

O/0832/23

TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION NO. UK00003757611
BY MD NASIR UDDIN
TO REGISTER THE FOLLOWING MARK:



IN CLASS 40

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 433535
BY THE PRINTING HOUSE LTD

Background and pleadings

1. On 22 February 2022, MD NASIR UDDIN (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 18 March 2022, and registration is sought for the services shown below:

Class 40: *Printing; Printing services; Digital printing; Silkscreen printing; Textile printing; Letterpress printing; Printing (Pattern -); Printing (Photographic -); Photogravure printing; Screen printing; Portrait printing; Offset printing; Wool printing; Intaglio printing; Lithographic printing; Discharge printing; Pattern printing; Photographic printing; Photo-printing; Printing (Lithographic -); Printing (Offset -); 3D printing; Printing of books; Digital printing services.*

2. On 17 May 2022, the application was opposed by The Printing House Ltd (“the opponent”) based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:

UK00003164214

The Printing House

Filing date: 12 May 2016

Registration date: 12 August 2016

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

Class 16: *Adhesive printed labels; Adhesive stickers; Advertisement boards of card; Advertising pamphlets; Advertising publications; Binders [stationery]; Blank forms; Block notepads; Book covers; Booklets; Boxes made of paper; Brochures in the field of real estate sales; Brochures; Business cards; Calendars; Carbon paper [finished products]; Catalogues; Desk calendars; Desk pads; Display banners of paper; Document folders in the form of wallets; Folders; Instruction sheets; Instructional material (except apparatus); Leaflets; Lithographic prints; Magazines [periodicals]; Magnetic boards for scheduling activities and appointments; Manuals [handbooks]; Mounted posters; Newsletters; Office stationery; Pamphlets; Paper folders [stationery]; Place*

cards; Post cards; Postcards; Printed advertising boards of cardboard; Printed award certificates; Printed educational materials; Printed publications; Printed questionnaires; Ring binders; User manuals; Wall calendars; Wall charts; Wall planners; Whiteboards; Whiteboards having magnetic properties; Writing stationery.

3. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to Section 6 of the Act. As the earlier mark had completed its registration process more than five years before the date of the application in question, it is subject to proof of use pursuant to Section 6A of the Act.

4. The opponent claims that the marks are similar and that the goods and services are identical or similar, meaning that there is a likelihood of confusion. It states:

“The marks 'The Printing House' and 'PRINTING house 01270 74 74 75 printinghouse.co.uk' are similar - aurally, visually and conceptually. Both marks contain the dominant and distinctive element 'Printing House', which is the opponent's mark in its entirety. The additional contact details in the applicant's mark do little to distinguish the marks and do not identify the specific source of origin, therefore it is highly likely that the contact details could be believed to be or mistaken for the opponent's. As such, there is a strong likelihood of confusion and also a likelihood of association between the marks. In addition, there are similar goods and services when comparing the marks. The applicant's goods in Class 40 for various printing services are similar to the opponent's goods in Class 16. The majority of the goods offered by the opponent in Class 16 are examples of printed matter or related stationery. There is therefore a risk of a likelihood of confusion and association whereby the applicant's offerings could easily be mistaken for the opponent's. In addition, geographically, the opponent and the applicant are operating and trading in the same town, thus it is likely that customers could reasonably assume that the offerings originate from the same source, or that there is a link between the two, resulting in a likely of confusion and potential loss of business and profit for the opponent”.

5. The applicant filed a counterstatement in which he denied the claims made and put the opponent to proof of use. He stated as follows:

- Although the opponent's goods and services could be similar, the parties are not in same business or do not supply the same goods;
- The applicant did not apply for the same mark, as the opponent's mark is 'THE PRINTING HOUSE', whereas the applicant's mark contains additional elements;
- There are other marks on the register which incorporate similar names including 'DEDRAX PRINTING HOUSE' (UK00917259251) and 'Diamond Painting Fan House' (UK00003574636). If these businesses are entitled to register their trade marks, the same should apply to the applicant;
- The applicant is already registered with Google, Facebook and LinkedIn with the name 'Printing house 0127074 74 75 Printinghouse.co.uk' since 2019;
- There is a business called 'THE PRINTING HOUSE' in Solihull and they have been trading for more than 30 years. Again, the applicant argues that if another business with an identical name has faced no objection from the opponent, he should be allowed to carry on with his business and register the applied-for mark;
- The applicant carries on his business "*with lots of private loan and borrowing*", and if the applicant were to close his business or change his business' name, he would be left destitute because his business represents his bread and butter.

6. The opponent is represented by Pure Ideas Limited. The applicant is without legal representation.

7. Only the opponent filed evidence. The opponent's evidence consists of a witness statement from Kevin Parnham who is a trade mark attorney employed by Pure Ideas Limited, the opponent's representatives in these proceedings. Mr Parnham's witness

statement is dated 6 January 2023 and is accompanied by exhibits KPA1 – KPA6 and KPB1. Neither party requested a hearing, nor did they file written submissions in lieu. This decision is taken following a careful perusal of the papers.

EU Law

8. 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.

DECISION

Proof of use

9. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(aa) or (ba) in relation to which the conditions set out in section 5(1),
(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed
before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

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

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

11. 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].”

12. The relevant period for the assessment of proof of use is the five-year period ending with the filing date of the contested application, namely 23 February 2017 to 22 February 2022.

13. 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.

Assessment of proof of use

14. Mr Parnham states that the opponent has used their mark ‘The Printing House’ extensively in the UK. The opponent has provided the following figures:-

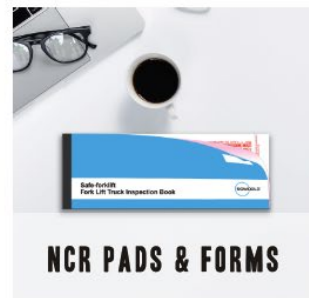
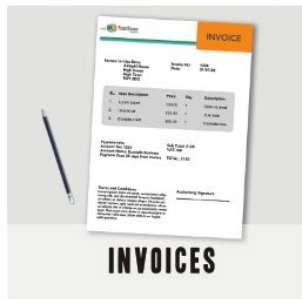
2019: £1.811 millions
2020: £1.769 millions
2021: £1.490 millions
2022: £1.220 millions

15. There is no explanation as to what these figures represent. If, as I assume, the figures produced are the opponent's turnover figures, they are not broken down in any way which enables me to apportion any volume of sales to any particular goods in class 16. Despite the opponent's claims in its statement of grounds that the mark has been used on each of the goods relied upon as set out in paragraph 2 above, the evidence is silent in respect of most of these goods.

16. Similarly, Mr Parnham says that the opponent has provided the details of a number of customers. He then lists just over 20 customers, some of which are identified with a degree of precision, including the names of companies, universities, councils, associations and football and rugby clubs; however, others are just referred to as "pubs & restaurants", "schools" and "design & marketing agencies" with no information regarding their identity. Mr Parnham also says that the opponent focussed upon an area roughly within 25 miles in Crewe, which is where the opponent is based. Again, whilst some customers' names are provided, there is no information about what goods these customers purchased and when. There is only one invoice exhibited, which is for goods described "box sleeve" (printed), a term that I understand refers to a custom printed paper that is used to wrap and package goods offered for sale. However, the invoice has the customer details, the price and the quantity redacted, and it is outside the relevant period (20 July 2022), so it does not count toward genuine use.

17. The exhibits produced appear to be marketing material (undated) which promotes the opponent as a business supplying custom and bespoke printing services for business cards, Christmas cards, compliments slips, invoices, invitations, labels and stickers, letterheads and pads and forms. The example shown below appears to be a screenshot from the opponent's website:

General Printing



18. A copy of a certificate from Companies House dated 22 December 2022 confirms that the main objective for which the opponent's company was established is *"to carry on business as printers"*.

19. The main issue with the opponent's evidence is that the opponent did not make any attempt to indicate how much of its overall sales related to the range of goods in the specification, or even the narrower range of goods identified in the statement of grounds, during the relevant period.

20. Further, it is clear that the opponent provides printing services. However, since the mark is registered only for goods in class 16, use of the mark in relation to printing services does not count toward genuine use of the mark in relation to the registered goods. Whilst it could be argued that aside from providing a bespoke printing service, the opponent supplies the goods themselves (an argument which I am not persuaded would be right), it is not possible to know how much of the turnover figures should be allocated to the goods (rather than the printing services). Further, as I have explained, the evidence is not sufficient to sustain any of the goods relied upon by the opponent, given the complete lack of information about the type, quantity and value of the goods sold during the relevant period.

21. In his evidence Mr Parnham states (as written):

"The applicant as accepted similarity of the goods of the Earlier Right and the services of the opposed application along with not requested evidence of use so only bare examples of use are provided in attached Exhibit KPA (within KPA1; KPA2; KPA3; KPA4; KPA5 and KPA6 and their Certificate of Incorporation is provided in attached Exhibit KPB1). Printing and provision of printing services is very dependent on service levels including delivery times and short response times so reputationally dependent. The Opponent has an enhanced reputation for safety and health sensitive goods so any diminish of their reputation will not only be detrimental to that reputation but may also provide a clear present and inherent danger to the public if such materials do not meet necessary standards expected from the Opponent."

22. I am not really sure what Mr Parnham means when he states: *“The applicant as accepted similarity of the goods of the Earlier Right and the services of the opposed application along with not requested evidence of use so only bare examples of use are provided.”* I can only think that Mr Parnham referred to the fact that when the applicant filled his Form TM8, he selected the box “Yes” to the question *“Do you want the opponent to provide proof of use?”* without listing the goods and services for which he required proof of use.

23. The fact that the applicant did not list the goods for which he requested proof of use did not make his request for proof of use invalid. The Tribunal further confirmed, in a letter of 7 November 2022, that since the applicant had requested that the opponent provides proof of use, the evidence of use needed to be filed within the two-month period set out for the filing of the opponent’s evidence in accordance with Rule 20(2)(c) of the Trade Marks Rules 2008. There was nothing in the Tribunal’s letter to say that the opponent no longer needed to file evidence due to the applicant’s failure to provide a list of goods for which he requested proof of use. The only consequence of the applicant not listing the goods for which he requested proof of use, was that the request for proof of use was intended as being directed to all of the goods identified by the opponent in the Form TM7.

24. On the basis of the evidence before me, I am not satisfied that genuine use has been made on or in relation to the goods upon which the opponent relies.

Conclusion

25. The opponent has failed to establish genuine use of its earlier mark within the relevant period. The opposition fails at the first hurdle and is dismissed accordingly.

26. Subject to appeal, the application will proceed to registration.

COSTS

27. The applicant has been successful, and ordinarily he would be entitled to an award of costs. As the applicant has not instructed professional representatives, he was invited by the Tribunal by email dated 5 May 2023 to indicate whether he intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. The applicant was also provided with a cost proforma and given a deadline of 2 June 2023 to respond. However, as the applicant did not file a completed copy of the costs proforma before the deadline given, or indeed at all, I make no order as to costs.

Dated this 31st day of August 2023

**Teresa Perks
For the Registrar**