

**O-292-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3154068  
BY BLUE DIGITAL (EUROPE) LIMITED  
TO REGISTER:**

**Blue**

**AS A TRADE MARK IN CLASS 36**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 407092 BY  
BANCO BILBAO VIZCAYA ARGENTARIA, S.A.**

## BACKGROUND & PLEADINGS

1. On 10 March 2016 and claiming an International Convention priority date of 26 October 2015 from an earlier filing in the Benelux, CKL Holdings N.V. applied to register the word **Blue** as a trade mark for the services in class 36 shown in paragraph 48 below. The application was published for opposition purposes on 10 June 2016. On 20 October 2016, the application was assigned to Blue Digital (Europe) Limited (“the applicant”). As nothing appears to turn on this assignment, I need say no more about it.

2. On 1 August 2016, the application was opposed in full by Banco Bilbao Vizcaya Argentaria, S.A. (“the opponent”). The opposition is based upon sections 5(1) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon all the goods and services in European Union Trade Mark (“EUTM”) no. 1345974 for the word **BLUE** which was applied for on 15 October 1999 and entered in the register on 10 October 2003.

3. The applicant filed a counterstatement in which it denies there is a likelihood of confusion. Following the serving of the Form TM8 upon the opponent, the proceedings were suspended to await the outcome of a revocation action filed by the applicant against the EUTM being relied upon. On 19 June 2018, the Cancellation Division of the European Union Intellectual Property Office (“EUIPO”) issued its decision (no. 11948C), in which it partially revoked the trade mark being relied upon with effect from 17 October 2015. The opponent’s surviving specification is as follows:

**Class 9:** Magnetic cards; cards having microprocessors (chips); smart cards having microprocessors.

**Class 36:** Financial affairs; monetary affairs; financial consultancy; financial information; financial sponsorship.

4. It is my understanding that although the opponent initially appealed that decision, the appeal was subsequently withdrawn. As a consequence, the Cancellation Division's decision is final and it is upon the specifications shown above my considerations will be based.

5. In these proceedings, the opponent is represented by Baker & McKenzie LLP and the applicant by Jonathan Morton. Only the opponent filed evidence. Although neither party requested a hearing, the opponent elected to file written submissions in lieu of attendance. I shall keep these submissions in mind, referring to them to the extent I consider it appropriate to do so.

## **EVIDENCE**

### **The opponent's evidence**

6. This consists of a witness statement, dated 19 March 2019, from Carlos Perez Beruete, who is the opponent's Digital Sales & Marketing Executive Director, a position he has held since 2009. Mr Beruete explains that the opponent is:

"7...a multi-national banking group which is headquartered in Bilbao, Spain... the second largest bank in Spain, where (sic) has one of the largest networks of branches and ATMs, totalling more than 3,000 branches and more than 6,000 ATMs. The Opponent currently has 53.399 employees in the EU.

8. The Opponent's financial services include banking, insurance and asset management...

10...As of 2015, the total number of the Opponent's clients stood at 14.8 million."

7. Mr Beruete states that in 1999 the opponent launched a new line of financial services under the trade mark BLUE. These services were, he explains, targeted at children and young people which he describes as those between 0 and 29 years old. He states that:

“13. BLUE is the trade mark used by the Opponent to identify a bank account offering in Spain, targeting young people. It is an account with no fees and requires only one card transaction per month. Ideally for 18-29 year olds, BLUE goods and services include facilitating in-store payment and online purchases, subscriptions to series platforms of music and entertainment and withdrawal of cash by ATM card.”

8. Mr Beruete states that the opponent has used its BLUE trade mark continuously since 1999 with the number of BLUE account customers as follows:

<b>2012</b>	<b>2013</b>	<b>2014</b>	<b>2015</b>
1,352,872	1,398,814	1,339,535	1,373,114

9. Mr Beruete describes exhibit CPB1 as:

“15...a sample selection of standard contracts, agreements, offers and information for BLUE customers pertaining to financial products and services, such as BLUE mortgages, loans, bank accounts and associated bank cards of varying types.”

10. The exhibit contains a number of pages of very poor quality in Spanish (the first page of which is partially redacted) together with an English version. No indication is provided of the origin of the English language pages. The opponent is, however, identified in what is described as an “Agreement” dated 14 February 2012 which, I note, contains a reference to “CARD PAGA AHORA BLU”.

11. Mr Beruete describes exhibit CPB2 as:

“16...a selection of illustrative invoices issued by global media agencies 'OMD' and 'Mindshare' to the Opponent, regarding BLUE publicity campaigns across various media (internet, radio, television, social media), covering the period from 2011-2015. These invoices demonstrate the investment in business development for the launch and promotion of the BLUE brand. Examples of use include launch of the Opponent's official website and social media websites, social media optimisation, launch of blogs, banners, sponsored articles and promoted tweets. The amounts featured in the invoices range from EUR 200 to around EUR 20,000...”

12. The exhibit is as described by Mr Beruete with, where it was considered appropriate, various words in the invoices translated into English, again with no explanation of by whom. I note all of the pages provided contain a reference to “Campaign Blue” or similar.

13. Mr Beruete describes exhibit CPB3 as:

“17...documents issued by Gemalto S.A., a digital security company, which issued a total of 1,737,892 bank cards to the Opponent between August 2010 to 31 December 2015...”

14. He further states that:

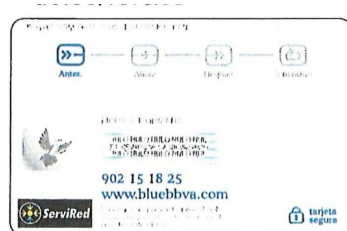
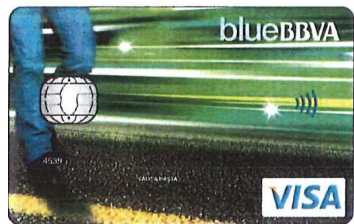
“17...these documents demonstrate evidence of the creation, print and production of BLUE bank cards, on which BLUE appears prominently). The documents issued by Gemalto S.A. demonstrate the repeat purchase by the

Opponent of BLUE branded bank cards for use by its customers between the years of 2012-2016.”

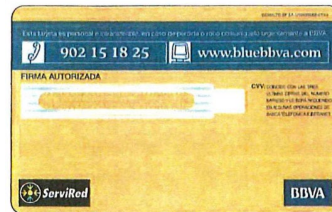
15. The page provided (again with a version in English) is from Nicolas Seoane an “attorney of fact” at gemalto SP, SA. Mr Seoane confirms that the number of plastic cards identified by Mr Beruete were supplied to the opponent. The five cards identified by Mr Seoane all contain the word “BLUE” in the title, for example, “AHORA BLUE” and “BLUE DIEZ”. Although Mr Beruete states that exhibit CPB4 is “a signed statement certifying the Opponent’s spend for creation of the cards between August 2010-December 2015”, as far as I can tell, it appears to be a further copy of exhibit CPB3.

16. Exhibit CPB5 consists of what Mr Beruete explains are “various designs of cards commissioned during this time.” Examples from the various years are as follows:

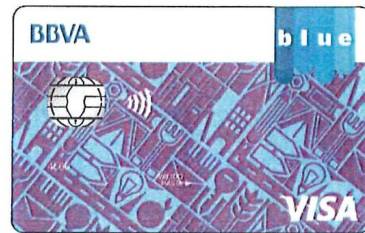
**2011:**



2013:



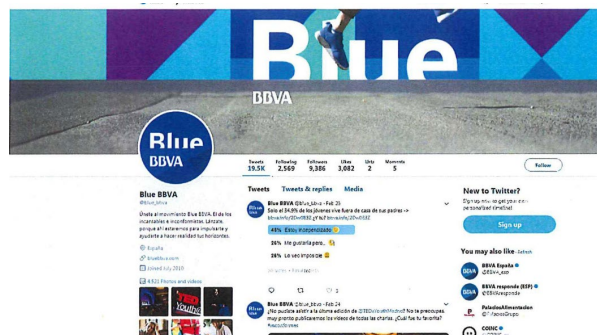
2015:



17. Exhibit CPB6 consists of what Mr Beruete explains are “invoices issued by Gemalto S.A for the production of BLUE cards.” There are five invoices, dated 29 January and 26 June 2014 and 26 January, 25 June and 23 December 2015, with various pages in English. All of the invoices contain references to the opponent and to “BLUE” with a typical example reading: “110001994 ANTES BLUE CONTACTLESS Ad.Per.Tarjt Chip.”

18. Exhibit CPB7 consists of two documents entitled “Report on Social Media blue BBVA October 2015” and “BLUE “ADELANTE CON” – Strategic recommendation Version 1 13 August 2015.” Exhibit CPB8 consists of what Mr Beruete describes as a “strategic and digital planning report dated 2015 in relation to the expansion of the BLUE campaign.” While I do not intend to summarise these exhibits here, I will of course keep their contents in mind.

19. Exhibit CPB9 consists of what Mr Beruete explains is how “the BLUE products and services are promoted on Twitter, Facebook and Instagram.” Although these are current printouts, Mr Beruete confirms that “BLUE branding appeared prominently on these social media sites between the years 2011-2016.” A current example, from Twitter, is shown below:





20. Mr Beruete states that in the period 2011 to 2015, the opponent spent in the order of €1.5m “on advertising exclusively in relation to the BLUE bank account offering...”. He goes on to describe exhibit CPB10 as:

“25...a selection of illustrative advertising material within the relevant period for (sic) relating to the BLUE bank account offering, such as BLUE mortgages, loans, bank accounts and associated bank cards, design of new debit cards, dated press and news articles, blogs and sponsored sporting events including the NBA and Global Games Madrid...”.

21. Once again the exhibit is accompanied by various unexplained translations into English. The word “blue” appears throughout the exhibit. I note that page 218 of the exhibit, dated 31 May 2013, from finanzalis.com (as translated) reads:

“BBVA Online Blue Account for young people

- Savings
- Stock Exchange
- Bank Accounts
- Deposits
- Investment Funds
- Mortgages
- Investments
- Pensions
- Loans
- Credit Cards
- Insurance.”

22. There are also a range of pages provided in relation to the opponent’s sponsorship of: (i) football, for example, page 213 (“XVIII – TORNEO INTERNATIONAL BLUE BBVA

FOOTBALL” 7 – December 2013), page 215 (“TORNEO NACIONAL BLUE BBVA ALEVIN DE FUTBOL 7” – June 2013), (ii) pages 244-247 in relation to basketball (“blue BBVA – BBVA activated their blue promotion during Global Games Madrid which included blue logo inclusion...”), and (iii) musical events, page 263 (“Macroquedada blue en “El dia Bustamante” i.e. “Blue Megaparty on Bustamente Day”).

23. That concludes my summary of the evidence filed to the extent I consider it necessary.

## **DECISION**

24. The opposition is based upon sections 5(1) and 5(2)(b) of the Act which read as follows:

“5 (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

(a)...

(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.”

25. The trade mark upon which the opponent is relying qualifies as an earlier trade mark under the provisions of section 6 of the Act. Given the interplay between the date on which the opponent's trade mark was entered in the register and the publication date of the trade mark being opposed, the earlier trade mark is subject to the proof of use provisions contained in section 6A of the Act. In its Notice of opposition, the opponent states that it has used its trade mark in relation to all the goods and services upon which it is relying and, in its counterstatement, the applicant asked the opponent to make good on that claim insofar as it relies upon services in class 36. The opponent can, as a consequence, rely upon its goods in class 9 without having to demonstrate it has made genuine use of them.

### **Proof of use**

#### **Section 6A:**

26. This reads as follows:

“(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 European Union 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 Union.

(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.”

27. I begin by reminding myself that the applicant has only asked the opponent to provide proof of use in relation to its services in class 36. In reaching a conclusion on that point, I must apply the same principles as I would if I were considering an application for revocation based upon non-use. The relevant five year period is 11 June 2011 to 10 June 2016. Section 100 of the Act 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.”

28. 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 as follows:

“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 Bundesvereinigung 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 Marken 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].”

29. The earlier trade mark being relied upon is an EUTM. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union (“CJEU”) noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”



And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

30. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

31. The General Court ("GC") restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

32. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown.

33. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated:

“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.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what

specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

34. 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:

“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.”

### **Overview of the opponent’s evidence**

35. Although Mr Beruete’s evidence contains a number of what appears to be unexplained documents in English, I note that his evidence stands unchallenged. As a consequence, I see no reason not to proceed on the basis that they are accurate English language versions/translations of the Spanish documents to which they relate. Mr Beruete has held his current position since 2009. He states that in 1999, the opponent launched a new line of financial services in Spain under its BLUE trade mark, explaining that this trade mark is used by the opponent to identify “a bank account offering” aimed at those up to 29 years of age.

36. In the period August 2010 and December 2015, Gemalto produced in excess of 1.7m bank cards for the opponent bearing the word BLUE (exhibit CPB3) and invoices issued by Gemalto between January 2014 and December 2015 addressed to the opponent are provided in support (exhibit CPB6). Mr Beruete provides a wide range of invoices dated between 2011 and 2015 in relation to the promotion of its BLUE trade mark (exhibit CPB2) as well as examples of how its trade mark has appeared on bank cards (exhibit CPB5), in advertising and on various social media sites (exhibits CPB10 and CPB9). Although the examples from the social media sites provided are current, Mr Beruete confirms the BLUE branding appeared on these social media sites between

2011 and 2016. Mr Beruete further explains that in the period 2011 to 2015, the opponent spent in excess of €1.5m exclusively advertising its BLUE bank account and in the years 2012 to 2015 the number of BLUE bank account customers was never less than 1,339, 535.

37. In the evidence, the trade mark relied upon appears in a range of formats, including in the form in which it is registered, as well as, for example, “blue”, “blueBBVA”, “www.bluebbva.com”, “Blue” and “Blue BBVA”.

38. The opponent has only used its BLUE trade mark in Spain. However, as I mentioned earlier, the tribunal continues to entertain the possibility that use of an EUTM in an area of the European Union corresponding to the territory of one Member State may be sufficient to constitute genuine use, and that this applies even where there are no special factors, such as the market for the goods/services being limited to that area of the European Union. Consequently, the fact that the opponent has only used its trade mark in Spain is not a point that counts against it.

39. It is, I think, fair to say that a good deal of the opponent’s use is of the word “blue” or “blue” accompanied by the letters “BBVA”. Insofar as the use of “blue” is concerned, this falls squarely within section 6A(4)(a) of Act and is acceptable. As to the use with “BBVA” this is also acceptable for the reasons explained by the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one trade mark with, or as part of, another trade mark, the court found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration

may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)".  
(emphasis added)

40. When considered as a totality, the opponent's evidence is, in my view, clearly sufficient to establish that within the period 11 June 2011 and 10 June 2016 it had made



genuine use of the trade mark upon which it relies. That use has been in relation to a personal bank account aimed at those up to the age of 29. Having reached that conclusion, I must now determine what constitutes a fair specification.

41. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

42. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average

consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

43. I remind myself that the opponent's specification in class 36 is as follows:

**Class 36:** Financial affairs; monetary affairs; financial consultancy; financial information; financial sponsorship.

44. In exhibit CPB10 (pages 218 and 219) dated 31 May 2013, under the heading "BBVA online Blue Account for young people", it indicates that the services provided include: "savings, stock exchange, bank accounts, deposits, investment funds,

mortgages, investments, pensions, loans, credit cards and insurance.” I am satisfied that the average consumer will be aware that such financial services are routinely provided in association with the operation of a personal bank account. There is also the opponent’s financial sponsorship of football, basketball and music to keep in mind. In my view, the first four terms in the opponent’s specification are very broad and include a wide range of financial and monetary affairs, consultancy and information which, on the basis of the evidence provided, are not justified.

45. Approaching the matter on the basis of the above, a fair specification which accords with how Mr Beruete describes the opponent’s services (i.e. a “bank account offering”) and, more importantly, how the average consumer would describe the opponent’s services is as follows:

Personal banking services; consultancy and information services all relating to personal banking; financial sponsorship.

It is that specification, I shall use for the purposes of comparison.

### **The objection based upon section 5(1) of the Act**

#### **Comparison of trade marks**

46. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

47. The opponent's trade mark consists of the word "BLUE" presented in block capital letters, whereas the applicant's trade mark is for the same word presented in title case i.e. "Blue". Applying the guidance above, the competing trade marks are to be regarded as identical.

### Comparison of goods and services

48. The competing goods and services are as follows:

<b>The opponent's goods and services in class 36 (the latter following the proof of use assessment)</b>	<b>The applicant's services</b>
<p><b>Class 9:</b> Magnetic cards; cards having microprocessors (chips); smart cards having microprocessors.</p> <p><b>Class 36 -</b> Personal banking services; consultancy and information services all relating to personal banking; financial sponsorship.</p>	<p><b>Class 36 -</b> Financing services; management of investment funds; investment of funds; financial management and planning.</p>

49. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where

the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

50. For present purposes, I need only compare the opponent’s services in class 36 with those of the applicant in the same class. As all of the applicant’s services would be encompassed by the opponent’s “personal banking services”, the competing services are to be regarded as identical on the *Meric* principle.

### **Conclusion under section 5(1) of the Act**

**51. As both the competing trade marks and the services in class 36 are to be regarded as identical, the opposition based upon section 5(1) of the Act succeeds and, subject to any successful appeal, the application will be refused.**

### **Observations on the opposition based upon section 5(2)(b) of the Act**

52. The applicant (in its counterstatement) and the opponent (in its written submissions) refer to a ground of opposition based upon section 5(2)(a) of the Act. As far as I can tell, no such ground was ever pleaded nor was any request made to add such a ground. Had the opposition based upon section 5(1) of the Act failed in whole or part (because the services were not identical), as the competing trade marks are identical, the opposition based upon section 5(2)(b) of the Act would not have assisted the opponent.

### **Costs**

53. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Having applied the guidance in the TPN, I award costs to the opponent on the following basis:

Preparing the Notice of Opposition and reviewing the counterstatement:	£300
Preparing evidence:	£800
Written submissions:	£100
Official fee:	£100
<b>Total:</b>	<b>£1300</b>

54. I order Blue Digital (Europe) Limited to pay to Banco Bilbao Vizcaya Argentaria, S.A. the sum of **£1300**. This sum is to be paid within two months of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 27<sup>th</sup> day of May 2020**

**C J BOWEN**  
**For the Registrar**