O/0821/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF
REGISTRATION NOS. 2563643 AND 904221297
BY DR. HAMISH STEVENSON

FOR THE TRADE MARK:

FAST TRACK

IN CLASSES 9, 16, 35, 36, 41 AND 43

AND

AN APPLICATION FOR REVOCATION
UNDER NOS. 505165 AND 505226
BY MSC R&D IP LIMITED

BACKGROUND AND PLEADINGS

1. Dr Hamish Stevenson ("the proprietor") is the registered proprietor of the following trade marks

   UK registration no. **2563643**
   FAST TRACK
   Filing date: 8 November 2010
   Registration date: 23 December 2011
   (The "first registered mark")

   UK registration no. **904221297**
   FAST TRACK
   Filing date: 8 February 2005
   Registration date: 9 June 2006
   (The "second registered mark")

2. The first registered mark is registered in respect of the following goods and services:

   Class 9: Electronic publications and information; all downloadable from the Internet or provided on data storage media; all relating to unquoted business enterprises or venture capital.

   Class16: Printed matter relating to unquoted business enterprises or venture capital.

   Class 35: Providing information; preparation of reports and articles for publication; all of the foregoing services relating to unquoted business enterprises; granting awards to businesses for promotional purposes; arranging business introductions; online and offline business and professional networking services; compilation, provision and updating of a business database for the use of subscribers

Class 36: Providing information; preparation of reports and articles for publication; all of the foregoing services relating to venture capital

Class 41: Providing on-line electronic publications relating to unquoted business enterprises or venture capital; arrangement of meetings and social events for business people, entrepreneurs and investors.

Class 43: Arrangement of dinners for business people, entrepreneurs and investors.

3. The second registered mark is registered in relation to the following goods and services:

Class 9: Electronic publications and information; all downloadable from the internet or provided on data storage media; all relating to unquoted business enterprises or venture capital.

Class 16: Printed matter relating to unquoted business enterprises or venture capital.

Class 35: Research and analysis services; providing information; preparation of reports and articles for publication; all relating to unquoted business enterprises.

Class 36: Research and analysis services; providing information; preparation of reports and articles for publication; all relating to venture capital.

Class 41: Providing on-line electronic publications relating to unquoted business enterprises or venture capital; arrangement of meetings, courses, conferences, sporting and social events for business people, entrepreneurs and investors.

Class 43: Arrangement of dinners for business people, entrepreneurs and investors.

4. Soho Flordis UK Limited ("the applicant") made an application to revoke the first registered mark on 19 July 2022 and a subsequent application to revoke the second registered mark on 28 July 2022. The applicant seeks revocation of both registered marks under sections 46(1)(a) and (b) of the Trade Marks Act 1994 ("the Act"). The applicant's claims are directed against all the goods and services for which the marks are registered.

5. In respect of the first registered mark the applicant claims non-use under section 46(1)(a) in the five-year period following the date on which the mark was registered, i.e. 24 December 2011 to 23 December 2016 (the "first relevant period"). The applicant requests an effective date of revocation of 24 December 2016. Non-use is also alleged under section 46(1)(b) for the following five-year periods:

- Between 24 December 2016 and 23 December 2021 (the "second relevant period"), seeking an effective revocation date from 24 December 2021;
- Between 18 March 2016 and 17 March 2021 (the "third relevant period"), seeking an effective revocation date from 18 March 2021;
- Between 19 July 2017 and 18 July 2022 (the "fourth relevant period"), seeking an effective revocation date from 19 July 2022.

6. As for the second registered mark, the applicant claims non-use under section 46(1)(a) in the five-year period following the date on which the mark was registered, i.e. 10 June 2006 to 9 June 2011 (the "first relevant period"). The applicant requests an effective date of revocation of 10 June 2011. Non-use is also alleged under section 46(1)(b) for the following five-year periods:

- Between 10 June 2006 and 9 June 2011 (the "second relevant period"), seeking an effective revocation date from 10 June 2011;

- Between 18 March 2016 and 17 March 2021 (the "third relevant period"), seeking an effective revocation date from 18 March 2021;

- Between 28 July 2017 and 27 July 2022 (the "fourth relevant period"), seeking an effective revocation date from 28 July 2022.

7. The proprietor filed counterstatements defending its registered marks for all the goods and services for which they are registered, in respect of which it claims its marks have been used. No claim is made to there being any proper reasons for non-use.

8. On 27 October 2022 the revocation proceedings were consolidated pursuant to rule 62(1)(g) of the Trade Marks Rules 2008 ("the Rules").

9. Only the proprietor filed evidence in these proceedings. The applicant is professionally represented by Swindell & Pearson Limited; the proprietor is professionally represented by Serjeants LLP. No hearing was requested, however both parties filed written submissions in lieu of a hearing. Therefore, this decision is taken following a careful consideration of the papers before me.

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 upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

EVIDENCE

11. The proprietor's evidence comprises the witness statement of Dr Hamish Stevenson, dated 28 December 2022, together with Exhibits DHS1 to DHS16. Dr Hamish Stevenson is the registered proprietor of the marks, and was the director, founder and owner of the company Fast Track 100 Limited, before its liquidation

in 2021. The purpose of the evidence is to demonstrate use of the registered marks.

PRELIMINARY ISSUES

12. The applicant states in its submissions that Dr Stevenson's witness statement (and, by extension, the attached exhibits) should not be relied upon nor admitted into these proceedings.[1] The applicant argues that the proprietor is not duly authorised to speak in his capacity as a director on behalf of Fast Track 100 Limited as the witness statement was signed after the date of its liquidation. Further, the applicant contends that there is no formal agreement/license between the proprietor and the liquidated company for it to use the registered marks. However, I disagree with the applicant's position. Taking the first point, it seems logical for former directors or business owners to give evidence, based on the information obtained during their time acting on behalf of a company. As for the second matter, Dr Hamish Stevenson is the registered proprietor of the marks, but the company is clearly a vessel through which he, the registered proprietor, could use the marks as owner and director. In these circumstances, I do not consider it necessary for consent to be shown through a formal written agreement; I accept that consent can be inferred. Accordingly, despite the applicant's submissions, it would not be appropriate to exclude the witness statement (and exhibits) provided by Dr Hamish Stevenson from the proceedings.

LEGISLATIVE PROVISIONS

13. Section 46 of the Act states:

> "46. - (1) The registration of a trade mark may be revoked on any of the following grounds-
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> (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

[1] Applicant's written submissions paragraphs 6-26.

United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(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".

14. Section 100 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."

MY APPROACH

15. It would appear having considered the evidence that it predominantly supports use of the marks between the years 2017 and 2021. Therefore, I will first consider the later relevant periods, identified in paragraph 5 for the first registered mark and paragraph 6 for the second registered mark. In line with the provisions of section 46(3) of the Act, a finding of genuine use within this period will prevent revocation of the marks, even if the evidence in relation to the earlier periods were not, of itself, sufficient to demonstrate genuine use during those periods.

CASE LAW

16. 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 I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 W.F. *Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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]."

17. Further, 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 and services protected by the mark" is not, therefore, genuine use.

18. I am also guided by *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."

and further at paragraph 28:

"28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, 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 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."

19. 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:

"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."

DECISION

Genuine use

20. Before I assess genuine use, I note the applicant argues that in related opposition proceedings (426309), the proprietor (acting as the opponent in the related proceedings) stated that it had only used its first registered mark (which the applicant contends is the same as its second registered mark) in relation to services registered under classes 35, 36 and 42.[2] In response the proprietor denies this and explains that on the Form TM7 it listed the services it wished to rely on at Q1 and in response to Q3a which states: 'For which of the goods and services listed at Q1 is trade mark use being claimed', it replied 'all the goods and

[2] Applicant's written submissions paragraph 3.

services'.[3] Consequently, I am satisfied that the proprietor has not conceded that either of its marks have been used only for services in classes 35, 36, and 41.

21. As referenced above, Dr Stevenson was the director, founder and owner of Fast Track 100 Limited from 24 February 1997 until the company was entered into liquidation in 2021.[4] He states that over the past 25 years the mark "FAST TRACK" has been used to publish 127 annual league tables in The Sunday Times, featuring 5,800 companies.[5] However, I note that not all of the 127 annual league tables necessarily fall within the relevant periods. Moreover, I have no precise details as to which of these league tables were provided under the "FAST TRACK" mark and which were provided under other marks, observing from the evidence that the proprietor's company also compiled league tables under other names, such as "PROFIT TRACK" and "TOP TRACK". Finally, notwithstanding the league tables being referred to as annual, I have no exact dates on which the "FAST TRACK" league tables were published in The Sunday Times.

22. Provided in support of the published league tables are three sets of extracts from The Sunday Times.[6] In relation to the first,[7] Dr Stevenson explains it shows the first "FAST TRACK 100" list which appeared on 7 December 1997.[8] However, this evidence pre-dates the relevant periods. As for the second, he confirms that by December 2020, "FAST TRACK 100" progressed to a full pull-out edition in The Sunday Times,[9] and provides photographs of the same.[10] It is difficult to clearly identify all the text contained within the extracts, however, the words "FAST TRACK 100" can be seen at the top of almost every page, as well as within the heading of the first page which reads "FAST TRACK 100" with the words "Covid-19 edition" underneath. The evidence shows a 100-list league table of "Britain's fastest growing private companies", as well as subheadings of articles related to businesses and stats and figures for business trends. The third shows a league

[3] Proprietor's written submissions paragraph 3
[4] Witness statement of Dr Hamish Stevenson, paragraph 1
[5] Witness statement of Dr Hamish Stevenson, paragraph 3
[6] Exhibits DHS3, DHS4, DHS5
[7] Exhibit DHS3
[8] Witness statement of Dr Hamish Stevenson, paragraph 9
[9] Witness statement of Dr Hamish Stevenson, paragraph 10
[10] Exhibit DHS4

table published in The Sunday Times on 11 April 2021, under the name "PROFIT TRACK".[11] Dr Stevenson claims this is the last league table published in The Sunday Times, and that reference is made to the "FAST TRACK" throughout the article.[12] However, from the images provided, I am unable to determine the content.

23. Dr Stevenson states that he has hosted over 500 invitation-only events attended by 18,000 entrepreneurs and directors with attendant press coverage of the 100+ larger award events, and in the latter years, coverage via social media posts from many of the attendees as well as the proprietor's company. He asserts that as a result, the general public recognise the mark and it is highly regarded within the business sector.[13] This evidence fails to address how many events were hosted within the relevant periods, the precise dates of the events, the nature of the events in relation to the registered goods and services, the number of attendees present for each of the events, and the revenue generated from these events. Further, I have not been provided with any supporting social media evidence directly from "FAST TRACK".

24. He claims "FAST TRACK" have featured rising stars such as ARM, Ocado and Fever Tree and that many company founders have attended "FAST TRACK" events and shared their stories along with notable key speakers including Boris Johnson, David Cameron and Gordon Brown.[14]

25. Various programmes referencing "FAST TRACK" have been provided to support the narrative evidence. These include programmes for virtual award events held on 19 May 2021[15] and 16 September 2020,[16] as well as award event programmes for 2006[17] and 2008[18]. Included within the evidence are three programme covers entitled "Alumni dinners for entrepreneurs" all dated in 2019,[19] each referring to

[11] Exhibit DHS5
[12] Witness statement of Dr Hamish Stevenson, paragraph 11
[13] Witness statement of Dr Hamish Stevenson, paragraph 3
[14] Witness statement of Dr Hamish Stevenson, paragraph 4
[15] Exhibit DHS6
[16] Exhibit DHS11
[17] Exhibit DHS9
[18] Exhibit DHS10
[19] Exhibit DHS7

"FAST TRACK". Dr Stevenson confirms that there were between 20 to 50 guests and that these dinners occurred in all 24 years (i.e. 1997-2001).[20] These appear to be private invitation-only events for entrepreneurs listed in previous league tables.[21] There are also programme covers for golf events and dinner events for entrepreneurs held in 2008 and 2009.[22] However, there is nothing before me to indicate any revenue generated as a result of these events.

26. Provided in evidence are a number of videos uploaded to the platform Vimeo under the "FAST TRACK" mark.[23] These show either still images from conferences and award dinners/events or their written description. Dr Stevenson explains the videos range in date from 2015 to 2021.[24] However, the majority of these videos do not refer to "FAST TRACK" events or awards but "SME EXPORT TRACK", "INTERNATIONAL TRACK", "PROFIT TRACK" or "TOP TRACK" events/award ceremonies. Only 12 out of 38 still images of the uploaded videos refer to "FAST TRACK", of which, only six appear dated.[25] However, I acknowledge that where videos are marked "4 years ago" they are likely to refer to events in 2017, and where they are marked "6 years ago" they are likely to refer to events in 2015. This has been deduced from considering video evidence which specifically refers to the years 2017 and 2015 that are also marked 4 or 6 years ago respectively. Therefore, I accept that the evidence shows award events for the years 2015 and 2017 as well as a 20th anniversary "FAST TRACK" drinks party held on 29 June 2017. Nonetheless, I have no information regarding the number of people in attendance at the events or the revenue that was generated as a result. Further, I have no information regarding who viewed the videos, and moreover, there are no comments or hearts/likes for any of the videos.

[20] Witness statement of Dr Hamish Stevenson, paragraph 13
[21] Witness statement of Dr Hamish Stevenson, paragraph 3
[22] Exhibit DHS8, page 2
[23] Exhibit DHS2
[24] Witness statement of Dr Hamish Stevenson, paragraph 8
[25] 13 December 2017, Exhibit DHS2, page 2, 29 June 2017, Exhibit DHS2, page 13, 29 April 2015, Exhibit DHS2, page 16, 23 May 2018, Exhibit DHS2, page 18, 19 May 2021, and the award presentations 2021, Exhibit DHS2, page 22.

27. The evidence presents various online press articles, [26] including articles from The Sunday Times dated 19 May 2019,[27] 28 May 2017,[28] and 3 May 2015,[29] as well as articles from the website of Virgin, which sponsors the proprietor's award events. One of those pages from the Virgin website is dated 7 December 2020;[30] the other is not specifically dated, but from its content, I am satisfied that it evidences activity from within the relevant periods as it refers to the "2021 FAST TRACK 100 awards".[31] These articles all refer to "FAST TRACK" in relation to either award events or the list/league table published in The Sunday Times. Within the evidence is also a Sunday Times article dated 29 May 2017, which reports on "Fast Track celebrating 20 years of recognising this country's most successful start-ups".

28. Further, dated within the relevant periods are various online articles from the webpages of third parties and sponsors.[32] These reference the existence of the "FAST TRACK 100" lists/league tables for the years 2011 to 2017 and 2019 to 2021. They discuss, inter alia, the criteria for appearing on the lists, as well as their prestige and what it means for the companies that feature. The articles also report on the annual award events hosted by "FAST TRACK", at which various awards recognising successful companies were granted.

29. The evidence also shows web pages and social media posts from numerous companies that have been featured within the "FAST TRACK 100" list/league table, dated between 3 December 2017 and 15 December 2020.[33] These publications mainly refer to the featured companies' positions within the lists/league tables, with one instance of a company posting about its attendance at "The Sunday Times Fast Track 100" virtual award event, dated 17 September 2020.

[26] Exhibits DHS1, DHS14 and DHS16
[27] Exhibit DHS1, page 2
[28] Exhibit DHS1, page 3
[29] Exhibit DHS16, page 2
[30] Exhibit DHS14, page 3
[31] Replicated in part, (apparent by the first two matching lines of the article) at Exhibit DHS1, page17 and 18 and Exhibit DHS14, page 2.
[32] Exhibit DHS1, pages 6, 7, 11, 14, 15 and 16, and Exhibit DHS15, page 4
[33] Exhibit DHS1, page 13 and DHS15.

30. Finally, within the evidence is a Wikipedia page about "FAST TRACK". As Wikipedia is crowdsourced, i.e. the information can be created and edited by anyone, I shall place little weight upon this evidence.

Form of the marks

31. 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 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)

32. Furthermore, 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 *Hyphen 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 supposed, 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*, 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).

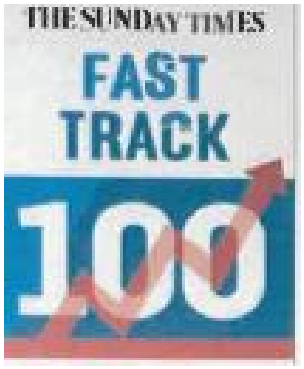
17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive 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."

33. The plain words "FAST TRACK" and "Fast Track" are visible within third party publications, some of the uploaded video evidence, and within the 2021 and 2020 event programmes. As both marks are registered in word-only format, they can be used in any standard typeface in any case. As such, this is clearly use of the marks as registered.

34. Further, "FAST TRACK 100" and "Fast Track 100" appear within third party publications, certain social media posts by third parties, some of the uploaded video evidence, The Sunday Times newspaper extracts from 2020, and within the event programmes. The additional inclusion of the "100" introduces a difference from the exact elements registered, however, as it is descriptive of the number of companies ranked in its league table, it does not alter the distinctive character of the registered marks. Therefore, it follows that the distinctive character remains in the registered words "FAST TRACK". Consequently, I am satisfied that this is acceptable variant use of the registered marks.

35. Also appearing within the evidence are, “The Sunday Times Fast Track 100”, “The Sunday Times Virgin Fast Track 100” or “The Sunday Times Virgin Atlantic Fast Track 100”. These variations appear within third party publications, such as online articles, websites and social media pages of sponsors or featured companies. As the case law above sets out, it is permissible for a registered mark to be used in conjunction with another mark, and indeed it is relatively common. While The Sunday Times and Virgin Atlantic may be better known and more distinctive trade marks, I consider the use of the proprietor’s registered marks alongside other such trade marks to be relevant actual use in the present case. As for the addition of the number one hundred, as discussed above, it will be viewed as descriptive of the number of companies appearing within the league table provided under the marks. Therefore, I consider the evidenced marks to be acceptable use of the marks as registered.

36. Finally, throughout the evidence - within third party publications and social media posts, still images of the video evidence, and on event programmes - the words “FAST TRACK” are presented as:



37. In the sign on the left, the words “FAST TRACK” appear in standard font in the single colour blue (so far as I can tell from the image). Above is “The Sunday Times” mark. Underneath is a figurative element that encompasses the number one hundred. I remind myself that ‘normal and fair’ use of a word-only mark includes use in a single colour. With respect to the presence of “The Sunday Times”, I note that a mark can be used in conjunction with another mark provided it still acts as an indicator of origin, which, in my view, it does. As for the figurative

element (of the rising arrow), I remind myself that where a mark is composed of a word and a figurative element, generally, the word element is more distinctive. Therefore, it follows that the addition of the figurative element when used in connection with the registered marks do not alter the distinctive character. As for the signs in the centre and on the right, the same reasoning applies to the replicated components. Equally, as it is permissible for one or more trade marks to appear together, the addition of "Virgin"/"Virgin Atlantic" do not cause concern. Lastly, in relation to the "2020" and "2017" elements, these are clearly descriptive of the year that the marks are used. Ultimately, in line with the case law, I am satisfied that the marks, as evidenced above, are acceptable use of the marks registered.

Sufficient Use

38. An assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself. [34] As indicated in the case law above, use does not need to be quantitively significant to be genuine.

39. The evidence provided by the proprietor shows actual use of the mark. As I have indicated, the evidence is not without its limitations: for instance, no details have been provided of the relevant markets, nor is there any evidence regarding the annual turnover figures or advertising expenditure promoting the "FAST TRACK" marks. Nevertheless, taking the evidential picture as a whole, it is clear that "FAST TRACK" provided annual lists/league tables and related information under its marks that were annually published within The Sunday Times newspaper between (at least) the years 2011 and 2021.[35] This is apparent from the 2020 extracts from The Sunday Times newspaper, as well as the assortment of publications from between 2011 and 2021, including via social media, from sponsors, and companies that have featured within the "FAST TRACK" list/league table referring to such. Furthermore, when taken as a whole, the evidence shows that "FAST TRACK" held

[34] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09
[35] Of which, I take judicial notice, is a national publication.

annual, invitation-only award events, with notable key speakers, in 2021, 2020, 2019, 2017, 2015, 2012, 2008 and 2006. The evidence shows that at these events "FAST TRACK" granted numerous awards to successful start-ups and fast-growing companies. These events resulted in press coverage and a number of third-party publications referencing the brand in relation to these awards. Whilst I accept that this is not direct evidence of the proprietor using the mark itself, there is direct evidence of the proprietor using the mark on event programmes and the uploaded video evidence of these events. From the overall evidential picture, including the supportive narrative evidence of Dr Hamish Stevenson, I am prepared to accept that the proprietor has demonstrated genuine use of its first and second registered marks in the UK. Whilst the evidence may be insufficient to demonstrate genuine use in some of the earlier relevant periods, the evidence of use post-dating those periods is, under section 46(3) of the Act, sufficient to avoid revocation.

Fair Specification

40. I must now consider whether, or the extent to which, the evidence shows use of the registered marks in relation to the goods and services relied upon. I must bear in mind that fair protection is not to be achieved by identifying and defining particular examples of goods and services for which there has been genuine use, but, rather, the particular categories of goods and services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer for the goods and services concerned.[36] In arriving at a fair specification, I must consider how the average consumer would fairly describe the goods and services shown in evidence; the task is not to describe the use made of the registered marks in the narrowest possible terms, unless that is what an average consumer would do. I remind myself that a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registrations.[37]

[36] *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10
[37] *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

41. The Proprietor has argued that:

> "The Sunday Times supplements are examples of use of the trade mark in respect of printed matter falling within the goods specified in Class 9 of the two trade mark registrations. Although published by the Sunday Times, the use of the trade mark FAST TRACK identifies Party A [the proprietor] as the source of those publications. In the alternative, the Sunday Times was clearly using the trade mark FAST TRACK in respect of the publications with the consent of Party A [the proprietor]."[38]

42. Further, in relation to use of the marks for "*providing on-line electronic publications relating to unquoted business enterprises or venture capital*" within class 41, the proprietor states:

> "It is common knowledge that in recent years many readers of newspapers – including the Sunday Times – prefer to read them online instead of printed on paper. When provided to such readers online, the supplements are examples of the use of the trade mark in respect of services falling within Class 41 […]."[39]

43. I disagree with these arguments. I have seen no evidence that would lead me to believe "FAST TRACK" is responsible for publishing the printed or online publications itself. Indeed, it appears from the evidence that "FAST TRACK" is commissioned to compile league tables and provide information in preparation for others to publish. As such, I am not satisfied that there is genuine use in relation to goods in classes 9 and 16 for either of the registered marks. Neither do I consider there to be genuine use in relation to "*providing on-line electronic publications relating to unquoted business enterprises or venture capital*" in class 41 of either registered mark.

44. On balance, I am prepared to accept that there is genuine use of the first and second registered marks for preparing articles in relation to compiling league table

[38] Proprietor's written submissions, paragraph 13
[39] Proprietor's written submissions, paragraph 14

information. Accordingly, I find a fair description to be "*providing information; preparation of reports and articles for publication; all of the foregoing services in relation to league tables related to unquoted business enterprises*" in class 35, as although The Sunday Times published the league tables and related articles, it is clear that "FAST TRACK" was responsible for compiling them for The Sunday Times to publish. Further, I acknowledge that the information and league tables relate to fast growing start-up companies, which I am satisfied fits within the description of unquoted business enterprises. However, I do not accept that the evidence shows the same in relation to venture capital within class 36. I understand venture capital to be a specific type of financing, and, in my view, the evidence does not show information or articles provided that discuss venture capital in a financial context, nor are the league tables based on the same.

45. In relation to the "*research and analysis services*" under the second registered mark, the proprietor contends:

> "In order to compile and publish the FAST TRACK league tables, Fast Track 100 Ltd – with the consent of Dr Stevenson – carried out the services specified in Classes 35 […] namely "Research and analysis services […]." It would have been clear to the editors of the Sunday Times who commissioned the supplements that the trade mark FAST TRACK indicated a consistent source for this research; and it would also have been clear to readers of the supplement. Additionally, we refer to page 2 of Exhibit DHS5, which shows the Sunday Times PROFT [sic] TRACK 100 supplement for 11 April 2021 (date confirmed in the Witness Statement paragraph 11). At the top right is stated "Researched and compiled by FAST TRACK", which is explicit evidence of the use of the trade mark for the Class 35 […] services."[40]

46. However, I disagree. To demonstrate genuine use of research and analysis services under the second registered mark, I would expect to see direct evidence of the proprietor (or its company) advertising these services for third parties to

[40] Proprietor's written submissions, paragraph 15

access and use, or evidence of them actually providing these services to third parties. In my view, research and analysis activities conducted by a company in the course of its business of providing information or compiling league tables on an annual basis does not satisfy genuine use requirements.

47. Next, I turn to *"compilation, provision and updating of a business database for the use of subscribers*" within class 35 of the first registered mark. I have seen no evidence of the mark in relation to these services, neither have I been pointed towards any evidence of use for these specific services by the proprietor.

48. In relation to use of the mark for the remaining services in class 35 under the first registered mark, I observe that the proprietor has not addressed use of these services within its submissions. Nevertheless, I am prepared to accept that there is genuine use in relation to "*granting awards to businesses for promotional purposes"* based on the video evidence, award event programmes and third-party publications reporting on such. As for "arranging business introductions" and "*online and offline business and professional networking services*", it is deduced from the evidence that networking opportunities arise at the award recognition events held by "FAST TRACK". In my view, the services shown in evidence would be fairly described by the average consumer as "*arranging business introductions and networking opportunities in the context of business award recognition gatherings*".

49. Turning to the remaining services in classes 41 and 43 for the first and second marks as registered, the evidence lacks granularity. For example, in relation to services for the "*arrangement of dinners for business people, entrepreneurs and investors*" in class 43, I have no clear numbers for the relevant periods, no information regarding the booking of facilities, evidence of communications with third parties requesting these services, or income resulting from the provision of these services. Instead, at best, the evidence shows that "FAST TRACK" events included dinners for invitation-only guests in the course of its business of arranging award recognition gatherings. Equally, the evidence does not sufficiently demonstrate genuine use for arranging social events for business people, entrepreneurs and investors outside the context of invitation-only gatherings for

business award recognition. Therefore, given the particular nuance and specification it is open to me to craft a fair specification in line with the use shown in the evidence provided, based on the relevant original services. I keep in mind that I cannot exceed the original specification of goods and services. Consequently, I consider a fair specification of class 41 services to read "*arranging business award recognition gatherings*". Therefore, the registration should be amended accordingly.

50. For the avoidance of doubt, in relation to sporting events specifically (which are listed under class 41 of the second registered mark), I have only a single leaflet for a golfing event. This by itself is not enough to demonstrate that the proprietor has shown genuine use for this service.

51. To summarise, I consider a fair specification for the first registered mark to be:

Class 35: Providing information; preparation of reports and articles for publication; all of the foregoing services in relation to league tables related to unquoted business enterprises; granting awards to businesses for promotional purposes; arranging networking opportunities in the context of business award recognition gatherings.

Class 41: Arranging business award recognition gatherings.

52. A fair specification for the second registered mark is:

Class 35: Providing information; preparation of reports and articles for publication; all of the foregoing services in relation to league tables related to unquoted business enterprises.

Class 41: Arranging business award recognition gatherings.

CONCLUSION

53. The first registered mark shall be revised to reflect the services outlined above in paragraph 51, whilst the second registered mark shall be revised to reflect the services listed at paragraph 52 above.

54. In line with sections 46(1)(a) and (b) and subject to any appeal against my decision, the changes will operate from the earliest date requested, i.e. 24 December 2016, for the first registered mark and 10 June 2011 for the second registered mark.

COSTS

55. As both sides have achieved a roughly equal measure of success, I make no order for costs. The parties shall each bear their own costs in the proceedings.

Dated this 30th day of August 2023

Sarah Wallace
For the Registrar