

O/1060/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. UK00003765421 AND UK00003765413

BY EAGLE INTERNATIONAL LOGISTICS LTD

TO REGISTER THE TRADE MARKS:



AND

**Eagle International**

IN CLASSES 35, 36, 49 AND 42

AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO

UNDER NOS. 433811 AND 433938

BY TRANSIT FRUITS

## BACKGROUND AND PLEADINGS

1. On 14 March 2022, Eagle International Logistics Ltd (“the applicant”) applied to register the following trade marks, in the UK:



UKTM no. 3765421  
 (“the First Application”)

Eagle International  
UKTM no. 3765413  
 (“the Second Application”)

(together “the applications”)

2. The applications were published for opposition purposes on 25 March 2022 and 1 April 2022, respectively. Protection is sought for the services set out in the Annex to this decision.

3. On 25 May 2022 and 1 June 2022 respectively, the applications were opposed by TRANSIT FRUITS (“the opponent”) based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act). Under sections 5(2)(b) and 5(3) of the Act, the opponent relies upon the following trade mark:



UKTM no. 911998441

Filing date 19 July 2013, registration date 11 December 2013

Priority date: 19 April 2013 (French TM no. 13999405)

Relying upon all services for which the mark is registered, namely:

Class 39 Arranging of maritime transport; Transport agents; Logistic services in the transport sector; Freight forwarding; Freighting; Providing of information and consultancy relating to maritime transport.

4. Under section 5(2)(b), the opponent claims that the marks are similar and the services are similar, with the result that there is a likelihood of confusion.

5. Under section 5(3), the opponent claims a reputation for the services listed above and submits that use of the applications would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character and/or repute of the earlier mark.

6. Under section 5(4)(a), the opponent relies upon the sign EAGLE which it claims to have been using throughout the UK since 2008 in relation to the same services listed in paragraph 3 above.

7. The applicant filed counterstatements denying the claims made and putting the opponent to proof of use.

8. The proceedings were consolidated pursuant to Rule 62(1)(g) of the Trade Marks Rules 2008 on 20 July 2022.

9. The applicant is represented by The Trademark Helpline and the opponent is represented by Dummett Copp LLP.

10. Both parties filed evidence in chief. The opponent also filed written submissions in reply. Neither party requested a hearing, and neither filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE AND SUBMISSIONS**

11. The opponent filed evidence in chief in the form of the witness statement of Yann Le Cozic dated 9 September 2022, which is accompanied by 10 exhibits. Mr Le Cozic is the Managing Director of the opponent.

12. The opponent's evidence in chief was accompanied by undated written submissions which were filed on 20 September 2022.

13. The applicant filed evidence in the form of the witness statement of Steve Dobson dated 19 December 2022, which is accompanied by 3 exhibits. Mr Dobson is the representative of the applicant in these proceedings.

14. The applicant's evidence was accompanied by written submissions dated 19 December 2022.

15. The opponent filed undated written submissions in reply on 13 March 2023.

16. I have taken the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

## **RELEVANCE OF EU LAW**

17. 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**

### **Sections 5(2)(b) and 5(3)**

18. Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

19. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

20. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause

would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

21. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

22. The trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had completed its registration process more than 5 years prior to the filing dates for the applications in issue, it is subject to the use provisions under section 6A of the Act.

### **Proof of use**

23. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

“(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.”

24. Section 100 of the Act states that:

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

25. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the date of the applications in issue i.e. 15 March 2017 to 14 March 2022. As the earlier mark is a comparable mark, pursuant to paragraph 7 of Part 1, Schedule 2A of the Act, use in the EU (including the UK) will be relevant for the period up to and including IP Completion Day i.e. 31 December 2020. After that date, only use in the UK will be relevant.

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

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno 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 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].”

27. 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, therefore, not genuine use.

28. I note the following from the opponent’s evidence:

- a) The opponent is a transport company which operates 9 vessels.

- b) The opponent transports perishable goods, primarily between Europe and Africa.
- c) The earlier mark appeared on the opponent's website in July 2019.<sup>1</sup> The web address visible is [www.transitfruits-eagle.com/en](http://www.transitfruits-eagle.com/en) and the page is available in two languages: English and French (the page displayed is in English).
- d) The opponent is listed as a partner of a business called ELOIS Belgium, but the webpage is undated and there is no information provided as to when this partnership began.<sup>2</sup>
- e) The opponent imports and exports goods to ports including Portsmouth (UK), Antwerp (Belgium), Port Vendres (France) and Vado (Italy).<sup>3</sup> However, no specific information is provided as to when the opponent began operating via these ports. I note that Mr Le Cozic does state (elsewhere in his evidence) that the opponent began operating in the UK in 2008, and there is also reference to the port of Dover being used in 2015.<sup>4</sup>
- f) Photographs of the opponent's stand at an event in Marseille in France have been provided.<sup>5</sup> However, this is before the relevant period.
- g) Various copies of the opponent's "General Conditions" have been provided, including for 2019 and 2020.<sup>6</sup> No information is provided as to whether any of these had been issued to customers located in the relevant jurisdiction during the relevant period (or how many).
- h) Examples of advertising in third party publications have been provided.<sup>7</sup> For some of these it is not clear to me what publication they have been placed in

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<sup>1</sup> Exhibit 2

<sup>2</sup> Exhibit 3

<sup>3</sup> Exhibit 4

<sup>4</sup> Exhibit 6

<sup>5</sup> Exhibit 5

<sup>6</sup> Exhibit 6

<sup>7</sup> Exhibit 7

and the last example is undated. However, there are examples of adverts placed in a publication called *L'Atenne* in 2011, 2013 and 2016. All of these pre-date the relevant period and no information is provided about circulation figures for this publication.

- i) Mr Le Cozic states that the opponent has transported the following numbers of pallets between Europe and Africa:

2019	67,296
2020	84,816
2021	94,301

- j) In 2021, Mr Le Cozic states that the opponent's vessels called at Portsmouth 52 times, importing over 1,900 containers and exporting over 568 containers. This amounted to a total turnover of €8.7million.

- k) A list of invoiced amounts has been provided, but no information is given as to the location of the customers to which the invoices have been issued.<sup>8</sup> Mr Le Cozic states:

"A similar level of activity would have been carried out in respect of the UK in other years. Further, the data above relates on [sic] to the UK. Similar, or greater, levels of activity and turnover would be applicable to other European ports before the end of the Brexit transition period."

However, whilst Mr Le Cozic appears to categorize these invoices as relating "to the UK", the connection appears to be that the shipment involved the port of Portsmouth, as identified in the exhibit itself.

- l) The evidence includes "Bill of Lading" documents which display the earlier mark.<sup>9</sup> A number of these documents are dated outside the relevant period and, consequently, will not be of assistance to the opponent in demonstrating

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<sup>8</sup> Exhibit 9

<sup>9</sup> Exhibit 10

genuine use. The port of discharge for the vast majority is Portsmouth. I note that a large number of the “shippers” are located in Africa. There are also examples of “shippers” in the UK/EU during the relevant period (taking account of IP Completion Day), such as The Netherlands (one each in 2017 and 2018), France (2017), UK (one in each of 2018, 2019, 2020 and 2021), France (2019), Denmark (2020) and Poland (2022). The majority of the consignees are located in the UK.

m) I note that there is also a cargo manifest from April 2017 which identifies the “shipper” as located in France and a Booking Confirmation issued to a customer located in Dublin in May 2021.<sup>10</sup> Clearly, the latter relates to an EU booking after IP Completion Day and, consequently, will not assist in demonstrating proof of use.

29. The fact that the opponent has been involved in shipping goods into (or out of) Portsmouth (or any other EU/UK port) is not, in my view, sufficient to demonstrate an attempt to create or maintain a market for its services in the relevant jurisdictions. The use of a port in a particular jurisdiction does not demonstrate an attempt to secure customers in that jurisdiction or demonstrate that potential customers in that jurisdiction would have been exposed to the earlier mark.

30. The only concrete evidence that I have before me to identify that the opponent has actively been using its mark in the UK/EU during the relevant period is the Bill of Lading/Booking Confirmation documents which identify the opponent as having customers located here. It seems to me that there are two customer groups for the opponent’s services: 1) the party that engages the opponent to transport its goods from one location to another, and 2) the recipient of those goods. Clearly, the opponent has customers in the UK/EU, because the Bill of Lading documents identify the vast majority of consignees as being located in the UK/EU (as well as a handful of “shippers”). However, the test for establishing genuine use is not whether the opponent has customers in the UK/EU; it is whether there has been real commercial

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<sup>10</sup> Exhibit 9

exploitation of the mark to create or maintain a market in the relevant jurisdiction for the relevant services during the relevant period.

31. I have scant evidence before me about the way in which customers engage the opponent's services. It seems likely to me that the "shippers" identified in the Bill of Lading/Booking Confirmation documents would have directly engaged with the opponent in order to purchase its services for the purposes of shipping their goods from one location to another. I am prepared to infer that they would have viewed the earlier mark on the opponent's website or in advertisements prior to securing its services for the shipment of their goods. However, I have no information before me as to how the "consignees" referred to in the Bill of Lading documents would have come into contact with the earlier mark (if at all). Perhaps they would have seen it on the opponent's containers/vessels? Perhaps they would have seen it on crates used to deliver the goods to them? Perhaps they would have seen it on the side of vehicles that transfer the goods from the opponent's vessels to the consignee's premises? However, there is simply no evidence on this point before me. In the absence of such evidence, I am not prepared to make an inference that the consignees would have come into contact with the earlier mark at all. I acknowledge, of course, that the earlier mark (or a variant thereof) appears on the Bill of Lading/Booking Confirmation documents themselves. However, again, I have no evidence before me as to whether the consignee would have had sight of these documents and, in the absence of such evidence, I am unable to find that they would.

32. I have, therefore, only the very limited number of "shippers" located in the UK/EU that I can identify as having been exposed to the earlier mark during the relevant period. It seems to me that it should have been straightforward for the opponent to provide evidence as to how customers within the relevant jurisdictions would have encountered its mark and/or details of the number of customers located within the relevant territories engaged its services. I bear in mind that the burden of proving genuine use is on the opponent. In the circumstances, I do not consider the evidence to be sufficient to demonstrate that the opponent has made real commercial exploitation of the mark in the UK/EU during the relevant period for the services relied upon.

33. As the opponent has failed to prove use of the earlier mark, the oppositions based upon sections 5(2)(b) and 5(3) of the Act are dismissed.

**Section 5(4)(a)**

34. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

35. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

36. I can deal with this ground relatively swiftly. I have summarised the opponent’s evidence of use above. In order to establish goodwill in the UK (which is the relevant territory), the opponent must be able to demonstrate the presence of customers in the

UK.<sup>11</sup> I have evidence of “shippers” located in the UK by virtue of four Bill of Lading documents, one each for the years 2018, 2019, 2020 and 2021. I also have evidence of “consignees” located in the UK, who I also consider to be customers of the opponent as they would have benefitted from the opponent’s transport service by receiving the required goods. However, I have no evidence of promotional activities taking place in the UK and no information regarding overall customer numbers. I have no evidence before me that recipients of the opponent’s services (i.e. the consignees) would actually have come into contact with the sign relied upon. Consequently, even if I found that the opponent had a protectable goodwill in the UK at the relevant date due to the presence of customers (mostly being consignees) in the UK, I am not satisfied that the sign relied upon would have become distinctive of that goodwill, because there is simply not enough evidence of it having been used in the UK.

37. The opposition based upon section 5(4)(a) of the Act is dismissed.

## **CONCLUSION**

38. The oppositions are dismissed, and the applications may proceed to registration.

## **COSTS**

39. As the applicant has been successful it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,650**, calculated as follows:

Preparing a counterstatement and considering the Notice of opposition (x2)	£450
Preparing evidence and considering the opponent’s evidence	£850
Written submissions	£350

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<sup>11</sup> Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others, [2015] UKSC 31

**Total**

**£1,650**

40. I therefore order TRANSIT FRUITS to pay Eagle International Logistics Ltd the sum of **£1,650**. 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 7<sup>th</sup> day of October 2023**

**S WILSON**

**For the Registrar**

## ANNEX

### Class 35

Administrative services relating to customs clearance; Import-export agencies; Import agency services; Export and import agencies; Export-import agency services; Import and export agencies; Goods import-export agencies; Import and export services; Import-export agency services; Advisory and consultancy services relating to import-export agencies.

### Class 36

Financial customs brokerage services; Arranging the collection of customs duties; Arranging the return of customs duties; Arranging the payment of customs duties.

### Class 39

Road freight services; Tracking of passenger or freight vehicles by computer or via GPS; Express delivery of freight; Freight and cargo transportation and removal services; Forwarding agency services; Forwarding of goods; Freighting; Freight services; Freight transportation; Freight shipping; Freight forwarding; Freighting services; Marine freighting; Collection of freight; Freight transportation services; Air freight transportation; Rail freight services; Freight-forwarding services; Freight train transport; Road freight services; Land freight services; Transportation of freight; Packing of freight; Sea freight services; Freight forwarding by air; Freight forwarding by land; Freight and cargo services; Freight forwarding between seaports; Air transportation of freight; Rail freight distribution services; Air freight shipping services; Freight transportation by air; Freight forwarding agency services; Sea freight forwarding services; Freight forwarding by sea; Freight [shipping of goods]; Transportation of freight by land; Transportation by air of freight; Air transportation services for freight; Transportation of freight by water; Cargo handling and freight services; Transportation of freight by road; Transportation of freight by air; International air freight shipping services; International ocean freight shipping services; Transport of freight by air; Transport of freight by rail; Services for freightforwarding by air; Services for the transportation of freight; Services for freight-forwarding by land; Transport of freight containers by lorry; Transport of freight containers by rail; Transport of freight containers by ship; Services for freight-

forwarding by sea; Arranging for the transport of air freight; Cargo forwarding services; Brokerage (Freight -); Freight brokerage; Freight transportation brokerage; Freight brokerage services; Freight and transport brokerage; Transport and freight brokerage; Services of a freight broker; Freight and transport brokerage services; Transport and freight brokerage services; Providing information relating to freight brokerage; Providing advice relating to freight forwarding services; Provision of information relating to the transport of freight; Aircraft charter brokerage; Air charter brokerage services; Aircraft chartering; Aircraft chartering services; Hauling services; Road haulage services; Road haulage services for containers; Shipping agency; Ocean shipping; Airline and shipping services; Shipping; Shipping services; Arranging the shipping of goods; Arranging for the shipping of cargo; Rental of storage containers; Rental of storage units; Rental of storage facilities; Rental of storage space; Rental of containers for warehousing and storage.

#### Class 42

Provision of information, advice and consultancy in relation to carbon offsetting.