

O/0996/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION UK00003011539

IN THE NAME OF ROMAN TARABRIN

AND

APPLICATION 505293

BY PIPL LIMITED TO REVOKE REGISTRATION UK00003011539

AND

APPLICATION UK00003569618

BY PIPL LIMITED

AND OPPOSITION 600001989

BY ROMAN TARABRIN

Background and Pleadings

1. On 18 December 2020, PIPL LTD ('PIPL') applied to register the following trade mark UK00003569618:

NOOSPHERE

For the following services:

Class 35:

Distribution of goods (not being transport services); wholesale services connected with the sale of stationery, gift wrapping products, motivational cards and posters, office supplies, books, publications, luggage, bags, wallets, purses, luggage tags, pet and animal toys, umbrellas, leads, collars, blankets, animal clothing, sporting goods, sporting equipment, drink bottles, towels, yoga accessories, fashion accessories, clothing, footwear, and headwear; retail services connected with the sale of stationery, gift wrapping products, motivational cards and posters, office supplies, books, publications, art materials, educational supplies, printed matter, stationery supplies, luggage, bags, wallets, purses, luggage tags, pet and animal toys, umbrellas, leads, collars, blankets, animal clothing, sporting goods, sporting equipment, drink bottles, towels, yoga accessories, fashion accessories, clothing, footwear, and headwear; provision of an on-line marketplace for buyers and sellers of goods and services; organisation and management of customer loyalty programmes; provision of assistance (business) in the operation of franchises; providing consumer product information and advice via the Internet; providing product recommendations to consumers for commercial purposes; retail store services and online retail store services in connection with the sale of cleaning preparations, cosmetic and beauty products, fragrancings preparations, toiletries, cutlery, food preparation implements, kitchen knives, audio-visual equipment, computer hardware, computer software, downloadable electronic publications, electronic book readers, home automation control devices, information technology equipment, mobile phones, navigation devices, recorded content, scientific research and laboratory apparatus, set-top boxes; retail store services and online retail store

services in connection with the sale of smartphones, smartwatches, tablet computers, wearable computers, hearing protection devices, cooling equipment, food cooking equipment, freezing equipment, heaters, heating equipment, lighting, refrigerating equipment; retail store services and online retail store services in connection with the sale of jewellery, time instruments, musical instruments; retail store services and online retail store services in connection with the sale of umbrellas, furnishings, furniture, cleaning articles, cookware, tableware, yarns, threads, fabrics, textiles and substitutes for textiles, clothing, footwear, headgear, sewing articles, floor coverings, wall coverings, festive decorations, games, sporting articles, sporting equipment, toys, video game apparatus; retail store services and online retail store services in connection with the sale of articles for use with kitchen appliances, domestic electronic equipment, domestic electrical equipment, disposable paper products, works of art.

2. On 29 October 2021, the application was opposed by Roman Tarabrin ('RT') under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). In the opposition, RT relies on the following earlier registration:

UK00003011539

Noosphere 

Filing date: 26 June 2013

Date of entry in register: 11 October 2013

Relying on the following services:

Class 35:

Advertisement for others on the Internet; Advertising and marketing; Advertising by transmission of on-line publicity for third parties through electronic communications networks; Advertising, including on-line advertising on a

computer network; Advertising on the Internet for others; Advertising services; Advertising services provided over the internet; Advertising services provided via a data base; Advertising services provided via the internet; Advertising services relating to books; Advertising services relating to data bases; Advertising services relating to the recruitment of personnel; Advertising space (rental of-) on the internet; Advertising via electronic media and specifically the internet; Analysis of advertising response; Analysis of business information; Analysis of market research data and statistics; Analysis of the public awareness of advertising; Analysis relating to marketing; Arranging business introductions; Arranging subscriptions of the online publications of others; Benchmarking (evaluation of business organisation practices); Business advice and information; Business consultancy, advisory, information and research services; Business information; Business information services provided on-line from a computer database or the internet; Business information services provided online from a global computer network or the internet; Career advisory services (other than education and training advice); Career information and advisory services (other than educational and training advice); Career planning services; Classified advertising; Classified advertising services; Collecting business information; Collection and systematisation of information into computer databases; Collection of commercial information; Collection of data; Collection of personnel information; Compilation of advertisements for use as web pages on the Internet; Compilation of computer databases; Compilation of directories for publication on the internet; Compilation of directories for publishing on global computer networks or the internet; Compilation of directories for publishing on the internet; Compiling of information into computer databases; Computer databases (Compilation of information into -); Computer databases (Systemization of information into -); Computerised data management; Computerised data processing; Computerised data-base management; Data compilation for others; Data entry and data processing; Data management services; Data processing; Database management; Data-base management (computerised -); Employment agency services; Employment consultancy; Employment consultancy services relating to data processing personnel; Human resources consultancy; Information, advisory and consultancy services relating to business and management or business administration, including such services provided on line or via the internet; Information (Business

-); Information services relating to advertising; Information services relating to business matters; Information services relating to jobs and career opportunities; International business representation services; Online advertisements; On-line data processing services; Price comparison of the services of other vendors, enabling customers to conveniently view and compare the services of those vendors; Price comparison services; Providing advertising services; Providing an on-line commercial information directory on the internet; Providing and rental of advertising space on the internet; Providing employment information; Public opinion polling; Recruitment consultancy services; Research (Business -); Subscription to an information media package; Subscriptions to electronic journals; Systematization of data in computer databases; Systemisation of information into computer databases.

3. RT claims that PIPL's applied-for mark is similar to RT's earlier mark and for identical or similar services. The opposition is directed against all of the services applied for by PIPL.
4. PIPL filed a Defence and Counterstatement in which it argues that the parties' services are dissimilar and therefore denies that there is a likelihood of confusion between the parties' marks. PIPL puts RT to proof of genuine use of the earlier mark upon which it seeks to rely.
5. On 18 August 2022, PIPL sought revocation of RT's registration UK00003011539 on the grounds of non-use. Under section 46(1)(a) of the Trade Marks Act 1994 ('the Act'), PIPL claims non-use in the five-year period following the date on which the contested mark was registered, i.e. 12 October 2013 to 11 October 2018, with an effective date of revocation of 12 October 2018. Under section 46(1)(b) of the Act, PIPL claims non-use in respect of the contested mark for the following three five-year periods:
 - 18 August 2017 – 17 August 2022, with an effective date of revocation of 18 August 2022;
 - 30 November 2016 – 29 November 2021, with an effective date of revocation of 30 November 2021;

and

- 16 June 2015 – 15 June 2020, with an effective date of revocation of 16 June 2020.

6. RT filed a Counterstatement defending its registration claiming that it has made genuine use of its mark, in respect of the entire specification for which it is registered, without suspension of use for any uninterrupted five-year period.
7. RT is represented by Olesia Verbitckaia and PIPL is represented by Sandra Santos.

Evidence and submissions

8. Only RT filed evidence, which is by way of a Statement of Use by Mr Roman Tarabrin, dated 13 February 2023, which is accompanied by 14 exhibits.
9. Both parties filed written submissions in the evidence round. RT's submissions are dated 18 August 2022; PIPL's submissions are dated 18 August 2022 and 15 May 2023.
10. Both parties filed written submissions in lieu of a hearing. RT's submissions are dated 28 June 2023 and PIPL's submissions are dated 27 June 2023.

Relevance of EU law

11. 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 upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Decision

12. The revocation proceedings will be addressed first because the mark for which revocation is sought is the earlier mark upon which RT seeks to rely in the related opposition proceedings.

13. Section 46 of the Act is relevant to the revocation proceedings, and states:

“46. - (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 in 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”.

14. Section 100 of the Act provides that:

“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.”

15. 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 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 Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I9223, 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], [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 6 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 7 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]."

16. 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, therefore, genuine use.

17. As noted above, the relevant periods are 18 August 2017 – 17 August 2022 ('the First Relevant Period'), 30 November 2016 – 29 November 2021 ('the Second Relevant Period'), 16 June 2015 – 15 June 2020 ('the Third Relevant Period') and 12 October 2013 to 11 October 2018 ('the Fourth Relevant Period').

18. I note the following from RT's evidence:

(a) Mr Tarabrin states that in the Summer-Autumn' of 2018, he applied for Government support for his project to 'promote the Noosphere UK00003011539 trademark and the services for which it is registered'.¹ Exhibit 1 comprises an application form for funding from the Department for Education for a project titled 'Noosphere'. I note from the content of Mr Tarabrin's application form that 'Noosphere is an online talent platform that connects individuals, educational providers and employers' and that the platform is intended to enable users to 'calculate their personal human capital and make informed decisions regarding their life-long education and career'. The application form does not appear to be dated. Exhibit 2 appears to be a 'scoring sheet' completed in respect of Mr Tarabrin's application form. No information is provided as to whether Mr Tarabrin's application for funding was successful.

(b) At Exhibit 9, RT has provided three screenshots of its website 'noosphere today', on which RT's mark is visible:

¹ Statement of Use, at [Q4].

About noosphere

A Noosphere diagram is a type of pie chart based on the noosphere concept, developed by Vladimir Vernadsky, Edouard Le Roy and Pierre Teilhard de Chardin in the twentieth century.

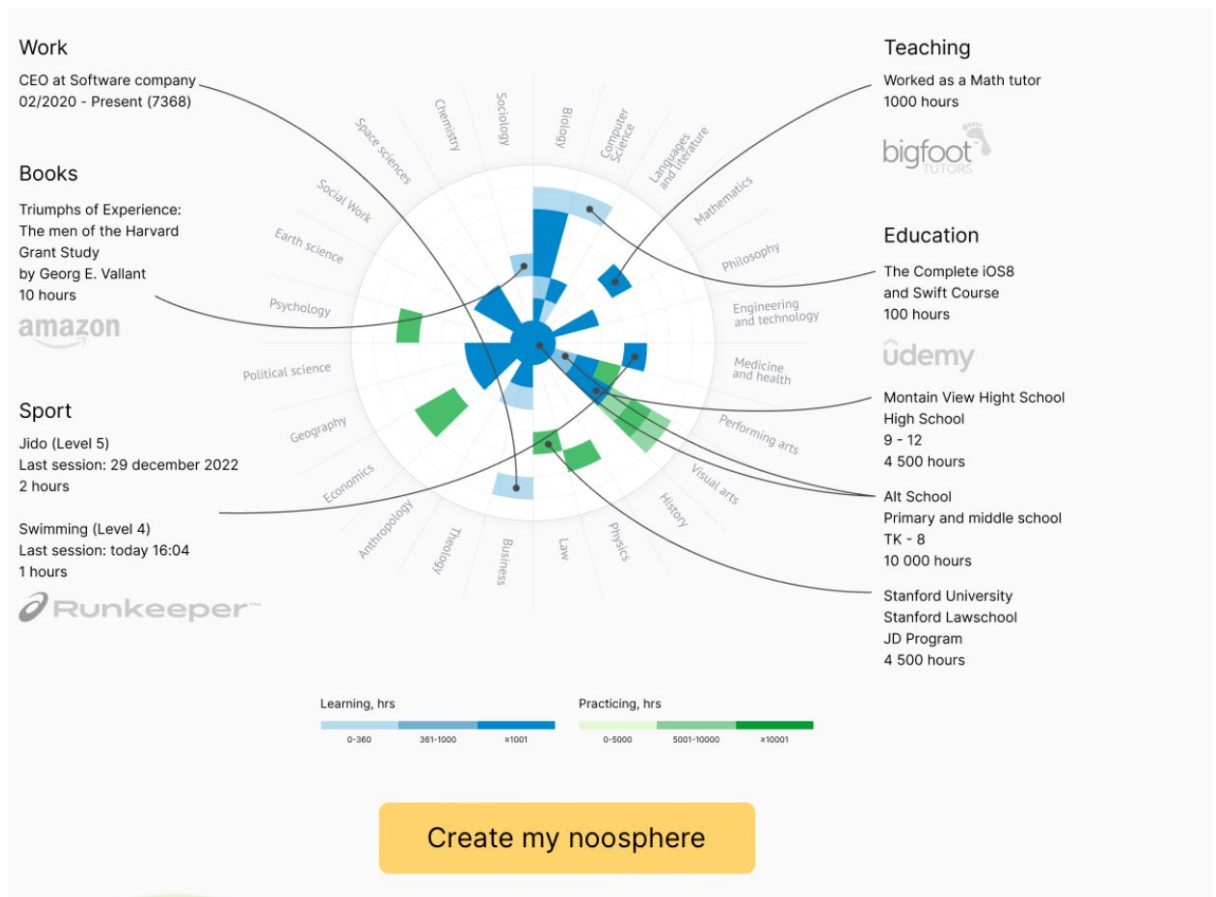
The diagram illustrates an individual's knowledge, broken down by discipline and level.

It allows individuals to log all productive hours and keep an on-going record of personal knowledge development (quantified yourself).

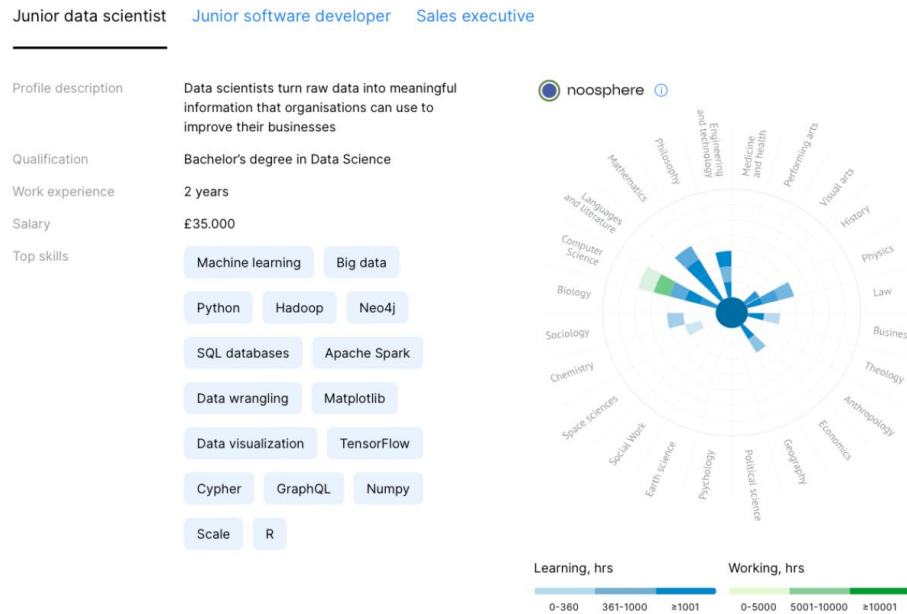
Structure

The Noosphere diagram uses the European Credit Transfer and Accumulation System (ECTS), which defines how much study time is required in order to complete each level of education.

The screenshots are undated, but Mr Tarabrin claims that the mark has been present on the website 'since 2014'. The second screenshot states that the 'noosphere' concept has its roots in the twentieth century and that RT has 'updated' it by providing 'noosphere' diagrams which provide 'a complex breakdown of individual fields of knowledge and level of expertise'. The third page shows an example of a 'noosphere' diagram:



(c) Mr Tarabrin states that he has used his mark on RT's website '73.today' since 2017.² However, I note that the only example provided is the following undated screenshot described by Mr Tarabrin as a recent example:



(d) Mr Tarabrin states that there are 'no sales at the moment' under the mark.³ He states that 'over £1.5 million and 10 years of research and development have been spent on the development and promotion of the Noosphere trademark'.⁴ Some documentary evidence of examples to support this statement would have been helpful.

(e) A 'Billing & payments' page and three invoices have been provided in respect of payments for advertisements on Google in relation to RT's website '73.today'.⁵ I note that the payment records and invoices relate to the periods May, June, July and August 2022. These dates fall within the three-month period prior to the filing of the application for revocation. I note that the revocation notification date was 3 February 2022 and that RT would therefore have been aware of the pending revocation proceedings against it for the time

² Statement of Use, at [Q4].

³ Statement of Use, at [Q6].

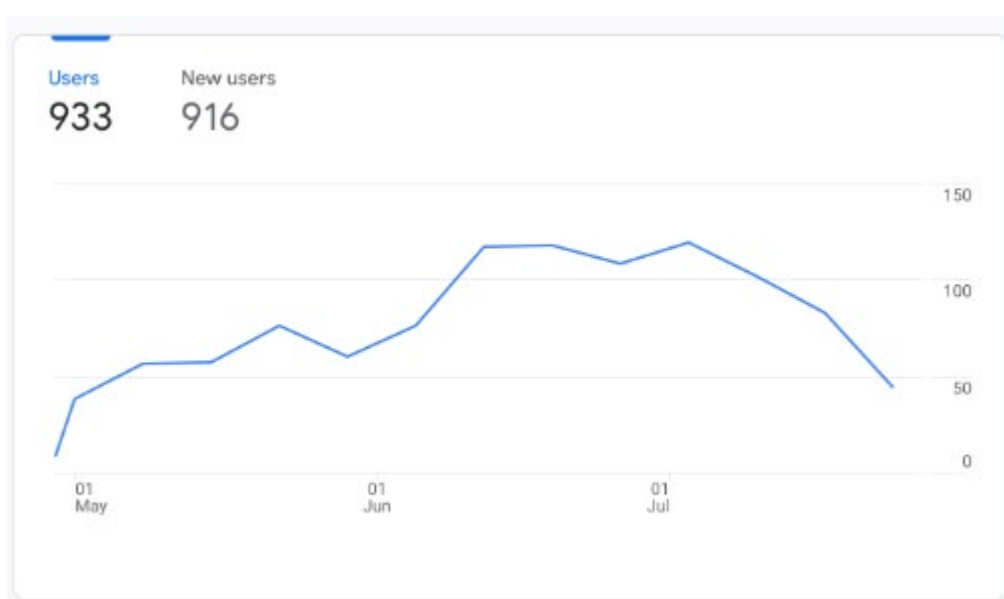
⁴ Statement of Use, at [Q7].

⁵ Exhibits 3 and 4.

periods to which these invoices relate. Use of the mark in this period must therefore be disregarded pursuant to section 46(3) of the Act.

- (f) Screenshots of what might be described as an ‘analytics’ page showing the level of engagement with RT’s website ‘73.today’ by way of the number of ‘clicks’ for the period June 2020 to 1 August 2022.⁶ There appear to have been 2,455 ‘clicks’ on the website for that period. However, these data relate to the three-month period prior to the revocation proceedings being instituted.

Also included is the following graph for the period 29 April – 27 July 2022:



This graph shows that there had been 916 new users in the above-mentioned period. Given that the total number of users is shown as 933, I infer that there were therefore just 17 users prior to 29 April 2022.

- (g) Mr Tarabrin states that in October 2022, RT participated in a job fair at Middlesex University and has provided 7 photographs and a write-up in support.⁷ RT’s ‘Noosphere’ mark does not appear in any of the photographs provided. The event post-dates the start of the revocation proceedings, in any event, and use of the mark on this date cannot, therefore, be taken into account in my assessment of whether there has been genuine use of the mark.

⁶ Exhibit 5.

⁷ Exhibits 7 and 8.

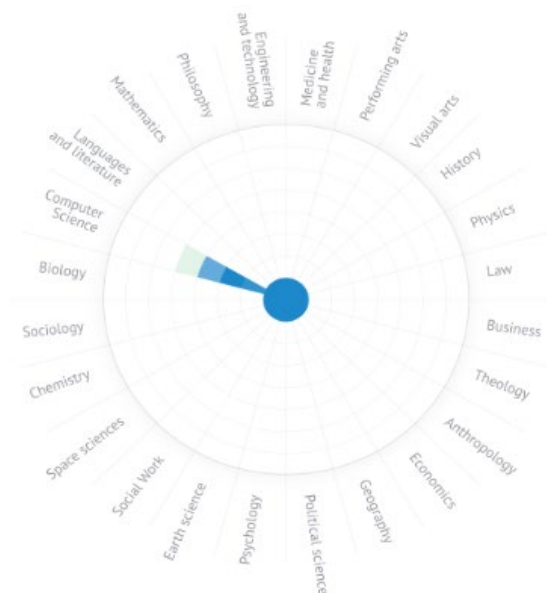
(h) Mr Tarabrin states that RT's mark has been present on its websites for the relevant period 18/08/2017 – 17/08/2022, but that he can only provide recent examples of this. Exhibit 11 comprises the following undated screen-shot of RT's website '37.today':

Find a good match

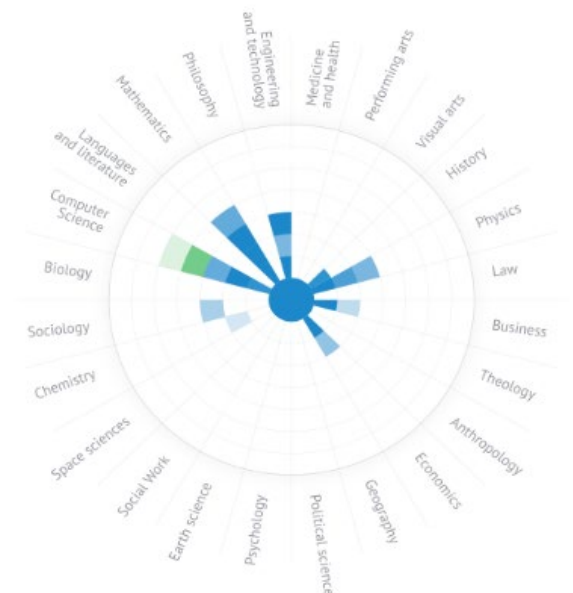
Visual comparison



Candidate requirements

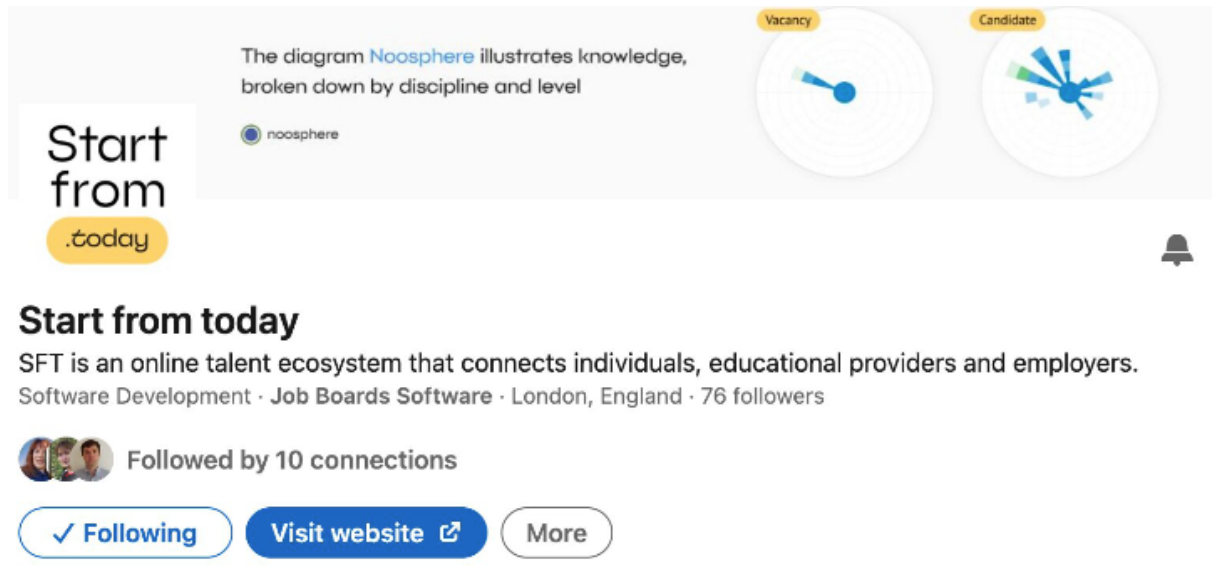


Candidate



I note that the 'Noosphere' mark is visible in the top right-hand corner of the page.

- (i) An undated screenshot from a social network platform called 'SFT' which describes itself as 'an online talent ecosystem that connects individuals, educational providers and employers' has been provided as follows:⁸



I note that the 'Noosphere' mark is represented in a small size and positioned to the left of the two diagrams.

- (j) Two letters have been provided, dated 25 January 2023 and 1 November 2022, respectively, in which the 'Noosphere' mark is visible at the footer. These letters post-date the filing of the application for revocation and, therefore, use of the contested mark on their faces cannot be taken into account.

19. 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

20. The screenshots from RT's websites are undated. However, Mr Tarabrin has given narrative evidence that the contested mark has been present on his websites since 2014, albeit that he has only been able to provide recent

⁸ Exhibit 12.

⁹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

examples. Some dated screenshots (for example, 'Wayback' prints) from each of the four relevant periods would have been useful and, given RT's statement that the marks have been present online consistently since 2014, would not, in my view, have been onerous to obtain. Furthermore, I consider that, in three of the screenshots provided, where the 'Noosphere' mark is positioned adjacent to the circular diagram or chart, a large proportion of average consumers would likely perceive the mark as merely the term to describe the type of diagram on the page, rather than as a trade mark. Some average consumers might presume the circle device with the blue infill to indicate some sort of key in relation to the blue sections of the diagrams. It is my view that the mark as presented would, for a significant proportion of average consumers, not immediately be perceived as a trade mark.

21. Mr Tarabrin has stated that no sales have been made to date. Although it is not imperative to provide evidence of sales in order to demonstrate genuine use, there must be genuine commercial exploitation of the mark. The only evidence of expenditure on promotional activity is in the form of invoices for Google adverts to promote RT's websites covering the period after which RT received notification that revocation proceedings against its mark were imminent (3 February 2022) and within the 3 months preceding the filing of the application for revocation. Although Mr Tarabrin has stated that over £1.5 million and 10 years of research and development have been spent on the development and promotion of the Noosphere trade mark, the only examples provided relate to the 3 months or so prior to the commencement of revocation proceedings (22 August 2022), or dates thereafter.

22. As noted above at f), the 'analytics' graph provided indicates a noticeable increase in new users of the '73.today' site in the three months prior to the filing of the application for revocation, i.e from 17 users to 916 between 29 April and 27 July 2022. No evidence relating to the number of users has been provided for any dates outside of this period.

23. The evidence provided has been scant. That which has been filed is either undated, or focused on dates, either within the 3-month period preceding, or

within the period post-dating, the commencement of the revocation proceedings. PIPL notified RT of pending proceedings on 3 February 2022. It is my view that, the totality of the evidence provided does not succeed in demonstrating that the contested mark has been put to genuine use in any of the four relevant five-year periods, for any of the services in respect of which the mark is registered.

Conclusion

24. The application for revocation of registration UK00003011539 has succeeded in full. Subject to any successful appeal, the mark will be revoked for all of the services in respect of which it is registered, with an effective revocation date of 12 October 2018. This date precedes the date on which PIPL applied for registration of the mark to which the related opposition proceedings relate (18 December 2020). Consequently, RT may not rely on its registration UK00003011539 as an earlier mark for the purpose of the opposition. The opposition therefore falls away and, subject to any successful appeal, the application UK00003569618 may proceed to registration in full.

COSTS

25. PIPL is the successful party and is entitled to a contribution to its costs based upon the scale published in Tribunal Practice Notice 2/2016, calculated as follows:

Filing of Application for Revocation	£200
Consideration of Opposition pleadings and preparation of Defence and Counterstatement	£300
Consideration of the other side's evidence	£200 ¹⁰
Preparation of written submissions in lieu of a hearing	£300
Total:	£1,000

¹⁰ A sum below the threshold has been awarded because PIPL did not file evidence and the evidence filed by RT was fairly scant.

26. I therefore order Roman Tarabrin to pay to PIPL Limited the sum of £1,000. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of October 2023

N. R. Morris

**For the Registrar,
the Comptroller-General**