

**O/154/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003296542**

**BY FOCUSVISION WORLDWIDE, INC.**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**DECIPHER**

**IN CLASSES 35 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 600000920**

**BY NIGEL JOHN WALLEY**

## BACKGROUND AND PLEADINGS

1. On 13 March 2018, FocusVision Worldwide, Inc. (“the applicant”) applied to register the mark **DECIPHER** in the UK. The application was published for opposition purposes on 1 June 2018. The applicant seeks to register the mark for the following services:

Class 35      Market research services, namely, sampling of survey populations for market research, data processing, online reporting of customer survey results, and custom community development for use in market research; Market research services, namely, development of online surveys; market research.

Class 42      Providing online non-downloadable software for use in data collection and data management in the field of market research.

2. The application was opposed under the fast track opposition procedure by Nigel John Walley (“the opponent”). The opposition is based on sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the UK trade mark (registration no. 2209315) for the series of three marks **DECIPHER/ Decipher/ decipher**. The opponent relies upon all goods and services for which the earlier mark is registered, namely:

Class 9      Computer hardware, firmware and software, all relating to management consultancy, e-commerce, market research and analysis and financing modelling, but none for use in or relating to deciphering.

Class 35      Market research and analysis, advice and information relating to e-commerce: but not including any such services relating to deciphering.

Class 36      Financial modelling, but not including any such services relating to deciphering.

Class 42      Management consulting, but not including any such services relating to deciphering.

3. The opponent submits that the respective goods and services are identical or similar and that the marks are identical or similar. Given the date of application, the opponent's mark qualifies as an earlier mark in accordance with section 6 of the Act. The opponent states in its Notice of Opposition that it has used its mark in relation to all of the goods and services relied upon. The statement is made because the earlier mark is subject to the proof of use provisions contained in section 6A of the Act.

4. The applicant filed a counterstatement denying the claims made. On its original counterstatement, the applicant requested that the opponent prove use of its mark. However rule 17A(7) of the Trade Mark Rules 2008 provides that where proof of use applies in a fast track opposition, evidence of use shall be filed with the notice of fast track opposition. The Registry wrote to the applicant and noted that, as evidence of use had already been filed with the notice of opposition (as required by the Rules), it did not need to request evidence of proof of use in its Counterstatement.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2003, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

7. The applicant is represented by Bird & Bird LLP and the opponent is unrepresented. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate costs; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; neither party filed written submissions in lieu.

## EVIDENCE

8. This being a fast track opposition, the opponent's evidence of use has been filed as a series of responses to questions on the form TM7F, verified by a statement of truth. There are 7 exhibits. The evidence has been given by the opponent himself.

9. Exhibit 1 shows what appears to be the front page of a marketing plan which is entitled "Marketing Plan for Decipher's MediaBug Launch" and is dated September 2015. Beneath this appears the words "TV Channels & Platforms in Future TV Delivery, Madrid ASI Conference 2014, Nigel Walley – MD Decipher". It is not clear whether the opponent is claiming that the document displayed in the exhibit was distributed at this event. However, as the document post-dates the event I assume that this is not the case. The opponent states that the mark DECIPHER has been used since 2002 on documents, research reports and client communications.

10. Exhibit 2 displays the following image:



11. It is not clear what the images themselves are intended to show. The domain name www.decipher.co.uk is displayed. It is stated that:

"Nigel John Walley's use of the Decipher TV and its associated logo and marks has been established since 2002. His name has been closely associated with delivering services covered by class 35 of Nigel Walley's TM UK00002209315) and use of online research software (covered by class 42 of TM UK00002209315)."

12. It is not clear what the reference to “Decipher TV” relates to.

13. Exhibit 3 is a print out from the opponent’s website, which he states has been in use since 2002. The page is entitled “Who are Decipher?” and states “Decipher are digital media experts – insight, consultancy and research on the consumer and commercial implications of emerging media technologies”. The page itself is undated. There is a sub-heading entitled “Reports & Events” which has links to five articles dated 2013 to 2014, although it is not clear from the titles what these relate to. The page also displays links to “Tweets” made from the opponent’s Twitter account, one of which is dated “6 Nov” (although no year is listed). However, as the articles on the page are dated 2013 and 2014, it is a reasonable inference that the tweets would have been made around the same time (or more recently).

14. Exhibit 4 is an undated printout from the opponent’s website which is entitled “MEDIA BUG”. The opponent states:

“The MediaBug service is a Decipher owned market research product (covered by Class 35 of Nigel Walley’s Decipher TM UK00002209315) and its use online research software (covered by class 42 of TM UK00002209315).”

15. The page also makes various references to the word DECIPHER. The opponent states that the website has been in use since 2002.

16. Exhibit 5 is a screenshot taken from the website [www.emarketer.com](http://www.emarketer.com) which is undated. It discusses the results of research undertaken and references Decipher as a source. The statistics provided by Decipher within this document are dated 10 November 2014.

17. Exhibit 6 is a print out of the opponent’s “Decipher ‘Off Air’ Blog” which appears to be dated November 2015 (although the print quality means that the document is difficult to read). This references the opponent’s MediaBug report, but the content is illegible.

18. Exhibit 7 is a screenshot of an article dated 22 January 2014 entitled “CES 2014: More science fiction than strategy”. No information is provided as to what website or other source this article is taken from. The article summary states:

“Following yesterday’s CES Debrief, Nigel Walley, managing director of Decipher, looks at some of the most interesting trends from the Las Vegas gadget-fest – and says one of the biggest problems is that we just don’t want to live in the world many of these companies envisage.”

## **PRELIMINARY ISSUE**

19. On 14 January 2019, the opponent wrote to the Tribunal to enquire as to whether it could respond to points made by the applicant in its counterstatement. The Tribunal wrote to the opponent and stated:

“The comments contained in your e-mail dated 14<sup>th</sup> January 2019 are noted and are taken to be an indication that you wish to file further evidence. If this is the case, any request for leave to file evidence should additionally explain why, having elected to use the fast track process which does not provide an automatic right to file (further) evidence, you now consider that an exception should be made for such evidence to be filed. Any request should be submitted within 14 days of the date of this letter, that is on or before **31<sup>st</sup> January 2019**. Further guidance is provided at paragraph 7 of the Tribunal Practice Notice 2/2013.”

20. On 4 February 2019, the opponent emailed the Tribunal with what amounted to further evidence of fact (although not in the correct format). In response, the Tribunal wrote to the opponent and stated:

“In the fifth paragraph of the Registry’s letter dated 17<sup>th</sup> January 2019 you were notified that if you wanted leave to file further evidence your request (with reasons) had to be filed on or before 31<sup>st</sup> January 2019.

The contents of your e-mail of 4<sup>th</sup> February 2019 are noted. However, your comments were filed outside of the above deadline and do not in any case appear to be a request to file further evidence which should have been filed in the form of a witness statement.

As such the contents of your e-mail will now be disregarded as the Registry does not consider that the required permission was sought by you to file further evidence as pointed out in the letter dated 17<sup>th</sup> January 2019.

This matter will now proceed to a decision”.

21. Consequently, I have not taken this into account in reaching my decision.

## **DECISION**

### **Proof of Use**

22. The first issue is 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 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 of 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.”

23. 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.”

24. What constitutes genuine use has been subject to a number of judgments. 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 Merken 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] to [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 always the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

25. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is not, therefore, genuine use.

26. According to section 6(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied for mark. The relevant period is, therefore, 2 June 2013 to 1 June 2018.

27. Before assessing the opponent’s evidence of use, I remind myself of the comments of Mr Daniel Alexander Q.C., sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*, Case BL O/236/13, where he 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.”

28. It is clear from the case law above that the onus is on the opponent to show that it has used its trade mark in the relevant period. It is also clear that no particular documents are required for that purpose. The difficulty for the opponent is that it has filed very few documents, some of which are undated. No evidence of sales or turnover has been provided. It ought not to have been difficult for the opponent to provide evidence to show that it had made sales under the mark in the form of, for example, invoices. No information is provided by the opponent regarding any advertising or promotional activity undertaken in relation to the mark. Whilst the mark has been used on the opponent’s website, no figures are provided to show how many people have viewed the site or the location of such viewers. The opponent has provided two examples of its mark being referenced in third party articles but it is not clear what audience these sources might reach and, indeed, the identity of one of the sources is not clear from the evidence provided. The opponent has shown some limited use of its mark in relation to a blog and a social media account, but no details of the number of views or followers are provided.

29. On the basis of the evidence before me, I am not satisfied that genuine use has been made on or in relation to the services upon which the opponent relies.

## **CONCLUSION**

30. The opponent has failed to establish genuine use of its earlier mark within the relevant period. Where the proof of use provisions apply, an opponent cannot rely on its earlier mark unless those provisions are satisfied. Consequently, as the opponent has not proved use of its mark, it cannot rely on its earlier mark for the purposes of this opposition and the opposition fails at the first hurdle. Subject to appeal, the opposition is dismissed and the application will proceed to registration.

## **COSTS**

31. As the applicant has been successful it is entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice 2 of 2015. Using that as a guide, I award the applicant the sum of **£200** calculated on the following basis:

Considering the opponent's statement and preparing a counterstatement	£200
<b>Total</b>	<b>£200</b>

32. I order Nigel John Walley to pay FocusVision Worldwide, Inc. the sum of £200. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated 25 March 2019**

**S WILSON**

**For the Registrar**