O/0899/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3780934

IN THE NAME OF PEACHY RELIGION LTD

TO REGISTER THE FOLLOWING TRADE MARK:

PEACHY RELIGION

IN CLASSES 25, 38 & 41

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 435645

BY RELIGION LIMITED

Background and pleadings

1. On 25 April 2022, Peachy Religion Ltd ('the applicant') applied to register the trade mark "PEACHY RELIGION". It was accepted and published in the Trade Marks Journal on 13 May 2022 in respect of the following goods and services:

> Class 25: Clothing; footwear; headgear.
>
> Class 38: Telecommunications services, namely, electronic transmission of data, messages, graphics, images, audio, video and information; Photo sharing and video sharing services, namely, electronic transmission of digital photo files, videos and audio visual content among internet users; Providing access to computer, electronic and online databases; Providing online forums for communication on topics of general interest; Chatroom services; Facilitating access to third party websites or to other electronic third party content via a universal login; Providing online chat rooms, email and instant messaging services, and electronic bulletin boards; Audio, text and video broadcasting services over computer or other communication networks namely, uploading, posting, displaying, modifying, tagging, and electronically transmitting data, information, audio and video; Data streaming; streaming of audio, visual and audiovisual material via a global computer network.
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> Class 41: Education; providing of training; entertainment; sporting and cultural activities.

2. On 10 August 2022, Religion Limited ("the opponent") filed a notice of opposition against the application. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed at the contested mark's specification in class 25[1].

[1] The opponent had previously relied upon its earlier mark UK009054331333 to oppose the contested mark's services in class 41 however, this was subsequently withdrawn as set out in paragraph 12 of the witness statement of Mr Collins dated 23 December 2022.

3. In respect of the 5(2)(b) claim, the opponent relies on its UK comparable mark "RELIGION". The opponent's mark was applied for on 26 March 2001 at the European Union Intellectual Property Office (EUIPO) and registered on 4 April 2002. Pursuant to the Withdrawal Agreement, the mark was automatically converted to comparable UK trade mark 902149714. The opponent relies upon its goods in class 25, namely *Articles of clothing.*

4. By virtue of its earlier filing date, the above registration constitutes an earlier mark within the meaning of section 6 of the Act. As the mark had completed its registration processes more than five years before the filing date of the contested mark, it is therefore subject to the proof of use provisions contained in section 6A of the Act.

5. In its notice of opposition, the opponent contends that the competing trade marks are highly similar and that the respective goods are identical, giving rise to a likelihood of confusion.

6. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use in respect of its earlier mark.

7. Both parties are professionally represented in these proceedings, the opponent by Gaby Hardwicke Solicitors and the applicant by Fry Heath & Spence LLP. Both parties filed evidence. Although the applicant originally requested a hearing, they withdrew their request and filed submissions in lieu of a hearing. The opponent did not file any submissions in lieu. I now make this decision after careful consideration of the papers before me.

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 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.

EVIDENCE

9. The opponent's evidence came in the form of two witness statements of Mr. Graham Peter John Collins the director of Religion Limited. The first witness statement is dated 3 January 2023 and is accompanied by one exhibit. The primary purpose of that evidence is to demonstrate that the earlier mark has been genuinely used in the UK during the relevant period. The second witness statement is dated 29 March 2023 and was filed in reply to the applicant's evidence. It is also accompanied by one exhibit.

10. The applicant's evidence came in the form of two witness statements. The first witness statement is dated 2 March 2023 and is in the name of Steven White of James Mintz Group UK Limited. His witness statement is accompanied by one exhibit. The second witness statement is dated 3 March 2023 and is from Heather Donald, a chartered trade mark attorney and a salaried partner at Fry Heath & Spence LLP. The witness statement is accompanied by one exhibit.

11. I do not intend to summarise the evidence of the parties at this stage but will, where appropriate, discuss them further below.

DECISION

Proof of use

12. The applicant has requested proof of use in these proceedings in respect of the opponent's earlier mark. I will begin by assessing whether and to what extent the evidence supports the opponent's statement that it has made genuine use of the marks in relation to the goods relied upon. In accordance with section 6A(1A) of the Act, the relevant period for this purpose is the five years ending on the filing date of the contested application: 26 April 2017 to 25 April 2022.

13. The relevant statutory provisions are set out in Section 6A of the Act, 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.”

14. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union".

15. 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."

16. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade mark was made within the relevant territory in the relevant period, and in respect of the goods and services as registered.

Relevant case law

17. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

> "114……The Court of Justice of the European Union ("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]."

18. Use does not need to be quantitively significant in order to be genuine, however, proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is not genuine use.[2]

19. In *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."
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> and further at paragraph 28:
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> "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

[2] *Nike Innovate CV v Intermar Simanto* (*Jumpman*) O/222/16 Daniel Alexander QC (as he then was) sitting as the Appointed Person on appeal.

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.”

20. Furthermore, 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."

21. In other words, a number of factors must be considered when assessing whether genuine use of the mark has been demonstrated from the evidence filed. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[3]

Use of the mark

22. Mr Collins explains in his first witness statement that Religion Limited has been trading for more than twenty five years and has, throughout its long history of trading, has sold a wide range of products under this brand, in particular clothing, footwear and headgear.[4]

23. It is set out in the evidence out that the opponent sells its goods from their own website www.religionclothing.com which ships to the UK and worldwide.[5] The opponent goes on to state that they work with various fashion retailers such as Very, ASOS and House of Fraser who also sell and deliver their products worldwide.[6] Pages 5-7 of exhibit GPJC1 include website printouts from these retailers showing images of clothing next to the mark "RELIGION" however, these images are undated.

[3] *New Yorker SHK Jeans GmbH & Co KG v OHIM,* GC Case T-415/09
[4] See paragraph 4 of the witness statement of Mr Collins
[5] See paragraph 7 of the witness statement of Mr Collins
[6] See paragraph 8 of the witness statement of Mr Collins

24. Further images are provided at pages 8-12 of exhibit GPJC1. The images show "RELIGION" branded products such as hats, t-shirts and shoes however, I note again that these images are undated.

25. Pages 13-24 of exhibit GPJC1 show invoices displaying the earlier mark. Whilst I acknowledge that the invoices are from sales made within the UK and show sales of items such as t-shirts, hoodies, joggers and sweatshirts, they are all dated outside of the relevant period with the earliest dated invoice being 4 August 2022.

26. In terms of advertising figures, Mr Collins claims that each year the opponent invests thousands of pounds in their marketing activities, the management of their online shop and the general maintenance of their brand.[7] Whilst such a claim is noted, there is no confirmation that these figures relate to marketing investments in the UK and EU.

Genuine use

27. I have carefully considered the evidence provided by the opponent and whether this meets the requirements for genuine use as per *Walton*, set out earlier in this decision. I am also mindful of 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 above, I have highlighted numerous shortcomings in the evidence. No turnover figures have been provided and the invoices that have been included in the evidence are dated outside of the relevant period. Although images have been provided portraying the mark next to clothing items, as previously stated, these are undated.

28. After considering the evidence and relevant caselaw, I am not satisfied that the opponent has demonstrated genuine use of its mark in the UK for any of the goods for which it is registered. The consequence of which is that the earlier mark may not be relied upon to support the opponent's claim and the opposition must inevitably fail.

[7] See paragraph 11 of the witness statement of Mr Collins

Conclusion

29. The opposition under section 5(2)(b) has failed in its entirety. Subject to any successful appeal, the contested mark will proceed to registration in the UK for all the specified goods and services.

COSTS

30. The applicant has been successful in this case and is therefore entitled to a contribution towards its costs. Awards of costs in proceedings commenced on or after 1 July 2016 and before 1 February 2023 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Although I did not consider it necessary to assess the applicant's evidence given the circumstances of this case, it is still entitled to an award of costs for the same. As such, using the TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the other side's statement:	£200
Preparing evidence and considering the other side's evidence:	£500
Filing submissions:	£300
Total:	**£1000**

31. I therefore order Religion Limited to pay the sum of £1000 to Peachy Religion Ltd. 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 20th day of September 2023

Catrin Williams
For the Registrar