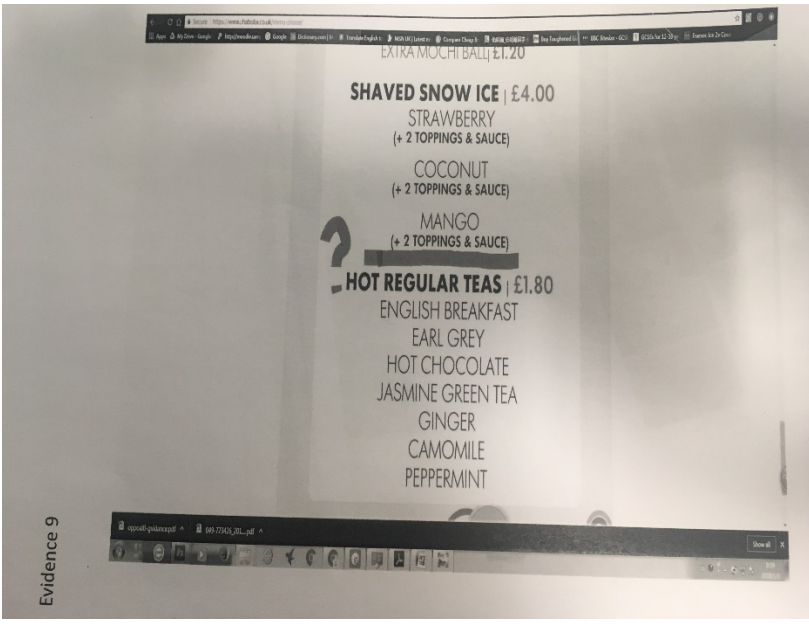
11. In his statement Mr Qui states:

“2. *The evidence listed below all collected from Opponent shop, and Opponent’s website, Facebook. All evidence shows the Opponent not use their Trade [Mark] at all. All Opponent shop logo, sign, plate, cups, menu, poster, flyer, order receipt, card payment machine receipt, website, facebook are **Chabaoba** to show the public. Bubble waffle only appeared on menu as single goods. But the Opponent’s trade mark only register on class 43. Class 43 is for service only not for goods. Therefore all evidence shows the Opponent’s use **Chaboba** for service for the public not **Bubble Waffle.**”*

12. In support of his argument that the opponent has used their trade mark for goods as opposed to their registered class 43 services and that their class 43 services are provided instead under the name Chaboba, Mr Qui refers to the following evidence:

Exhibit	Date	Comments
1	Receipts dated 23 November 2017	There are two separate order tickets, the first for dumplings and the second for a plain Bubble waffle at a cost of £3.50. The order tickets are headed with the name of the business, Chaboba bubble tea, at an address in Wembley. At the foot of the order tickets there is a link to the website www.chaboba.co.uk . The earlier mark, Bubble Waffle, features as an order for the product itself on order number 23. The global debit card receipt does not display the earlier mark. It is headed with what appears to be the trading name of the business, Chaboba Bubble Tea, at a different address in Camden, London.
2	Mr Qui states this is a screenshot he took of the opponent's website on 13 November 2017. The date itself is not shown on the exhibit.	This appears to be a screenshot taken from www.chaboba.co.uk/contact/ and shows the business trading name of Chaboba bubble tea and a menu of the products available to purchase including Bubble Waffle.
3	Mr Qui states this is a screenshot he took of the opponent's Facebook page	The Facebook entry itself is dated 18 October at 10:13 [the year is not displayed]. Mr Qui argues that this is the same entry exhibited to Ms Hong Sin Chan's statement at HC6. The text is different as in Mr Qui's snapshot the opening words are "Welcome back bubble waffle!" as opposed to "Check out our bubble waffles@!" at HC6. Mr Qui argues that these are the same Facebook entry and

		<p>Evidence 5</p> 
6	<p>Undated but image shows an order receipt dated 23 November 2017</p>	<p>This is a photograph showing the same order ticket for the bubble waffle product at 1 above together with the bubble waffle itself in a container displaying “Chaboba bubble tea.” The photograph also shows a poster in the window with the same trading name and a menu for “Mochi Balls and Other Beverages.”</p>
8	<p>Undated</p>	<p>This page displays several images. One is from a Facebook page which appears to show Chaboba bubble tea as trading from two premises in Camden and Wembley. There are then photographs of the outside of two different retail premises. The first has displayed above the door “chaboba bubble tea”. The second has displayed above the door “chaboba”. There is additional signage attached to the front of the premises that appears to display “chaboba bubble tea.” The images are small and it is not possible to make out what is displayed on other signs within the windows. Mr Qui comments that there is nothing to show the public a trade mark of bubble waffle for the services. The fourth image may be an</p>

		extract from Facebook but its provenance is unclear and again displays an image of “Chaboba bubble tea.”
9	Mr Qui states this is a screenshot he took of the opponent’s website on 13 November 2017. The image itself is dated in the bottom right hand corner at 2018/1/3	<p>The screenshot appears to display an extract from a menu at www.chaboba.co.uk/menu-please/. The menu extract includes “extra mochi ball”, shaved snow ice and various drinks. Mr Qui submits that Bubble Waffle is not displayed as a menu item. He submits that his snapshot image is different to HC9 above and believes this shows that the opponent’s HC9 was edited after 13 November 2017.</p> 

13. In his statement Mr Qui argues that the opponent has made changes to their Facebook posts and website. At Mr Qui’s exhibit 7 he appended website pages from gb.pacedigger.com. He states that for a short period after he took the screenshots on 13 November 2017 the website was hidden from the google search engine and inaccessible when typing www.chaboba.co.uk.

14. At Mr Qui's exhibit 10, he appends screenshots which he states he took after a google search. 10-1 are the images produced from a search term of "bubble waffle" and he states none of these images refer to the opponent. 10-2 are the images produced from a search term of "chaboba" and produce images apparently relating to the opponent which he again argues demonstrates this is the term they use for branding their services. 10-3 are the images produced from a search term of "super bubble waffle". That search therefore relates to the applicant's own applied for trade mark. The search results show various images of the goods, some branded with the applicant's applied for mark, and others with unrelated branding, or none at all.

Section 5(2)(b)

15. The opposition is brought under Section 5(2)(b) of the Act which states:

"5 (2) A trade mark shall not be registered if because –

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

Section 6

16. An earlier trade mark is defined in section 6 of the Act, which states:

"6. - (1) In this Act an "earlier trade mark" means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a

date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

17. The opponent’s mark qualifies as an earlier trade mark under section 6(1). The application was published on 11 August 2017. The opponent’s earlier mark completed its registration procedure on 22 April 2011. Consequently, the opponent’s application for registration is subject to the proof of use requirements in section 6A of the Act.

18. The relevant sections state:

“6A Raising of relative grounds in opposition proceedings in case of non use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark 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 the goods or to the packaging of goods in the United Kingdom solely for export purposes...
 - (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.

- (7) Nothing in this section affects –
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
 - (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

19. The relevant period for proof of use is the 5 year period ending on the date of publication of the application, namely **12 August 2012 to 11 August 2017**.

Proof of use – the legal framework

20. 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. *The law with respect to genuine use.* In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to

the judgment of the CJEU in Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and 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)...

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 Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [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].”

21. The onus is on the opponent, as proprietor of the earlier mark, to show use. 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.”

22. In reaching a decision regarding the opponent’s use of its mark, I am mindful of the decision of Daniel Alexander QC, sitting as the Appointed Person in *Awareness Limited v Plymouth City Council*, Case BL O/236/13. He said:

“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.”

23. 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 also 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.”

Proof of Use – Findings

24. Under section 6A(3)(a) the earlier trade mark must have been put to genuine use in the UK, in the relevant period, and “in relation to the goods or services for which it is registered.” An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.
25. The evidence presented by the opponent is brief and limited. Based on the evidence presented in HC2, HC3 and HC4, I accept that in the period 30 May 2011 to 20 May 2012 the term “Bubble Waffle” was used to describe a food item¹ available to order on the opponent’s menu. This was before the start of the relevant period. However, looking at matters in the round, I am also prepared to accept that this use continued up the end of February 2013. This use was as a particular food good available to buy, and displayed on the menu as such, as shown at HC5² (the date being verified by Ms Hong Sin Chan in her witness statement) and on the walls of the premises at HC2, HC3 and HC4.

¹ HC8 (which is itself outside the relevant period) explains that a Bubble Waffle is known as an Eggette Waffle in Hong Kong and that it is a popular street food which is crispy on the outside with soft chewy bubbles on the inside. There is a picture of the goods at HC6

² Although I have no evidence that describes when, how, and where that menu at HC5 was actually on display.

26. After March 2013 there is simply insufficient evidence shown to me by the opponent to make a finding of ongoing use. In paragraphs 3 and 4 of her statement Ms Hong Sin Chan states that there has been continuous use of the Bubble Waffle mark since at least October 2011. That broad statement, however, is not supported by sufficient evidence. Other than HC5 identified above there is no other supporting evidence of the mark being used for the remainder of the relevant period.
27. I accept that the opponent has presented evidence of the earlier mark being used in the Autumn of 2017 and thereafter in HC6, HC7, HC8 and HC9. The applicant disputes the legitimacy and dating of some of these evidential exhibits (and indeed HC8 and HC9 are not even definitively dated in Ms Hong Sin Chan's statement). However, even if I were to accept at face value the opponent's evidence, it only shows that "Bubble Waffle" was again being used as a menu item in store and publicised as such on Facebook and on the opponent's website from October 2017 onwards³, which is all outside the relevant period.
28. I must consider whether this is sufficient evidence to show use as a trade mark in relation to bar services. I do not consider that it does. The evidence set out above only shows very limited use of the earlier mark to describe a single type of food good for sale. The sale of bubble waffles as a good is proper to class 30, which is not the registered class for the earlier mark.
29. I do not consider that the opponent has demonstrated use as a trade mark in relation to any services, let alone bar services. On my findings, the only evidence I have is of the goods described as bubble waffles, displayed on a menu, being sold in a café or snack bar. The evidence shows, however, that the café/snack bar is not providing its services under the "Bubble Waffle" mark but under

³ In paragraph 10 of her statement Ms Hong Sin Chan states that the menu show at HC7 is a google image that was posted in October 2017. But she provides no evidence as to exactly when, how, and to whom it was displayed as a google image and it is therefore of no assistance to me.

“Chaboba” or “Chaboba-bubble tea.”⁴ The average consumer would, even when buying a bubble waffle from the opponent, associate the opponent’s café/snack bar services with “Chaboba” or “Chaboba bubble tea”. It is “Chaboba” or “Chaboba bubble tea” that is functioning as the badge of origin for the services in question. “Bubble Waffle” is therefore not being used in a trade mark sense in guaranteeing the identity of the origin for such café/snack bar services in any event.

30. In reaching my conclusions, I have taken account of the fact that it can be possible for a proprietor to use more than one mark acting as an identification of commercial origin.⁵ However each mark must be capable, independently, of performing the essential function of a trade mark. Here the use of “Bubble Waffle”, in a descriptive sense as a menu item does not function, in its own right, as a trade mark for the café/snack bar services identified.
31. Further, even if such café/snack bar services were being provided under the “Bubble Waffle” mark this would not amount to use in relation to “bar services”. A bar is a drink related service i.e. an establishment and/or counter where customers can purchase and consume drinks, principally alcoholic drinks. It would include, for example, public houses, cocktail bars and wine bars. It would not include the kind of café/snack bar services in play here. There is therefore no evidence of the earlier mark being in use for its registered specification of bar services.
32. In reaching these findings I have borne in mind that Ms Hong Sin Chan has been a director of the opponent throughout and states that she has full and unrestricted access to the opponent’s records. She is therefore in the best possible position to explain the scope and extent of use of the earlier mark and to exhibit examples of its use specifically for bar services during the relevant period. Such evidence is conspicuous by its absence.

⁴ In particular HC2, HC3 and HC4

⁵ For example, *Castellblanch v OHIM – Champagne Roederer* T-29/04

Conclusion

33. The opposition fails as the opponent has failed to prove genuine use of its earlier mark in respect of the services for which it is registered within the relevant period. It therefore fails at that first hurdle.
34. The applicant's mark can proceed to registration.

Costs

35. Under cover of a letter dated 17 August 2018 the applicant was sent a costs proforma which it was directed to complete and return by 31 August 2018 if it intended to request an award of costs. The letter informed the applicant that if the proforma was not completed and returned no costs would be awarded other than any official fees paid. The proforma has not been returned. I therefore do not make any costs award in favour of the applicant. There are no official fees to reimburse.

Dated this 7th day of December 2018

Rachel Harfield

For the Registrar,

The Comptroller-General