

O-050-19

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 2195850A
IN THE NAMES OF ROBERT JOHN JONES AND TIMO MULLEN
FOR THE FOLLOWING SERIES OF TWO TRADE MARKS IN CLASS 9:

HAWAII FIVE-O

&

HAWAII 5-O

AND AN APPLICATION TO REVOKE ON GROUNDS OF
NON-USE (NO 501814) BY BROOKFIELD ASSOCIATES LIMITED

BACKGROUND

1. UK trade mark registration 2195850A is for the series of two trade marks shown on the front cover of this decision and stands in the names of Robert John Jones and Timo Mullen (the proprietors). It has a filing date of 27 April 1999, was published on 15 September 1999 and was entered in the register on 2 January 2000. The goods for which the mark is registered are as follows:

Class 9

Electronic games; videos, surf videos; computer software; compact discs; audio recordings, video recordings.

2. On 5 October 2017, Brookfield Associates Limited (the applicant) sought revocation of the registration under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”) on the grounds that the mark has not been put to genuine use. Under section 46(1)(a), revocation is sought from 3 January 2005. Under section 46(1)(b), revocation is sought from 4 January 2010, 4 January 2015 and 5 October 2017.

3. The proprietors filed a counterstatement in which they rejected the claim that the mark had not been used, stating:

“3. The Registered Proprietors will submit evidence in due course to support the claim to having made genuine use of the trade mark of the Registration in the United Kingdom in relation to all of the Class 09 goods during the Relevant Periods.

4. In the event that for any reason some or all of the evidence submitted by the Registered Proprietors to support the claim to having made genuine use of the trade mark of the Registration in the UK in relation to some or all of the Class 09 goods during the Relevant Periods is considered insufficient to sustain the registration, the Registered Proprietors submit that there are proper reasons for non-use of the trade mark of the Registration in respect of said goods of the Registration during the Relevant Periods.”

4. The proprietors filed evidence in these proceedings. Both sides provided skeleton arguments. A hearing subsequently took place before me, by video conference, on 16 January 2019. The applicant was represented by Mr Christopher Hall of Counsel, instructed by Mischon de Reya. The proprietors represented themselves.

EVIDENCE

Proprietors' evidence of use

Witness statement by Timo Mullen and exhibits TM1-TM3

5. Mr Mullen is one of the proprietors. He states:

"2. Robert Jones and I have been in the production stages of making the movie 'Hawaii Five-O' for the last 9 years. Hawaii Five-O is a windsurfing documentary film about windsurfing in Hawaii. It follows us and a group of professional windsurfers to the island of Maui, Hawaii in our search for the perfect 50 year wave, thus the title Hawaii Five-O.

3. A fifty year wave is a statistically projected wave, the height of which, on average, is met or exceeded once every fifty years for a given location. This Wave therefore needs a rare coincidence of conditions to happen, which can only happen every 50 years in practice. Ideally what we wait for is a huge storm generated in the Northern Pacific Ocean which generates the swell that hits the North Shore of Maui, Hawaii...We have been extremely lucky to have these conditions which have finally made our investment worthwhile. Attached at Exhibit TM1 is a photo of me riding this wave on 19 March 2016.

4. The movie is set to be released in November 2019 with the premiere in Maui, Hawaii. We have provisionally pencilled in to show this at the final event of the Professional Wavesailing Association World Tour prize giving evening in Maui, Hawaii."

With regard to the cost of the film Mr Mullen states:

“5. We are nearing completion of the production of this movie...This investment has amounted financially to around £10,000 but this does not include our own personal time and future costs in production...”

6. In support Mr Mullen provides TM2 which is a print of flight details for Mr Mullen for travel between London Heathrow and Maui in April 2010, March 2012, April 2013 and October 2014.

7. Mr Mullen explains that a trailer has been produced for the movie. Exhibit TM3 is described as ‘print outs for the trailer’ for the proprietors’ movie. The video itself has not been provided in evidence.

8. The prints have been taken from vimeo.com which Mr Mullen describes as a video sharing website. A picture of a windsurfer at sea is shown in the top left corner, next to which are the words ‘HAWAII FIVE O’. The video was added to the site ‘three years ago’ and has been viewed 12.5 thousand times. Further down the page is the following:

“Work in progress of the latest edit of Hawaii Five O, myself and Rob’s future windsurfing movie.”

Witness statement by Alice Jane Cole and exhibits AJC1-AJC4

9. Ms Cole was the proprietors’ attorney with Urquhart-Dykes and Lord when these proceedings were launched. Her evidence comprises prints taken from Google following a search for the term, ‘how long does it take to make a film’. It also includes some examples of films which have taken many years to make. I do not intend to summarise it here.

DECISION

10. 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.”

11. Section 100 of the Act makes clear that the onus is on the proprietors to show use of their mark. It 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.”

12. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. summarised the case-law on genuine use:

“114. The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as

a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: Gözze at [43]-[51].

(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] and [22]. 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]; Reber at [29].

(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]; Leno at [29]-[30], [56]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34].

(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] and [76]-[77]; 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].”

13. In *Plymouth Life Centre*, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“20. Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time review the material that it has to prove use of it...

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.”

14. Recital 9 to Directive 2008/95/EC explains the purpose of articles 10 and 12 of the Directive, which are implemented in the UK through sections 46(1)(a) and (b) of the Act:

“In order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation for non-use”.

The proprietors’ documentary film

15. The crux of the proprietor’s defence appears to be that a trailer for their documentary film was posted to vimeo.com in approximately March 2015¹ and has been viewed by 12.5 thousand ‘fans of the movie’ and that this constitutes genuine use of the mark and further, that ‘significant preparations have been made’² with the movie set to be released in 2019.

16. In making a finding on these points I bear in mind the decision of Daniel Alexander sitting as the Appointed Person in *The Baba House*.³ The case concerned an appeal from a Registry decision in which the Hearing Officer had concluded that the requirement in *Ansul* for goods or services about to be marketed meant that those goods or services had to be in existence. Having outlined the case law (as I have done at paragraph 12), he referred to a number of decisions before the Registry and Appellate Tribunal. It is clear from these cases that where goods and/or services take a considerable time to develop or are bespoke goods and/or services of the type which

¹ Both parties accepted this date at the hearing.

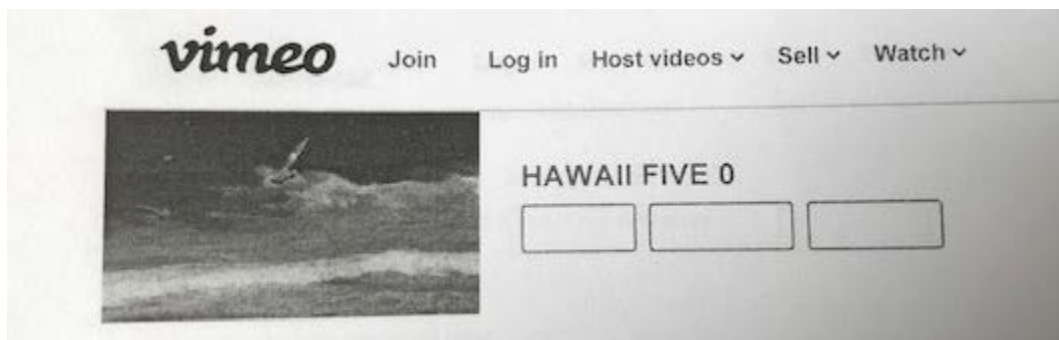
² See the proprietors’ skeleton argument.

³ O-049-15

are created once a contract or purchase has been made, then a more liberal view of the requirement in Ansul for goods 'about to be marketed' to be in existence may be taken.

17. The proprietors have provided pages printed from vimeo.com which purport to show the trailer for their film.

18. The video itself is not in evidence so I have not been able to view the content. The print shows a still photograph of a windsurfer at sea next to the words HAWAII FIVE 0. I reproduce it below:⁴



19. The number of views the video has achieved appear further down the same page, along with a description of the video posted by one of the proprietors. It appears as follows:



⁴ See exhibit TM3 attached to Mr Mullen's witness statement.

20. Mr Hall, for the applicant, submitted that the proprietors' best case was if the trailer could be considered a video in class 9. Given that the video is not evidence and all I have is what I have reproduced in the preceding paragraphs, I cannot tell how long the video is, what it shows, whether the trade mark has been used in the video or to whom it has been directed. It has been viewed twelve and a half thousand times but, as vimeo.com is an international website, I cannot determine how many of these viewers were in the UK. From the evidence provided, I cannot conclude that the video posted to vimeo.com in March 2015 was either a video made available to customers in the UK under the trade mark, or an advertisement or promotional video to create a market for the proprietors' future documentary film.

21. The words HAWAII FIVE 0, displayed alongside the image, appear to be the title of the video rather than a trade mark under which the video is provided. In the face of the very limited evidence I have before me, I find that the originator of the video is more likely to be seen as the individual who posted the video, in this case, Tam Mullen. This is particularly so, as later on the same page there is a list provided of other videos made available by the same individual.

22. Mr Hall made a number of points in his skeleton argument and at the hearing concerning the fact that the last character of the film title shown on the print taken from vimeo.com appears to be a zero rather than a letter 'O'. He also drew my attention to the missing dash between '5' and 'O' in the registered trade mark. Given that I cannot determine that the title is acting as a trade mark at all, I do not intend to consider whether the change of the last character and the missing dash result in a trade mark which is an acceptable variant of the one currently registered by the proprietors.

The remaining goods in class 9

23. The proprietors state that they have been in discussions with Microsoft UK regarding a computer game under the trade mark but that, *'film footage is required for the game, so this should follow shortly.'*⁵ The proprietors have not given any evidence to support this claim. There are no details of when these meetings took place, nor

⁵ See Mullen paragraph 8.

evidence of, for example, emails between Microsoft and the proprietors, nor is there anything to indicate that a product for sale under the trade mark is in the planning or development stages.

24. The proprietors have not referred in their witness statements nor provided any evidence to show use of their mark in respect of computer software (other than computer games, referred to above), compact discs or audio recordings.

Conclusion on proof of use

25. Whilst I accept that making a film of the type being undertaken by the proprietors will take longer to reach the market than some other goods, there are no press releases, advertisements, brochures or websites in evidence to show that any of the proprietors' goods are about to be made available. The proprietors were able to film the 50 year wave in March 2016 and still, some eighteen months later when the revocation application was made, there are clearly no customers and there have been no opportunities for any potential customers to see the proprietors' products or even express an interest in them. The proprietor has not shown evidence of any products which either existed in the relevant periods or were likely to exist shortly after those periods. I find that they have not used the mark in a commercial sense to create a market for the relevant goods (in class 9) during any of the periods claimed by the applicant.

26. Having reached these conclusions I will go on to consider the proprietors' case that they have proper reasons for non-use.

Proper reasons for non-use

27. No proper reasons for non-use were advanced at the pleadings stage. The counterstatement simply stated that the proprietors would seek to rely on proper reasons for non-use if no use was found in the relevant periods.

28. Such a reason was advanced in the proprietor's evidence and in its skeleton argument and was framed slightly differently on each occasion. I provide three examples:

1. A number of unusual weather events which must coincide in order for there to be a fifty-year wave of the type which is the subject of the proprietors' documentary film.⁶

2. Ms Cole, the proprietors' former representative, gives evidence relating to length of time taken to make a film and appears to conclude that 'the rare phenomenon of the 50 year wave that [the proprietors] have been anticipating has had the same effect as script re-writes'.⁷ She provides evidence of delays suffered by a number of well-known films, some of which are due to script re-writes.⁸

3. Production timing has been governed by the weather 'which is out of our control'.⁹

29. In any event, the reason provided by the proprietors, which is primarily weather related, would not have got off the ground as a proper reason for non-use. In the judgment of the CJEU in *Haupt v Lidl Stiftung & Co KG* it was stated:

"It follows that only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as 'proper reasons for non-use' of that mark."

30. The CJEU reaffirmed its position in *Il Ponte Finanziaria SpA v OHIM*¹⁰ when it stated:

⁶ See Mr Mullen's witness statement.

⁷ See Cole at paragraph 4.

⁸ See AJC2 and AJC3.

⁹ See the proprietors' skeleton argument.

¹⁰ Case C243/06P [2008] ETMR 13.

“The concept of ‘proper reasons’... refers essentially to circumstances unconnected with the proprietor of a trade mark which prevent him from using the mark...”

31. The proprietors chose of their own volition to pursue one documentary film about one particular wave in Hawaii. Whilst this may have been more complex or expensive than expected, these are not circumstances unconnected with the proprietors. Mr Hall submitted at the hearing that in the 17+ years that have elapsed since the registration of the trade mark there have no doubt been many waves surfed around the world in that time. I agree. The restrictions placed on the proprietors were in their own hands. For example, the goods in their trade mark specification include ‘surf videos’ and I see nothing in the evidence which suggests other videos on this topic could not have been produced in the period between January 2000 and October 2017. This defence (if properly pleaded at the outset) would fail on its facts.

Conclusion

32. The proprietors have not shown that there has been genuine use of the mark within either the section 46(1)(a) period or the section 46(1)(b) periods for any of the goods in class 9, nor have they provided proper reasons for non-use.

33. In accordance with section 46(6)(a) of the Act, trade mark registration 2195850A is revoked with effect from 3 January 2005.

COSTS

34. Brookfields Associates Limited has been successful and is entitled to a contribution towards its costs on the basis of the published scale (Tribunal Practice Notice 2/2016). I bear in mind that the proprietors filed very little evidence and the applicant did not file evidence at all:

Official filing fee	£200
Preparing the application for revocation	£200

Considering the proprietor's evidence	£300
Preparation for and attendance at a hearing:	£700
Total	£1400

35. I order Mr Timo Mullen and Mr Robert Jones to pay Brookfield Associates Limited the sum of £1400 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 24th day of January 2019

Al Skilton
For the Registrar,
The Comptroller-General