

BL O/0917/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF THE FOLLOWING TRADE MARK REGISTRATIONS
IN THE NAME OF STOREBOX HOLDING GMBH:

REGISTRATION NO. 914697585:



IN CLASSES 36, 38 AND 39

REGISTRATION NO. 916191413:



IN CLASSES 36, 38 AND 39

REGISTRATION NO. 918129291:

Storebox

IN CLASSES 36 AND 38

REGISTRATION NO. 918052495:



IN CLASSES 36, 39 AND 42

— AND —

APPLICATIONS FOR THE REVOCATION THEREOF UNDER NO.S

508408, 508409, 508410 AND 508412

BY STORE BOX SELF STORAGE LIMITED

Background and pleadings

1. Storebox Holding GmbH (“**the Proprietor**”) is the registered proprietor of the comparable trade marks (EU)¹ shown on the cover page of this decision. The details of those registrations are set out below:

“Registration 1”

Representation of Mark:	“Mark 1” 
Type of Mark:	Figurative
Registration No:	914697585
Filing Date:	20 October 2015
Registration Date:	12 February 2016
Expiration Date:	20 October 2025
Removal Date:	27 April 2026
Services: <u>Class 36</u> Rent collection; Real estate selection and acquisition [on behalf of others]; Assessment and management of real estate; Computerised information services relating to real estate; Real estate time-sharing; Time share management services; Real estate agency services for the rental of buildings; Real estate agency services for the leasing of land; Real estate brokerage; Brokerage; Brokerage house services; Real estate lease surrender services; Real estate lease renewal services; Provision of information relating to property [real estate]; Provision of information relating to the property market [real estate]; Rental of buildings; Real estate lending services; Real estate agency; Agencies or brokerage for renting of buildings; Letting and rental of permanent accommodation; Rental of office space; Rental of offices; Renting of commercial premises; Leasing of accommodation in a retail outlet; Letting of showrooms; Rental of apartments; Rental of apartments and offices; Rental of flats, studios and rooms; Commercial real estate agency services; Real estate procurement for others; Arranging of leases for the rental of commercial property; Leases (arranging of -) [real estate property only]; Arranging of leases and rental agreements for real estate; Accommodation (leasing of -) [apartments]; Apartments	

¹ Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

(Arranging letting of -); Residential real estate agency services; Accommodation bureaux (real estate property); Providing information relating to the rental of buildings; Providing information relating to real estate affairs, via the Internet.

Class 38

Providing access to Internet forums; Provision of access to sites on an electronic information network; Providing access to weblogs; Providing user access to platforms on the Internet; Providing user access to information on the Internet; Providing user access to portals on the Internet; Providing access to databases in computer networks; Provision of access to web pages; Providing access to web sites on the internet; Provision of access to electronic sites; Providing access to Internet portals for third parties; Providing access to platforms on the Internet; Providing access to platforms and portals on the Internet; Providing access to portals on the Internet; Provision of access to an electronic marketplace [portal] on computer networks; Providing access to e-commerce platforms on the Internet.

Class 39

Consultancy in the field of storage services provided by telephone call centers and hotlines; Consultancy services relating to storage; Advisory services relating to the packing of goods; Advisory services relating to the repacking of goods; Advisory services relating to the storage of goods; Providing information relating to warehousing services; Skip hire service; Warehouse storage; Storage of goods; Storing, safekeeping of clothes; Storage information; Storage of vehicles; Storage of freight; Storage of cargo after transportation; Storage of cargo before transportation; Freight warehousing; Storage of goods in warehouses; Rental of storage containers; Rental of storage units; Rental of storage facilities; Hiring of storage sites; Leasing of warehouse units; Rental of storage crates; Rental of warehouses; Provision of refrigerated storage facilities; Goods warehousing; Temporary storage of deliveries; Providing information relating to the rental of warehouse space; Providing information about temporary storage services; Providing information relating to the temporary storage of personal belongings; Provision of warehousing services and facilities.

“Registration 2”

Representation of Mark:	“Mark 2” 
Type of Mark:	Figurative
Registration No:	916191413
Filing Date:	21 December 2016

Registration Date:	28 June 2017
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Services:

Class 36

Real estate services; Rent collection; Real estate affairs; Real estate consultancy; Real estate appraisal; Real estate management; Leasing of real estate; Real estate agencies; Real estate lending services; Management of property; Real estate lease renewal services; Real estate brokerage; Estate agency; Rental of offices; Real estate time-sharing; Real estate insurance services; Provision of information relating to property [real estate]; Arranging of shared ownership of real estate; Leases (arranging of -) [real estate property only]; Time share management services; Insurance for property owners; Advisory services relating to real estate ownership; Real estate procurement for others; Real estate selection and acquisition [on behalf of others]; Arranging of leases and rental agreements for real estate; Providing information relating to real estate appraisal.

Class 38

Provision of access to sites on an electronic information network; Providing online forums; Providing an online interactive bulletin board; Providing access to Internet forums; Electronic communication by means of chatrooms, chat lines and Internet forums; Providing on-line forums for transmission of messages among computer users; Electronic exchange of messages via chat lines, chatrooms and Internet forums; Telecommunication gateway services; Telecommunication services provided via Internet platforms and portals; **Providing user access to portals on the Internet**; Providing access to portals on the Internet; Providing access to platforms and portals on the Internet; Provision of access to an electronic marketplace [portal] on computer networks; Providing access to a video sharing portal; Telecommunication services provided via platforms and portals on the Internet and other media.

Class 39

Bulk storage; **Storage**; Parcel receipt services; Provision of shipborne storage services; Arranging the storage of luggage; Storage of clothing; Container storage; Storage of waste; Storage of commercial goods; Storage of packages; Rental of strongrooms; Transportation and storage; Warehouse storage; Storage of freight; Freight warehousing; Hazardous materials warehousing; Food storage services; Storage of brochures; Storage of liquids; Storage of vehicle parts; Boat storage; Storage of domestic appliances; Storage of documents; Storage and delivery of goods; Bonded storage of goods; Packaging and storage of goods; Temporary storage of deliveries; Storage of documentary records; Refrigerated storage of goods; Storage of frozen food in warehouses; Storage of goods in transit; Storage of goods in warehouses; Consultancy services relating to storage; Storage information; Transport and storage of trash; Bonded storage of wines; Providing information relating to warehousing services; Storage of cargo; Storage of cargo before transportation; Storage of cargo after transportation; Advisory services relating to the storage of goods; Physical storage of electronically stored data, documents, digital photographs, music, images, video, and computer games.

“Registration 3”

Representation of Mark:	“Mark 3” 
Type of Mark:	Figurative
Registration No:	918052495
Filing Date:	16 April 2019
Registration Date:	15 January 2020
Services: <u>Class 36</u> Real estate services; Safe deposit services. <u>Class 39</u> Vehicle parking and storage; Transport; Rental services related to transportation and storage ; Packaging and storage of goods; Distribution by pipeline and cable; Parking and vehicle storage, mooring. <u>Class 42</u> IT services; Science and technology services; Design services.	

“Registration 4”

Representation of Mark:	“Mark 4” 
Type of Mark:	Word Mark
Registration No:	918129291
Filing Date:	26 September 2019
Registration Date:	05 February 2020
Services: <u>Class 36</u> Real estate services; Rent collection; Real estate affairs; Real estate consultancy; Real-estate valuations; Real-estate valuations; Real estate management; Arranging	

letting of real estate; Real estate agency; Real estate lending services; Management of property; Arranging letting of real estate; Arranging letting of real estate; Real estate lease renewal services; Estate management; Real estate affairs; Real estate brokerage; Real estate agency; Estate agency; Real estate consultancy; Real-estate valuations; Rental of offices [real estate]; Real estate time-sharing; Real estate consultancy; Real estate insurance services; Arranging letting of real estate; Estate agency; Arranging letting of real estate; Provision of information relating to property [real estate]; Time share management services; Insurance for property owners; Advisory services relating to real estate ownership; Corporate real estate advisory services; Time share management services; Real estate procurement for others; Real estate selection and acquisition [on behalf of others]; Arranging of leases and rental agreements for real estate; Providing information relating to real estate affairs, via the Internet.

Class 38

Provision of access to sites on an electronic information network; Provision of on-line forums; Providing an online interactive bulletin board; Providing access to Internet forums; Electronic communication by means of chatrooms, chat lines and Internet forums; Electronic exchange of messages via chat lines, chatrooms and Internet forums; Providing on-line forums for transmission of messages among computer users; Providing on-line chat rooms for transmission of messages among computer users; Providing internet chatrooms; Telecommunication gateway services; Telecommunication services provided via Internet platforms and portals; **Providing user access to portals on the Internet;** Telecommunication services provided via Internet platforms and portals; Providing access to portals on the Internet; Providing access to platforms and portals on the Internet; Provision of access to an electronic marketplace [portal] on computer networks; Providing access to a video sharing portal; Telecommunication services provided via platforms and portals on the Internet and other media.

2. On 6 February 2025, Store Box Self Storage Limited (“**the Applicant**”) sought revocation of the Proprietor’s trade mark registrations on the grounds of non-use under section 46 of the Trade Marks Act 1994 (“**the Act**”).²

3. Under section 46(1)(a) of the Act, the Applicant claims that the registrations were not put to genuine use in respect of any of the registered services, during the five-year period following their registration. It therefore seeks revocation of each registration with effect from the dates indicated below:

² The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

	Five-year period following the date of registration	Effective date of revocation sought
Mark 1	12 February 2016 to 11 February 2021	13 February 2021
Mark 2	28 June 2017 to 27 June 2022	29 June 2022
Mark 3	15 January 2020 to 14 January 2025	16 January 2025
Mark 4	5 February 2020 to 4 February 2025	6 February 2025

4. Under section 46(1)(b) of the Act, the Applicant claims that Registrations 1, 2 and 3 were not put to genuine use during the five-year period from 6 February 2020 to 5 February 2025. It therefore seeks revocation of those registrations with effect from 6 February 2025.

5. The Proprietor filed counterstatements denying the grounds of revocation.

6. The four separate revocations were subsequently consolidated in accordance with Rule 62(1)(g) of the Trade Mark Rules 2008. From that point on, the four cases proceed as one consolidated set of proceedings.

7. Only the Proprietor filed evidence. The Applicant filed submissions contesting the evidence, however the Proprietor did not respond with evidence nor submissions in reply. No hearing was requested, rather both parties filed submissions in lieu of a hearing. This decision is therefore taken following careful consideration of the papers before me.

8. In these proceedings the Applicant is represented by Wedlake Bell LLP and the Proprietor is represented by Christof Strasser.

EVIDENCE FILED

9. The Proprietor's evidence is provided in the witness statements of Johannes Braith and James Melvin MacGregor.

10. The witness statement of Johannes Braith is dated 30 June 2025 and has twelve accompanying exhibits labelled JB1 – JB12. Mr Braith is the Chief Executive Officer

and co-founder of the Proprietor company. The purpose of his witness statement is to provide evidence of genuine use of the Proprietor's four registrations.

11. The witness statement of James Melvin MacGregor is dated 29 July 2025. Mr MacGregor is a professional translator and interpreter, the purpose of his witness statement is to provide certified English translations of Mr Braith's exhibits JB7, JB8 and JB9, which were originally filed in German. His witness statement is accompanied by three exhibits labelled JM1 – JM3, referenced as follows:

- Exhibit JM1 – Original JB7 and its certified English translation
- Exhibit JM2 – Original JB8 and its certified English translation
- Exhibit JM3 – Original JB9 and its certified English translation

Preliminary Issues

12. I note that the Proprietor has provided two storage contracts, entered into before IP Completion Day and framed in substantially the same terms: one with a customer based in Switzerland (Exhibit JM2) and the other with a customer based in Germany (Exhibit JM3). As Switzerland is not a Member State of the European Union, the Swiss contract does not establish use within the European Union and I shall make no further reference to it.

13. Albeit translations were provided for three of Mr Braith's exhibits, I note that parts of his Exhibit JB2 remain untranslated, and I therefore cannot take the untranslated parts into account.

14. I also disregard the undated evidence marked Exhibit JB4. At most, the website screenshot contained in that exhibit can be treated as current at the date of the witness statement, which postdates the latest relevant period.

DECISION

Legislation and Case Law

15. The relevant provisions section 46 of the Act state:

“(1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) 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.”

16. Pursuant to Schedule 2A, Part 1, paragraph 8 of the Act, the Proprietor may rely on use of the comparable trade marks (EU) in the EU during any part of the relevant periods falling before IP Completion Day (i.e. prior to 31 December 2020).³

17. Section 100 of the Act states:⁴

“Burden of proving use of trade mark.

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.”

18. The law relating to genuine use of a registered trade mark was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors*⁵ as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU [Court of Justice of the European Union] in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v*

³ Also see Tribunal Practice Notice 2/2020, paragraph 4.

⁴ Section 100 of the Act makes it clear that the trade mark proprietor bears the burden of proving genuine use of its trade mark. In this regard see *Ferrari SpA v DU*, C-721/18, at paragraphs 73 to 83.

⁵ [2023] EWCA Civ 1247.

Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

“106. [...] the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve

an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

107. [...] The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the

commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. ...

22. ... 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 ... 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.”

19. In *Awareness Ltd*, the Appointed Person goes on to say that:

“28. [...] 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 [...].”

20. In *Walton International*,⁶ Arnold J (as he then was), after setting out the eight applicable principles when assessing genuine use (which are the same as the eight

⁶ *Walton International Ltd & Anor v Verweij Fashion BV*, [2018] EWHC 1608 (Ch), (which is also a decision by Arnold LJ, or Arnold J as he then was, that predates his decision in *easyGroup Ltd*).

principles he subsequently set out in *easyGroup Ltd*),⁷ added the further three principles when assessing genuine use in the EU:

“118. The law with respect to genuine use in the Union. Whereas a national mark needs only to have been used in the Member State in question, in the case of a EU trade mark there must be genuine use of the mark “in the Union”. In this regard, the Court of Justice has laid down additional principles to those summarised above which I would summarise as follows:

(9) The territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to genuine use in the Union: *Leno* at [44], [57].

(10) While it is reasonable to expect that a EU trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be deemed genuine, since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]–[55].

(11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory of a single Member State, and in such a case use of the EU trade mark in that territory might satisfy the conditions for genuine use of a EU trade mark: *Leno* at [50].”

21. The genuine use provision is not there to assess economic success or large-scale commercial use.⁸ 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.⁹

THE CLAIM FOR THE REVOCATION OF REGISTRATION 1

22. During the course of these proceedings, Registration 1 lapsed following non-renewal. It remains necessary, however, to determine the revocation application

⁷ Ibid., paragraphs 114 and 115.

⁸ *MFE Marienfelde GmbH v OHIM*, Case T-334/01

⁹ *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, at [53]

because its outcome affects the period during which the mark remained validly registered in the UK.

23. The Applicant submits that no evidence of use was filed in relation to Mark 1.¹⁰ In its submissions in lieu, the Proprietor acknowledges that submission but does not challenge it. Instead, having noted that the registration had lapsed, the Proprietor states that its submissions focus principally on its remaining registrations.¹¹ Thereafter,¹² the Proprietor neither identifies any evidence of use relating to Mark 1 nor advances any substantive defence of Registration 1.

24. Having reviewed the evidence, I can identify no evidence of genuine use of the mark. Revocation of Registration 1 therefore takes effect from the earlier date sought, and the application succeeds under section 46(1)(a).

OUTCOME

25. UK comparable trade mark No. 914697585 is revoked in its entirety with effect from the 13 February 2021.

THE CLAIM FOR THE REVOCATION OF REGISTRATIONS 2, 3 AND 4

Assessment of the evidence

26. As Registrations 2, 3 and 4 are comparable trade marks (EU), use in the EU before IP Completion Day remains relevant. From 1 January 2021, however, only use in the UK is relevant.

27. The Proprietor operates a self-storage business, transforming vacant retail spaces into self-storage facilities,¹³ both directly and through franchisees.¹⁴

28. The business was established in Austria in 2016 and subsequently expanded into Germany, Switzerland, Luxembourg, Belgium and the Netherlands.¹⁵ Mr Braith states that *“the brand ‘Storebox’ is a core identifier of our company and has been used*

¹⁰ Applicant’s submissions, dated 16 December 2025, paragraphs 12 – 14.

¹¹ Proprietor’s submissions in lieu, dated 19 March 2026, paragraph 2.

¹² See the Proprietor’s submissions in lieu, paragraphs 3 *et seq.*

¹³ Exhibit JB1.

¹⁴ Exhibit JB2. See in particular page 9 of this exhibit which breaks down the locations by ‘own’ and ‘franchise’.

¹⁵ Witness Statement of Johannes Braith, paragraphs 3 and 4.

continuously in our marketing online services, and customer communications throughout these territories”.

29. Mr Braith states that “from the outset, our business has focused on offering decentralised self-storage services that allow customers to book, unlock, and manage storage units entirely digitally.” Evidence dated in 2018 shows that customers can select and pay for the storage services via their smartphones (see ‘Image 1’ below). For ease of reference, the sign used in offering those services through the mobile application is labelled ‘Image 2’ below.¹⁶

Image 1

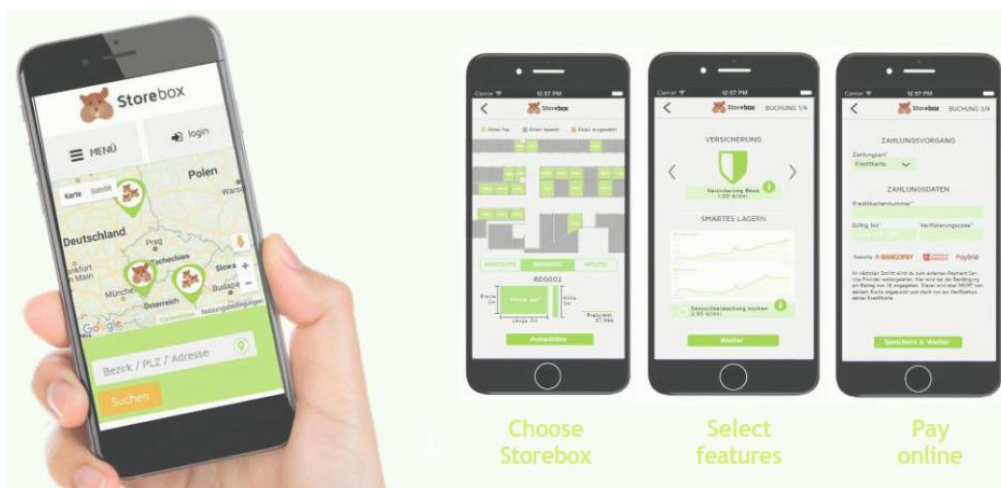
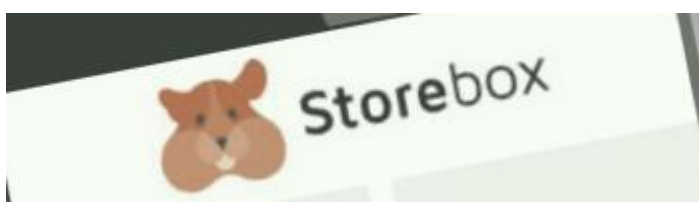


Image 2



30. A screenshot of the Proprietor’s website dated 18 December 2020 shows a notification inviting users to download the Proprietor’s application from the ‘App Store’ or ‘Google Play’.¹⁷ The website screenshot uses the following two signs:

Storebox (word only)

¹⁶ Exhibit JB1.

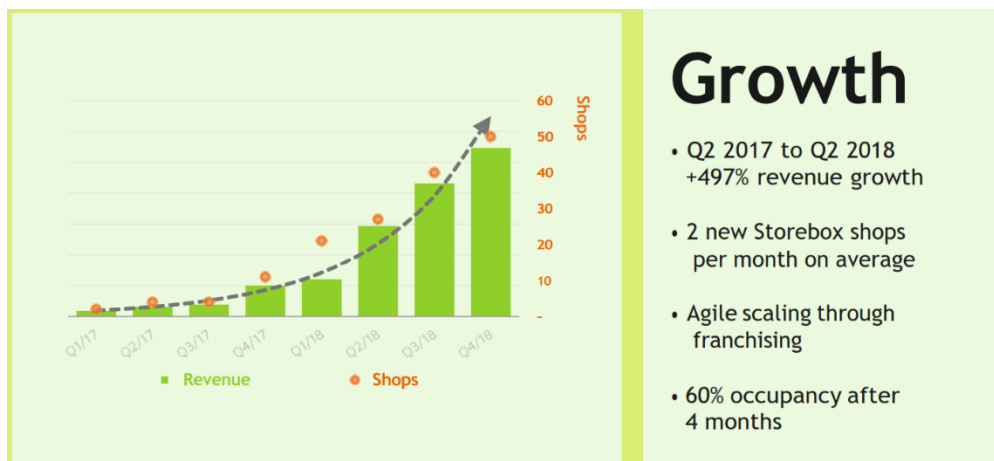
¹⁷ Exhibit JB3.



31. The following location map was prepared in 2018,¹⁸ when the business operated from more than 40 locations:¹⁹



32. Although no evidence of revenue has been provided, Mr Braith states that over a 12 month period (from 2017 to 2018), the revenue of the business grew by 497%. This is illustrated by the following graph:²⁰



33. By 31 December 2020, the business operated from 105 locations.²¹ Although the evidence does not identify the location of each operation, it sufficiently establishes that

¹⁸ Exhibit JB1.

¹⁹ See the graph included at paragraph 32 of this decision, taken from page 2 of Exhibit JB1.

²⁰ Exhibit JB1, page 2.

²¹ Witness Statement of Johannes Braith, paragraphs 3 and 4.

the business operated in EU territories, including Austria and Germany. An image of a store front from evidence dated in 2019 is shown below:²²



34. Although no invoices have been provided, Mr Braith exhibits a storage contract between one of the Proprietor's franchisees and a German customer, entered into in May 2018 and remaining in force as of February 2023.²³ The monthly storage fee has been redacted. The contract header displays the sign shown below (I note that evidence from 2018 suggests that the wording 'Dein Lager nebenan' translates to 'Your Storage Next Door').²⁴



35. Mr Braith states that Exhibit JB7 is an internal marketing report concerning the Proprietor's 2019 multi-channel 'Liebe ist' ('Love is') campaign. The campaign comprised flyer distribution, online marketing and a television advertisement which, he states, reached more than 3.1 million viewers in Austria. The sign used in the campaign is shown below:

²² Exhibit JM1.

²³ Exhibit JM3.

²⁴ Exhibit JB1, page 2.



36. Marketing expenditure figures are provided for Google, Meta, Bing and Pinterest in Germany, Austria, Switzerland and the Benelux countries from 2017 to the first quarter of 2025. The annual totals preceding IP Completion Day are set out below, which I have adjusted to exclude expenditure in Switzerland:²⁵

2017	€311.38
2018	€6,731.40
2019	€39,784.78
2020	€41,406.03

37. A report prepared by the business, dated 23 December 2020, showed that the business had a 4.5 out of 5 star rating on Trustpilot.²⁶

38. As regards use in the UK, Mr Braith states that in July 2021, the Proprietor “secured €52 million in funding to support European expansion, including market entry into the United Kingdom” and provides the screenshots of the following two headlines:²⁷

This startup offering
one-stop solution
for your storage
problems is coming
to the UK with
€52M funding

Storebox raises EUR52m in financing

39. At Exhibit JB11, he provides a screenshot of a YouTube video thumbnail titled “Annual Storebox Franchise Conference 2021 – Aftermovie”.

²⁵ Expenditure in Switzerland amounted to €1,821.98 in 2020 and nil in all other years pre-IP Completion Day.

²⁶ Exhibit JB2, pages 14 and 15.

²⁷ Exhibits JB5 and JB6.

40. Mr Braith states that the articles “*confirm our continued commercial interest in the UK and the importance of maintaining protection of the Storebox brand as we expand*”, and that the video at Exhibit JB11 “*supports our consistent commercial strategy and long-term intent to bring the Storebox franchise model to the UK*”. Although he describes the articles and video in terms suggesting that their contents are before me, only the screenshots have been provided; the underlying articles and video have not been exhibited.²⁸ Accordingly, my assessment has been confined to the content shown in the screenshots.

41. Whilst I have no reason to doubt the Proprietor’s stated interest in expanding into the UK market, intention is not use. There is no evidence that any of the marks have been used in the UK. Taking Mr Braith’s witness statement as a whole, it is clear that no expansion into the UK had taken place by February 2025.

42. Mr Braith relies on the global pandemic, particularly between March 2020 and March 2021, as having prevented the Proprietor from establishing or activating operations in the UK. I take judicial notice of the pandemic and the disruption it caused to many businesses. However, while the pandemic may have impeded the Proprietor’s plans between March 2020 and March 2021, in July 2021 the Proprietor secured €52 million in funding to support its European expansion. This gave the Proprietor the financial means to pursue that expansion. Nevertheless, there is no evidence of any preparation towards entering the UK market, or that the pandemic remained an obstacle to doing so. I therefore do not consider that the pandemic constituted a proper reason for non-use in the UK following the period of disruption identified by Mr Braith and up to February 2025.

43. The absence of use in the UK is not, however, determinative, since the use shown in the EU before IP Completion Day remains relevant.

44. Assessing the forms of the signs shown in evidence, I note that those shown on the shop front at paragraph 33 and on the storage contract at paragraph 34 plainly constitute use of Mark 3. The same applies to the figurative signs shown on the Proprietor’s website at paragraph 30 and in the Austrian advertising campaign at

²⁸ A Hearing Officer cannot undertake independent research or treat material accessible only through an external link as part of the evidential record. See the Tribunal Section of the Registry’s manual of Trade Marks Practice, part 4.8.4.

paragraph 35 - although used in 'grey and black' and 'green and white' colourways respectively, that use is covered by the black and white registration.²⁹

45. Use of 'Storebox' in word-only form constitutes use of Mark 4 as registered. Accordingly, the word-only use shown in the December 2020 website evidence is use of Mark 4.

46. Within Mark 3, the word 'Storebox' remains prominent and continues independently to indicate trade origin.³⁰ Its figurative elements and the descriptive wording 'Dein Lager nebenan' ('Your Storage Next Door') do not alter the distinctive character of 'Storebox'.³¹ Accordingly, the use shown of Mark 3 also constitutes acceptable variant use of Mark 4 under section 46(2) of the Act. The fact that Mark 3 is separately registered in the Proprietor's name does not affect that conclusion.

47. Although the sign shown in relation to the mobile application at paragraph 29 contains only the device element and the word 'Storebox', omitting 'Dein Lager nebenan' and 'by store me', it constitutes acceptable variant use of Mark 2 because those omissions do not alter the distinctive character of the mark as registered.

48. Additionally, the use shown of Mark 3 also constitutes acceptable variant use of Mark 2. The colour scheme and additional wording 'by store me' are subordinate to the prominent and distinctive word 'Storebox'. Their alteration or omission does not therefore alter the distinctive character of Mark 2. The fact that the Mark 3 variant is separately registered in the Proprietor's name does not affect that conclusion.

49. I bear in mind the Applicant's criticisms of each piece of evidence exhibited, namely that they do not prove genuine use of the registrations, however, 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.

50. Although the evidence has shortcomings, for example, it is quite sparse and does not include evidence typically expected, such as turnover figures, I bear in mind that it is not strictly necessary to exhibit any particular kind of evidence. Taking the evidence as a whole, I am satisfied that it establishes genuine use in relation to storage services

²⁹ Registration of a mark in black and white covers its use in colour. See *Specsavers* [2014] EWCA Civ 1294 at [5]; and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at [47].

³⁰ *Collosum Holdings AG v Levi Strauss & Co.*, Case C-12/12, at [32] and [35].

³¹ *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22.

in Class 39 and the provision of access to an online portal in Class 38, including through a mobile application by which customers could book and manage those storage services. In reaching that conclusion, I have taken into account the length of use, the geographical spread in the EU, including at least 105 locations before IP Completion Day, the marketing spend, the mobile application and website evidence, and the established trade in the services, as shown, for example, by the storage contract and images of the shops.

51. Bearing in mind that Registration 2 is registered in both Classes 38 and 39, whereas Registration 3 is registered in Class 39 and Registration 4 in Class 38, I consider the following to be fair specifications, based on the wording of the respective registrations³² and subject to appropriate limitations.³³

Registration 2

Class 38 Providing user access to portals on the Internet, including via a mobile application, for the provision of storage services.

Class 39 Storage.

Registration 3

Class 39 Rental services related to storage.

Registration 4

Class 38 Providing user access to portals on the Internet, including via a mobile application, for the provision of storage services.

52. The Proprietor therefore retains registration for the above fair specifications. Registrations 2, 3 and 4 shall be revoked in respect of everything else from the earlier dates of revocation sought.

OUTCOME

53. The applications to revoke Registrations 2, 3 and 4 under section 46(1)(a) of the Act are partially successful. Subject to any successful appeal, the registrations will

³² For ease of reference I have indicated the original wording in bold font in the tables set out at paragraph 1 of this decision.

³³ *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834.

remain registered for the specifications set out below and will be revoked in respect of all other services, with effect from the dates specified.

Registration 2

54. With effect from 29 June 2022, the specification for UK comparable trade mark No. 916191413 will appear as follows:

Class 38 Providing user access to portals on the Internet, including via a mobile application, for the provision of storage services.

Class 39 Storage.

Registration 3

55. With effect from 16 January 2025, the specification for UK comparable trade mark No. 918052495 will appear as follows:

Class 39 Rental services related to storage.

Registration 4

56. With effect from 6 February 2025, the specification for UK comparable trade mark No. 918129291 will appear as follows:

Class 38 Providing user access to portals on the Internet, including via a mobile application, for the provision of storage services.

COSTS

57. As both parties have been partially successful, I order that each party bear its own costs.

Dated this 6th day of October 2026

Daniela Ferrari
For the Registrar