O/0995/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003694520
BY LFG NFTS, CORP.
TO REGISTER:

AUTOGRAPH

AS A TRADE MARK IN CLASSES 9, 35, 38, 41 & 42

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP600002232 BY
SION O'CONNOR

BACKGROUND AND PLEADINGS

1. On 14 September 2021, LFG NFTS, CORP. ("the applicant") applied to register the trade mark on the cover page of this decision in the UK ("the applicant's mark"). The application was published for opposition purposes on 19 November 2021 and registration is sought for the following goods and services:

Class 9: Non-fungible tokens; downloadable computer software for manipulating digital audio information for use in audio media applications; digital media hubs; digital media servers; digital media streaming devices; digital media; Downloadable virtual goods, namely, computer programs for the creation and trade of digital collectibles using blockchain-based software technology and smart contracts.

Class 35: Provision of an on-line marketplace for buyers and sellers of goods and services; Retail services connected with the sale of non-fungible tokens.

Class 38: Electronic transmission and streaming of digital media content for others via global and local computer networks.

Class 41: Entertainment services, namely, providing on-line, non-downloadable digital collectibles; consulting services in the field of entertainment and media; consulting services in the field of media production services.

Class 42: Providing online, non-downloadable virtual goods, namely, online non-downloadable computer programs for the creation and trade of digital collectibles; Computer services, namely, digital formatting and compression of music and video images into downloadable media; consulting services in the field of digital media; Providing online, non-downloadable virtual goods, namely, non-fungible tokens.

2. On 21 February 2022, the applicant's mark was opposed under the fast track procedure by Sion O'Connor ("the opponent"). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), is reliant upon the following trade mark:

AUTOGRAPHIC ("the opponent's mark")
UK registration no. 2645208
Filing date 10 December 2012; registration date 28 February 2014
Relying on some goods and services, namely:

Class 9: Computer hardware and computer peripheral devices; mobile phone handsets and mobile phone peripheral devices; smart phone handsets and smart phone peripheral devices; tablets and tablet peripheral devices; computer programs for use in the fields of desktop publishing, electronic publishing, digital publishing, graphic design, illustration, animation and typesetting; computer software for creating, processing, manipulating, editing, managing and transferring graphics, illustrations, animations and text for use on a local or global computer or communications network; computer programs for desktop publishing, electronic publishing, digital publishing, graphic design, illustration, animation and typesetting via a local or global computer or communications network.

Class 38: Computer services, namely providing an interactive website featuring technology that allows users to manage their online image and social networking accounts; electronic mail, message and group communication services over computer networks; bulletin board services.

Class 42: Computer services; hosting of digital photographs, digital and graphical images, and digital content on the internet; providing temporary use of non-downloadable software for creating,

viewing, manipulating, editing, managing, indexing, cataloguing, sorting, organizing, storing, transferring, synchronizing, printing, and exchanging digital photographs, digital and graphic images, text, audio, video, multimedia and interactive documents and works, and recorded information; providing information in the fields of graphic design via the Internet; creating an online community for registered users to view images, create, share, store upload and download digital images, showcase their skills, post artwork and photographs, get feedback from their peers, form virtual communities, engage in social networking, collect preference data, and improve their skills; providing a website featuring information in the fields of graphic design via the Internet; providing an interactive website featuring technology that allows users to manage their online image and social networking accounts; design and design consulting services.

3. The opponent claims that the applicant's mark is phonetically, visually and linguistically almost identical to the opponent's mark and submits that the goods are in identical or similar classes and as such there is a likelihood of confusion between the two.

4. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use.

5. 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."

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. This would apply to evidence, which is filed

later in the proceedings, and therefore would not include evidence of use which is filed alongside the notice of opposition (Form TM7F). The opponent filed evidence within their TM7F but, at a later date, also sought leave to file additional evidence in relation to the reputation of the applicant's company. This request was refused as it was not relevant to the claims made under section 5(2)(b).

7. 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.

8. The opponent is unrepresented and the applicant is professionally represented by Fieldfisher LLP. A hearing was neither requested nor considered necessary. I note that the opponent filed evidence within its Form TM7F and the applicant filed written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

9. 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

10. The opponent's evidence consists of a statement of use from the opponent, Sion O'Connor. It is accompanied by 9 exhibits and an additional page of information from the opponent about their earlier mark and why they have raised the opposition.

11. I note that exhibits 1 to 9 consist of undated screen printouts from the opponent's website such as the welcome screen, registration screen and "media creation" screens. As an illustrative examples, exhibits 1, 2, 3 and 5 are reproduced in full below:

Exhibit 1 - Welcome Screen for autographic.me

Exhibit 2 - Registration Screen for autographic.me

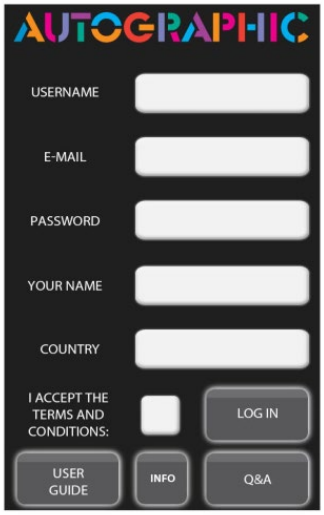


Exhibit 3 - Media Creation Landing State on autographic.me

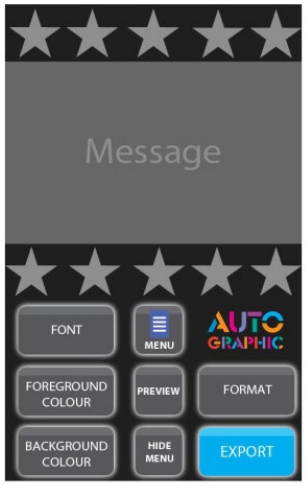
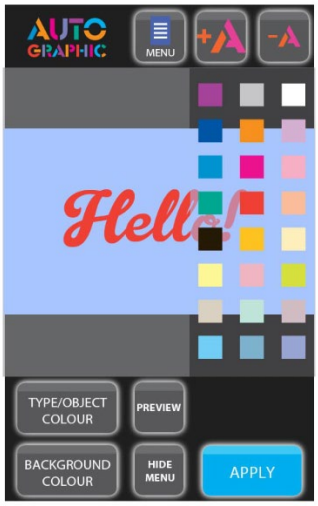


Exhibit 5 - Media Creation Step 2 on autographic.me



12. I further note that in their evidence, the opponent raises their concerns about the applicant's mark specification including non-fungible tokens (NFTs). They include summaries of press articles reporting on instances of fraud in relation to NFTs. The opponent submits that this would negatively impact upon their mark. I must

clairfy at this early stage that the opponent has based their opposition on section 5(2)(b) grounds only, namely that the respective marks are similar and for identical or similar goods and services. I therefore do not consider the opponent's comments in relation to the applicant's use of the contested mark potentially having a negative impact of the earlier mark to be relevant to my assessment of the likelihood of confusion under section 5(2)(b) and I need not consider the matter any further.

Proof of use

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a)a registered trade mark or international trade mark (UK) 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.

14. The opponent's mark qualifies as an earlier trade mark under the above provisions. As the opponent's mark had completed its registration process more than five years before the application date of the contested mark, it is subject to proof of use pursuant to section 6A of the Act. 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 and services 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: 15 September 2016 to 14 September 2021.

15. 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."

16. 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."

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

Relevant case law

18. 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]."

19. 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.[1]

20. 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."

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

and further at paragraph 28:

"28. ..... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as "tuition services", is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to "tuition services" even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted."

21. 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."

22. 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.[2]

Use of the mark

23. The opponent's evidence describes their services as a website that enables users to create and personalise digital messages and greetings that can be shared electronically either directly via email or by exporting them to share on social media websites. As highlighted in paragraph 11 of this decision, each exhibit provided is an undated screenshot of the opponent's website.

24. The opponent sets out that their website was launched in 2013 however, by 2017 they stopped operating their website with the intention of developing a better

[2] *New Yorker SHK Jeans GmbH & Co KG v OHIM,* GC Case T-415/09

version of their website. They claim that their plans to relaunch their website have been delayed due to cost, time and resources. The opponent states that they plan to relaunch the website[3], though I note that they have not provided any indication of when they intend to do this.

25. I note that the opponent states that their website was provided free of charge so they cannot provide turnover figures.[4] Further, the opponent has not indicated how many customers engaged with or used their goods and services during the relevant period.

Conclusions on genuine use

26. As far as the form of the mark is concerned, I am satisfied that the mark has been used as registered; with the word AUTOGRAPHIC appearing on the opponent's website. For the sake of completeness, I note that the word AUTOGRAPHIC appears in different stylised typefaces. However, I note that the earlier mark is a word mark which protects the words contained in the mark whatever form, colour or typeface is used.[5] Therefore I consider this to be acceptable use of the mark through fair and notional use.

27. The case law summarised in the passage from *Walton* quoted above makes it clear that real commercial exploitation of the trade mark must be shown. Even in a case where the use is not sham, i.e. it is not use engineered solely to preserve the trade mark registration, the use must be more than trivial if it is to be considered genuine. An example of this can be seen in *Memory Opticians Ltd's Application*, BL O/528/15, where the Appointed Person, Professor Ruth Annand, upheld the decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local, from 3 branches of an optician. There was no advertising of the goods under the mark,

[3] See page 10 of the opponent's attachment to the Form TM7F
[4] See question 7 of the Form TM7F
[5] LA Superquimica v EUIPO, Case T-24/17, paragraph 39

and the evidence indicated that they were only displayed in-store on occasion. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain a market under the mark. Consequently, it was not genuine use.

28. Turning to the present case, the burden is on the opponent to prove that it has used its mark within the relevant period. Therefore, it was the opponent's responsibility to provide proof that the mark was used between 15 September 2016 to 14 September 2021. Although the opponent has stated that they stopped operating their website in 2017, no information has been provided alongside the undated images of website print-outs such as the number of users that engaged with their website, promotional material or the geographical spread of the mark and where the opponent's customers were located.

29. It is not necessarily fatal to the assertion of genuine use that there is no such evidence, if other material filed by the opponent is sufficient to show that there has been a real attempt to exploit the mark in the sector. However, there is no evidence of other activity in this case and the opponent has confirmed that they stopped operating their website in 2017, indicating that they have not used their mark for the majority of the relevant period. Therefore, taking all of the above into account, I do not consider that there has been genuine use of the AUTOGRAPHIC mark for any of the opponent's goods and services. The consequence of which is that the earlier mark cannot be relied upon to support the opponent's opposition and the opposition must inevitably fail.

CONCLUSION

30. The opposition is unsuccessful and the application may proceed to registration.

COSTS

31. Award of costs in fast track proceedings are governed by TPN 2/2015. An award of costs is not compensatory, it is contributory. In the circumstances, I award the

applicant the sum of **£500** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the notice of opposition and Preparing a counterstatement:	£200
Filing written submissions:	£300

32. I therefore order Sion O'Connor to pay LFG NFTS, CORP. the sum of £500. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 24th day of October 2023

Catrin Williams
For the Registrar