

O-126-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2483908
BY JASON WRIGHT TO REGISTER THE TRADE MARK**

tfl

IN CLASSES 42 AND 45

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 98034
BY TRANSPORT FOR LONDON**

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By Jason Wright to register the trade mark

tfl

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IN THE MATTER OF Opposition thereto under No. 98034

by Transport For London

BACKGROUND

1. On 7th April 2008, Jason Wright of 53 Thetford Close, Woodthorpe View, Arnold, Nottingham, Nottinghamshire NG5 6PH (hereafter “Mr Wright”) applied to register the mark, “tfl”, in Classes 42 and 45 for the following list of services:

Class 42

Operating search engines; providing search engines for the internet; website hosting services.

Class 45

Compilation, creation and maintenance of a registry of domain names; domain name management services.

2. The application was published on 4th July 2008 and on 6th October 2008 Transport For London of Windsor House, 42-50 Victoria Street, London SW1H 0TL (hereafter “Transport”) lodged an opposition against all services specified.
3. Transport have an earlier mark, 2251513, the details of which are as follows:

Mark	Filing and registration dates	Goods and services relied upon under section 5(2)(a)
TFL	6 th November 2000 and 31 st August 2001	Class 9 Computer software, including software supplied from the Internet; electronic publications (downloadable) provided on-line from

		<p>a database or the Internet; computer software to enable the searching of data.</p> <p>Class 37</p> <p>Installation and maintenance of services relating to telecommunications, computer systems, transport systems, fault recovery and maintenance services.</p>
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4. Transport has based its opposition on the following sections of the Trade Marks Act 1994 (hereafter “the Act”):

Section 5(2)(a) – in that Transport say the mark applied for is identical to their earlier mark and the services applied for are similar to the relevant goods and services for which the earlier mark is registered, such that there is a likelihood of confusion;

Section 5(3) – in that Transport’s earlier mark has a reputation for all the goods and services for which it is registered (ie not just those goods and services specified in the table above), and use of Mr Wright’s mark would be detrimental to the distinctive character of that earlier right. The full specification of 2251513 appears as Annex A to this decision. The specific claim is that use of Mr Wright’s mark will ‘dilute’ Transport’s earlier mark. Transport say that ‘Transport for London’ was created in July 2000 to manage the majority of transport services in London, including buses, underground, Docklands Railway as well as managing the Congestion Scheme and 580km of roads. Transport for London is commonly known by the acronym, ‘TFL’ or ‘TfL’, and is referred to as such on the internet, at stations and on vehicles, on tickets and in relation to Transport’s OYSTER card scheme, on maps and on advertising. Transport’s website is www.tfl.gov.uk and if the letters “TFL” are typed into GOOGLE, Transport’s website is the first to be revealed.

Section 5(4)(a) – in that Transport has used the mark TfL in relation to a wide range of goods and services since 2000. The mark TfL is well known in London and throughout the country as being the abbreviated name for Transport For London. Use by Mr Wright of an identical mark in relation to the services sought to be protected would be connected to Transport and would damage Transport’s

reputation and goodwill in the mark. Thus, registration of the application should be refused on the basis that use of the mark applied for would amount to 'passing off'.

5. Mr Wright filed a counterstatement denying all the grounds of the opposition. He says that other proprietors notified of his application had not opposed. He notes the application is in lower case rather than upper and that Transport's mark is registered in completely different classes to his own and therefore, he says, no likelihood of confusion can arise. In relation to the section 5(3) claim, he notes that Transport's mark is a random three letter mark and not a real word. Previous opposition decisions have concluded that such marks are not highly distinctive. He also says that such distinctiveness as the opponent has in their mark is closely tied to its field of activity and so it is unlikely to suffer dilution. Moreover, the earlier mark relied upon is far from unique or exclusive to the opponent and in support of this, printouts from the UK Registry's database of marks using the letters 'TFL' are annexed. In addition, he says his research on GOOGLE™ has revealed a wide range of undertakings using the letters TFL. Finally, in relation to the section 5(4)(a) claim, he says that this claim too should be dismissed for the reasons given in connection with the other grounds; it adds nothing further to the case.
6. Mr Wright puts Transport to proof of their use of the earlier mark.
7. Evidence has been filed by Transport which I shall summarise below. No evidence has been filed by Mr Wright. Neither party has requested a hearing and instead, both parties are content for a decision to be issued based on the papers. Both parties request costs.

Opponent's evidence

8. This is in the form of a witness statement dated 19th August 2009 by David Ellis, who is Head of Intellectual Property Development for Transport. As Transport's attorney's state, the witness statement is primarily aimed at establishing that the earlier mark has been in genuine use for the relevant five year period and in respect of the goods and services relied upon for the opposition. In other words, the primary purpose of the evidence is to support the section 5(2)(a) grounds of opposition rather than the other grounds.
9. Mr Ellis details the history of Transport, more or less as I have outlined in my introduction. He then goes on to seek to demonstrate that the letters 'TFL' or 'TfL' have become synonymous and interchangeable with 'Transport For London'. Exhibit DE1 is a Factsheet giving information on Transport. Published in July 2009, it contains at the

beginning the longer name, 'Transport for London', but this is then abbreviated throughout, to the letters 'TfL'. Exhibit DE2 is a print out from a GOOGLE™ search on the letters 'tfl' in lower case. The results show the top four sites listed in the search appear to relate to Transport's website, www.tfl.gov.uk, these include the main 'Home' site, as well as information on the tube to be found at www.tfl.gov.uk/tube, and a journey planner at tflwap.gov.uk'. Exhibit DE3 shows results of a search on 'tfl' on the websites of 'THE TIMES', 'THE EVENING STANDARD' and 'THE SCOTSMAN'. These show the letters 'TfL' in consistent and constant use in respect of a variety of news stories over the period May 2003 through to March 2009 (in the case of THE TIMES), in 2008 and 2009 in the case of THE EVENING STANDARD, and so far as I can ascertain, between 2007 and 2009 in THE SCOTSMAN.

10. Exhibit DE4 is an extract from the well known user generated website WIKIPEDIA and shows the letters 'TFL' as shorthand for 'Transport For London'.
11. Exhibit DE5 is a copy of the 'Home' page for the website www.tfl.gov.uk. Mr Ellis says that the website is one of the top 100 most used websites in the UK with over 30 million unique visitors each year. It is the second website to appear if the letters 'TFL' (upper case) are typed into GOOGLE™ (Exhibit DE6). One of the hits relates to Transport's 'wap' services at wap.tfl.gov.uk'. Exhibits DE7 and DE8 comprise internal records and third party statistics showing the usage of the website. Exhibit DE9 is a series of leaflets available at underground stations showing use of the letters 'tfl' in the context of reference to the website, www.tfl.gov.uk, or more usually 'tfl.gov.uk'. There is no reference to 'TFL' or 'TfL' solus.
12. Mr Ellis then goes on to address the issue of use in relation to the specific goods and services relied upon in Classes 9 and 37. Exhibit DE10 shows examples of downloadable publications available from their website. One of these publications, entitled TRAMLINK, refers in its introduction to trams being part of the 'TfL family'. Otherwise, there is no reference to 'TfL' or 'TFL' other than as part of the website. Over 10 million tube maps were downloaded in 2008, along with 69,713 Night Bus maps. LONDON LOOP is an e-zine, also downloadable from the website along with a brochure on river transport services and tramlink services. As I state, these maps and brochures invariably contain the letters 'tfl' as part of the website designation www.tfl.gov.uk, or more usually 'tfl.go.uk'.
13. At Exhibit DE13 there is a print out from a journey planner, available and accessible from Transport's website which enables users to plan

journeys by multiple mode in and around London. The printout only shows use of the longer name Transport for London, accompanied by the familiar circular device with latitudinal bar across the centre.

14. He also says that in 2003 Transport introduced OYSTER cards, an example of which is shown at Exhibit DE14, in relation to their transport systems. OYSTER cards are used to implement a pre-paid ticket scheme operated by Transport and are used at underground stations, Docklands Light Railway (DLR) stations and certain national rail stations. This exhibit shows on the reverse of the card, that the card is issued subject to "TfL's Conditions of Carriage". Exhibit DE15 is a leaflet on use of the OYSTER card, published in 2006. An application form contained in the brochure refers to a data protection statement referring to "Transport for London (TfL)". Exhibit DE16 is a downloadable guide on the OYSTER card, published in January 2009, showing reference, eg to the website 'tfl.gov.uk/oyster', but there is no use of 'TFL' or 'TfL' solus. Mr Ellis says that software used to operate OYSTER is unique to Transport. In addition, OYSTER cards are known as being specifically for use on Transport's systems.
15. Exhibit DE17 shows photographs of service vehicles, being a bus breakdown vehicle and a 'Community Safety Enforcement and Policing' vehicle. It is unclear whether these vehicles have the letters 'TFL' or 'TfL' on them but certainly as far the bus breakdown vehicle the words 'London Buses' appear, together with the familiar circle and latitudinal bar device.
16. Exhibit DE18 shows a road maintenance vehicle bearing the letters 'tfl', again as part of the website www.tfl.gov.uk. Exhibit DE19 comprises photographs of a Transport For London CCTV vehicle, again showing the letters 'tfl' as part of the website address.
17. Finally, Exhibit DE20 shows examples of billboard posters used to update passengers on maintenance and repair services at stations where work is going on. These include the website address, including 'tfl'. Similarly, electronic updates are also available from the website as publications (Exhibit DE21).

DECISION

Proof of use

18. The Trade Marks (Proof of Use, etc) Regulations 2004 apply in respect to the Section 5(2) (b) grounds of this case. The provision reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(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), (b) 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

...

(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...”

19. With a registration date of 31st August 2001, it is clear that under Section 6(1) of the Act, Transport's mark is an earlier trade mark. Further, as it completed its registration procedure more than five years before the publication of the contested mark (being 4th July 2008), it is subject to the proof of use requirement set out in section 6A of the Act. The relevant 5 year period ends on 4th July 2008 and starts on 3rd July 2003.

20. Consideration has to be taken, also, of section 100 of the Act which states:

"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."

Consequent upon section 100, the onus is upon the registered proprietor to prove that it has made use of the trade mark in suit, or that there are proper reasons for non-use.

21. The basis of what constitutes genuine use was decided by the European Court of Justice (ECJ) in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] ETMR 85 at paragraph 47 ("*Ansul*"):

"1. Article 12(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that there is "genuine use" of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is 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, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark that is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods."

22. In *La Mer Technology Inc v Laboratoires Goemar SA* [2004] FSR 38, the ECJ considered the extent of use, the amount of use and the types of use that can be considered when deciding whether there has been genuine use of a trade mark:

“20. It follows from those considerations that the preservation by a trade mark proprietor of his rights is predicated on the mark being put to genuine use in the course of trade, on the market for the goods or services for which it was registered in the Member State concerned.

21. Moreover, it is clear from paragraph 39 of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive, even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed to be justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case-by-case assessment which is for the national court to carry out. The characteristics of those products and services, the frequency or regularity of the use of the mark, whether the mark is used for the purpose of marketing all the identical products or services of the proprietor or merely some of them, or evidence which the proprietor is able to provide, are among the factors which may be taken into account.

23. Similarly, as emerges from paragraphs 35 to 39 of *Ansul* set out above, the characteristics of the market concerned, which directly affect the marketing strategy of the proprietor of the mark, may also be taken into account in assessing genuine use of the mark.

24. In addition, use of the mark by a single client which imports the products for which the mark is registered 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 of the mark.”

23. In *Laboratoires Goemar S.A. v La Mer Technology Inc* [2005] ETMR 114, Neuberger LJ held that:

“45 The notion that the use of the trade mark must be substantial or

significant before it qualifies as "genuine" seems to me to run into two difficulties in any event. The first is that it does not involve attributing the word "genuine" its natural meaning, although this point of course potentially substantially weakened by the fact that the equivalent word used in the text in Art.10 in other languages may carry with it a slightly different meaning.

46 Secondly, once one imposes a requirement of significance or substantiality, it becomes potentially difficult, time-consuming, and expensive to decide whether, in any particular case, that requirement is satisfied. In this connection, Mr Tritton made a fair point when he suggested that the introduction of a test of significant use could lead to detailed arguments about the precise nature and extent of the market in which a particular trade mark is to be used, as well as a detailed enquiry in many cases as to the precise nature and extent of the use of the particular mark over the relevant five-year period. I do not regard that as a particularly desirable outcome.

47 Although the use of the instant mark within the jurisdiction can be said to be close to exiguous, I do not think it could be characterised as *de minimis*. Even if it could be so characterised, I do not consider that that concept would be a useful or helpful one to invoke or apply, even if it had not been effectively ruled out by the European Court.

48 I turn to the suggestion, which appears to have found favour with the judge, that in order to be "genuine", the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the Directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be "consistent with the essential function of a trade mark" as explained in [36] and [37] of the judgment in *Ansul*, it appears to me that genuine use for the purpose of the Directive will be established.

49 A wholesale purchaser of goods bearing a particular trade mark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted

by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler.”

24. In *The Sunrider Corp v Office for Harmonization in the Internal Market (TradeMarks and Designs) (OHIM)*, Case C-416/04 P, the ECJ stated:

“72 It follows that it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A de minimis rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order in *La Mer Technology*, paragraph 25). Thus, when it serves a real commercial purpose, in the circumstances referred to in paragraph 70 of this judgment, even minimal use of the trade mark can be sufficient to establish genuine use (order in *La Mer Technology*, paragraph 27).”

26 A further, helpful synthesis of the ‘legal learning’ from these cases has been provided in the appointed person case, *Sant Ambroeus* (BL O-371-09), as follows:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR 28 (*Silberquelle*) where relevant:

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

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services,

i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

Transport’s own use and what the evidence shows

27 Turning firstly to the evidence which shows that Transport themselves are using the letters ‘TFL’ as registered, or an ‘acceptable variant’ thereof. I should say that the words ‘acceptable variant’ admit that use may be found if “use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered” (Section 6A (4) of the Act).

28 Having carefully scrutinised the evidence, I have found the following examples of Transport's own use of the letters 'TFL'. I should just say Transport invariably use the form 'TfL' (with the letter 'f' in lower case), and so I will necessarily have to determine in due course whether use of a lower case 'f' alters the distinctive character of the mark as registered.

Transport's 'Factsheet' published in July 2009. Although this contains the longer name 'Transport for London', this is immediately abbreviated to 'TfL' and this is then used throughout the information sheet (Exhibit DE1);

the results of the GOOGLE™ search which shows for example use by Transport of the designation 'TfL' in relation to their OYSTER card (Exhibit DE2);

further results of a GOOGLE™ search showing use of 'TfL' in relation to 'wap' services (Exhibit DE6);

Transport's TRAMLINK brochure which refers in its introduction to trams being part of the 'TfL family' (Exhibit DE10);

the copy of the OYSTER card, stating on the reverse that the card is issued subject to "TfL's Conditions of Carriage" (Exhibit DE14);

a brochure, published in 2006, in respect of the OYSTER card and comprising an application form with a data protection statement referring to 'Transport for London (TfL)' (Exhibit DE15).

29 The evidence also shows use in the context of Transport's website, www.tfl.gov.uk, or, as is more commonly used on printed matter, 'tfl.gov.uk', without the 'www'. Such use can be seen not just on the internet and GOOGLE™ searches, but also in relation to printed (including paper, billboards and the sides of vehicles) matter such as, eg Exhibits DE9, DE18, DE19 and DE20.

Whether use in a domain name context or use as 'TfL' constitute 'acceptable variants' of 'TFL' as registered

30 As explained above, the law permits use of the mark "in a form differing in elements which does not alter the distinctive character of the mark as registered".

31. This test has been broken down by the appointed person in the *NIRVANA* case (BL O/262/06) as follows:

“33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

32. In formulating this test, the appointed person had regard to a number of authorities, both European and derived from the Courts of the United Kingdom. Amongst them was the decision of the Court of Appeal in *Bud/Budweiser Budbrau* [2003] RPC 25. Of relevance are the statements of Lord Walker of Gestingthorpe where he stated:

“43. ...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

‘Bare ruin’d choirs, where late the sweet birds sang’

is effective whether or not the reader is familiar with Empson’s commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of ‘whose eyes? - registrar or ordinary consumer?’ is a direct conflict. It is for the registrar, through the hearing officer’s specialised experience and judgement, to analyse the ‘visual, aural and conceptual’ qualities of a mark and make a ‘global appreciation’ of its likely impact on the average consumer, who:

‘Normally perceives a mark as a whole and does not proceed to analyse its various details.’

The quotations are from para [26] of the judgement of the Court of Justice in Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I- 3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance.”

33. Also of relevance are the comments, in the same decision, of Sir Martin Nourse; where he stated at paragraph 12:

“Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements....”

34. Clearly from the test enunciated by the appointed person in *NIRVANA*, it is perfectly possible for a consumer to register differences in the relevant marks or signs but that, of itself, would not be decisive of the question whether the sign in use differs in elements which do not affect distinctive character. That said, it is as well also to recall the key purpose behind the requirement to use in the form registered and in doing so, it can be seen that the interpretation given to this requirement has to be necessarily narrow. That is, to allow an opponent to properly rely on *variations* in the way in which the mark is used, when exploiting it commercially, for example so as to enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned, *provided* that the distinctive character of the mark remains the same: Court of First Instance (now General Court) Case T-194/03 *Il Ponte Finanziaria SpA v OHIM* at [50]. In this way, an opponent or proprietor can also avoid the need to register every different *variant* of his mark in which the differences do not alter its distinctive character. But variants that go beyond that test, even if the differences are only “slight”, will need to be registered separately to be protected: *BUD* at [22]-[23]; Case C-234/06P *Il Ponte Finanziaria SpA v OHIM* [2008] ETMR 13 at [86].
35. Ultimately, the rationale behind both requiring an opponent to use his or her mark in the form registered and in order to avoid revocation is the

same; to avoid unnecessary conflicts on the register. The first sentence of recital 9 of Council Directive 2008/95/EC (codified version) reads as follows:

“(9) In order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation.”

36. I must firstly consider use of ‘tfl’ in the context of a domain name or website address, namely www.tfl.gov.uk or ‘tfl.gov.uk’. In Case R 710/2002-2, (*Telefonica Moviles SA v Orbseal LLC (Telefonica)*), the Second Board of Appeal at the Office for Harmonization in the Internal Market (‘OHIM’) had a similar issue to decide. In this case the Board had to decide whether use of tsm.es constituted use of ‘TSM’ as registered. The Board concluded as follows:

“30. The Board shares the view that the evidence submitted is insufficient to prove genuine use of the opposing Spanish trade marks in Spain.

31. It appears that, as shown in the internet excerpts and the one from ‘ES-NIC’ database, ‘tsm.es’ is used as a domain name. However, use of a domain name does not equal use of a trade mark which forms a part of that domain name. The appellant argues that the component ‘tsm’ is the dominant element and the use, together with ‘.es’ does not change its distinctive character. *Firstly, if ‘tsm’ were used with a trade mark always with ‘.es’ this would alter it. One might expect ‘.es’ to be part of a domain name, but would normally not expect to find it in a trade mark.* [my emphasis] Secondly and more importantly, ‘tsm.es’ has not been used as a trade mark. All the evidence submitted, as pointed out above, refers to the use as a domain name. Even the Alta Vista search has been conducted using the search term ‘tsm.es’ rather than ‘tsm’ on its own. Contrary to the appellant’s contention, use as a domain name does not automatically imply use as a trade mark.”

37. Of course, OHIM Board of Appeal decisions are not binding upon the Registrar, but nonetheless this case provides a useful starting point from which to start the analysis. It is important to note that, inevitably, the evidence before the Board was different to the evidence before me. Most particularly, it is noted that as far as the search results in the case before the Board were concerned, they related to the letters ‘tsm.es’ and were criticised on that basis, ie that they included the top level domain name ‘es’. In the case before me the search results put in evidence were simply

'tfl', or 'TFL', without any other indicators. Secondly however, there is the proposition, emphasised by me above, that if the only use was with '.es' then that would 'alter' in some way the 'TSM' mark as registered. That 'alteration' is assumed from the next sentence to relate to the fact that one would assume '.es' to be part of a domain name, but would not normally expect to find it in a trade mark.

38. In the case before me, the mark as registered is simply a three letter mark 'TFL', with no other matter. In Transport's use, the sign used is www.tfl.gov.uk or 'tfl.gov.uk'. The differences between the respective designations are obvious, in that the signs in use are in lower case, and much more importantly, contain other matter, consistent with use as a domain name:- www, gov, and uk spilt up with the dot character. The designation 'gov' will indicate that the owner is connected with a government authority, and 'uk' will indicate that the owner is based in the UK. Given the length of its full title, 'Transport for London', it is unsurprising that Transport should have registered and used an abbreviated version, 'tfl', for use in internet browsers. Can those additional domain name elements be ignored for the purposes of deciding whether the sign in use differs in elements which do not alter distinctive character? My view is they cannot. If an applicant opts to register his mark as a random three letter mark *solus*, then he does not thereby acquire 'protection' or be able to rely upon use in the context of a domain name. Such use is not in my view, 'acceptable *variant*' use, but rather placing the mark as registered in an instantly recognisable, but different context altogether, from randomly chosen letters, namely that of a domain name. I would just add that, in terms of the underlying purpose behind the requirement to use the mark as registered, or an acceptable variant thereof, namely to reduce the number of unnecessary conflicts on the register, this would be significantly undermined if a proprietor could rely upon domain name use (including, potentially, with a host of different gTLDs) to support use of a non-internet related mark.
39. I am reinforced in my conclusion that use of 'tfl.gov.uk' or www.tfl.gov.uk is *not* use in a manner which does not alter the distinctive character of the mark as registered when I have regard to authorities based on another provision in the Act, namely the requirements in the UK regarding the registration of series marks. The view that the two provisions (section 41(1) (in connection with series) and section 46(2) (in connection with revocation on the basis of non-use and by definition, the requirement to show genuine use in an opposition) are essentially similar, if not entirely analogous, has been raised in, eg the appointed person's decision in *LOGICA* (BL O/68/03) (see para 6 and para 39(i) to that effect). In that case the appointed person, relying on or at least drawing upon guidance from Australia (para 42), concluded at para 44 that the word only, *LOGICA*, could not be regarded as a series with any of the other marks,

containing as they did domain name indicators. It is important to recognise in this case that an argument based on the fact that domain name indicators are purely non-distinctive (just as the designations, 'Ltd' or 'plc' are), and so their inclusion has no impact upon the average consumer's perception is not accepted by the appointed person. The key question in relation to series, is whether their inclusion substantially affects the overall identity of the mark and on that point, the appointed person was in no doubt in the *LOGICA* case. **In the same way, I have no doubt that use of www.tfl.gov.uk or 'tfl.gov.uk' is *not* use of the registered mark 'TFL' in a way which differs from the registered trade mark in elements which do *not* alter the latter's distinctive character.**

40. Moving, secondly, onto the question whether use of 'TfL' constitutes use of 'TFL' in a way which does not alter the distinctive character of 'TFL'. This is plainly an assessment that must be done on a case-by-case basis. I am aware that in, eg, Case T 147/03 *Devinlec Développement Innovation Leclerc SA v OHIM*, the CFI (now the General Court) upheld the Board of Appeal's view that in the particular case, differences in typeface and stylisation did not alter the distinctive character of the particular mark as registered. The view expressed in that case cannot however be expressed as a legal principle, namely that, eg all differences in typeface will not alter the distinctive character of the mark in which form it is registered. In that case, the respective marks were word marks. In this case the upper case letters 'TFL' are registered. When viewed in isolation and without assuming prior knowledge, to the average consumer this mark will comprise three randomly chosen letters, and that is an expression also of the distinctive character of the mark as registered. As the letters have no meaning of themselves, it is quite likely that the average consumer will assume that it is an acronym or abbreviation for something else. The fact that the middle letter, 'f', is in lower case would not in my view alter the distinctive character of the mark as registered. Firstly, it is plainly a letter 'f', whether in lower or upper case. Unlike certain letters whose identity may be uncertain in lower case, eg the letter 'L' in lower case, being 'l', could possibly be seen as an upper case 'l', no such confusion is likely with the letter 'L'. Secondly, the fact that it is in lower case may well suggest or reinforce to the average consumer that the overall mark is an abbreviation or acronym with the letter 'f' being short for a 'secondary' or 'linking' word between whatever the 'T' stands for and whatever the 'L' stands for. But crucially, it does not alter the distinctive character of the mark as registered, being, as I have said, the randomly chosen three letters 'TFL', in that order. **For these reasons, I conclude that use by Transport of the mark 'TfL' does constitute an acceptable variant of 'TFL' as registered.**

Conclusions on genuine use

31. I have found above that use by Transport of 'TfL' does constitute an acceptable variant of 'TFL', as registered. Looking at that use I need to determine whether, in respect of all the other factors and case law, such use may be considered to be 'genuine'. As is clear from their 'Factsheet', Transport operate public transport services, including trams, river transport, buses, and rail, in and around London. Transport's operation is huge by any standards; for example the 'Factsheet' refers to two billion passenger trips on 8,000 buses in the year to March 2009 and one billion customer journeys on the tube in 2008/2009. Government funding for investment, agreed in Feb 2008, is put at £40bn for projects up to 2017. I am left in no doubt that Transport's business, and the business in relation to which they use the sign 'TfL', is that of the provision of a wide variety of public transport services in and around London. In connection with that business, inevitably they provide information services connected with (and ancillary to) their own operation and these can be accessed through a variety of different media, such as the internet and more traditional printed media including, eg pamphlets and billboards. The evidence they have provided of their own use of 'TfL' is not strong by any means, but I am nonetheless prepared to accept that Transport themselves use 'TfL' in some of their dealings with the consumer and in connection with their public transport operation, as I have detailed in para 28 above from the evidence. I say the evidence is not strong for a number of reasons; there is a lack of turnover figures, no context is provided in terms of the overall market share in the goods and services in respect of which they use 'TfL', the evidence is 'diluted' by third party references which I shall discuss below, and finally, in at least five out of the six examples of use of 'TfL', detailed in para 28 above, they appear to comprise publications and searches made *outside* the relevant period during which use must be shown. As regards the last weakness, I have had to make an assumption that the evidence put forward is illustrative of Transport's use *during* the relevant period, and thus it cannot simply be dismissed for being 'out of time'.
32. Given the high profile nature of their business, its size, its 'political' dimension and its overall impact (including economic), it is not surprising that the approach Transport take in this case is primarily to seek to demonstrate that the letters as registered 'TFL' or 'TfL' are, or have become, synonymous with 'Transport for London'. It is understandable that Transport may wish to take such an approach as such an organisation will inevitably, and as the evidence proves, be newsworthy. In other words, journalists, politicians and others will wish to refer to the organisation and in doing so, will adopt the 'norms and customs' of their own trade, one of which is undoubtedly, and for reasons of economy, to

- refer to, eg organisations (especially those having cumbersome and long winded ‘proper’ versions) in abbreviated form. This cannot constitute ‘genuine use’ for my purposes as it is not by the *proprietor* and nor is it in the course of trade, that is by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [paras 37 and 38]; *Silberquelle*, [para 18].
33. As I say, strictly speaking and for the purposes of these proceedings, Transport is not entitled to rely upon third party use, such as the reports from ‘THE TIMES’, ‘THE EVENING STANDARD’ or ‘THE SCOTSMAN’, or indeed, from any other similar source such as WIKIPEDIA. These appear as Exhibits DE3 and DE4. I may just add that WIKIPEDIA additionally suffers in terms of its probative worth by being a ‘user generated’ encyclopedia. The most that can be said about this evidence is that, taken cumulatively, it may point in the direction of a knowledge by the public at large as to what the acronym may mean, and that Transport themselves has perhaps done more in that educative process than the evidence on file may suggest. Clearly it has been a relatively recent educative process as, from the evidence, Transport was only created in July 2000.
34. This brings me to the inevitable question however. Can the evidence, even on the most generous of interpretations, support the claim to ‘genuine use’ in relation to the specific goods and services in Classes 9 and 37, on which Transport rely in the section 5(2) opposition ?
35. Whilst it is clear that Transport use computer software (in Class 9) in their operation and dealings with their customers, for example in relation to the OYSTER Card and journey planners etc, it cannot be said that they ‘trade’ in such. Their use is not for the purposes of real commercial exploitation or maintaining or creating an outlet for computer software or getting a share in the software market (*Ansul*, *Silburquelle*). As I have said, they are a public transport operator. In relation to Class 37, such installation and maintenance of telecommunications, computer or transport systems as they undertake appears to be only in connection with their own services. The evidence does not establish that they operate a ‘trade’ in such, which would involve providing others with these services and, once again, creating or maintaining an *outlet* for these services. Such use would inevitably be considered to be ‘internal’ (*Ansul*, [para 37]).
- 36. My conclusion then is that whilst the evidence of use of ‘TfL’ is weak for the reasons given in para 31, Transport has nonetheless shown use in relation to public transport services and their own ancillary, related services, such as information provision and pre-paid ticketing, but crucially failed to show ‘genuine’ use (that is, for the purposes of real commercial exploitation in the relevant markets) in**

respect of the goods and services relied upon in the section 5(2)(a) opposition.

41. I would just add as a contingency, that if I am found to be wrong in respect of my finding above, I would just add that had I proceeded to conduct a full assessment based on any or all of the goods and services relied upon by Transport in Classes 9 and 37, my overall conclusion would be that there would be no likelihood of confusion as the services applied for are not similar to Transport's goods and services in Classes 9 and 37. That is to say that, inter alia, the nature, intended purpose, identity of consumers and channels of trade are different. It is not sufficient, for Transport's purposes, to say that both parties' goods and services are in some way 'connected with the internet', and users of that particular medium by its nature, would be unable to distinguish between a search engine operator and domain name registration body and a public transport operator.
42. Accordingly, the opposition under section 5(2)(a) fails in its entirety.

Sections 5(3) and 5(4)(a)

43. The opposition under section 5(3) likewise fails as, firstly, Transport has not established that they have an earlier right to rely upon, given the analysis under section 5(2)(a) above. Secondly, to the extent that any claimed reputation may have existed outside the goods and services relied upon under section 5(2)(a), but nonetheless covered by their wider specification, Transport has failed to demonstrate any possible 'link' that would be made by the consumer between its goods and services and those of Mr Wright. Still less has it demonstrated, or even pleaded in a properly particularised way, any possible detriment or unfair advantage.
44. The opposition under section 5(4)(a) also fails. To succeed, Transport would have had to have shown to have possessed both a protectable goodwill at the material and established by what distinguishing feature that goodwill would have been known. Even if I were to accept that Transport had such a protectable goodwill in the distinguishing signs, 'TfL' or 'TFL', at the material date (being the date of application, assuming no prior use by Mr Wright), then Transport would have then had to establish that Mr Wright's use of his sign would have constituted a misrepresentation. The question whether a misrepresentation would occur has to be answered by reference to a number of factors, one of which would have been whether a 'common field of activity' is engaged by the respective parties (see, eg *Harrods v Harrodian School* [1996] RPC 697) (*Harrods*). Whilst there may in certain circumstances be no absolute requirement for a common field of activity to establish passing off, the absence of one may, as in the *Harrods* case, constitute a significant factor. In this particular case, whilst Transport may have got me to accept that they had protectable goodwill in

the distinguishing features, 'TFL' or 'TfL', this is but the starting point. As my previous conclusions under section 5(2)(a) state, such a protectable goodwill would, based on the evidence, have revolved around their activities as a public transport operator. Such a field of activity is sufficiently far removed in my view from that of domain name registrant and search engine operator for there to be no misrepresentation.

Costs

45. Mr Wright has succeeded in the opposition. Accordingly, he is entitled to a contribution towards his costs. I take account of the fact that the decision has been reached without a hearing taking place. It is the Registrar's practice to award litigants in person at half the rate he awards them where they have legal representation. In the circumstances I award Mr Wright the sum of £200 as a contribution towards his costs of the proceedings. The sum is calculated as follows:

Filing a counterstatement and considering the statement of case:
£200

46. I order Transport for London to pay Mr Wright the sum of £200. The sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23 day of April 2010

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

Annex A

Class 6

Common metals and their alloys; metal for railway tracks; metal pipes, metal tubes, vehicle number plates; building materials; strips, sheets, shaped sections, all made of metal; cables (non-electric), wires (non-electric or fuse wires); safes, cash boxes, ladders, posts, fences, door gratings and furniture fittings; bells, tanks, keys and articles of hardware; ironmongery, platforms, bridges, shelters and fittings made of metal and not included in other classes; transportable buildings made of metal, gangways, guard rails, hand rails, railings, couplings, door fittings and handles; locks of metal, signs, sign posts, sign fastenings, metal badges, identity plates, sign boards, key chains, keyrings of metal, waste containers, fittings, hinges, bolts, plugs, rope clamps, cable clamps.

Class 09:

Computer software, including software supplied from the Internet; electronic publications (downloadable) provided on-line from a database or the Internet; computer software to enable the searching of data; mobile telephones, credit cards, cards for use in connection with loyalty or promotion schemes; vending machines, cash registers, ticket machines, coin-operated apparatus, fire extinguishing apparatus, smart cards, time recording apparatus, slot machines; electrical and electronic apparatus for use in building and premises control and management systems; electrical and electronic apparatus for use in transport systems, integrated transport systems and safety systems; optical and photographic apparatus and CCTV systems; emergency call systems and apparatus; lighting control systems, alarms and alarm systems; audio and visual public announcement systems, including loud speakers and electronic and digital sign boards; cabling, signalling apparatus, CD-ROMs, video discs, recorded tapes, discs and cassettes, circuit breakers, control panels, switchboards, electrically operated door closing apparatus, traffic control and monitoring equipment; luminous and mechanical signs; telephones, elevator operating apparatus.

Class 12:

Vehicles; apparatus and vehicles for locomotion by land, air, rail, road, tram or water; parts and fittings for the aforesaid goods.

Class 16:

Printed matter, printed publications, books, tickets, maps, diaries, posters, manuals, magazines, newspapers, timetables, leaflets, directories, plans and drawings, photographs, postcards, prints, stationery, pens, pencils, rulers, memo pads, playing cards, calendars, bookmarks; instructional and teaching materials; tourist guides, personal organisers, coasters of paper

or card, stamps, certificates, photograph albums, luggage tags, labels, scratch cards.

Class 19:

Building and construction materials, not of metal; non-metallic transportable buildings, sheets and panels for buildings; tiles, slates; glass; insulating glass, reinforced glass; partition walls, frames for building purposes, balustrades and railings for balconies, roofs, doors, windows, frames, all these goods containing predominantly non-metallic materials; surfacing (not of metal) for building, floor coverings.

Class 35:

Advertising services, promotional services, rental of advertising space, including rental of space on advertising boards and hoardings; services for promotion of tourism and transport; information and advisory services in relation to any of the foregoing services.

Class 36:

Administration of franchise financial affairs; procurement and provision of grants; property services; estate agency and real estate management; management, leasing, hiring and disposal of infrastructure for transport and real estate; renting of commercial premises, offices, houses, residential accommodation and retail premises.

Class 37:

Building and construction services; cleaning and repair of the exterior and interior of buildings and premises; interior and exterior building installation, maintenance and repair; installation and maintenance of furniture and fittings; installation, maintenance and repair of machines and equipment; vehicle repair and maintenance; rental of equipment for building, construction, cleaning and repair; installation and maintenance of services relating to telecommunications, computer systems, transport systems, fault recovery and maintenance services; vehicle service stations; construction engineering services; rental of maintenance equipment; construction, maintenance and repair of roads, rails, paths, streets, bridges, tunnels; construction, building and maintenance of commercial properties and civil engineering structures such as roads, bridges, rail projects; rail works.

Class 39:

Transportation of persons, animals, goods, valuables, mail by air, sea, inland waterways, rail, underground rail, tram and road; information services relating to travel, including timetables, fares, schedules, connecting transport and tourist information; provision and arrangement of holidays, travel and tours; travel agency services; services for the arrangement of transport of luggage, goods, animals, mail and valuables; services for the booking of travel; storage of goods; freight services; issue

of travel tickets; issue of tickets; luggage storage services; sightseeing tours; taxi transport; boat transport; guarded transport of goods; provision of information relating to travel, including that provided on-line from computer databases or websites on global computer networks; escorting of passengers; ticket booking agency services; seat and berth reservation services; timetable and fare enquiry services; tourist agency services; vehicle rental and charter; consultancy, advisory and information services relating to passenger transportation services, goods transportation services, infrastructure for transport, rolling stock, light rapid transport and integrated transport; supervision, operation and management of policies relating to the transportation of passengers and goods; advisory and consultancy services relating to the conditions of the carriage of passengers and goods; information and advisory services in relation to any of the foregoing services.

Class 42:

Services relating to the conditions of the carriage of passengers and goods; licensing services; intellectual property licensing; meteorological information; research services, professional advisory and consultancy services relating to transport, civil, electrical and mechanical engineering; operational research in respect of transport; certification of standards in respect of transport; provision of conference facilities and exhibition facilities; cafe, restaurant and hotel services; hotel reservation services; information on hotels and hotel bookings.