

O/673/22

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION UK 3495735

IN THE NAME OF

MAURICE JOSEPH

FOR THE TRADE MARK

1ALPHA

IN CLASSES 7, 9, 28, & 42

AND

**THE APPLICATION FOR DECLARATION OF INVALIDITY THERETO
UNDER NUMBER 504051**

BY

**INALFA ROOF
SYSTEMS GROUP B.V.**

Background and Pleadings

1. On 1 June 2020, Maurice Joseph (“the Proprietor”) filed an application for the trade mark 1ALPHA, which completed its registration process on 19 March 2021, in respect of the following goods and services:

Class 7: Aeroplane motors; Robots for industrial use; Robotic lawnmowers; Robotic mechanisms used in agriculture; Industrial robots; Transportation robots. None of the aforesaid relating to artificial intelligence.

Class 9: Apparatus and instruments controlling electricity; Apparatus and instruments for accumulating and storing electricity; Apparatus and instruments for controlling the distribution of electricity; Apparatus and instruments for controlling the use of electricity; Apparatus and instruments for regulating electricity; Apparatus and instruments for switching electricity; Apparatus and instruments for transforming electricity; Apparatus and instruments for transforming the use of electricity; Nautical apparatus and instruments; Data capture apparatus; Data communications apparatus; Data loggers and recorders; Data networks; Data processing programs; Data processing systems; Computer firmware; Computer games; Computer hardware; Computer interfaces; Computer networks; Computer software; Peripheral devices (Computer -); Downloadable application software; Downloadable digital photos; Downloadable educational media; Downloadable electronic brochures; Downloadable electronic maps; Downloadable electronic publications; Downloadable media; Downloadable videocasts; Vehicle tracking systems; Vehicles (Navigation apparatus for -) [on-board computers]; Laboratory robots; Security surveillance robots; Teaching robots; Telepresence robots. none of the aforesaid relating to artificial intelligence.

Class 28: Radio-controlled toy robots. none of the aforesaid relating to artificial intelligence.

Class 42: Scientific and technological design; Scientific and technological services; Scientific research and analysis; Scientific research and development; Surveying; Engineering services relating to robotics; Installation and customisation of computer applications software; Installation, maintenance and repair of computer software; Industrial analysis and research services; Design and development of computer hardware and software; Consultancy in the design and development of computer hardware; Consultancy relating to the design and development of computer software programs; Providing information about the design and development of computer software, systems and networks; Computer consultancy and advisory services; Computer security consultancy; Design services. none of the aforesaid relating to artificial intelligence.

2. On 10 May 2021, Inalfa Roof Systems Group B.V. (“the Applicant”), initiated invalidation proceedings against the Proprietor’s registration, under section 47(2) of the Trade Marks Act 1994 (“the Act”), based upon section 5(2)(b) of the Act.

3. The Applicant relies upon two International Registrations (“IRs”), the relevant details of which are as follows:

No. 672881, which has an international registration date of 4 April 1997 and a UK designation date of 7 April 1998, for the following goods:

INALFA

IR 672881 – (“the first earlier mark”)

Priority date: 14 November 1996 (Benelux)

International registration date: 4 April 1997

Designation date: 7 April 1998

Class 6: Base metals and alloys thereof; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electrical metallic cables and wires; ironmongery and small items of metal hardware; metal pipes; safes; goods of common metals not included in other classes; ores.

Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; air conditioning apparatus for automobiles.

Class 12: Manually or electrically operated windows and sunroofs, for automobiles.



IR 699829 - ("the second earlier mark")

Priority date: 29 May 1998 (Benelux)

International registration and Designation date: 11 September 1998

Date of protection of the international registration in UK: 4 February 2000

Class 12: Manually or electrically operated windows and sunroofs, for automobiles.

4. The Applicant relies on all its goods for which the earlier marks are registered, claiming that there is a likelihood of confusion because the respective trade marks are similar and the contested mark is registered for goods and services identical to, or similar with those for which the earlier marks are registered. The Applicant therefore pleads that the registration of the contested mark was contrary to section 5(2)(b) of the Act, and should now be declared invalid in accordance with section 47(2) of the Act.

5. The Proprietor filed a defence and counterstatement denying that its trade mark offends against section 5(2)(b) on the basis that the competing marks do “not share a common word or item” and/or that there is no likelihood of confusion.

6. The trade marks relied upon by the Applicant are earlier marks, in accordance with section 6 of the Act. As both achieved registration more than five years prior to the date on which the application for invalidation was filed, they are both subject to the proof of use provisions set out in sections 47(2A) - (2E) of the Act.

7. The Applicant has formally declared that it has made genuine use of its trade marks for all of the goods under its respective registrations. Nevertheless, the Proprietor has put the Applicant to proof of use of its earlier marks. The periods for which evidence of use of the earlier marks is required are:

(i) 2 June 2015 to 1 June 2020 (five years ending on the date the application to register the contested marks was filed), and

(ii) 11 May 2016 to 10 May 2021 (five years ending on the date the application to invalidate the marks was filed).

8. In these proceedings, the Applicant is represented by Novagraaf UK; the Proprietor is a Litigant in Person. Both parties filed evidence and neither party requested a hearing, nor filed submissions in lieu of a hearing. This decision is therefore taken following careful consideration of the papers before me.

Evidence

9. The Applicant filed evidence in chief in the form of the witness statement of Rob Rikkert dated 4 January 2022 (with Exhibits RR1 – RR6). Mr Rikkert is the Director of Intellectual Property at Inalfa Roof Systems, a position he has held for 13 years, with a total of 23 years of service at said Applicant company; he is duly authorised to make a statement on the Applicant’s behalf.

10. The Proprietor's evidence consists of a witness statement in the name of Mr Maurice Joseph, dated 4 March 2022, with exhibits MJ1 – MJ4). Mr Joseph is the registered proprietor of the contested mark.

DECISION

11. Section 47 of the Act sets out the provisions which apply in these proceedings, namely:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) 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

(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.

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

12. 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.”

13. Consequently, the onus is upon the Applicant to prove that genuine use of its registered trade marks was made in the relevant periods.

14. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to 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 Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.¹

¹ Although the UK has left the EU, section 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

15. 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].”

16. In considering the Applicant’s evidence 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:

“22. The burden lies on the 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 skeptical 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.”

17. The comments of Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, are also relevant. He stated as follows:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in

order to satisfy a decision-making body about that of which that body has to be satisfied.

“22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

Proof of use

18. Mr Rikkert’s evidence is that:

“For a significant number of years, the “INALFA” brand has been used in the UK, as earlier (sic) as 1995, in relation to the design, engineering and production of automotive/electrical windows and sun roofs.

“The Cancellation Applicant has made use of the trade marks upon which the Cancellation Action has been based in the UK since 1995 and 1996 respectively in relation to ‘Manually or electrically operated windows and sunroofs, for automobiles’.”

The annual turnover figures for INALFA in the UK –“Inalfa Roof Systems Group B.V.” are as follows:

INALFA Marks	
Year (Calendar)	Turnover for INALFA (in EURO)
2015	17,200,000
2016	48,400,000
2017	55,100,000
2018	44,000,000
2019	41,600,000
2020	28,000,000

Overview of the evidence

Exhibit RR1 consists of: a photograph of a building (a Green Field Plant) in Staffordshire, UK, bearing the logo “inalfa”, which was opened in 1995; a global organisational chart for Inalfa; excerpts from a Memorandum of Association for Inalfa UK Limited; reviews published in *Manufacturer* magazine, one of which is dated February 2004”, however, there is no information on distribution or readership, for example; an Inalfa brochure “for public use in 1997”, presented in the absence of information as to where and/or how many were distributed; and articles from an internal newspaper, which does not assist the Applicant as such use was not visible to the public.

Exhibit RR2 shows the turnover figures, as reproduced above. The turnover figures do not disclose what proportion is attributable to sales of the various goods relied upon; and for reasons set out below, I could not rely upon the samples of invoices to decidedly corroborate the turnover figures. There also was no evidence on advertising expenditure to assist me.

Exhibit RR3 comprises 30 invoices covering the period April 2015 to February 2020. All the invoices are made out to Jaguar Land Rover Ltd, PO Box 6186, Coventry, UK (recording two different delivery addresses in the UK), from Venray, Inalfa Roof Systems BV, The Netherlands. The invoices record, amongst

other things, the quantity of goods and prices (in Euros); however, there is no information on the invoices identifying what goods were traded, possibly save and except for two invoices: (1) dated 7 February 2020 (invoice number 200/10146339), which records one of the descriptions as “Assy cust JLR X761-FIXED LIGHT”, a quantity of 14, 0000 pcs at the price of 301, 35 (per unit); and (2) invoice number 200/10146863, dated 13 February 2020, for 7,000 pcs, “Assy cust JLR L560-FIXED LIGHT” at a price of 304,03 (per unit) and a further 7,000 pcs, “Assy cust JLR X761-FIXED LIGHT” at the price of 301,35 (per unit). Although I accept that the description might not be a reference to a product, it is the only description to which a match can be made to the Applicant’s goods, namely: class 11 (under the first earlier mark), which covers “*Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes*”. The invoices include other descriptions, which could not be matched against any of the Applicant’s protected specifications, for example:

Jaguar Land Rover Ltd
 PO Box 6186
 Land Rover Purchase Accounts
 CV3 9HQ WHITLEY, COVENTRY
 United Kingdom

Invoice Number : 200/10121402
 Our Supplier Number : D48PD
 Our VAT-Nr. : NL003626477B01
 Invoice Date : 20-Feb-2019
 Sold-To : C0070000
 Ship-To :
 Customer order :
 Customer VAT-Nr. : GB927153228
 Terms of Payment : 60 Days Nett
 Terms of Delivery : FCA

Pos	Part Nr	Cust. Part Nr.	Description	Quantity	Price	Amount In EUR
000000098 D						
Shipment	1	10035052F	J8A2 50054AJOLKP : 21136740 / 000000042 D	1		
			Assy customer COUNTRY OF ORIGIN: The Netherlands JLR L560 - FIXED	14,0000 pcs	301,31	4.218,38
Shipment	2	10027590K	JK83 50054AE8PVJ : 21136740 / 000000098 D	4		
			Assy customer COUNTRY OF ORIGIN: The Netherlands JLR X761 - FIXED	28,0000 pcs	298,63	8.361,75
Shipment	3	10031501F	J8A2 502B98AK8PVJ : 21136740 / 000000896 D	6		
			Assy customer COUNTRY OF ORIGIN: The Netherlands JLR L560 - TLES	182,0000 pcs	458,24	83.399,68

Goods	Costs	Service	Others	Exchange Rate	Net Amount	Total Tax Amount	Total
95.979,81	0,00	0,00	0,00	1,000000	95.979,81	0,00	95.979,81
						SBI Amount:	95.979,66
Packing:	Net Weight:		7274,6940	Gross Weight:		14698,6940	
Delivery to: 88-98 Wingfoot Way Tyre Fort B24 9HY BIRMINGHAM United Kingdom				Shipping date : 11-Feb-2019 Transported by : DHL 0D MB/L Number : 11080279 Intrastat code :			

The exporter of the products covered by this document (Exporter Reference No: NLREX1272) declares that, except where otherwise clearly indicated, these products are of EU preferential origin. Venray, Inalfa Roof Systems BV
 For any questions please contact our Finance Department: finance@inalfa.com

Jaguar Land Rover Ltd
 PO Box 6186
 Land Rover Purchase Accounts
 CV3 9HQ WHITLEY, COVENTRY
 United Kingdom

Invoice Number : 200/10146863
 Our Supplier Number : D48PD
 Our VAT-Nr. : NL003626477B01
 Invoice Date : 13-Feb-2020
 Sold-To : C0070000
 Ship-To :
 Customer order :
 Customer VAT-Nr. : GB927153228
 Terms of Payment : 60 Days Nett
 Terms of Delivery : FCA

SIMMONS, MARK (M.R.)											
Pos	Part Nr	Cust. Part Nr.	Description	Quantity	Price	Amount In EUR					
Shipment	1	J8A2 50054AK0LKP SIMMONS, MARK (M.R.)	21312531 / 1 Assy cust JLR L560-FIXED LIGHT	7,0000 pcs	304,03	2.128,21					
Shipment	2	J8A2 50054AK8PVJ SIMMONS, MARK (M.R.)	21312531 / 7 Assy cust JLR L560 - FIXED JET	7,0000 pcs	304,03	2.128,21					
Shipment	3	JK83 50054AF0LKP SIMMONS, MARK (M.R.)	21312531 / 4 Assy cust JLR X761-FIXED LIGHT	7,0000 pcs	301,35	2.109,45					
Shipment	4	JK83 50054AF8PVJ SIMMONS, MARK (M.R.)	21312531 / 9 Assy cust JLR X761 - FIXED JET	42,0000 pcs	301,35	12.656,70					
Shipment	5	J8A2 502B98AL0LKP SIMMONS, MARK (M.R.)	21312531 / 8 Assy customer JLR L560 - TLIES	105,0000 pcs	449,97	47.246,85					
Goods					Costs	Service	Others	Exchange Rate	Net Amount	Total Tax Amount	Total
66.269,42					0,00	0,00	0,00	1,000000	66.269,42	0,00	66.269,42
					SBI Amount:		66.269,63				
Packing:		Net Weight:		35322,6790	Gross Weight:		70586,6790				
Delivery to: 80-98 Wingfoot Way Tyre Fort B24 9HY BIRMINGHAM United Kingdom				Shipping date : 31-Jan-2020 Transported by : DHL 0D MB/L Number : 11244251 Intrastat code :							

The exporter of the products covered by this document (Exporter Reference No: NLREX1272) declares that, except where otherwise clearly indicated, these products are of EU preferential origin. Venray, Inalfa Roof Systems BV
 For any questions please contact our Finance Department: finance@inalfa.com

Exhibit RR4 “shows a range of examples of the marks ... from the car sale website Autotrader, car reviews where the goods are included, examples of the mark in use on product labels and some further invoice examples.” This sample of invoices presents the same problems as those identified in the earlier sample at Exhibit RR3. The Autotrader listings are of cars with sunroofs, with quotations for the complete, finished product, that is, the car, and not for the individual/distinct sunroofs. The Autotrader webpages are not date-stamped, though I note that the 5 listings show car registrations for 2015, 2016 and 2017; the top left of each page, at the side of the Autotrader listing, displays information relating to “Inalfa project” and “Inalfa item number”. This does not appear to have been part of the Autotrader listing. At the bottom right of each listing is found an image of a variant form of the second earlier mark,² which also does not appear to be part of the published listing, but one superimposed on to the pages, as it consistently appears on all the pages of this exhibit, including a further sample of invoices. The invoices are of the same format as those of Exhibit RR3, which do not include the logo (in that earlier exhibit). Exhibit RR4 also includes samples

² I address the variant form of the mark later.

of Inalfa labels affixed to unidentified/unidentifiable components, one of which is reproduced below. Looking at that example, the Inalfa mark appears alongside other trade marks: Jaguar, Land Rover and ASSY PCA (for example). From this is it reasonable to infer that an Inalfa component has been used in a product; however, it is unclear as to what the component or product might be (despite the Applicant's narrative).

Use of the name Inalfa on Products (sunroofs for vehicles) which is visible to the public when handling the product outside the boxes in the UK.



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3 Title / date



Invoices 2020

Jaguar Land Rover Ltd.
Jaguar Purchase Accounts
CPS 08P WHITLEY, COVENTRY
United Kingdom

Invoice Number : 200/10157701
Our Supplier Number : 112860
Our VAT No. : NL09626477801
Invoice Date : 30-Sep-2020
Sold to : C0392000
Ship to :
Customer Order :
Customer Ref. No. : GB927153228
Terms of Payment : 60 Days Nett
Terms of Delivery : Ex-Works



Pos Part Nr	Cust. Part Nr.	Description	Quantity	Price	Amount In EUR
110024993K	GX53 50054AB8PW7	1 Assy customer JLR-XL52	21,0000 pcs	307,21	6.451,45

Goods	Costs	Service	Others	Exchange Rate	Net Amount	Total Tax Amount	Total
6.451,45	0,00	0,00	0,00	1,000000	6.451,45	0,00	6.451,45

Packing: Net Weight: 1177,0420 Gross Weight: 3220,1620
 Delivery to: Chester Road, Altrincham, B15 7BA CASTLE BROMWICH, United Kingdom
 Shipping date : 28-Aug-2020
 Transported by : DHL 00
 W/F Number : 11286701
 Incoterms code :

The exporter of the products covered by this document (Importer Reference No: NL5EX1771) declares that, except where otherwise clearly indicated, these products are of EU preferential origin. Venray, Inalfa Roof Systems BV
 For any questions please contact our Finance Department: finance@inalfa.com

9 Title / date

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Exhibit RR5 consists of “extracts from the [Applicant’s] website and Twitter social media showing the marks in use on their website and Twitter account and references, ‘Manually or electrically operated windows and sunroofs, for automobiles’ products available for purchase in the UK within the relevant period.” There are 5 samples of the relevant webpage, with a form of the second earlier mark displayed at the top left of each page; these are dated: 22 October 2017; 8 July 2018; 7 August 2018; 25 August 2018 and 13 July 2019. Each page records “230 captures” between 2 June 2004 and 8 December 2021. There is no information on what products these pages relate to, nor whether the site specifically targeted the UK market; its URL is: [https //www.inalfa-root-systems.com/](https://www.inalfa-root-systems.com/) (and from the global organisational chart exhibited at RR1, it is evident that the Applicant operates in other English-speaking markets).

Similarly, the evidence relating to the Applicant’s *Twitter* account does not delineate what engagement pertains to its UK market; and in any event, the overall engagement is negligible. For example, the *Twitter* page of *InalfaRoofSystems* dated 10 July 2015, records that 187 tweets were issued (from the account at said date); of the tweet displayed, there were no comments,

retweets, likes or shares. The tweet with the most engagement is one dated 20 April 2020, which garnered 2 retweets, and 3 likes.

19. Case law provides that “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”, although “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’”.³

20. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act - which parallels the variant use provisions under section 6A(4) - as follows:

“33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

21. Although this case was decided before the judgment of the Court of Justice of the European Union (“CJEU”) in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of

³ See ruling of CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 §§ 31 - 35.

the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.



23. This composite mark consists of the word INALFA, and a stylised orbit and sphere in black/white. The word INALFA plays a more dominant role in the mark, with the stylised orbit and sphere playing a lesser role. The variant form of this mark shows an astronomic orbit with the spherical representation of planet earth in colour, against a blue background in one variant, and in black and white in another. Therefore, the second earlier mark is reproduced in its entirety in both variants, with the addition of the words “roof systems” beneath the word INALFA. These forms of use are acceptable variants of the registered marks.

24. Considering the scale of the Applicant’s business in the UK, as per its unchallenged narrative evidence, and the evidence of relatively consistent use of the earlier marks on its invoices, I am satisfied that the earlier marks were used during the relevant periods to create or maintain a market for the Applicant’s core goods. I therefore accept that the applicant has shown genuine use of both earlier marks.

22. Having concluded that the Applicant has made genuine use of its trade marks, I must now decide what constitutes a fair specification. In this regard, I am guided by the following cases. 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.”

23. 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.”

24. It is clear that the evidence does not support the claim for use in relation to all of the goods relied upon by the Applicant. There is stark emphasis in the narrative evidence (in particular) of use in relation to “*Manually or electrically operated windows and sunroofs, for automobiles*” (paragraphs 9, 10, 11, 12, 13, 15 and 16 of Mr Rikkert’s witness statement) as opposed to any of the other protected specifications. I have already found that there is some (albeit tenuous) evidence of use with respect to “Apparatus for lighting...” in class 11. In view of the relevant identifiable items in the evidence, in the context of the above guidance (on identifying and defining the particular categories of goods they should realistically be taken to exemplify from the average consumer’s perspective, for example), I am satisfied that the following represent fair specifications: “*Apparatus for lighting*” (in class 11, under the first earlier mark); and “*Manually or electrically operated windows and sunroofs, for automobiles.*” (in class 12, of both earlier marks). I will therefore conduct the comparison with these conclusions in mind.

Relevant case law in relation to likelihood of confusion – section 5(2)(b)

25. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- a. The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b. the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- c. the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d. the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e. nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f. however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g. a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

- h. there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i. mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- j. the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- k. if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

25. The goods and services to be compared are as follows:

The Applicant's Goods	The Proprietor's Goods and Services
<p>Class 11 Apparatus for lighting, ...</p> <p>Class 12 Manually or electrically operated windows and sunroofs, for automobiles.</p>	<p>Class 7 Aeroplane motors; Robots for industrial use; Robotic lawnmowers; Robotic mechanisms used in agriculture; Industrial robots; Transportation robots. None of the aforesaid relating to artificial intelligence.</p> <p>Class 9 Apparatus and instruments controlling electricity; Apparatus and instruments for accumulating and storing electricity; Apparatus and instruments for</p>

	<p>controlling the distribution of electricity; Apparatus and instruments for controlling the use of electricity; Apparatus and instruments for regulating electricity; Apparatus and instruments for switching electricity; Apparatus and instruments for transforming electricity; Apparatus and instruments for transforming the use of electricity; Nautical apparatus and instruments; Data capture apparatus; Data communications apparatus; Data loggers and recorders; Data networks; Data processing programs; Data processing systems; Computer firmware; Computer games; Computer hardware; Computer interfaces; Computer networks; Computer software; Peripheral devices (Computer -);Downloadable application software; Downloadable digital photos; Downloadable educational media; Downloadable electronic brochures; Downloadable electronic maps; Downloadable electronic publications; Downloadable media; Downloadable videocasts; Vehicle tracking systems; Vehicles (Navigation apparatus for -) [on-board computers];Laboratory robots; Security surveillance robots; Teaching robots; Telepresence robots. none of the aforesaid relating to artificial intelligence.</p>
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	<p>Class 28</p> <p>Radio-controlled toy robots. none of the aforesaid relating to artificial intelligence.</p> <p>Class 42</p> <p>Scientific and technological design; Scientific and technological services; Scientific research and analysis; Scientific research and development; Surveying; Engineering services relating to robotics; Installation and customisation of computer applications software; Installation, maintenance and repair of computer software; Industrial analysis and research services; Design and development of computer hardware and software; Consultancy in the design and development of computer hardware; Consultancy relating to the design and development of computer software programs; Providing information about the design and development of computer software, systems and networks; Computer consultancy and advisory services; Computer security consultancy; Design services. none of the aforesaid relating to artificial intelligence.</p>
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27. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

28. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

29. In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks)* (IP

TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

30. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

31. The Applicant states, following its recitation of the *Treat* principles, that: "The objected goods and services in Classes 07, 09, 28 and 42 of the Mark at issue are therefore highly similar to those goods covered by the Earlier Trade Marks as all goods and services for both parties relate to electronic and computer goods or services."

32. The Proprietor contends that:

- (i) "There is a clear distinction between the goods and services offered by the proprietor and cancellation applicant's Trademarks."
- (ii) The Applicant "work[s] exclusively for car manufacturers and do not distribute parts directly to third parties like car dealers or individuals." In support of this contention, Mr Joseph exhibits a screenshot of the Applicant's website, where the following statement is made: "Inalfa Roof Systems does not supply aftermarket parts or roofs directly to the consumer. We work exclusively for car

manufacturers. We do not distribute parts directly to third parties. Like car dealers or individuals.” It is important to make clear, on this point, that the Applicant’s protected specifications are not limited in the way the Proprietor suggests, and I must consider all goods that could be covered by the terms in the Applicant’s specifications; therefore the Proprietor’s submission regarding aftermarket goods is of no relevance to this consideration.

(iii) “The classes, goods and services do not overlap, and have different; A: uses, B: users, C: physical nature, D: trade channels.”

33. The Applicant submits that the uses and users of the respective goods and services overlap, in that they “relate to electronic and computer goods or services” (Statement of Grounds, § 13). However, this is not sufficient to find similarity on its own.

34. The high point of similarity is the class 9 electronic control apparatus/instruments, which will be necessary to operate the Applicant’s sunroof goods, leading to a possibility of a very low degree of complementarity. However, the respective goods are not in competition; the users and uses will be different, as well as the nature and trade channels. Therefore, I find that the earlier goods and the contested goods and services are dissimilar.

34. As some degree of similarity between the respective specifications is necessary to engage the test for likelihood of confusion, the cancellation application must fail in respect of all goods and services in the Proprietor’s specification since I have found that they are all dissimilar to the Applicant’s goods.

Outcome

35. The application for a declaration of invalidity fails.

Costs

36. The Proprietor, Maurice Joseph, has been successful and is entitled to an award of costs in his favour. He is a Litigant in Person and has accordingly completed the Registry's Cost Pro Forma, as follows:

Notice of Defence	8 hours
Considering forms filed by the other party	8 hours
Preparing a witness statement	4 hours
Considering the other side's witness statement	6 hours
Preparing evidence	8 hours
Considering the other side's evidence	12 hours
Seeking legal advice	4 hours
Total	50 hours

37. The time spent on preparing the defence appears to be inconsistent with the fact that the defence consists of a standard, three-page Form TM8, completed with minimal information, and a four-page Counterstatement with little essential information. The 8 hours claimed for considering forms filed by the other party is also considered to be excessive: the relevant forms are not particularly demanding and this consideration has been factored into the process of preparing the defence. The time claimed for preparing evidence is entirely unreasonable, in light of the fact that 4 hours have been claimed for preparing a witness statement, which consisted of the only properly constituted evidence (inclusive of a one-page witness statement and 4 screenshots of websites) filed by the Proprietor. Similarly, the time claimed for considering the other side's evidence is unjustified, particularly given the 6-hour claim for considering the Applicant's witness statement, which was the only evidence (accompanied by exhibits) filed by the Applicant. It is not clear to me why the Proprietor, who is self-represented, has claimed for seeking legal advice. I decline to award this part of the claim. The award for costs is as follows:

Notice of Defence	4 hours
Preparing a witness statement	4 hours
Considering the other side's witness statement	6 hours
Total	14 hours

38. Taking an overall view, I consider that a total of 14 hours reasonably reflects the recoverable time spent on defending the application. The Litigants in Person (Costs and Expenses) Act 1975 (as amended), provides that the amount which may be allowed to a litigant in person is set at the rate of £19 per hour. This therefore produces a total recoverable sum of **£266**.

39. Accordingly, I hereby order Inalfa Roof Systems Group B.V. to pay to Maurice Joseph the sum of **£266**. This sum is to be paid within twenty-one days 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 11th day of August 2022

**Denzil Johnson
For the Registrar**