

**O/0826/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION  
NO. 03746875 BY  
ISLESTARR HOLDINGS LIMITED  
TO REGISTER AS A TRADE MARK:**

**PILLOW TALK**

**IN CLASSES 9, 28, 35, 36, 41 & 42**

**AND**

**OPPOSITION THERETO  
UNDER NO. 600002348 BY  
SCOBIE (LLARN) LTD T/A BOXER**

## Background & Pleadings

1. Islestarr Holdings Limited (“**the applicant**”) applied to register the trade mark shown on the front page of this decision in the United Kingdom. The application was filed on 24 January 2022 and was published on 15 April 2022. For the purposes of this partial opposition the relevant goods in the specification are:

**Class 28:** Games, toys and playthings.

2. SCOBIE (LLARN) LTD T/A BOXER (“**the opponent**”) opposes (using the Fast Track provisions) the application on the basis of Section 5(2)(a) of the Trade Marks Act 1994 (“the Act”).
3. The opponent is the proprietor of the UK registration number 03053809 which stands as follows:

### PILLOW TALK

4. The opponent’s mark was filed on 1 May 2014 and registered on 8 August 2014 for the following goods:

**Class 28:** Electronic hand-held game units; Game cards; Playing card cases; Computer game apparatus; Toy card games; Trading cards [card game];Playing cards and card games.

5. For the purposes of this fast track opposition, the opponent relies upon all of the goods for which the mark is registered.
6. In its notice of opposition, the opponent claims that “any other game with the name ‘PILLOW TALK’ would be confusing to the trade and the public.”

7. The applicant filed a defence and counterstatement in which it denied the opponent's claims requesting the opposition be dismissed in its entirety and an award of costs be made in the applicant's favour.
8. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
9. The net effect of these changes is to require the parties to seek leave in order to file evidence in Fast Track oppositions. The only exception to that general position is that a fast track opponent who is relying on an earlier mark that is subject to proof of use must file evidence of use at the time of filing the opposition. No leave was sought to file any additional evidence in respect of these proceedings.
10. Rule 62 (5) (as amended) states that arguments in Fast Track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.
11. Both parties have made submissions in lieu of a hearing. A hearing was neither requested nor was it considered necessary, however, the opponent filed evidence within its Form TM7F. This decision has been taken following a careful consideration of the papers.
12. In these proceedings, the opponent is unrepresented, and the applicant is represented by Lane IP Limited.

13. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

### **Relevant Date/Period**

An “earlier trade mark” is defined in Section 6(1) of the Act:

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

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

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered. [...]

15. As the earlier mark relied upon had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies, which states:

“(1) This Section applies where–

- (a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

16. In accordance with Section 6(1) of the Act, the opponent’s trade mark clearly qualifies as an earlier mark. The relevant period for proof of use of the opponent’s mark is **25 January 2017 to 24 January 2022**. The relevant date for the assessment of likelihood of confusion as per Section 5(2)(a) is the date on which the contested application was filed, namely **24 January 2022**.

## Decision

### Proof of Use

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 Bunderversammlung 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].”

18. The onus is on the proprietor of the earlier mark to show use. This is in accordance with Section 100 of the Act, 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.”

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

### **Genuine Use**

20. As indicated in the case law cited above, use does not always need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.
21. In making my determination as to whether the evidence presented shows the necessary genuine use, I also take account of judicial comment as to probative and evidential issues in such cases. In *Awareness Limited v Plymouth City Council*, Case BL O/230/13, Daniel Alexander QC (as he then was) sitting 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.”

22. 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.”

23. In *Naazneen Investments Ltd v OHIM*, Case T-250/13,<sup>1</sup> the General Court upheld a decision by the OHIM Board of Appeal that the sale of EUR 800 worth of non-alcoholic beverages under a mark over a five year period, which had been accepted was not purely to maintain the trade mark registration, was insufficient, in the economic sector concerned, for the purposes of maintaining or creating market share for the goods covered by that Community trade mark. The use was therefore not genuine use.

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<sup>1</sup> The judgment of the General Court was upheld on the appeal to the CJEU. In this regard, see Case C-252/15 P.

24. In *JUMPMAN Trade Mark*, BL O/222/16, the Appointed Person upheld a Hearing Officer's finding that sales of around 55,000 pairs of trainers over a 16-month period were insufficient to qualify as genuine use for an EUTM registration.
25. I include these extracts from case law merely as examples of instances where certain levels of sales have been insufficient to establish genuine use, but clearly, each case must be determined on its own merits, facts and relevant factors. Furthermore, I do not overlook that the relevant territory in the present case is not the EU, but the smaller territory of the UK.

### **Consideration of the evidence of use**

26. The opponent's evidence consists of two Exhibits. The opponent claims within its form TM7F that the average annual turnover of the goods in Class 28, using the 'Pillow Talk' mark, during the relevant period, was £45,000.
27. **Exhibit 1** is an undated screenshot taken from the online store, Ann Summers, demonstrating images and the retail price in GBP of the 'Pillow Talk Card Game'. However, I note that the original web address is not visible in the Exhibit. The lack of a web address and a date on this Exhibit limits its evidential value.

**Exhibit 2**, which shows images and the retail price in GBP of the 'Pillow Talk Intimate Card Game', is an undated screenshot from the opponent's website, *boxergifts.com*. However, the lack of a date on this Exhibit, again, limits its evidential value.

29. I have given close consideration to the evidence provided by the opponent in order to demonstrate that the use of its earlier mark, in respect of the goods relied upon, during the relevant period, meets the requirements for genuine use as per *Walton*, set out earlier in this decision. I also have in mind the guidance from the *Dosenbach-Ochsner* and *Awareness* appeal cases emphasising the need to consider what the evidence fails to "show"

and what might reasonably have been conclusively shown. In my analysis in the paragraphs above, I have highlighted the shortcomings in the evidence.

30. In its submissions in lieu, the applicant challenged the opponent's evidence by highlighting its deficiencies and inadequacies. I concur with the majority of the applicant's submissions and note that the body of evidence adduced is very thin and minimal, consisting of only two undated Exhibits. Their evidential value is limited due to the shortcomings I explained above, and, thus, it is not possible to deduce from the evidence whether the exhibited goods were available online and sold during the relevant period. Additionally, the opponent's claim that the annual turnover from the sales of the goods amounted to £45,000 is not sufficient to establish genuine use as this alone does not allow me to discern the scale, frequency, and territorial extent of the use of the registered mark in the UK, which are all vital factors in establishing genuine use. The sales figures would have been of more probative value if they had been broken down by month and refined according to the product type or term within the opponent's specification.
31. In addition, I note that it is typical to see evidence, such as invoices under the mark, particularised in relation to the goods relied upon. Such information should have been available to the opponent, and relatively easy to provide. Despite having full access to its company records and despite disclosing that the turnover under the registered mark during the relevant period was £45,000 per annum, the evidential picture is silent in crucial aspects, and the Exhibits are of limited, if any, evidential value.
32. Further, there is no clear evidence of how the goods under the mark are promoted or offered for sale with no marketing expenditure or promotional activities being provided or detailed in the evidence. Again, this is evidence which would have been readily available and easy for the opponent to provide.

33. The opponent, in its submissions, puts forward reasons of competition and client and data confidentiality for not filing extensive evidence. Nevertheless, it mentions that it has ample evidence to support genuine use of the mark “which is available to this tribunal immediately upon request”. I reiterate here that the burden is on the opponent to prove its case and show use of the mark in the relevant period without the prior request of the Tribunal. Thus, it is evident from the opponent’s submissions that it chose to file limited evidence to support its case.
34. The evidential picture as a whole is not sufficiently consistent, and what relevant evidence there is, is of limited value. It is my view that the evidence is not sufficiently “solid or specific to enable proper and fair evaluation of the scope of protection to which the opponent is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the [applicant], the opponent and, it should be said, the public.”<sup>2</sup> Consequently, the above evidence fails to show real commercial exploitation of the mark to create and maintain a share of the UK market for the given goods.
35. The applicant also submitted its concerns regarding the accuracy of the annual figures provided by Mr James O’Brien, who signed the opposition and statement of use as the Company Director, but resigned from the position on 4<sup>th</sup> September 2019, as per the UK Companies House. I note that his resignation would have occurred over 2 years before the filing of the applicant’s mark. The opponent argued that this is irrelevant since it is a family business and they share information, and the current managing director can countersign the forms upon request. I note that the fact that Mr O’Brien ceased to hold the post of Company Director some time before he signed his statement appears to raise a prima facie issue with the evidence. However, in light of my finding that the evidence is, anyway,

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<sup>2</sup> See *Awareness Limited v Plymouth City Council*, Case BL O/230/13.

insufficient to demonstrate genuine use, it is not necessary to comment further on this matter.

## **Outcome**

36. Since I have found that the evidence filed is insufficient to establish genuine use of the earlier mark in the UK during the relevant period, the opponent is unable to rely on any part of their registration as a basis to pursue her section 5(2)(a) objection. **Consequently, the opposition fails, and the application, subject to appeal, may proceed to registration in its entirety.**

## **Costs**

37. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in fast-track opposition proceedings are governed by Tribunal Practice Notice 2/2015. I award costs to the applicant on the following basis:

Considering a notice of opposition and filing a counterstatement	<b>£100</b>
Filing written submissions	<b>£300</b>
Total	<b>£400</b>

38. I, therefore, order SCOBIE (LLARN) LTD T/A BOXER to pay Islestarr Holdings Limited the sum of £400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 30<sup>th</sup> day of August 2023**

**Dr Stylianos Alexandridis  
For the Registrar,  
The Comptroller General**