

**BL O/0456/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003674674**

**BY MIE CHILDRENSWEAR LIMITED**

**TO REGISTER THE TRADE MARK:**

**mie**

**IN CLASSES 16, 25, 28, 38**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 600002328**

**BY JAMES EDWARD CHARLES WARREN**

## **BACKGROUND AND PLEADINGS**

1. On 28 July 2021, MIE CHILDRENSWEAR LIMITED (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 21 January 2022 and registration is sought for the following goods and services:

Class 16 Printed books.

Class 25 Children’s clothing; children’s footwear.

Class 28 Toys, games, and playthings.

Class 38 Communication by online blogs.

2. On 19 April 2022, the application was partially opposed by James Edward Charles Warren (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against the applicant’s class 25 goods; children’s clothing and children’s footwear.

3. Under section 5(2)(b), the opponent relies upon the following trade mark:

# **Mie**

UK registration no. UK00002344381

Filing date 26 September 2003; Registration date 20 February 2004.

Relying upon all of the goods for which the earlier mark is registered, namely:

Class 25 All types of clothing, footwear and headgear.

4. The opponent claims that its mark is “highly distinctive”, “well-established” and has been used continually for its registered class 25 goods. The opponent also claims that the parties’ marks are “confusingly similar”.

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

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

7. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. This would apply to evidence, which is filed later in the proceedings, and therefore wouldn't include evidence of use which is filed alongside the Notice of Opposition (Form TM7). No leave was sought to file any additional evidence in respect of these proceedings.

8. Rule 62 (5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

9. The opponent is unrepresented, and the applicant is represented by Briffa. A hearing was neither requested nor considered necessary, however, a CMC did take place before me 2 March 2023. I note that this was regarding a procedural issue which does not impact the substantive issues, nor bear any outcome, on these proceedings. Therefore, it will not be addressed within this decision. I note that the opponent filed evidence within its Form TM7 and submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

10. 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 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.

## EVIDENCE

11. The opponent's evidence consists of 9 exhibits, and the following figures detailing the number of units sold for its for class 25 goods from 2005 to 2021:

Year	Number of Sales
2005	55
2006	256
2007	537
2008	460
2009	204
2010	391
2011	473
2012	602
2013	1,376
2014	1,591
2015	1,073
2016	473
2017	574
2018	679
2019	603
2020	743
2021	802

12. I note that exhibits 1 to 7 consists of the following undated pictures of its mark being used on clothing (specifically t-shirts):

Exhibit 1  
1/9



Exhibit 4  
4/9



Exhibite 3  
3/9



Exhibite 2  
2/9



Exhibite 6  
6/9



Exhibite 5  
5/9

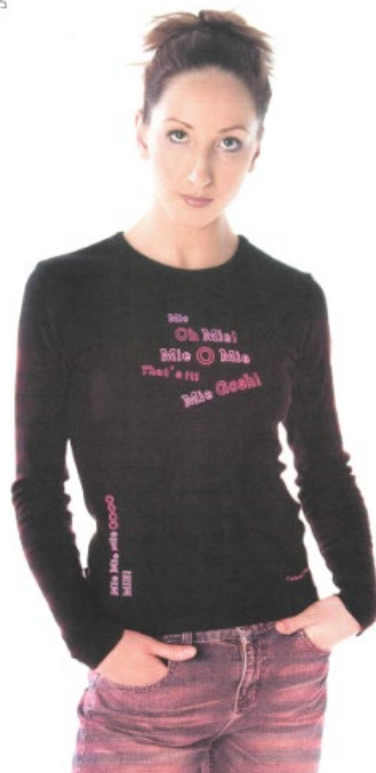


Exhibit 7

719



13. Lastly exhibits 8 and 9 are the following undated "marketing material" provided by the opponent:

Exhibit 8  
819

John and Sinead Kerr  
British Champions  
and Olympic Competitors

Mie  
adj. or interj.  
1. pronounced my  
(as in tie and pie!)  
2. stands for . . .  
Made in England  
3. typical usage in English

Clothes  
Mie  
in  
Get

This advertisement features a man and a woman. The man is wearing a red polo shirt and the woman is wearing a white long-sleeved shirt. They are both wearing jeans. The background is white with purple and red accents.

Exhibit 9  
919

Mie  
adj. or interj.  
1. pronounced my . . .  
(as in tie and pie!)  
2. stands for . . .  
Made in England  
3. typical usage in English . . .

Clothes  
Mie  
in  
Get

John Kerr  
British Champion and  
Olympic Competitor

This advertisement features a man wearing a striped shirt and jeans. He is looking down and adjusting his shirt. The background is white with purple and red accents.

## **Proof of use**

14. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark ... or international trade mark (UK) ... which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

[...]

15. Section 6A of the Act states:

“(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), (aa) 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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (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.

(5)-(5A) [Repealed]

(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.”

16. The opponent’s mark qualifies as an earlier mark in accordance with section 6(1)(a) and 6(1)(ab) as its filing date is earlier than the filing date of the applicant’s mark.

17. The opponent’s mark completed its registration process more than five years before the filing date of the mark in issue; therefore it is subject to proof of use pursuant to section 6A of the Act.

18. 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.”

19. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) 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 Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR

19223, 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].”

20. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>1</sup>

21. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

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

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

23. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

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<sup>1</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

“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.”

24. I must assess whether, and to what extent, the above evidence supports the opponent’s statement that it has made genuine use of its mark in relation to the class

25 goods it relies upon. The relevant period for this purpose is the five years ending on the filing date of the applicant's mark, i.e. 29 July 2016 to 28 July 2021.

### **Conclusions from the evidence on genuine use**

25. As far as the form of the mark is concerned, I am satisfied that the mark has been used as registered; with the word MIE appearing on the opponent's t-shirts. For the sake of completeness, I note that the word MIE also appears in different stylised typefaces. However, the stylisation is very minimal and does not alter the distinctive character of the mark.<sup>2</sup> Therefore it is acceptable variant use.

26. The case law summarised in the passage from *Walton* quoted above makes it clear that real commercial exploitation of the trade mark must be shown. Even in a case where the use is not sham, i.e. it is not use engineered solely to preserve the trade mark registration, the use must be more than trivial if it is to be considered genuine. An example of this can be seen in *Memory Opticians Ltd's Application*, BL O/528/15, where the Appointed Person, Professor Ruth Annand, upheld the decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local, from 3 branches of an optician. There was no advertising of the goods under the mark, and the evidence indicated that they were only displayed in-store on occasion. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain a market under the mark. Consequently, it was not genuine use.

27. Turning to the present case, I note that in its submissions, the opponent states that "if the Form TM7 had stipulated the pictures had to be dated, then dated pictures would have been provided". The burden is on the opponent to prove that it has used its mark within the relevant period. Therefore, it was the opponent's responsibility to provide proof that the mark was used between 29 July 2016 to 28 July 2021. It is not the

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<sup>2</sup> *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19

responsibility of the Registry to stipulate that the evidence must be dated within this period.

28. I also note that the opponent has not provided any information alongside the undated photos of its goods and brochures. I have not been provided with any explanation as to the distribution of the brochure, including the number of people who received it. Nor have I been provided with any evidence of how the customers purchased the goods.

29. Where proof of use is required, it is typical to see evidence such as the number of units sold during the relevant period. Albeit the opponent has provided this, I have not been provided with total turnover figures, advertising figures or invoices showing the sale of goods to customers (whether retail or wholesale), which is plainly information which should have been available and relatively easy to provide. Consequently, I am unable to determine the geographical spread of the mark as I am unable to determine where the customers of the opponent's goods were located.

30. Furthermore, the opponent has claimed that it has used its mark in relation to "all types of clothing, footwear and headgear". However, the undated evidence only shows use of its mark on t-shirts, and the evidence of sales provided by Mr Warren is stated to be in relation to "class 25". Mr Warren has not specified which class 25 goods the sales figures relate to. There is consequently no way in determining how many units of each class 25 goods were sold, and which of those sales only relate to t-shirts. Furthermore, I also consider that the yearly figure of sales which were made during the relevant period are very low considering that the clothing market is significant, and is highly saturated, in the UK.

31. It is not necessarily fatal to the assertion of genuine use that there is no such evidence, if other material filed by the opponent is sufficient to show that there has been a real attempt to exploit the mark in the sector. However, there is no evidence of other activity in this case. Therefore, taking all of the above into account, I do not consider that there has been genuine use of the MIE mark for any of the opponent's goods.

32. The consequence of my finding on use is that UK00002344381 may not be relied upon in these proceedings. As there is no other basis for the opposition, the action must fail.

## **CONCLUSION**

33. The opposition is unsuccessful, and the application may proceed to registration.

## **COSTS**

34. Award of costs in fast track proceedings are governed by TPN 2/2015. An award of costs is not compensatory, it is contributory. In the circumstances, I award the applicant the sum of **£400** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Preparation and attendance of a CMC	£200
<b>Total</b>	<b>£400</b>

35. I therefore order James Edward Charles Warren to pay MIE CHILDRENSWEAR LIMITED the sum of £400. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 16<sup>th</sup> day of May 2023**

**L FAYTER**

**For the Registrar**