BL O/0284/26

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO. 3271708

IN THE NAME OF TENSIXTWO LIMITED

IN RESPECT OF THE FOLLOWING TRADE MARK

9elms

IN CLASS 35

AND

AN APPLICATION FOR REVOCATION THEREOF

UNDER NUMBER 508061

BY NINE ELMS REAL ESTATE LTD

BACKGROUND AND PLEADINGS

1. The UK trade mark ("UKTM") shown on the front page of this decision (UKTM no: UK00003271708) ("the contested mark") stands registered in the name of Tensixtwo Limited ("the registered proprietor"). It was filed on 20 November 2017 and completed its registration process on 15 November 2019. The mark stands registered for the following services:

Class 35: Administration of loyalty and incentive schemes; Administration of loyalty programs involving discounts or incentives; Advertisement and publicity services by television, radio, mail; Advertisement for others on the Internet; Advertisement via mobile phone networks; Advertisements (Preparing of -); Advertising; Advertising and advertisement services; Advertising and marketing; Advertising and marketing consultancy; Advertising and marketing services; Advertising and marketing services provided by means of blogging; Advertising and marketing services provided by means of social media; Advertising and marketing services provided via communications channels; Advertising and promotion services; Advertising and promotion services and related consulting; Advertising and promotional services; Advertising and publicity; Advertising and publicity services; Advertising flyer distribution for others; Advertising for others; Advertising in the popular and professional press; Advertising, including on-line advertising on a computer network; Advertising, marketing and promotion services; Advertising, marketing and promotional consultancy, advisory and assistance services; Advertising, marketing and promotional services; Advertising of business web sites; Advertising of cinemas; Advertising of the goods of other vendors, enabling customers to conveniently view and compare the goods of those vendors; Advertising of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Advertising on the Internet for others; Advertising particularly services for the promotion of goods; Advertising, promotional and marketing services; Advertising services provided over the internet; Advertising services provided via the internet; Advertising services to

promote public awareness of social issues; Advertising services to promote public awareness of the benefits of shopping locally; Advertising text publication services; Advertising through all public communication means; Advertising via electronic media and specifically the internet; Advertising via the Internet; Advice and information concerning commercial business management; none of the aforesaid services in relation to real estate agency services or estate agency services, valuation services for real estate property, real estate management services or advertisement of property sales or lettings, or magazine publishing services.

2. On 18 November 2024, Nine Elms Real Estate Ltd ("the cancellation applicant") applied to revoke the contested mark in accordance with section 46(1)(a) of the Trade Marks Act 1994 ('the Act'). Revocation is sought in respect of the specification in its entirety. The period in respect of which non-use is claimed is 16 November 2019 to 15 November 2024, with an effective date of revocation of 16 November 2024.

3. The registered proprietor filed a defence and counterstatement in which the entirety of its counterstatement comprised the sentence "we oppose the application for revocation of non-use as we've used been providing services via all forms of advertising and social media activations for personal and commercial clients".

4. The registered proprietor is unrepresented. The cancellation applicant is represented by Bristows LLP. Only the registered proprietor filed evidence in these proceedings, and this will be summarised to the extent that it is considered appropriate. No hearing was requested, however the cancellation applicant filed written submissions in lieu of a hearing. This decision is taken following a careful consideration of the papers filed.

5. 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.

EVIDENCE AND SUBMISSIONS

6. The registered proprietor filed evidence in chief in the form of a witness statement of Michael Jatto, dated 23 May 2025, accompanied by exhibits MJ1-MJ19 (but not including exhibit MJ11). Mr Jatto is the Director of Ten Six Two Ltd, trading as Tensixtwo Treatment Rooms, a position he has held since 2007. I note that an earlier witness statement of Mr Jatto dated 30 April 2025 was originally filed, however, two exhibits included personal bank details and one exhibit was not paginated correctly. Following correspondence from the Registry dated 12 May 2025 regarding this, the witness statement and accompanying exhibits were subsequently re-filed. The registered proprietor confirmed that there is no exhibit MJ11. I will therefore only consider the re-filed evidence of 23 May 2025 within this decision.

7. The cancellation applicant filed written submissions in lieu of a hearing dated 21 August 2025.

8. I have given due consideration to all of the documents filed by both parties but will only refer to the evidence/submissions as appropriate to the extent that is necessary in my decision.

DECISION

9. Section 46 of the Act is relevant to the revocation proceedings, which states:

> "46. - (1) The registration of a trade mark may be revoked on any of the following grounds-
>
> (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the

goods or services for which it is registered, and there are no proper reasons for non-use;

(b) [...]

(c) […]

(d) […]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) […]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date."

10. Section 100 of the Act is also relevant, which states:

"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."

11. 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 C40/01 *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 Bundervsvereinigung 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], 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].

12. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander QC (as he then was) 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."

13. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person stated that:

"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."

14. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me, and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the contested mark.

EVIDENCE OF USE

Relevant Period

15. I remind myself that the relevant period for assessing whether there has been genuine use of the contested mark under section 46(1)(a) of the Act is 16

November 2019 to 15 November 2024. As the contested mark is a UK trade mark, the relevant territory in which use must be shown is the UK.

16. I note the following from the witness statement of Mr Jatto:

a. Mr Jatto states that his company has been using the contested mark since October 2015 when they acquired the lease for their secondary shop in Nine Elms and throughout the relevant period. Mr Jatto states that the contested mark was initially used to support and grow the Tensixtwo Treatment Rooms Shop in Nine Elms and used in communications with the local community.

b. Mr Jatto states that the contested mark has been used through social media with the use of the #9elms hashtags to promote products and services that the Tensixtwo Treatment Rooms were providing to the general public.[1] The two exhibits that show the #9elms hashtag appear to be identical posts from the website X. The two references to "#9elms" appear to be a reference to a location given the first reference states "Based in #balham & #9elms" and the second reference states "#9elms #balham…" at the end of the post. The only other reference to "9elms" is at the bottom left side of the page which states "9elms @9elmslondon". Once again, location is referred to in the @9elmslondon and it is unclear what the other reference of "9elms" is in relation to. Despite all of this, as both exhibits are dated 8 Feb 2018 which is a date outside of the relevant period, they are not relevant to my assessment.

c. Mr Jatto states that use of the contested mark was shown by creating the contested mark's own email address nineelms@tensixtwo.co.uk, with all other emails for Tensixtwo Treatment Rooms directed to info@tensixtwo.co.uk. Mr Jatto states that the contested mark was used as the point of contact for all marketing, advertisement, communication with suppliers, local organisations, entities and the public on behalf of

[1] Exhibit MJ1 and Exhibit MJ2

Tensixtwo Treatment Rooms at Nine Elms, as well as being publicly visible on the shop in Nine Elms. Mr Jatto provided the following evidence to support these statements:

i. An email dated 2023-05-22 addressed to nineelms@tensixtwo.co.uk from a local police officer enquiring as to whether there was CCTV footage available following an incident on 19 December 2022.[2] The email is addressed "Good afternoon Nine Elms". However, there is no evidence of the contested mark in this email.
ii. An email dated 2023-12-08 addressed to nineelms@tensixtwo.co.uk with the subject "Nine Elms Neighbourhood Festive Events" regarding what activities/workshops will be taking place in Nine Elms in December.[3] It appears this email was received as part of a subscription. There is no evidence of the contested mark in this email.
iii. An email dated 2024-03-20 addressed to nineelms@tensixtwo.co.uk and an individual named Lerato asking if they would consider partnering with Treatwell.[4] There is no evidence of the contested mark in this email.
iv. An email dated 2022-11-18 addressed to nineelms@tensixtwo.co.uk with the subject "Take 40% off your entire cart!".[5] This email contains a discount code for Beau Tex Designs. Once again, there is no evidence of the contested mark.
v. An undated photograph of the frontage of what appears to be Ten Six Two Treatment Rooms.[6] This photograph shows an email address and a website displayed on the front of the treatment rooms being nineelms@tensixtwo.co.uk and www.tensixtwo.co.uk respectively, together with a phone number.

[2] Exhibit MJ7
[3] Exhibit MJ8
[4] Exhibit MJ9
[5] Exhibit MJ10
[6] Exhibit MJ18

There is no evidence of the contested mark displayed on the sign or advertising in the window. The name is clearly displayed as "Ten Six Two Treatment Rooms" with no reference to '9elms'. Mr Jatto has not indicated when this photo was taken, where the premises are located or the number of customers that attend the treatment rooms and are exposed to the frontage of the premises. The photo is undated. Given this, I have no information as to whether this photograph was taken within the relevant period.

d. Mr Jatto states by having its own designated web page of the Tensixtwo Treatment Rooms website, www.tensixtwo.co.uk, the trademark is clearly shown on the home page. Mr Jatto states that the initial registration date for the Tensixtwo Treatment Rooms website is 22/10/2007 and via the trademark link on the homepage there is a subsequent web page showing the trademark to advertise to partner companies. Mr Jatto has provided the following evidence in support of these statements:

    i. Exhibit MJ5 appears to be an undated screenshot of a portal called NetNerd that Mr Jatto has logged into which shows information regarding the domain tensixtwo.co.uk, its registration date and first payment and recurring payment amounts. The screenshot states the domain is active and the next due date is Friday August 22, 2025. There is no evidence of the contested mark and this exhibit is undated.

    ii. Exhibit MJ12 appears to be an undated screenshot of the homepage of the Tensixtwo treatment rooms website. Mr Jatto states that the contested mark is shown clearly on the home page. The following image is displayed at the bottom of the home page, underneath stockists depicted in figurative terms:

Given its location, it is difficult to determine if the above image is also included as a stockist or not or if it is referring to the location of the Tensixtwo Treatment Rooms. Within the body of the homepage "Nine Elms" is referred to as a location as the main body of text includes the sentence "We are located in hip and stylish Balham South West London and also in Nine Elms, Battersea, near Embassy Gardens in Central London's newest district". This screenshot is undated.

iii. Exhibit MJ13 appears to be an undated screenshot of another webpage with the heading Ten Six Two Treatment Rooms including two partner businesses. The image depicted in the previous paragraph is shown at both the top and bottom of the webpage. The page also includes the text "Home – Nineelms". However, it is unclear if these references are to the contested mark or the location of the Tensixtwo Treatment Rooms. This screenshot is undated.

e. Mr Jatto submits that whilst the COVID pandemic from March 2020 until 1 April 2022 restricted the ability for Tensixtwo Treatment Rooms to trade as normal as before the pandemic, they expanded the use of the contested mark to provide advice and information concerning commercial business management with partner companies. Mr Jatto provided four exhibits in support of this as detailed below:

i. An invoice dated 01/12/2022 addressed to an individual Mr SC located in Geneve, Switzerland in respect of advice and information concerning commercial business management and advertising and marketing consultancy totalling 20,000 euros.[7] The invoice indicated that £16,940.54 was received on 15/11/2022. The top left hand corner of the invoice displayed the image shown at paragraph 16(d)(ii) above stating "9ELMS Welcome to Zone 1".

[7] Exhibit MJ6.

ii. Mr Jatto provided another invoice dated 10/11/2023 addressed to Braveheart Investments Inc c/o Mr SC.[8] The invoice detailed the amount received from Braveheart Investments Inc being 270,000.00 CAD/£157,361.00. It also detailed advice and information concerning commercial business management totalling £23,604.15 that was received on 02/11/2023. The invoice was addressed to Mr SC in Geneve, Switzerland. The top left hand corner of the invoice displayed the image shown at paragraph 16(d)(ii) above stating "9ELMS Welcome to Zone 1".

iii. Mr Jatto provided a third invoice dated 15 September 2024 addressed to AD c/o Mr SC.[9] The invoice detailed the amount received from AD being 346,100.00 EUROS/£285,902.83. It also detailed advice and information concerning commercial business management totalling £42,885.42 that was received on 03/09/2024. This invoice was addressed to Mr SC in Geneve, Switzerland. The top left hand corner of the invoice displayed the image shown at paragraph 16(d)(ii) above stating "9ELMS Welcome to Zone 1".

iv. A screenshot of a BBC news article dated 21 February 2022 headed "COVID: England ending isolation laws and mass free testing".[10]

f. Mr Jatto states that the contested mark promoted Tensixtwo Treatment Rooms and being the online communication face of it, facilitated the use of Groupon and Treatwell websites, whose advertisement reach are throughout London, UK and globally. Mr Jatto states that the use of the contested mark through these platforms enabled products and services provided by Tensixtwo Treatment Rooms to be visible through a variety of loyalty schemes and advertising and marketing services. Mr Jatto provided the following evidence in support of these statements:

[8] Exhibit MJ14
[9] Exhibit MJ15
[10] Exhibit MJ16

i. An undated screenshot of a Groupon page regarding a choice of hot stone, Indian head, revital wrap massage at 30 Ascalon Street Nine Elms, London by Ten Six Two.[11] The contested mark is not displayed and the screenshot is undated. The only reference to Nine Elms is in the address. Mr Jatto also provided an undated screenshot regarding merchant support Groupon provides.[12] The contested mark was not used.

ii. The same email dated 2024-03-20 as previously outlined at paragraph 16(c)(iii) above addressed to an individual named Lerato regarding partnering with Treatwell.[13] There is no evidence of the contested mark in this email.

iii. An undated screenshot from Treatwell website regarding "Tensixtwo – Nine Elms Reviews. [14] "Nine Elms" appears to refer to the location of the Tensixtwo treatment rooms in Nine Elms. There is no evidence of the contested mark. One review refers to "eyebrow waxing and shaping" and another review refers to "facial and eyebrow shape". I note that there is no mention of services that could be attributed to the registered proprietor's class 35 services.

iv. A Groupon invoice dated 5 December 2019 addressed to Ten Six Two at 271 Cavendish Road, London for £7.14 for marketing services rendered in the period 1 November 2019 to 30 November 2019.[15] The period 1 November 2019 – 15 November 2019 falls outside of the relevant period. However, the date of the invoice falls within the relevant period. This invoice was not addressed to 9elms and there is no evidence of the contested mark.

[11] Exhibit MJ3.
[12] Exhibit MJ4
[13] Exhibit MJ9
[14] Exhibit MJ17
[15] Exhibit MJ19

Form of the mark in use

17. Before I move on to assess the sufficiency of the evidence, I shall begin by addressing the way in which the contested mark has been displayed in relation to the relevant services in the evidence.

18. In *Colloseum Holdings AG v Levi Strauss & Co*., Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

> "31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.
>
> 32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in Nestlé, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.
>
> 33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

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

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark Page 16 of 25 must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)." (emphasis added)

19. In *Lactalis McLelland Limited v Arla Foods AMBA,* BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative

elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis,* EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, Page 17 of 25 EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still."

20. Further, in *Dreamersclub Ltd v KTS Group Ltd*, Mr Philip Johnson, as the Appointed Person, found that the use of the mark shown below qualified as use of the registered word-only mark DREAMS.[16] This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.[17]

[16] BL O/091/19
[17] See also *La Superquimica v EUIPO*, T-24/17, EU:T:2018:668 at paragraph 39

21. The contested mark is a word only mark presented in lower case. Given that normal and fair use of the registration will cover use in any standard typeface or font, where the mark is used in capitals or title case this is use of the mark as registered and use upon which the registered proprietor may rely. The mark also appears to be shown as follows in the evidence:

22. It is unclear if the above mark is being used as reference to the location of the Tensixtwo Treatment Rooms or as a variation of the mark. As the above is the only reference to the contested mark in the exhibits provided by Mr Jatto, I will proceed by considering if this variation is an acceptable form of the contested mark. The above variation is presented in a different font to the contested mark as registered. I consider that the use of the difference case and font does not detract from the number and word themselves and will merely be seen as stylistic elements. This variation also includes the additional wording "WELCOME TO ZONE 1" in a considerably smaller font underneath "9ELMS". The evidence appears to suggest that Nine Elms is a reference to a location where one of the Tensixtwo Treatment Rooms is located and that Zone 1 is an area in London. I consider the phrase WELCOME TO ZONE 1 to either be a play on words or to highlight a location. I consider that "9ELMS" remains the dominant element of the mark, and this variant form is therefore an acceptable variation upon which the registered proprietor can rely.

Genuine Use

Assessment of Evidence

23. 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. It is possible for an accumulation of evidence to show use,

even if individual items of evidence would on their own be insufficient proof.[18] However, where there is no use of the mark in respect of the services as registered, it follows there has been no genuine use of the mark.[19]

24. Case law does not specify particular types of documentation that must be adduced in evidence. When considering the evidence, I am 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".[20]

25. Whether the use shown is sufficient to constitute genuine use will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK during the relevant periods. In making my assessment, I must consider all relevant factors, including:

    v. the scale and frequency of the use shown;
    vi. the nature of the use shown;
    vii. the goods for which use has been shown;
    viii. the nature of those goods and the market(s) for them; and
    ix. the geographical extent of the use shown.

26. At its height the use shown of the contested mark is provided in three invoices addressed to a customer in Switzerland and two undated webpages of the Tensixtwo website. All other remaining documents, either do not show the mark in use at all, are undated or appear to be a reference to the location of one of the Tensixtwo treatment rooms. Only three invoices in total have been provided and I have not been informed whether these are a sample of invoices or if they are the totality of use. Additionally, the invoices are addressed to the same customer, it is not clear what services have been provided as the invoice descriptions are so vague and broad and it is not clear where the services have been provided given the invoices are to an address in Switzerland. Even if I consider the three invoices

[18] *New Yorker SHK Jeans GmbH & Co. KG v OHIM* Case T- 415/09, paragraph 53
[19] *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd Case* BL 0/404/13 at [22]
[20] *Awareness Limited v Plymouth City Council,* BL O/236/13, paragraph 22

to show use, the three invoices by themselves are insufficient to prove use when considering the remainder of the evidence which is rather vague.

27. Over half of the evidence provided is undated or dated before the relevant period meaning that it has little relevance to showing genuine use across the relevant period. The only evidence dated within the relevant period showing use of the contested mark are the three invoices provided at Exhibits MJ6, MJ14 and MJ15.

28. There are multiple issues with the evidence. The first is that there are no turnover figures and neither is there any information as to advertising or marketing spend. The absence of such is not automatically fatal to the issue of genuine use but it does cause me some issues in that I am not able to determine the overall picture with regard to sales in the UK during the relevant period. Additionally, no information has been provided as to market share.

29. This leads me to the second criticism of the evidence, which is Mr Jatto provides only three invoices all addressed to Switzerland and the same customer. The registered proprietor was aware of its need to show use of its mark in the relevant period. It is fairly common for only a sample of invoices to be filed in proceedings such as these, for various reasons including to limit the volume of evidence. However, in the case before me, such a small selection of three invoices has not assisted the registered proprietor, especially when the three invoices provided are addressed to one customer with an address in Switzerland and when they are not accompanied by revenue/turnover figures, for example. It was open to, and presumably entirely possible for, the registered proprietor, in order to demonstrate genuine use, to (1) provide overall revenue/turnover figures, (2) file all of the invoices for the relevant period, or (3) file a representative sample from each year of the relevant period. It did not.

30. The three invoices all relate to sales in Switzerland totalling £86,489.57. Two of the invoices also state amounts received which equate to £443,263.83, with a third invoice stating £20,000 has been received. Two of the invoices are in relation to “advice and information concerning commercial business management” which is a

class 35 service included within the contested mark's specification as outlined in paragraph 1 above. The other invoice is in relation to both "advice and information concerning commercial business management" and "advertising and marketing consultancy" again which relate to the class 35 services included in paragraph 1 above. There is no evidence of the services being widespread given all of the invoices are addressed to the same consumer. Given that the three invoices are directed at Switzerland without any narrative evidence to explain what they show and where the services are rendered, I cannot be certain that the use of the services are shown to have been provided in the UK. Further, there is no breakdown as to what the services entail given the very broad nature of the description.

31. Thirdly, Mr Jatto submits that the contested mark was visible on the advertising and marketing websites, Groupon and Treatwell, who's online, TV and physical advertisements reach are throughout London, UK and globally, and in which the contested mark promoted Tensixtwo Treatment Rooms. However, from the evidence provided there is no evidence of the contested mark on these websites. Of the 18 exhibits only 5 showed the variation of the contested mark, being the three invoices and the undated homepage of the Tensixtwo website and another undated webpage of the Tensixtwo website. The contested mark is displayed at the bottom of the homepage of the Tensixtwo Treatment Rooms. A consumer would assume that the use of the mark in the variant form as displayed on the Tensixtwo Treatment Rooms' website could be referring to the location of the Tensixtwo Treatment Rooms as opposed to a reference to origin of the services. Despite the contested mark being displayed twice on the other webpage provided of the Tensixtwo website the same reasoning applies. Both webpages are undated and no details have been provided as to consumer engagement such as the number of views.

32. Fourthly, there is no evidence that the registered proprietor offers the types of services stated in its class 35 specification to third parties to assist with their advertising, marketing or promotional activities, administration of loyalty schemes or business management services. The limited evidence provided appears to show that the registered proprietor is providing spa services and advertising their own

services. Despite the invoices referring to class 35 services, as stated previously, these are very broad descriptions and these services may not have been available in the UK given the invoices are addressed to Switzerland. The fact that the registered proprietor may advertise its own services does not equate to advertising, marketing or promoting third party services to the public. Any advertising, marketing or promoting the registered proprietor might have carried out in relation to the contested mark would have been for the registered proprietor's own benefit; it would not be a service targeting the average consumer of advertising and marketing activities. In this connection, I should say, there is a fundamental misconception in the registered proprietor's approach about what "use" of a trade mark means in the context of those services. This goes back to the essential function of a trade mark which is to denote the origin of the goods and services to which it is applied or in relation to which it is used; even if the registered proprietor might have used the contested mark '9elms' for the purpose of creating awareness of, and promoting, its own brand through the offering of branded spa centres, that would not be use of '9elms' as a trade mark to identify the registered proprietor's advertising, marketing and promotional services. Whilst in several cases the courts have acknowledged that other legitimate functions of a trade mark include the quality function, the investment function and the advertising function, the relevance of these functions has emerged in the context of disputes involving damage to the function of trade marks in comparative advertising whereby the courts had to face the question of whether use of a sign identical to a trade mark in relation to imitation or competitive products was liable to have an adverse effect on the investment and advertising functions of that trade mark.[21] This is not the case here.

33. In relation to the business services included in the class 35 specification of the contested mark, the evidence as to the provision of advice and information concerning commercial business management is unspecified as to exactly what was provided and where, which on its own is insufficient to prove genuine use. Additionally, Mr Jatto states that the use of the contested mark through the Groupon and Treatwell websites enabled products and services by the registered proprietor to be visible through a variety of loyalty schemes and advertising and

[21] *L'Oréal v Bellure*, C-487/07

marketing services. However, as stated previously, from the evidence provided, the contested mark was not displayed on these websites. Even if the contested mark was visible on these websites, this does not equate to the administration of loyalty and incentive schemes, the administration of loyalty programs involving discounts or incentives or advertising and marketing services.

34. Fifthly, reasons for non-use have not been pleaded but I note that Mr Jatto has filed a BBC news article dated 21 February 2022 headed "COVID: England ending isolation laws and mass free testing". I take from this that Mr Jatto is providing this information as a possible reason for non-use. However, Mr Jatto submits that whilst the COVID pandemic from March 2020 until 1 April 2022 restricted the ability for Tensixtwo Treatment Rooms to trade as normal as before the pandemic, they expanded the use of the trademark to provide advice and information concerning commercial business management with partner companies. This infers that the business diversified. However, this is unclear as no evidence corroborating this statement has been received and no evidence demonstrating expansion of the use of the trademark to provide advice and information concerning commercial business management with partner companies has been received. Even if non-use had been pleaded and I took the evidence into account it would not be sufficient to prove this in any event because I have not been provided with enough evidence pre or post the Covid pandemic such as evidence of sales, turnover or the number of customers purchasing the services to be able to compare how the business was impacted.

35. Finally, Mr Jatto has provided four emails that were addressed to nineelms@tensixtwo.co.uk during the relevant period and two undated screenshots of the Tensixtwo Treatment Rooms homepage and another Tensixtwo webpage. However, the registered proprietor has not provided any website analytics in the UK during the relevant period which show how many users visited the website, their average engagement time or their exposure to the contested mark. Mr Jatto submits that use of the contested mark was shown by creating the contested mark's own email address nineelms@tensixtwo.co.uk. However, the email address nineelms@tensixtwo.co.uk does not demonstrate use of the

contested mark. Even if it did this evidence would be insufficient on its own to show genuine use of the mark when taking the totality of the evidence into account. Mr Jatto states all other emails for Tensixtwo Treatment Rooms were directed to info@tensixtwo.co.uk. I have no evidence regarding how many emails each email address received, what the main email address used was and how exposed to the email address the average consumer was apart from it appearing on the frontage of the Tensixtwo Treatment Rooms.

36. Taking all of the evidence into account and considering all of the criticisms cited above, I find that the material provided is insufficient to demonstrate that the registered proprietor has genuinely used its mark within the relevant period and within the relevant territory in relation to the class 35 services. As this is something that could reasonably have been provided, I am entitled to be sceptical of the evidence provided by the registered proprietor. I note that the limited evidence filed does not establish or even suggest the level of turnover or sales achieved by the registered proprietor within the relevant period, nor does it show that the contested mark has been consistently in use within the same in respect of the relevant services. I have no evidence for the size of the market for the services at issue, however, it is reasonable for me to conclude that the market for the services at issue is a relatively sizable one. I consider it reasonable to suggest that the overall turnover is something that would have been known to the registered proprietor and, should have been provided in evidence. Therefore, the invoices provided are the only evidence that I have of actual sales during the relevant period. Whilst I accept that there has been some repeat custom, I note that the Switzerland sales made are all ultimately to the same individual but with little or no explanation as to what was provided. Further in terms of the UK use, I have no evidence or detail about marketing activities or preparations for use, no turnover figures or evidence of sales in the UK. From the evidence provided it appears that the registered proprietor has been providing cosmetic services via a treatment room which are not services that appear within the contested marks specification. Again, I remind myself that use need not be quantitatively significant in order for it to be deemed genuine but, in the present case, I am of the view that the use shown in the evidence is at such a low level or so vague that I am not satisfied that it demonstrates when taken in its

entirety that the registered proprietor has genuinely tried to create or preserve a market share for its class 35 services in the UK.

CONCLUSION

37. The application for revocation under section 46(1)(a) against the registered proprietor's registration No. UK00003271708 has been successful. As a result, subject to any successful appeal, the contested mark is hereby revoked, with effect from 16 November 2024, for all of the services in its specification.

COSTS

38. The cancellation applicant has been successful and is entitled to a contribution towards their costs. In the circumstances I award the cancellation applicant the sum of £1,050 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 1/2023.

The sum is calculated as follows:

Official fee:	£200
Preparing and filing the TM26(N) and considering the counterstatement:	£250
Considering the other side's evidence and preparing and filing submissions in lieu:	£600
Total:	**£1,050**

39. I therefore order Tensixtwo Limited to pay Nine Elms Real Estate Limited the sum of £1,050. The above sum should 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 day 30th day of March 2026

N Barratt

For the Registrar