

o/566/22

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK REGISTRATION NO. 3138367

IN THE NAME OF PARA LONDON LIMITED

FOR THE TRADE MARK:

IBC Radio

AND

AN APPLICATION FOR REVOCATION UNDER NO. 503981

BY GLOBAL MEDIA GROUP SERVICES LIMITED

Background and pleadings

1. Trade mark number 3138367 for the trade mark “IBC Radio” stands in the name of Para London Limited (“the proprietor”). The trade mark was registered on 25 March 2016 in respect of “radio and television advertising” in class 35.

2. On 5 July 2021, Global Media Group Services (“the applicant”) applied for the trade mark to be revoked on the grounds of non-use under ss. 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”). The revocation under both of these grounds is directed against all of the services in the specification. The applicant says that the trade mark has not been used in the five-year period following registration, i.e. 26 March 2016 to 25 March 2021, and that it should be revoked under s. 46(1)(a) with effect from 26 March 2021. The claim under s. 46(1)(b) is there has been no use of the trade mark in the periods 26 March 2016 to 25 March 2021 and 5 July 2016 to 4 July 2021. Accordingly, the proprietor says that the trade mark should be revoked with effect from 26 March 2021 and 5 July 2021, respectively.

3. The proprietor filed a form TM8(N) defending the registration in full. It accepts that there has been no use of the mark but claims that there are proper reasons for non-use. It says that IBC Radio was launched to exchange information between the Tamils in Sri Lanka and the Tamil diaspora during the civil war. The application for the trade mark in 2015 coincided with a renewed interest in war crimes and human rights abuses. It was thought at that time that the government was more benign but journalists continue to be at serious risk in Sri Lanka. The proprietor says that without its own journalists and reporters in Sri Lanka the radio station cannot succeed. However, the proprietor is still pursuing every avenue to commence the broadcasting operation and is actively exploring the possibility of commencing the broadcasting operation with a bureau set up in Sri Lanka.

4. Neither party requested an oral hearing. The applicant filed written submissions in lieu, which I will bear in mind. This decision is taken following a careful reading of all of the papers.

5. The applicant is represented by Mischon de Reya LLP and the proprietor is represented by Nag Law Solicitors.

Evidence

6. The proprietor's evidence is contained in two witness statements of Paramasamy Nishakaran, with accompanying exhibits PN1 to PN10. Mr Nishakaran is the sole director of the proprietor. Mr Nishakaran's evidence explains the history of the brand and why the mark has not been used in the UK.

7. The applicant's evidence is in the form of the witness statement of David Henderson, with accompanying exhibits DH1 to DH9. Mr Henderson is Chief Technology and Product Officer of the applicant. He provides evidence about the proprietor and broadcasting activities in the UK under the "IBC" moniker, as well as some more general information about radio broadcasting.

Decision

Legislation and case law

8. So far as it is relevant, s. 46 reads:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) 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;

[...]

(2) For the purposes of subsection (1) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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 preparation for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(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.

9. The leading case on proper reasons for non-use is *Armin Häupl v Lidl Stiftung & Co. KG*, Case C-246/05, EU:C:2007:340.¹ In that case, the Court of Justice of the European Union (“CJEU”) held that:

“52. In particular, as correctly stated by the Advocate General in [79] of his Opinion, it does not suffice that “bureaucratic obstacles”, such as those pleaded in the main proceedings, are beyond the control the trade mark proprietor, since those obstacles must, moreover, have a direct relationship with the mark, so much so that its use depends on the successful completion of the administrative action concerned.

53. It must be pointed out, however, that the obstacle concerned need not necessarily make the use of the trade mark impossible in order to be regarded as having a sufficiently direct relationship with the trade mark, since that may also be the case where it makes its use unreasonable. If an obstacle is such as to jeopardise seriously the appropriate use of the mark, its proprietor cannot reasonably be required to use it nonetheless. Thus, for example, the proprietor of a trade mark cannot reasonably be required to sell its goods in the sales outlets of its competitors. In such cases, it does not appear reasonable to require the proprietor of a trade mark to change its corporate strategy in order to make the use of that mark nonetheless possible.

54. 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. It must be assessed on a case-by-case basis whether a

¹ Although the UK has left the EU, s. 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to refer to EU trade mark law.

change in the strategy of the undertaking to circumvent the obstacle under consideration would make the use of that mark unreasonable. It is the task of the national court or tribunal, before which the dispute in the main proceedings is brought and which alone is in a position to establish the relevant facts, to apply that assessment in the context of the present action.

55. Having regard to the foregoing considerations, the answer to the second Proper question referred for a preliminary ruling must be that Art.12(1) of the Directive must be interpreted as meaning that obstacles having a direct relationship with a trade mark which make its use impossible or unreasonable and which are independent of the will of the proprietor of that mark constitute “proper reasons for non-use” of the mark. It is for the national court or tribunal to assess the facts in the main proceedings in the light of that guidance”.

10. In *Naazeen Investments Ltd v OHIM*, Case T-250/13, the General Court held that difficulties in manufacturing a product were not outside the proprietor’s control and therefore did not constitute a proper reason for non-use. The court stated that:

“66. According to the case-law, ‘proper reasons’ refers to circumstances unconnected with the trade mark proprietor rather than to circumstances associated with his commercial difficulties (see, to that effect, judgment of 9 July 2003 in *Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO AIRE)*, T-156/01, ECR, EU:T:2003:198, paragraph 41). The problems associated with the manufacture of the products of an undertaking form part of the commercial difficulties encountered by that undertaking.

67. In the present case, the marketing of the goods in question was stopped because those goods were defective. Given that it was for Gondwana to supervise and control the manufacture of the goods in question even though they were being manufactured by a third party, the interruption to the marketing of those goods cannot be regarded as independent of the will of Gondwana.

68. Furthermore, the applicant is wrong in claiming that it had no choice but to stop using the mark at issue or to put consumers' health in danger. As OHIM has observed, further products could have been manufactured and placed on the market within a reasonable period. Therefore, the applicant cannot claim that the change in strategy of the proprietor of the mark at issue made use of that mark unreasonable. The additional economic investments necessary for the manufacture of further products form, as OHIM states, part of the risks that an undertaking must face.

69. Accordingly, the applicant cannot claim that the Board of Appeal was wrong to take the view that the difficulty encountered by Gondwana concerning the manufacture of the goods in question did not constitute a proper reason for non-use of the mark at issue (paragraph 36 of the contested decision)".

The judgment of the General Court was upheld on further appeal to the CJEU: see Case C-252/15 P.

Evidence

Proprietor's evidence

11. Mr Nishakaran says that journalists reporting on human rights issues relating to the Tamils living in Sri Lanka are being put at risk.² The risks faced by journalists are, he says, the main reason why there has been no use of the trade mark, because the radio station "cannot function without the journalists operating in Sri Lanka".³ To underscore the point, he says that at the time of compiling his statement one of the deputy editors of the IBC Tamil Radio/Television was forced to flee Sri Lanka and has sought asylum in the UK.⁴

12. In support of the difficult situation faced by journalists, Mr Nishakaran provides a number of documents. The first is a decision of the Upper Tribunal (Immigration and

² Nishakaran 1, §10.

³ Nishakaran 1, §13. See also Nishakaran 1, §22 and Nishakaran 2, §§9-10.

⁴ Nishakaran 1, §14.

Asylum Chamber) dated 27 May 2021 in appeals against deportation by two Tamil refugees.⁵ The case set out new country guidance regarding the risks of repatriation to Sri Lanka, in particular for those who have expressed Tamil separatist beliefs. The new country guidance is set out at [536] of the judgment and has 29 separate points. It begins:

“(1) GoSL [Government of Sri Lanka] is an authoritarian regime whose core focus is to prevent any potential resurgence of a separatist movement within Sri Lanka which has as its ultimate goal the establishment of Tamil Eelam.

(2) GoSL draws no material distinction between, on the one hand, the avowedly violent means of the LTTE in furtherance of Tamil Eelam, and non-violent political advocacy for that result on the other. It is the underlying aim which is crucial to GoSL's perception. To this extent, GoSL's interpretation of separatism is not limited to the pursuance thereof by violent means alone; it encompasses the political sphere as well.

(3) Whilst there is limited space for pro-Tamil political organisations to operate within Sri Lanka, there is no tolerance of the expression of avowedly separatist or perceived separatist beliefs.

(4) GoSL views the Tamil diaspora with a generally adverse mindset, but does not regard the entire cohort as either holding separatist views or being politically active in any meaningful way”.

13. Journalists are acknowledged as a specific risk category. The guidance is as follows:

“(25) Journalists (whether in print or other media) or human rights activists, who, in either case, have criticised the Sri Lankan government, in particular its human rights record, or are associated with publications critical of the government, face a reasonable likelihood of being detained after return, whether or not they continue with their activities”.

⁵ PN3.

14. Additionally, the decision points out at [547] that:

“However, a tribunal considering the question of how GoSL will react to the expression of beliefs must do so on a correct premise: a genuine belief in varying degrees of autonomy for the Tamil majority areas within Sri Lanka is self-evidently distinct from a commitment to the establishment of Tamil Eelam. As discussed earlier, GoSL views separatism with real hostility. The view of a witness in *GJ* [the previous country guidance case] that any political activity within Sri Lanka was at that time ‘incredibly dangerous’ remains valid now in the context of a ‘separatist ideology’ and the expression thereof”.

15. Mr Nishakaran also provides the Annual Report of the United Nations High Commissioner for Human Rights dated 16 March 2021.⁶ The report expresses serious concern about the “deteriorating situation of human rights” in Sri Lanka over the previous year and certain trends which “risk the recurrence of policies and practices that gave rise to the grave violations of the past”.

16. In addition, a report dated 24 October 2018 by the organisation Reporters Without Borders describes the “constant harassment” of a newspaper journalist for the *Tamil Guardian* and a Tamil-language newspaper called *Valampuri* by Sri Lanka’s anti-terrorism police.⁷ The authorities’ interest is said to have resulted from the coverage of an “innocuous” festival in which a photograph showing a map of the “traditional Tamil homeland” could be seen in the background.

17. There is also in evidence a report from www.jdslanka.org dated 15 July 2021 titled “Intimidation of Tamil Journalists continues unabated in Sri Lanka”.⁸ This article details the alleged intimidation and wrongful arrest of several Tamil journalists. I note that the article says that “[apart] from reporting on sensitive issues such as the plight of the Tamil

⁶ PN4.

⁷ PN5.

⁸ PN5.

minority or Sri Lanka's Muslim community, even reporting on day to day happenings in the North and East of the country is increasingly becoming dangerous for journalists".

18. There is some hearsay evidence in the form of "to whom it may concern" letters from the following:

- A Tamil Member of Parliament, Selvarajah Kajendren. Mr Kajendren says that IBC Radio "played a major part in the parliamentary election since 2004".⁹ He adds that "IBC RADIO which operated as IBC Tamil Radio regularly exposed the human rights violations of the Sri Lankan state and due to this the journalists working for this broadcasting organization were targeted by the state security forces and its Para-Military Group [...]".
- A reporter who worked for IBC Radio from 1997.¹⁰ He states that he was targeted and threatened as a result of his efforts to expose human rights violations by the GoSL and that he "was about to be killed on many occasions". He went into hiding in 2007 and later sought asylum in Switzerland.

19. Mr Nishakaran also adduces evidence about the arrest of a murder suspect in the UK in 2022.¹¹ The victim was an IBC radio reporter, who also worked for the BBC. The murder was committed in Sri Lanka in 2000. Mr Nishakaran says that this shows the Sri Lankan state reaching the UK.

20. There is also evidence in the form of Wikipedia pages about IBC Tamil.¹² The page is not dated but it was last edited on 4 October 2019. It indicates that the company is responsible for IBC Tamil television as well as IBC Tamil Radio. There is no explanation of the connection between this company and the proprietor. The evidence is that the radio station was established in 1997 and "is considered the largest and most popular radio station the Tamil diaspora [sic]. Its core audience is estimated to be over one million". Mr Nishakaran gives evidence that until May 2009, IBC radio and television "functioned as a

⁹ PN6.

¹⁰ PN7.

¹¹ Nishakaran 2, §§11-12 and PN9.

¹² PN8.

bridge between the Tamil diaspora world over and Tamils in Sri Lanka”.¹³ In his evidence in reply, Mr Nishakaran clarifies that IBC radio “spawned” IBC Tamil TV but that they are not managed by the same organisation and their editorial focus is different.¹⁴

Applicant’s evidence

21. The applicant has produced some evidence regarding IBC Tamil and the radio station it appears to broadcast under the name “IBC Tamil”.¹⁵ The prints are from <https://tvibctamil.com> and are dated only with the printing date in January 2022, which is after the date on which the revocation action was filed and, therefore, too late for the saving provision under s. 46(3). There are, however, references to IBC Tamil Radio becoming in 2010 the first Tamil station to broadcast 24 hours a day, seven days a week in DAB in London and to new IBC radio stations in 2015. There is also reference to advertising campaigns across the company’s radio, television and online services.

22. Mr Henderson exhibits a screenshot from <https://static.ofcom.org.uk> which shows the “current” (it is assumed that this is at the date of Mr Henderson’s statement in 2022) licence for IBC Tamil and indicates that it is a “service comprising news, information and music for the Tamil community”.¹⁶

23. Additionally, there is some evidence about different methods of radio broadcasting, such as via the internet, as well as of radio stations which are said to be accessible from the UK but where the broadcast emanates from a different territory.¹⁷

Assessment

24. The decision of the Upper Tribunal (IAC) and the guidance set out therein shows that there remains a risk of detention on return to Sri Lanka and, consequently, torture and death, for individuals who have been involved with pro-Tamil separatist activities.

¹³ Nishakaran 1, §3.

¹⁴ Nishakaran 2, §6.

¹⁵ DH1- DH2.

¹⁶ DH9.

¹⁷ DH3 – DH8.

Journalists who have reported on certain issues are at particular risk. The guidance is not, however, authority for the assertion that there is such a risk for any journalist in Sri Lanka. The position appears to be more nuanced, with the threat directed at those in favour of separatism or critical of the government's record. I accept that the article from www.jdslanka.org suggests that the position is more precarious for journalism of any description. However, there is no context for the article, in particular whether [jdslanka.org](http://www.jdslanka.org) itself has any particular political leaning. The Upper Tribunal (IAC) decision is based on a range of evidence and the conclusions reached in that decision carry greater weight than the article from www.jdslanka.org. I note that the United Nations High Commissioner's report expresses concern for the deteriorating human rights situation and that Reporters without Borders highlight what is, in their telling, a paranoid reaction on the part of the GoSL. However, I do not consider that this evidence takes the proprietor any further. I accept that journalists who have criticised the Sri Lankan government, particularly its human rights record, or who are associated with publications critical of the government, are likely to be targeted by the Sri Lankan authorities. I also accept that the Sri Lankan government's hostility to those reporting on such issues is beyond the proprietor's control and that it would be unreasonable to put journalists in the position of serious harm.

25. However, the issue here is not, or is only tangentially, whether journalists can operate in Sri Lanka. The question with respect to the use of the trade mark is whether it could reasonably have been used in the UK. This is a country in which there is still freedom of the press and there is no question of detention, still less physical harm, from reporting truthfully on events here and around the world. The proprietor suggests that the arrest in London of a man thought to be connected to the Sri Lankan state means that the threat of harm extends to those in the UK. I reject that submission. The murder was committed many years earlier in a different country. The fact that the suspect was in the UK at the time of his arrest does not show that any journalist operating in the UK was targeted during the periods of non-use, still less that there was a threat sufficient to justify the non-use of the trade mark.

26. The applicant has noted that there is a television station which operates under the name “IBC Tamil” and argues that if a television station can operate freely in the UK, then a radio station ought to be able to do so too. Mr Nishakaran’s response is that the radio station has a focus on human rights abuses and war crimes in Sri Lanka and that it is imperative that there be reporters on the ground. There are plainly difficulties in overtly obtaining information about such abuses from individuals who remain in Sri Lanka but journalists are generally enterprising people and there is nothing to stop reporters based in the UK from using sources outside Sri Lanka (such as refugees or others in the diaspora). While sourcing information from inside Sri Lanka may be harder, there is nothing to indicate that it is any more difficult to obtain information from inside Sri Lanka than it is to extract intelligence from any other authoritarian regime and the fact remains that there is no prohibition on reporting such stories in the UK. It would be entirely possible for the proprietor to report on human rights violations in Sri Lanka via a radio station in the UK. There is no evidence that there are restrictions on that subject matter, other than those which apply to any reporting (e.g. that it be accurate). In short, I do not accept that the fact that journalists critical of the Sri Lankan government are regarded with hostility in Sri Lanka means that the proprietor cannot reasonably have been expected to use the mark in the UK. I would add that, although Mr Nishakaran has suggested that there are preparations for starting the use of the mark, no details of any such plans are provided in either narrative or documentary form, with the result that the assertion is inadequately substantiated.

27. The above discussion has followed the parties’ submissions and evidence about the issues involved. One would be forgiven for thinking that the specification at issue is for broadcasting services. It is not. The trade mark is registered for radio and television advertising services. I cannot see any good reason why difficulties reporting human rights abuses or criticising the Sri Lankan government would have any relevance to the ability of the proprietor to provide advertising services in the UK. Even if a third party wished to use the proprietor’s registered services to create or disseminate advertising material highlighting the shortcomings of the Sri Lankan government, there is no reason why the presence of journalists in Sri Lanka would be of any particular importance, let alone

critical, to the performance of an advertising service. There are no proper reasons for non-use.

28. For completeness, in spite of the admitted non-use, there is some evidence that the contested mark was used from 1997, and that “IBC Tamil Radio” began 24/7 broadcasts in 2010 and was re-launched in 2015. As of October 2019 it is said to be the most popular radio station among the Tamil diaspora; however, it is not clear how many listeners it may have had in the UK. There is also no evidence of revenue arising from the registered services or of any advertising directed at a UK audience during the relevant periods. The screen prints in the applicant’s evidence show “Listen Live Radio” at the top of one web page and there is mention of “Advertising, Sponsorship & Promotions” at “IBC Tamil”.¹⁸ However, this evidence is dated January 2022 and is too late to be taken into account. Irrespective of whether the mark mentioned in the evidence is an acceptable variant, the evidence is far too thin to show genuine use. There has been no genuine use and there are no proper reasons for non-use.

Conclusion

29. UK trade mark number 3138367 will be revoked with effect from 26 March 2021.

Costs

30. The applicant has been successful and is entitled to an award of costs. I see no reason to depart from the scale contained in Tribunal Practice Notice 2/2016. I award costs to the applicant as follows:

Official fees:	£200
Filing the revocation and considering the counterstatement:	£400
Preparing evidence and considering the other party’s evidence:	£800

¹⁸ DH2.

Written submissions: £400

Total: £1,800

31. I order Para London Limited to pay Global Media Group Services Limited the sum of **£1,800**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of July 2022

**Heather Harrison
For the Registrar
The Comptroller General**