

O-218-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3159450
BY VIVO INTERNATIONAL LIMITED
FOR REGISTRATION OF THE TRADE MARK**

vivo

**AND OPPOSITION UNDER NO 407110
BY TiVo BRANDS LLC**

Background

1. Application no 3159450 stands in the name of Vivo International Limited (“the applicant”) and seeks registration of the trade mark **vivo**. It has a filing date of 14 April 2016 and a priority date of 15 October 2015 based on a Namibian filing NA/T/2015/2253. Registration is sought in respect of the following services:

Class 41

Production and distribution of television shows and movies; production of television programs; provision of non-downloadable films and television programmes via video-on-demand services.

2. Following publication of the application in the *Trade Marks Journal* on 6 May 2016, notice of opposition was filed by TiVo Brands LLC (“the opponent”) based on grounds under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following EU trade mark registrations (“EUTM”):

Mark	Dates	Specification
EUTM 1006014 TiVo	Filing date: 27 November 1998 Priority date: 29 May 1998 (from USA application 75/493408) Date of entry in register: 1 February 2001	Class 9 Computer hardware, software and peripherals for personalized, interactive television programming; televisions; television peripheral remote controls; communication devices; transmitters; receivers and controls, and software for use therewith. Class 16 Manuals for use with computer hardware, software and peripherals for personalized, interactive television programming, televisions, television peripheral remote controls, communication devices, transmitters, receivers and controls and software for use therewith. Class 35 Advertising; business management; business administration; office functions;

		<p>the promotion and sale of goods and services for others.</p> <p>Class 38 Telecommunications; subscription television services; transmission of cable television and interactive audio and video services; personalized and interactive television transmission services.</p> <p>Class 41 Education; providing of training; entertainment; sporting and cultural activities; entertainment services, namely, personalized and interactive entertainment services; online guide to personalised and interactive television programming.</p>
<p>EUTM 8493587</p> <p>TIVO</p>	<p>Filing date: 17 August 2009</p> <p>Date of entry in register: 17 February 2010</p>	<p>Class 9 Computer hardware; computer software; computer peripherals; remote controls; apparatus for receiving, transmitting, storing and managing audio, video and other digital media; software for use therewith; digital video recorders; parts and fittings for use with all the aforesaid goods; manuals sold as a unit with all the aforesaid goods; downloadable music, films and television programs.</p> <p>Class 38 Telecommunication services; broadcasting services; transmission of video and audio content; providing access to databases and directories via communications networks; transmission of information through communications networks for purposes of programming and operating appliances and electronics; advisory, consultancy, and information services in relation to the aforesaid services.</p> <p>Class 41 Entertainment and education services; entertainment services in the nature of audio</p>

		and television programming; providing guides, directories, databases, reviews, ratings and recommendations in the field of entertainment; advisory, consultancy, and information services in relation to the aforesaid services.
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3. In respect of its objection under section 5(2)(b) of the Act, the opponent relies on its earlier marks insofar as they are registered for services in classes 38 and 41. In respect of its objection under section 5(3), the opponent relies on all of its goods and services as registered.

4. The applicant filed a counterstatement in which it denies the grounds of opposition.

5. Only the opponent filed evidence. Whilst neither party requested to be heard, both filed written submissions in lieu of attendance at a hearing. I give this decision after a careful review of all the papers before me.

Proof of use

6. The opponent relies on the two EUTMs set out above. As can be seen from the respective dates, both are “earlier marks” within the meaning of section 6 of the Act and both were entered in the register more than five years before the date of publication of the application. Both are therefore subject to the proof of use provisions in the Act. In its counterstatement the applicant put the opponent to proof of use of its marks. The relevant section of the Act is section 6A which states:

“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.”

7. 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:

“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 Bunderversammlung Kameradschaft '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].”

8. Section 100 of the Act is also relevant and 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.”

9. The opponent’s evidence comes in the form of a witness statement from Nicholas Christopher Alwyn Bolter, who is a solicitor and Partner with Cooley (UK) LLP, its representatives in these proceedings. Mr Bolter states that he is authorised to make the statement on behalf of the opponent. He states that some of the content of his statement is from his own knowledge whereas other parts are from documents he has read or information he has been given though he does not give the source of any specific information. Despite the guidance provided in Tribunal Practice Notice 5/2004, evidence of fact is sadly lacking in Mr Bolter’s witness statement; much of it is submission which I do not summarise but have read and will refer to as and when appropriate in this decision.

10. Mr Bolter states:

“...the products and services provided by the Opponent in the UK are offered through Virgin Media but under the Opponent’s Marks. The Opponent has an exclusive partnership with Virgin Media in the UK under which the Opponent provides Virgin Media customers with a TiVo branded high definition digital video recorder, or set top box. Virgin Media is therefore the exclusive distributor of the Opponent’s products and technology in the United Kingdom but notably the products and services are still provided under the Opponent’s TiVo mark”.

11. Attached to Mr Bolter’s witness statement are a number of exhibits (Exhibits 1 to 12). None of them include any evidence of any “exclusive partnership” nor is there any evidence in the form of e.g. a distribution agreement. Mr Bolter states that he relies on Exhibits 1 to 3 in support of the claim that genuine use of the marks have been made in the relevant period, which is 7 May 2011 to 6 May 2016. I go on to consider this evidence in more detail.

12. Exhibit 1 consists of some 40 articles downloaded from the LexisNexis® database and originally published in a variety of newspapers or other publications, whether physical editions or those published via a website. None of these appear to have been published by the opponent or Virgin Media. Whilst all date from within the relevant period and all mention TIVO or TiVo, many do so only in passing. For example, at page 14 is an article about the BBC which refers to “Birmingham – where Virgin Media engineers helped to create the Tivo Box...”. At page 59 is an article comparing BT’s achievements against those of Sky. One sentence reads: “BT also said it outpaced Virgin Media, although with new customers being brought on to its TiVo services, Virgin disputes the claim”.

Other articles within this exhibit refer to Virgin/Virgin Media as a supplier of broadband, telephone (landline and mobile) and TV services. In relation to TV services, some of the articles provide a little more detail. For example, at page 11 is an article which states: “Virgin packages also come with a TiVo box so you can pause, record and rewind live TV”. At page 21 the article refers to the “TiVo digital TV service”. Other articles refer to the planned introduction of various goods or services: for example, the article at page 62 refers to a “smartphone app” and the article at page 26 refers to “a significant update to its TiVo platform [which will bring a] new brand new identity” though the latter reference does not assist me in identifying what the “TiVo platform” might be. Not all of this material appears to refer to the position in the UK or EU or to the marks as registered e.g. an article at pages 17/18 refers to a new digital recorder box known as TiVo Bolt being available only in the US.

Yet others within this exhibit refer to Virgin/Virgin Media’s turnover or profits and the numbers of subscribers to its services, some of which appear to have been provided under the TiVo/TIVO mark (see e.g. pages 25 and 27). Some give figures only in combination with those of other providers or under other marks: e.g. the articles at pages 16 and 19 refer to combined figures for “The UK TiVo services and Ireland’s Horizon” describing them as having a combined “installed base” of around 3 million customers.

13. Exhibit 2 consists of a print of what appear to be two user manuals downloaded from the Internet. The first is a “guide to the new TiVo® box under your telly”, the second a “guide to your new Virgin TV service”. In respect of the latter guide, there are references (pages 25 and 26) to “The Virgin TV V6 box, powered by TiVo®” underneath a picture of said box. On neither image can I see either of the earlier marks. No indication is given of any sales or distribution of these guides and neither are dated.

14. Exhibit 3 consists of what Mr Bolter says are “screenshots from the Virgin Media website”. There are two pages. The first shows “Your Virgin TV Box” and invites readers to “Say hello to the Virgin TV V6 box, powered by TiVo®”. Underneath this is another area of text. Whilst the text itself is not legible, the heading reads “Or, choose our Tivo® box”. The second is headed “Virgin Media TiVo® service” and invites readers to “Take a close look at TiVo” but much of the remainder of the text is not legible. Neither screenshot is dated.

15. Whilst Mr Bolter has indicated his reliance only on Exhibits 1 to 3 as proof of use of the marks, for the sake of completeness I have reviewed the remaining exhibits. As with the material at Exhibit 1, all have been downloaded from the LexisNexis database. These are:

Exhibit 4: An article from the Guardian published on 27 October 2011 and entitled “Virgin Media says customers are spending more for faster internet”. The article appears to have been corrupted when downloaded and the only mention of the earlier marks appears in the sentence:

“...despite the [#####]10m Virgin spent marketing its TiVo set-top box in the last quarter...”.

There is also a three page article published on the campaignlive.co.uk website and which is dated 30 June 2011. It is entitled “Virgin Media launches multimedia campaign for TiVo” and refers to the impending launch of a “first advertising campaign for TiVo [which] includes TV, digital, print, retail, experiential and social media, and aims to highlight the “positive reception”

the Virgin Media TiVo set-top box service has enjoyed since it launched in December 2010". With the exception of what appears to be a still from a planned TV advertisement (which does not show either earlier mark nor indeed any text), no examples of that advertising have been exhibited and no details are provided to show what may have been seen, where, by whom or when.

Exhibit 5: an article from the Independent published on 28 October 2011 and entitled "Virgin hails the connected TV bump". The article refers to Virgin Media's revenue and reports that the company "yesterday hailed the popularity of its connected television service TiVo and said it planned to bring it to all of its customers...". The article gives number of customers "in the third quarter" of some 222,000, but gives no further information of their purchases.

Exhibit 6: an article from the Guardian published on 8 February 2012 and entitled "Virgin Media posts first-ever profit". It reports that "Subscribers to Virgin Media's Tivo digital video recorder more than doubled in the three months to 31 December with 273,000 net additions –bringing the total to 435,000..."

Exhibit 7: an article from the Guardian published on 19 December 2011 entitled "Virgin Media signs BBC sports coverage deal". It reports that coverage of major sports events will be available through the TiVo service in 2012. Contrary to other articles and Mr Bolter's own statement, this article indicates that the TiVo service was launched "in April".

Exhibit 8: an article from Haymarket Publishing Services Ltd published on 27 July 2012. Headed "City News-TiVo overtakes rival BT Vision" it refers to Virgin Media passing "the one-million customer mark for its TiVo television service..."

Exhibit 9: an article from the Telegraph published on 12 February 2014. It refers to the two millionth Virgin Media TiVo customer having been connected

to the service which allows them to record, pause, rewind and watch TV and “access 3rd party apps”.

Exhibit 10: an article from the Yorkshire Post published on 10 May 2015. Headlined “Find a recording deal”, the article refers to a number of suppliers and their services including “Virgin [which is] the UK distributor for Tivo [which was] launched here 15 years ago but inexplicably failed to take hold”.

Exhibit 11: an article from the Daily Telegraph published on 25 April 2016. Headlined “Virgin Media turns up the television volume”, the lengthy article makes a single reference to there being “more software upgrades for the Virgin Media Tivo set-top box over the year...”.

Exhibit 12: an article from Broadband TV News published on 20 April 2016. It refers to TiVo subscriber numbers “for its enabled platforms deployed by operators in North America and Europe” but does not specify numbers of subscribers in any particular country. Other than referring to “an increasingly fragmented viewing experience” the article does not say what services are the subject of those subscriptions.

16. As the applicant points out in its written submissions filed in lieu of a hearing, the:

“vast majority [of the opponent’s evidence] consists solely of newspaper articles...It does not show any direct evidence of sales figures, advertising spend or market share... We also note that [it] fails to provide evidence to cover all the goods and services specified by the earlier marks”.

17. There is no evidence to show any sales of any of the goods as are specified in class 9 (both earlier marks) or class 16 (EUTM1006014) at any time and certainly not within the relevant period. The only specific goods Mr Bolter refers to in his witness statement is a “high definition video recorder or set top box” with related software. I pause to note that these are goods proper to class 9 and therefore outside the scope of the opposition under section 5(2)(b) which is based on services in classes 38 and 41. A number of the articles within Exhibit 1 refer variously to

digital video recorders, set top boxes, smartphone apps, TiVo hardware, TiVo platforms, TiVo-powered set top boxes and zapper boxes though the latter appears to have only been available in the US. No sales or turnover figures for any specific goods, whether individually or not, have been provided and there is no evidence of e.g. any marketing in relation to the supply of goods as standalone products.

18. As regards the services for which the opponent's mark is registered in class 35 (EUTM1006014) there is no evidence of any use at any time in relation to any of them.

19. In relation to the services for which both earlier marks are registered in classes 38 and 41, I am prepared to accept that Virgin or Virgin Media is a supplier of TV, broadband and other telecommunications services and that it has relied, at least in part, on a set-top box to deliver some of its services. The evidence shows there have been a number of references in the media throughout the relevant period to TiVo or TIVO in connection with Virgin or Virgin Media, however, none of it is evidence of use by the proprietor or a third party with the authority to use those marks and the source of much of the "information" contained within the articles is not given. Some of it appears to be contradictory: e.g. Mr Bolter says the first TiVo co-branded product was released in December 2010, one article (Exhibit 1 page 58) refers to TiVo being first introduced in 2011 whereas other articles say it was "new" in 2012 (exhibit 1 page 56). Some of the newspaper articles, as set out above, refer to subscriber or customer numbers at various points in time though some refer to combined figures with others (e.g. Exhibit 1 page 16) and there is no evidence to show what, specifically, any customers may have subscribed to or bought nor under which mark nor when. Whilst some of the articles refer to Virgin/Virgin Media's income or profits, the source of these figures are not specified and various articles refer to the fact that not all of Virgin/Virgin Media's customers were subscribers to a TiVo branded service. There is no evidence which informs me as to what specific services may have been provided under the earlier marks and what figures are given are not broken down in any way to show how much, if any, might have derived from e.g. subscription TV services as opposed to, say, telecommunication services being telephone services or broadband services (should such services have been supplied under the marks). Whilst the material at Exhibit 4 refers to a marketing campaign

through various media, other than the still for the planned TV advertisement mentioned above (which does not show either trade mark), no examples of any actual advertising or marketing materials have been filed and no evidence is given to show where it may have appeared or when. There is no evidence to show who or how many people would have seen any of the advertising or what, specifically they may have seen in terms of the earlier marks or goods or services involved.

20. In Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v OHIM* the General Court stated:

“53 In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (COLORIS, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07 P *Ferrero Deutschland v OHIM*, not published in the ECR, paragraph 36).”

21. In *PLYMOUTH LIFE CENTRE* (BL O-236-13), Mr Daniel Alexander Q.C. sitting as the appointed person stated:

“22...it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the

first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

22. In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Mr Geoffrey Hobbs Q.C. sitting as the appointed person, stated:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co v Comptroller-General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

“[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made, For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.”

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the

evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

23. The evidence which has been filed is not from an officer from the opponent company nor from Virgin/Virgin Media and I have already commented on the lack of detail regarding the source of the content of some of Mr Bolter's witness statement although the overwhelming majority of the exhibits are taken from published articles downloaded from a commercial database. No turnover or sales figures for any of the specific goods or services as registered have been provided and, with the exception of the single still from the planned television advertisement described above, no evidence of what advertising or marketing material may have been presented to potential purchasers of the opponent's (or any distributor's) goods or services during the relevant period has been filed. There is no evidence to show how any goods and services were presented to (potential) customers whether in terms of the goods and services themselves or the earlier marks as relied upon. All of this is material which should have been relatively easy for the opponent to supply given the length and extent of claimed use. As set out above, the onus under section 100 of the Act is on the proprietor (in this case the opponent) to show what use has been made of its marks. Taking all relevant factors into account and considering the evidence as a whole as I am required to do, I find that the evidence filed is not sufficient to discharge that onus. The opponent has not shown genuine use of either mark within the relevant period in relation to any of the goods or services for which they are registered.

Summary

24. In view of my findings, the opponent is not entitled to rely on either earlier mark. That being the case, its opposition under both section 5(2) and 5(3) of the Act fails.

Costs

25. The opposition having failed, the applicant is entitled to an award of costs. I make the award on the following basis:

For filing Form TM8 and reviewing the Form TM7: £200

For reviewing the opponent's evidence and filing written submissions: £500

Total: £700

26. I order TiVo Brands LLC to pay Vivo International Limited the sum of £700. In the absence of any appeal against my decision, this sum should be paid within 14 days of the expiry of the appeal period.

Dated this 8th day of May 2017

Ann Corbett

For the Registrar

The Comptroller-General