

**O-202-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3194148  
BY HIGH STREET TV (GROUP) LTD TO REGISTER THE TRADE MARK**

**Life. Love it. Live it.**

**IN CLASS 35**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 408487  
BY SANDY KENNY**

## Background and pleadings

1) High Street TV (Group) Ltd (“the applicant”) applied to register, under no 3194148, the mark “Life. Love it. Live it.” in the UK on 31 October 2016. It was accepted and published in the Trade Marks Journal on 11 November 2016. The services covered by the application are as follows:

**Class 35:** *Advertising; business management; business administration; office functions; advertising and marketing services; the bringing together, for the benefit of others, of the following goods, enabling customers to conveniently view and purchase chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry, unprocessed artificial resins, unprocessed plastics, manures, fire extinguishing compositions, tempering and soldering preparations, chemical substances for preserving foodstuffs, tanning substances, adhesives used in industry, unprocessed plastics in the form of liquids, chips or granules, paints, varnishes, lacquers, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins, metals in foil and powder form for painters, decorators, printers and artists, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, deodorants for personal use, air perfuming preparations, industrial oils and greases, lubricants, dust absorbing, wetting and binding compositions, fuels and illuminants, candles and wicks for lighting, combustible fuels, electricity and scented candles, pharmaceutical and veterinary preparations, sanitary preparations for medical purposes, dietetic substances adapted for medical use, food for babies, plasters, materials for dressings, material for stopping teeth, dental wax, disinfectants, preparations for destroying vermin, fungicides, herbicides, foods and beverages which are adapted for medical purposes, air deodorising preparations, common metals and their alloys, metal building materials, transportable buildings of metal, materials of metal for railway tracks, non-electric cables and wires of common metal, ironmongery, small items of metal hardware, pipes and tubes of metal, safes, ores, unwrought and partly wrought common metals, metallic windows and doors, metallic framed conservatories, machine tools, motors and engines (except for land vehicles), parts of engines and motors, machine coupling and transmission components (except for land vehicles), exhausts and starters (for vehicles), vacuum cleaners, electric drills, electric screwdrivers, incubators for eggs, hand tools and hand operated implements, cutlery, side arms, razors, electric razors and hair cutters, scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, supervision, life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin operated apparatus, cash*

*registers, calculating machines, data processing equipment and computers, fire-extinguishing apparatus, recorded media, computer hardware and firmware, computer software, software downloadable from the Internet, downloadable electronic publications, compact discs, digital music, telecommunications apparatus, computer games equipment adapted for use with an external display screen or monitor, mouse mats, mobile phone accessories, contact lenses, spectacles and sunglasses, clothing for protection against injury, accident, irradiation or fire, furniture adapted for laboratory use, surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth, orthopaedic articles, suture materials, sex aids, massage apparatus, supportive bandages, furniture adapted for medical use, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, air conditioning apparatus, electric kettles, gas and electric cookers, vehicle lights and vehicle air conditioning units, vehicles, apparatus for locomotion by land, air or water, wheelchairs, motors and engines for land vehicles, vehicle body parts and transmissions, firearms, ammunition and projectiles, explosives, fireworks, precious metals and their alloys, jewellery, costume jewellery, precious stones, horological and chronometric instruments, clocks and watches, musical instruments, stands and cases adapted for musical instruments, printed matter, book binding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters packaging materials, printers' type, printing blocks, disposable nappies of paper for babies, printed publications, paint boxes for children, cheque book holders, plastics in extruded form for use in manufacture, semi-finished plastics materials for use in further manufacture, stopping and insulating materials, flexible non-metallic pipes, leather and imitations of leather, animal skins, hides, trunks and travelling bags, handbags, rucksacks, purses, umbrellas, parasols and walking sticks, whips, harness and saddlery, clothing for animals, non-metallic building materials, non-metallic rigid pipes for building, asphalt, pitch and bitumen, non-metallic transportable buildings, non-metallic monuments, non-metallic framed conservatories, doors and windows, furniture, mirrors, picture frames, garden furniture, pillows and cushions, household or kitchen utensils and containers, combs and sponges, brushes, brush-making materials, articles for cleaning purposes, steel wool, electric and non-electric toothbrushes, ropes, string, nets, tents, awnings, tarpaulins, sails, sacks for transporting bulk materials, padding and stuffing materials which are not made of rubber or plastics, raw fibrous textile materials, yarns and threads, for textile use, bed and table covers, travellers' rugs, textiles for making articles of clothing, duvets, covers for pillows, cushions or duvets, tea cosies, clothing, footwear, headgear, lace and embroidery, ribbons and braid, buttons, hooks and eyes, pins and needles, artificial flowers, badges for wear, carpets, rugs, mats and matting, linoleum and other materials for covering existing floors, wall hangings (non-textile), wallpaper, games and playthings, playing cards, gymnastic and sporting articles, decorations for Christmas trees, childrens' toy bicycles, meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces, eggs, milk and milk products, edible oils and fats, prepared meals, soups and*

*potato crisps, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, sandwiches, prepared meals, pizzas, pies and pasta dishes, live animals, fresh fruits and vegetables, seeds, natural plants and flowers, foodstuffs for animals, malt, food and beverages for animals, beers, mineral and aerated waters, non-alcoholic drinks, fruit drinks and fruit juices, syrups for making beverages, shandy, de-alcoholised drinks, non-alcoholic beers and wines, alcoholic wines, spirits and liqueurs, alcopops, alcoholic cocktails, tobacco, smokers; articles, matches, lighters for smokers, cardboard packaging, rubber covered electrical wires, hoses made of rubber, flexible hose pipes made of rubber, rubberized fabrics, toys, fitness exercise machines, manually operated exercise equipment, metal pans, cooking pans, cookware, cookers, pressure cookers, pots, coffee pots, stew pots, cooking pots, underwear, food processors, electric food processors, hand operated food processors, oil free electric fryers, deep fat fryers, domestic deep fryers, fittings for the drainage of water, sanitary armatures for basins, sanitary armatures for showers, sanitary armatures for baths, sanitary armatures for bidets, ironing machines, flexible pipes, tubes, hoses and fittings therefor, including valves, plant pots, hair styling appliances.*

2) Sandy Kenny (“the opponent”) opposes the application on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This ground is based upon the earlier UK mark 2562096 and the opponent claims that the applicant’s mark is too similar and whilst appreciating that the application is in respect of:

“a different class it still has wording exact to ours from the fact that one word has been taken out and reworded. Our concern is if this is registered there is a risk of other classes under life love it live it, or life love it live it could be applied for and have to safeguard our brand and business concept”

3) The relevant details of the earlier mark are shown below:



Filing date: 25 October 2010

Registration date: 21 January 2011

4) This registration has an earlier filing date than the applicant's mark and therefore qualifies as an earlier mark under section 6 of the Act. It is registered in respect of goods in classed 9, 14, 16, 18, 21, 25, 26 and 28, however, because the mark completed its registration procedures more than five years before the filing date of the contested mark it is subject to the proof of use provisions contained in section 6A of the Act. In answer to question 3a of the Form TM7, the opponent claimed use in respect of only some of these goods, underlined in the full list of goods below:

**Class 9:** *Mouse mats, computer accessories.*

**Class 14:** *Wristbands/jewellery.*

**Class 16:** *Stickers [insofar as they are **car stickers**], diaries, planners, stationery [insofar as they are **pens**].*

**Class 18:** *Bags.*

**Class 21:** *Mugs, tablewear.*

**Class 25:** *Clothing, footwear, headgear.*

**Class 26:** *Badges, brooches.*

**Class 28:** *Sports equipment, toys.*

5) In addition, the opponent also claims proper reasons for non-use in respect of *jewellery* stating that a "large investment of potential investors" is sought "within this year".

6) As a consequence of the opponent's claims to use/proper reasons for non-use, I need to also consider whether she is entitled to rely upon *jewellery* as well as the underlined terms in paragraph 4. In respect of the remaining goods, there is no claim that they have been used, nor that there are proper reasons for non-use and the opponent cannot rely upon these goods.

7) The applicant filed a counterstatement denying the claims made. It also puts the opponent to proof of use in respect of all of the goods listed in the earlier mark.

8) Both sides filed evidence and written submissions. I will keep the submissions in mind but I will not summarise them. No hearing was requested and I make my decision based upon a careful consideration of the papers.

### **Opponent's Evidence**

9) The opponent's evidence takes the form of a witness statement by the opponent. This can be summarised as follows:

- The opponent runs a coaching, fitness and sports training business and she is already “using One Life Love it Live it for our existing sports range Fizz Fitness on our website and are currently developing brand after interruption of business affairs, due to personal circumstances”;
- At Exhibit B are copies of undated photographs of a pair of trousers, a jacket, a zipped hoodie, t-shirts and a mug. Signs appear on these items of clothing that appear to be the earlier mark, but because of the poor quality of the copies this cannot be stated with certainty;
- Exhibit C consists of copies of undated pages from the opponent's “Fizz Fitness” website showing (the date appearing at the bottom right of the screen print shows that they were printed on 15 July 2017):
  - The words “One Life Love it Live it” used to identify T-shirts for sale;
  - A welcome page with the words “One Life Love it Live it” appearing above the text “Welcome to Fizz Fitness. A gym with a difference”;
  - The earlier mark appearing twice on a page, but it is not possible to see the context that it appears due to the poor quality of the exhibit.
- Exhibit E consists of a copy of a newspaper article entitled “Gym boss is aiming to get local folk fitter” and refers to “Sandy's One Life Fizz Project”. There is no date legible. A second page consists of an undated photograph of a stand set up in the outdoors with t-shirts being displayed. One of these t-

shirts has a shape on the chest that is reminiscent of the earlier mark, but it is not legible;

- Exhibit G consists of copies of three photographs of handwritten statements from individuals. They are dated between 29 June 2017 and 1 July 2017. The first two state that the opponent “owns a range of registered trademarks including One Life Love it Live it.” The third appears to be the second page of a two page letter. This page begins “...trade mark and is selling [...illegible...] pens, car stickers, clothing [...illegible...]”;
- Exhibit I contains a page that consists of a typed price list for “Fizz Tshirts”, “Mugs”, “Car stickers”, “Pens”, “Hoodies Zipped”, “Bottoms” and “Caps”. The earlier mark does not appear;
- Exhibit J includes of a copy of a “Statement of Use” form completed by Ms Kenny that provides the following information:
  - Use is claimed on “Class 9, 16, 18, 21, 25”;
  - Where use is claimed on an EU trade mark, the owner is asked to indicate where in the EU (referred to as “the Community”) the mark has been used. The earlier mark is not an EU trade mark and Ms Kenny’s response to the question is not relevant;
  - In respect of the UK, use is claimed in Plymouth;
  - “Newspaper, Facebook, website” is provided in answer to the question “Provide a list of examples of the mark in use ... and indicate against each such entry the goods/services for which you claim it shows use of the mark ...”;
  - In response to the question of why no examples of use are available Ms Kenny has answered “Personal circumstances caused interruption of business & project”;
  - In response to the question “provide details of the number of sales achieved...”, Ms Kenny merely provides, what I assume are the selling prices in respect of caps, t-shirts, water bottles, mugs, car stickers, pens, hoodies and bottoms;
  - An irrelevant answer is provided to the question “...please state how much was spent promoting the mark...”.

## **Applicant's Evidence**

10) This takes the form of a witness statement by Hannah Ruddy, Chartered Legal Executive for the applicant. She states that upon receiving the opposition, she conducted an Internet search but was unable to find the opponent's earlier mark in use.

11) At Exhibit A, Ms Ruddy provides a copy of the *Whois* data for the opponent's website, pages of which are provided at the opponent's Exhibit C. This data shows that the website domain was not registered until 1 June 2017. Further, at Exhibit B, Ms Ruddy provides a screenshot of a Google indexing page that shows the opponent's website appearing a number of times in a list of hits, the earliest with a date of 3 June 2017. Ms Ruddy explains that this was the date "the website was first seen by Google".

## **DECISION**

### **Proof of Use**

12) The relevant parts of the Act are set out below:

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (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, 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

13) 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.”

14) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237 ). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in 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 that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaf” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria”

(Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

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

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

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

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

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

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

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

15) The relevant period in which the opponent must demonstrate genuine use is set out in section 6A(3)(a) as being the five year period ending with the publication date of the contested mark. In the current case this is 12 November 2011 to 11 November

2016. As I set out in paragraphs 3 – 5, I will consider proof of use in respect of *car stickers, pens, mugs and clothing*. I must consider if the opponent has also provided sufficient reasons for non-use of the earlier mark in respect of *jewellery*.

16) I make it clear at the outset that the earlier mark relied upon by the opponent is a complex word and logo mark and any use of just the word element will not qualify as illustrating use of this complex mark. The word element does not form an acceptable variant use of the earlier mark under the test set out by Mr Richard Arnold Q.C. (as he then was) as the Appointed Person in *Nirvana Trade Mark*, BL O/262/06. With that in mind, I consider the evidence in respect of each item of goods in relation to which use is claimed or reasons for non-use are relied upon.

#### Car stickers and pens

17) The evidence supporting the opponent's assertion that she has used the earlier mark in respect of *car stickers and pens* consists of:

- the second page of a hand written letter from a third party named Mick Murray (Exhibit G). The relevant text is difficult to read but appears to state “[previous text missing] trade mark and is selling ... pens, car stickers ...”;
- an undated typed price list that includes *car stickers* for £5 and *pens* for £4 (Exhibit I);
- On the form entitled “Statement of Use” (Exhibit J), the opponent includes *car stickers and pens* in a list of goods in the box available to “provide details of the number of sales achieved...”

18) This evidence fails to support the assertion that there has been actual use of the earlier mark in respect of these goods. There is not one example showing the mark in use in respect of *car stickers* or *pens*, there is no turnover figures provided, nor is there any evidence of promotional spend. Further, there are no evidence showing that the opponent procured such goods. The minimal evidence that is provided, even if it was otherwise acceptable, is undated and does not specify when the use was and, therefore, it cannot be shown that the use claimed originated from within the relevant period.

19) Taking account of all of this together, even though sometimes minimal use may be sufficient, in this case there is not one corroborative example to support the claim to use in the relevant period. I conclude that the evidence fails to establish genuine use of the earlier mark in respect of *car stickers* and *pens*.

### Mugs

20) The evidence supporting the assertion of genuine use in respect of mugs is even less persuasive with the only corroboratory evidence being (i) a reference to *mugs* on the form at Exhibit J, and (ii) a poor quality copy of a photograph showing a mug possibly bearing the earlier mark at Exhibit B. There is nothing more to indicate actual sales or use of the earlier mark in respect of *mugs*. I find that genuine use has not been shown in respect of *mugs*.

### Clothing

21) The corroboratory evidence supporting the assertion that the earlier mark has been used in respect of clothing can be summarised as follows:

- Undated photographs of a pair of trousers, a jacket, a zipped hoodie and t-shirts with a sign appearing thereon that has the same shape as the earlier mark, but because of the quality of the copying, it is not possible to ascertain with any certainty, that it is the earlier mark (Exhibit B);
- The words “One Life Love it Live it” were used on the opponent’s website in respect of t-shirts as of the 15 July 2017 (some seven months after the end of the relevant period). The opponent has provided data to illustrate that this website domain was not registered until 1 June 2017 and therefore any use shown upon it could not illustrate use during the relevant period;
- Several undated photographs showing an outdoor stand where t-shirts are displayed. A sign in the shape of the earlier mark appears on the chest of the t-shirts, but because of its size and the quality of the copy, it is not possible to say with any certainty, that it is the earlier mark;

- Three hand written third party statements in the form similar to a “who it may concern letter” dated over seven months after the end of the relevant period all make a general statement that the opponent’s “range of products” under “her registered trade marks including One Life Love it Live it”;
- An undated typed price list of six items including “Hoodies Zipped £25”, “Bottoms £20”, “Caps £15”;
- The opponent refers to “hoodies”, “bottoms”, “caps” and “tshirts” when asked to provide details of the number of sales achieved in the Statement of Use form provided at Exhibit J.

22) Whist there is a suggestion that the opponent is trading in certain items of clothing using the earlier mark, the evidence suffers from a number of flaws. Firstly, the earlier mark (as registered) as opposed to the words only cannot be identified in use in respect of these goods. The exhibits are not of a good enough quality to confirm this despite a sign appearing on some of the items that has the same shape as the earlier mark. However, ultimately, even if this flaw did not exist, none of the exhibits demonstrate use in the relevant period because they are either undated or dated after the end of the relevant period and, as submitted by the applicant, the exhibits merely illustrate that the earlier mark has been applied to certain items of clothing, not that they have been sold. Further, and also as submitted by the applicant, a price list is not evidence of sales, even if it were dated. Taking this together with a total absence of evidence indicating the volume of sales during the relevant period or the scale of any promotion undertaken, I conclude that the evidence fails to demonstrate that genuine use has been made of the earlier mark during the relevant period.

23) Even if I were to overlook these flaws in the evidence of use in respect of clothing, there is nothing to demonstrate that the level of use is such as to support a claim to genuine use. In reaching this conclusion, I have kept in mind the comments of Professor Ruth Annand, sitting as the Appointed Person in *Memory Opticians Ltd's Application*, BL O/528/15 where she upheld the Hearing Officer’s decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5 year period. There had in fact been sales of goods

bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local from 3 branches of an optician. There was no advertising of goods under the mark, although the evidence indicated that they were only displayed in-store on occasions. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lense. This level of use was held to be insufficient to create or maintain market under the mark. Consequently, it was not genuine use.

### Jewellery

24) In her statement of case the opponent claimed that there were proper reasons for non-use in respect of *jewellery*. *Kerly's Law of Trade Marks and Trade Names* (Fifteenth Edition) refers to Article 19(1) of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) 1994:

“References to proper reasons for non-use need to be interpreted in accordance with art.19(1) of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) which uses the expression valid reasons based on the existence of obstacles to the genuine use which is required. The provision continues:

Circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other governmental requirements for goods or services protected by the trademark, shall be recognized as valid reasons for non-use.”

25) I am mindful of the guidance of the courts regarding what constitutes proper reasons for non-use and, in particular, the following comments of the Court of Justice of the European Union in *Armin Häupl v Lidl Stiftung & Co. KG*, Case C-246/05:

52. In particular, as correctly stated by the Advocate General in [79] of his Opinion, it does not suffice that “bureaucratic obstacles”, such as those pleaded in the main proceedings, are beyond the control the trade mark proprietor, since those obstacles must, moreover, have a direct relationship



with the mark, so much so that its use depends on the successful completion of the administrative action concerned.

53. It must be pointed out, however, that the obstacle concerned need not necessarily make the use of the trade mark impossible in order to be regarded as having a sufficiently direct relationship with the trade mark, since that may also be the case where it makes its use unreasonable. If an obstacle is such as to jeopardise seriously the appropriate use of the mark, its proprietor cannot reasonably be required to use it nonetheless. Thus, for example, the proprietor of a trade mark cannot reasonably be required to sell its goods in the sales outlets of its competitors. In such cases, it does not appear reasonable to require the proprietor of a trade mark to change its corporate strategy in order to make the use of that mark nonetheless possible.

54. It follows that only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as “proper reasons for non-use” of that mark. It must be assessed on a case-by-case basis whether a change in the strategy of the undertaking to circumvent the obstacle under consideration would make the use of that mark unreasonable. It is the task of the national court or tribunal, before which the dispute in the main proceedings is brought and which alone is in a position to establish the relevant facts, to apply that assessment in the context of the present action.

55. Having regard to the foregoing considerations, the answer to the second Proper question referred for a preliminary ruling must be that Art.12(1) of the Directive must be interpreted as meaning that obstacles having a direct relationship with a trade mark which make its use impossible or unreasonable and which are independent of the will of the proprietor of that mark constitute “proper reasons for non-use” of the mark. It is for the national court or tribunal to assess the facts in the main proceedings in the light of that guidance.”

26) The reason cited by the opponent in her statement of case is that “some goods have not been done i.e. jewellery as of yet due to seeking large investment of potential investors within this year”. It is not clear from this statement whether it is that (i) that the opponent has sought and failed to find investment during the relevant period, or (ii) if it is only latterly that the opponent has attempted to find an investor. The first scenario, if correct, is not supported by any evidence and consequently, taking account that such an assertion is for the opponent to prove, the failure to do so is fatal to the case of proper reasons for non-use. If the second scenario is correct then I reject it as a reason for non-use because it would indicate that the opponent made no efforts to trade in respect of jewellery during the relevant period, nor that it made efforts to use the mark but failed.

27) In her witness statement, the opponent also makes reference to “currently developing [*the*] brand after [*an*] interruption of business affairs, due to personal circumstances” and that she wished “to remain personal away from the public eye”. With a lack of information it is difficult to take a view as to whether such a reason is sufficient. However, whilst some personal circumstances can be tragic and disruptive, in the absence of any information to illustrate otherwise, it is difficult to envisage circumstances that would prevent a business operating for nearly 6 years (between November 2011, being the start of the relevant five year period, and September 2017, when the opponent made her statement). Therefore, whilst I have every sympathy for difficult personal circumstances, I find that on the information before me, this does not amount to proper reasons for non-use.

28) I reject the opponents claim to having proper reasons for not using the earlier mark in respect of *jewellery*.

29) Finally, the opponent makes numerous comments that she is also providing services in Class 35 under her “Fizz Fitness” mark and that the earlier mark in these proceedings is used as a strapline for these services. This is not relevant to these proceedings because the only earlier right relied upon by the opponent is the earlier mark 2562096 that does not extend to Class 35 services.

30) In summary, I find that the opponent has failed to illustrate that her mark has been genuinely used. Consequently, she is unable to rely upon any of the goods listed in the earlier mark.

### **Section 5(2)(b)**

31) In light of my findings above, it follows that the case based upon section 5(2)(b) of the Act must fail.

### **Conclusion**

32) The opposition is unsuccessful in its entirety and the application can proceed to registration.

### **COSTS**

33) The applicant has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 2/2016. Both sides filed evidence and written submissions and no hearing was held. With all of this in mind, I award costs as follows:

Considering statement and preparing counterstatement	£200
Considering other side's evidence and preparing own brief evidence	£500
Preparing written submissions	£300
<b>Total:</b>	<b>£1000</b>

34) I order Sandy Kenny to pay High Street TV (Group) Ltd the sum of £1000 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

**Dated this 29<sup>th</sup> day of March 2018**

**Mark Bryant**

**For the Registrar**

**The Comptroller-General**