

O/0155/26

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBER 1830594

BY

BOELSZ INTERNATIONAL HOLDING BV
TO REGISTER THE FOLLOWING TRADE MARK:

VOLARE

IN CLASS 6, 9, 11, 12, 21, 25, 35 AND 39

AND

IN THE MATTER OF FAST TRACK OPPOSITION

THERE TO UNDER NUMBER 600003640

BY

MUSWELLBROOK PROPERTIES PTY LTD AS TRUSTEES FOR THE
MUSWELLBROOK PROPERTY TRUST

BACKGROUND & PLEADINGS

1. Boelsz International Holding BV (“the holder”) is the holder of the International Registration shown on the cover page of this decision (“the IR”). The IR was registered on 15 October 2024 and, with effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR claims a priority date of 8 May 2024 (“the relevant date”), and the IR was accepted and published in the Trade Marks Journal for opposition purposes on 28 February 2025.
2. On 6 June 2025, the IR was partially opposed under fast-track opposition proceedings by Muswellbrook Property Pty Ltd as Trustee for the Muswellbrook Property Trust (“the opponent”). The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and, specifically, the opponent sought to challenge the holder’s registration of the IR in relation to the following goods:

Class 9: Bicycle helmets and motorcycle helmets; ski helmets; skate helmets; safety helmets for use in sports such as skating, equestrian sports, water sports, kayaking, mountain climbing, lacrosse, American football; eye protectors, including cycling glasses; rechargeable batteries, rechargeable bicycle batteries, rechargeable batteries for vehicles; connectors and cables for connecting batteries; portable battery chargers, wall connectors (wall chargers); safety, security, protection and signalling devices; bicycle speedometers; reflective clothing for the prevention of accidents; locks (electric) for bicycles; bicycle computers; holders for mobile phones, tablets and bicycle computers; parts for the aforementioned goods insofar as included in this class.

Class 25: Clothing, headgear, footwear; cycling and sports clothing, including shirts, cycling jackets, cycling jackets, shorts and long trousers, cycling shorts with and without chamois, underwear, thermal underwear, socks, arm and leg pieces; gloves, cycling shoes, hats, helmet liners [headwear], balaclavas, scarves and headgear for sports, with the exception of safety helmets; rainwear; sportswear; bathing suits; sports shoes; headbands [clothing]; belts (straps).

3. For the purpose of its opposition, the opponent relies upon the following international registration (“the earlier mark”):



International Registration Number: WO0000001331240

4. The earlier mark was registered on 11 April 2016 and, with effect from the same date, the opponent designated the UK as a territory in which it sought to protect its mark under the terms of the Protocol of the Madrid Agreement. Protection was granted on 10 August 2017, and the earlier mark claims a priority date of 12 October 2015 (based on an Australian trade mark).
5. For the purpose of its opposition, the opponent only relies upon some of the goods for which its earlier mark is registered, namely:

Class 9: Goggles; goggles for sports; goggles for swimming; goggles for use in sports; goggles used in sports; head straps for goggles; sports goggles; swimming goggles; buoyancy clothing.

Class 25: Wetsuits for surface watersports; wetsuits for surfing; swimwear; apparel (clothing, footwear, headgear); articles of water-resistant clothing; articles of waterproof clothing; articles of weatherproof clothing; articles of windproof clothing; athletic clothing; clothing for sports; clothing for surfing; clothing for swimming; gloves (clothing); hoods (clothing); jackets (clothing); jerseys (clothing); ladies' clothing; men's clothing; pants (clothing); ready-to-wear clothing; sports clothing (other than golf gloves); thermal clothing (not specifically adapted for protection against accident or injury); thermally insulated clothing (not specifically adapted for protection against accident or injury); water-resistant clothing; waterproof clothing; weather resistant outer clothing; weatherproof clothing (not specifically adapted for protection against accident or injury); women's clothing; wristbands (clothing).

6. The opponent claims that the marks in issue, and the goods for which they are protected/registered, are “highly similar”.
7. The holder filed a counterstatement denying the claims made against it. Whilst the holder acknowledged a similarity between some of its class 9 goods and the earlier mark’s class 9 goods, the holder denied that the remaining goods in issue were similar, or that “there is any likelihood of confusion between the contested mark and the Opponent’s earlier mark”.
8. As a preliminary point, it is noted that the holder did not complete the proof of use section of the Notice of Defence and Counterstatement (the “Form TM8”) filed on 31 July 2025. However, in this instance, the opponent had already filed evidence of its use with its Notice of Opposition. It is also noted that the holder clearly challenged the evidence that had been filed by the opponent in its counterstatement filed alongside the Form TM8, the opponent was therefore on notice that proof of use was in issue in these proceedings at the time the Form TM8 was filed, and the opponent addressed the holder’s criticisms of its evidence in its submissions filed on 27 August 2025. In the light of the above, I do consider that all parties were on notice that proof of use was an issue in these proceedings, and I will proceed to consider the evidence filed by the opponent on that basis.
9. As a second preliminary point, it is also noted that, when addressing the criticism that had been made by the holder of the proof of use evidence filed, the opponent submitted the following:

“Should the Tribunal require further material, the Opponent is willing to supply product images from its current range, which would clearly illustrate the overlap and likelihood of confusion if another company were permitted to use the same brand in the same categories.”
10. It is, of course, for the opponent to establish its case in these opposition proceedings and the burden lies on the opponent, as the proprietor of the earlier

mark, to prove use of its earlier mark.¹ It would not be appropriate for the Tribunal to request further evidence from the opponent, as has been proposed in this instance. Should the opponent have wished to file further evidence in support of its claim, it could have made such a request to the Tribunal. Accordingly, I will therefore only consider the evidence that has been filed by the opponent to date and will disregard the opponent's offer to file further evidence.

REPRESENTATION

11. The opponent is represented by Interform Manufacturing Ltd.
12. The holder is represented by Lincoln IP.

EVIDENCE AND SUBMISSIONS

13. In this case, the opponent filed evidence of its use of the earlier mark in the form of two exhibits, which are discussed in further detail in paragraphs 25 to 26 below.
14. Neither party sought leave to file further evidence. No hearing was requested, and only the opponent filed written submissions in lieu of a hearing. This decision is therefore taken following a careful consideration of the papers that have been filed by the parties, which will not be summarised but will be referred to as and where appropriate during this decision.
15. 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 it 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.”

¹ *Awareness Limited v Plymouth City Council*, Case BL O/236/13 – paragraph 22

16. The effect of the above is to require parties to seek leave in order to file further evidence in fast track oppositions. Further, 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.

DECISION

17. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.
18. 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 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.
19. Given its earlier filing date, the trade mark identified in paragraph 3 qualifies as an earlier trade mark under the above provision. As the earlier mark had completed its registration process more than 5 years prior to the relevant date of the IR, it is subject to the use provisions in section 6A of the Act. Consequently, I will begin by assessing whether the earlier mark has been put to genuine use by the opponent during the relevant period.

Proof of Use

20. The relevant statutory provisions are as follows:

“6(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.”

21. Section 100 of the Act is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

22. The relevant period for assessing genuine use is the five-year period ending with the relevant date of the IR in issue, i.e. 9 May 2019 to 8 May 2024.

23. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology*

Inc v Laboratories Goemar SA [2004] ECR I-1159, 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 Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'[2008] ECR I9223, 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], Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], 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], Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 Ferrari SpA v DU [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns:

Ansul at [37]. Internal use by the proprietor does not suffice: Ansul at [37]; Verein at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: Silberquelle at [20]-[21]. But use by a non-profit making association can constitute genuine use: Verein at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18]; Centrotherm at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34]; Leno at [29]-[30], [56]; Ferrari at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72]; Leno at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32].”

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

25. As discussed above, the opponent provided evidence of its use of the earlier mark in the United Kingdom (“UK”) during the relevant period in the form of two exhibits. Having reviewed the evidence filed by the opponent, I note the following:

(i) The first exhibit contains two screenshots from webpages (neilednie.com and childspaysurf.co.uk) showing the advertisement of various swimwear and swimwear accessories for sale. Specifically, the screenshot from the childspaysurf.co.uk shows the sale of male and female wetsuits and swim caps displaying the earlier mark, or a variant form of the earlier mark. The screenshot from neilednie.com shows a pair of “VOLARE KIRRA SOCKET GOGGLES” being sold for £22. However, as has been noted by the holder in its counterstatement, this webpage is undated. It is further noted that, when challenged on this point by the holder, the opponent simply submitted that its “products are actively marketed and available online in the UK at present.” I therefore have no evidence before me that would indicate that the goods contained on the screenshot were sold during the relevant period.

(ii) The second exhibit contains just one invoice totalling £15,296.60 from Volare Sports Pty Ltd to Monkton Combe School, Bath, for the sale of a number of splash jackets and row suits. The invoice is dated 19 December 2023 and does therefore fall within the relevant period, and a variation of the earlier mark is present in the top right-hand corner of the invoice.

26. In addition to the above, the opponent confirmed in its Notice of Opposition that its approximate annual UK sales during the relevant period were £20,000. However, no breakdown of the goods that this figure relates to have been provided. I cannot therefore determine how much of this £20,000 annual sales figure relates to the specific goods that are being relied upon by the opponent for the purposes of this opposition.

27. In *Awareness Limited v Plymouth City Council*,² Mr Daniel Alexander K.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.”

28. Further, at paragraph 28 of that decision, Mr Daniel Alexander K.C stated that:

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

² Case BL O/236/13

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

29. Having fully considered all of the evidence submitted by the opponent and the subsequent submissions made by the parties, I do not consider the evidence provided to be sufficient to establish genuine use of the goods relied on by the opponent during the relevant period. This is because, for the reasons outlined above, this evidence amounts to just one sale of splash jackets and row suits during the relevant period (in 2023). Whilst annual approximate sales figures have been provided by the opponent, in the context of the sport clothing and accessories industry, which is undoubtedly a huge market, I consider the sales figures confirmed by the opponent to be very small. It is also noted that the opponent confirmed that its annual sales are approximately £20,000 and the only invoice that has been provided was for sales in 2023, and this totalled just over £15,000, which therefore indicates that over 76% of the sales for 2023 were made in one instance, to just one entity in 2023 (Monkton Combe School). Whilst I appreciate that use of the mark need not always be quantitatively significant for it to be deemed genuine,³ I am unable to reach a finding of genuine use of the mark based on the very limited evidence provided by the opponent.
30. Without further evidence relating to sales (i.e., further invoices or a breakdown of sales figures), I am unable to discern the scale, frequency, and the territorial extent of the use of the earlier mark in the UK, which are all vital factors in establishing genuine use. All of this information should have been available and relatively easy to provide, which would have allowed me to determine what and how many goods were sold by the opponent, or if its sales were geographically spread across the UK, for example.

³ Case C-40/01 Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439 – paragraph 39

31. I also bear in mind that I have not been provided with any evidence of any advertising or marketing utilising the earlier mark during the relevant period, which, again, I consider would have been easily and readily available to the opponent to provide.
32. In the light of the above, I therefore find that the evidence filed fails to show real commercial exploitation of the mark to create and maintain a share of the UK market for the given goods. I find that the evidence is insufficient to demonstrate genuine use, and therefore, the opponent is unable to rely upon International Registration Number WO0000001331240 as an earlier mark under section 5(2)(b) of the Act.

CONCLUSION

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

COSTS

34. As the holder has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the holder the sum of £250 as a contribution towards its costs.⁴ The sum is calculated as follows:

Considering the Notice of Opposition and preparing a Counterstatement £250

Total **£250**

I hereby order Muswellbrook Property Pty Ltd as Trustee for the Muswellbrook Property Trust to pay Boelsz International Holding BV the sum of £250. The above sum should 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.

⁴⁴ These costs are in line with the scale adaptations for trade mark fast-track opposition proceedings.

Dated this 26th day of February 2026

**B Hartland
For the Registrar**