

BLO/316/20

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3343515
BY GAMES SCIENCE LTD
TO REGISTER AS A TRADE MARK:**

DILEMMA

IN CLASSES 9, 16, 28, 35 & 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 415291
BY EMMA CATHERINE HOWEY**

BACKGROUND AND PLEADINGS

1. On 5 October 2018, Games Science Ltd (“the applicant”) applied to register the trade mark **DILEMMA**, under number 3343515 (“the application”). It was accepted and published in the Trade Marks Journal on 26 October 2018 in respect of the following goods and services:¹

Class 9: Computer software; computer games software; computer software for database management and searching databases; databases; software applications for computers, laptops, mobile phones and tablet devices; downloadable electronic publications; computer software in relation to team building, the development of individuals and organisations and change management.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; periodicals; magazines; books; book covers; catalogues; calendars; diaries; booklets; cards; stationery; office requisites; notepads; folders; pens; pencils; pencil sharpeners; pencil cases; erasers; rulers; boxes for pens; book markers; drawing materials; instructional and teaching materials; parts and fittings for all the aforesaid goods.

Class 28: Games and playthings; board games; electronic board games; playing cards; dice games; game cards; parts and fittings for all the aforesaid goods.

Class 35: Human resources management and consultancy; business organisation; assistance in relation to business organisation; strategic business management; commercial assistance relating to system implementation and system integration; business management consultancy as well as development of processes for the analysis and the implementation of strategy plans and

¹ The specifications of classes 16 and 41 of the application have since been amended to include a limitation, namely, *‘none of the aforesaid relating to fashion’*, by virtue of Form TM21B filed by the applicant on 9 December 2019.

management projects; analysis of company behaviour; business research and surveys; market surveys; compilation of computer databases; computer database management; information, advisory and consultancy services relating to all the aforesaid services.

Class 41: Education; providing of training; organising, arranging and conducting seminars, workshops and training sessions; publication of books, periodicals and magazines and texts; publication of books, periodicals and magazines and texts in relation to team building, the development of individuals and organisations and change management; team building training; career consultancy (educational and training consultancy); career advisory services (educational and training advice); providing on-line computer database in the field of computer games; electronic games services provided from a computer database or by means of the internet; publication of material which can be accessed from databases or from the internet; information, advisory and consultancy services relating to all the aforesaid services.

2. On 25 January 2019, Emma Catherine Howey (“the opponent”) filed a notice of opposition. The opposition is brought under Sections 5(1) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against the following goods and services of the application:

Class 9: Computer software; computer games software; computer software for database management and searching databases; databases; software applications for computers, laptops, mobile phones and tablet devices; downloadable electronic publications; computer software in relation to the development of individuals and change management.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; periodicals; magazines; books; book covers; catalogues; calendars; diaries; booklets; cards; stationery; office requisites; notepads; folders; pens; pencils; pencil sharpeners; pencil cases; erasers; rulers; boxes for pens; book markers; drawing materials; instructional and teaching materials; parts and fittings for all the aforesaid goods.

Class 41: Education; providing of training; organising, arranging and conducting seminars, workshops and training sessions; publication of books, periodicals and magazines and texts; publication of books, periodicals and magazines and texts in relation to team building, the development of individuals and change management; career consultancy (educational and training consultancy); career advisory services (educational and training advice); electronic games services provided from a computer database or by means of the internet; publication of material which can be accessed from databases or from the internet; information, advisory and consultancy services relating to all the aforesaid services.

3. The opponent relies upon two United Kingdom Trade Marks (“the earlier marks”), the relevant details of which are displayed below:

UK00002430158 (“the 158 mark”)	UK00002430156 (“the 156 mark”)
	
<p>Filing date: 14 August 2006 Registration date: 31 July 2009 Series of four marks (figurative)</p>	<p>Filing date: 14 August 2006 Registration date: 11 June 2010 Series of four marks (figurative)</p>

4. A full list of the goods and services for which the earlier marks are registered are included as an annex to this decision. However, for the purposes of the opposition, the opponent relies upon the following goods and services:

The 158 mark

Class 16: **Paper, cardboard and goods made from these materials, posters, cards, postcards, greetings cards, trading cards, invitations, diaries, calendars, photograph albums, prints, paper and plastic bags, gift boxes, storage boxes, posters, notepads, writing instruments and crayons, coasters, desk mats, gift tags and printed tags for luggage, stickers, transfers, stamps, personal organisers, address books, notebooks, office requisites, pen and pencil holders, gift wrap, gift vouchers and holders, printed publications, magazines, books, pamphlets, printed guides, catalogues, programmes, photographs, stationery, instructional and teaching materials, plastic material for packaging, paper materials for packaging, tissue paper, ornaments of paper, card.**

The 156 mark

Class 9: **Audio, video, still and moving images and data recordings in compressed and uncompressed form;** computer software, including software for use in downloading audio, video, still and moving images and data in compressed and uncompressed form from a computer or communication network and organisation of data; **downloadable electronic publications;** computer, electronic and video games programmes and equipment; **electronic instructional and teaching apparatus and instruments,** mobile phone fascias and covers; and parts for all the aforesaid goods.

Class 16: **Paper, cardboard and goods made from these materials; posters, cards, postcards, greetings cards, trading cards, invitations, diaries, calendars, photograph albums, prints, paper and plastic bags, gift boxes, storage boxes, posters, notepads, coasters, desk mats, gift tags and printed tags for luggage, stickers, transfers, stamps, personal organisers, address books, notebooks, office requisites, pen and pencil holders, gift wrap, gift vouchers and holders, sewing and knitting patterns, printed publications, magazines, books, pamphlets, printed guides, catalogues,**

programmes, photographs, stationery, instructional and teaching materials, plastic material for packaging, paper materials for packaging; tissue paper, **ornaments of paper, card**.

Class 41: **Education; providing of training; entertainment**, including provision of on-line electronic publications from the Internet; electronic games services; **production and rental of educational and instructional materials; publishing services (including electronic publishing services); exhibition services; organisation, production and presentation of live and pre-recorded shows, roadshows, performances, competitions, contests, games, concerts and events; provision of information and advisory services relating to any of aforesaid services; arrangement and conducting of conferences, seminars, conventions, workshops for educational and recreational purposes; computer based/assisted education and teaching services; design of educational courses, examination and qualifications**; education services relating to business franchise management; **life coaching/lifestyle counselling/consultancy; mentoring (training); organisation of courses using distance learning and open learning methods**.

Class 44: **Consultancy services relating to personal behaviour**; preparing psychological profiles.

5. Given the respective filing dates, the opponent's marks are earlier marks, in accordance with Section 6 of the Act. As they had been registered for more than five years at the application date of the application, they are subject to the proof of use requirements as specified in Section 6A of the Act. In its notice of opposition, the opponent claimed that the earlier marks had been used for the goods and services presented in bold, above.

6. The opponent contends that the word "dilemma" forms an integral and fundamental element of the earlier marks. Despite the marks being figurative in nature, the opponent argues that the word "dilemma" is the distinctive and dominant element of the earlier marks, while the figurative swirl device plays a lesser role. Moreover, in

respect of the 156 mark, the opponent submits that the dominance of the word “dilemma” is not diminished by the inclusion of the word “style”, due to it being less distinctive and less memorable. The opponent highlights that the application shares this common distinctive element and argues that the contested mark is too conceptually similar to the earlier marks for consumers to distinguish between them. Furthermore, the opponent submits that the competing trade marks would “seek to operate in the same or very similar marketplaces”. These factors, the opponent contends, will result in a likelihood of confusion. The opponent also argues that the applicant’s use of the contested mark would amount to unfair advantage, though I note that the opposition has not been pleaded on the basis of Section 5(3) of the Act.²

7. The applicant filed a counterstatement denying the grounds of opposition. The applicant denies that the competing trade marks are identical and further denies that the marks are similar, despite them sharing the common word “dilemma”. On this basis, the applicant disputes the existence of a likelihood of confusion. In its counterstatement, the applicant indicated that it would require the opponent to provide evidence of use of its marks.

8. The applicant has been professionally represented throughout these proceedings by Gill Jennings & Every LLP, while the opponent is unrepresented. Only the opponent filed evidence in these proceedings. The applicant filed written submissions in lieu of an oral hearing. I do not intend to summarise these submissions here but will refer to them throughout this decision, as and where appropriate. Both parties were given the option of a hearing but neither asked to be heard on this matter. Therefore, this decision is taken following a careful perusal of the papers, keeping all submissions in mind.

² As Section 5(3) of the Act has not been pleaded in these proceedings, the opponent’s references to unfair advantage are not considered relevant for the purposes of my decision and will not form part of my assessment under Sections 5(1) and 5(2)(b) of the Act.

EVIDENCE

Opponent's evidence

9. The opponent's evidence consists of a witness statement of Emma Howey, the opponent, together with twenty-four exhibits.

10. Exhibit SDA1 is a copy of a leaflet for an event at Kirkley Hall, at which it appears that the opponent provided fashion advice for Christmas and New Year festivities. The details of the leaflet are largely incomprehensible, though there is an invitation to prospective attendees to "dispel your style dilemmas". There is no use of the earlier marks as indicators of brand origin. The exhibit is undated, however, the opponent's witness statement indicates that the leaflet is from 2006.

11. Exhibit SDA2 is a copy of a leaflet for a wedding open day event at Maften Hall, at which it appears the opponent ran a 'style the bride' competition. No use of the earlier marks is evident from the leaflet. The exhibit is dated 29 April, but does not demonstrate what year it is from. In its witness statement, the opponent indicates that the leaflet is from 2006.

12. Exhibit SDA3 is a print of information regarding the domain name styledilemma.co.uk. The print indicates that the domain name was active between 23 March 2005 and 22 February 2020 (upon which date the domain was up for renewal). There is nothing in the exhibit which directly ties the domain name to the opponent and there is no use of the earlier marks in relation to the goods and services for which they are registered.

13. Exhibit SDA4 is a print of a letter from Next Retail Ltd, addressed to the opponent and Style Dilemma. The letter is dated 13 May 2009. The contents of the letter are not visible in the exhibit, other than references to previous correspondence and telephone conversations. It is unclear what the correspondence was regarding and, as such, what the exhibit is intended to demonstrate.

14. Exhibit SDA5 is a photograph of word documents pertaining to a column on MSN, dated 2 July 2009. The exhibit shows use of “Style Dilemma” in word-only format and indicates that this was to be the name of the column.

15. Exhibit SDB1 comprises a photograph of a Copyright Acknowledgement Booklet from the examination board OCR, regarding the Advanced GCE English Language examination in January 2011. The 156 mark is displayed on the top-right of one of the pages.

16. Exhibit SDB2 is a photograph of the same documents as in Exhibit SDB1, though in this exhibit the OCR Advanced GCE English Language examination reading booklet is visible. There is no use of the earlier marks.

17. Exhibit SDB3 is a photograph of press cards from the retailer House of Fraser. These are addressed to the opponent. However, the exhibit is undated and there is no use of the earlier marks.

18. Exhibit SD4 is a print of an email from Press Association addressed to the opponent. The email appears to be welcoming the opponent to the site and advising that access has been granted to their collection of images. There is use of Style Dilemma, though only as part of the opponent’s email address. The email is dated 24 September 2009.

19. Exhibit SDC1 is a photograph of cards, compliment slips and testimonial leaflets, all bearing the 156 mark (or variants). The items shown in the exhibit all appear to be connected to a style and fashion consultancy business. The exhibit is undated.

20. Exhibit SDC2 comprises a photograph of an information booklet, upon which the 156 mark is displayed. The information booklet is undated. Also displayed in the photograph is the opponent’s client file from 2018 for its style and fashion consultancy.

21. Exhibit SDC3 is a photograph of cards, complement slips and testimonial leaflets, all bearing the 156 mark (or variants). The items all appear to be connected to a style and fashion consultancy business. Th exhibit is undated.

22. Exhibit SDC4 is a photograph of cards and leaflets bearing the 156 mark (or variants). The leaflet includes information about a “shoe dilemma” and advice, which would appear to be connected to the style and fashion consultancy business. The exhibit is undated.

23. Exhibit DA1 comprises a print of an order for 500 business cards, purchased by the opponent on 11 February 2014. The order confirmation demonstrates that the business cards were to bear the 158 mark.

24. Exhibit DA2 is a photograph of an advertisement board regarding a special collection in 2015 for Mothering Sunday. The 158 mark can be seen at the bottom of the board, though the advertisement relates to jewellery.

25. Exhibit DA3 is a photograph of leaflets promoting the opponent’s jewellery and handmade designs in a display cabinet at gallery45. The 158 mark can be seen on the leaflets in combination with the word “jewellery”. The exhibit is undated.

26. According to the opponent, Exhibit DA4 is a “blue light collection promotional photo”. While it is not entirely clear from the exhibit, I would interpret this to be jewellery. The jewellery is presented upon a display bearing the 158 mark. The exhibit is undated.

27. Exhibit DB1 is an information sheet relating to the opponent’s jewellery business; there are a number of photographs of jewellery displays and corresponding details about the items. Use of the 158 mark can be seen on the information sheet. The exhibit also demonstrates that the jewellery is to be supplied with Dilemma branded packaging. The exhibit is undated.

28. Exhibit DB2 appears to be a promotional advertisement for the opponent’s jewellery business. There is no use of the marks, though the word “dilemma” is used in combination with the word “jewellery”. The copyright suggests that the advertisement is from 2018.

29. A Dilemma Network Artists listing is included at Exhibit DB3. The listing describes the jewellery business and the goods it produces, as well as providing contact details for various platforms. Overall, the listing appears to be promoting the opponent's jewellery business. No use of the marks is evident from the exhibit, which is listed under the opponent and "Dilemma Jewellery". The exhibit is undated, though the opponent maintains that it is from 2018-2019.

30. Exhibit DB4 is a photograph of packaging and display materials adorned with the 158 mark. These appear to be used for the packaging and displaying of the opponent's jewellery products. The exhibit is undated.

31. Included at Exhibit DB5 is a photograph of assorted documents shown in Exhibits DB1 through DB4. The exhibit supports the opponent's narrative that the Network Artists directory (in which it had a listing) is from 2018-2019. Also pictured in the photograph is a business card bearing the 158 mark in conjunction with the word "Jewellery".

32. Exhibit WS1 is a print of an entry in the Design Network online catalogue. The exhibit shows use of the 158 mark underneath photographs of the opponent's jewellery products. The exhibit is undated, though the opponent indicates that it is from 2015.

33. Exhibit WS2 comprises prints of the opponent's website www.dilemmajewellery.co.uk, Instagram page, and Twitter page. The print of the website is low quality, though a vague outline of the 158 mark can be made out in the top-left corner. I note that no indication of website traffic has been provided. With regards the print of the opponent's Instagram page, there is no indication of how many followers the account has. Again, the print is of low quality but the 158 mark appears to be visible in the top-left corner. In relation to the Twitter page, I cannot confirm how many followers the account has. I note there is no use of the marks and the handle is listed as "Dilemma Jewellery".

DECISION

34. Section 5(1) of the Act reads as follows:

“(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

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

“5(2) A trade mark shall not be registered if because -
[...]

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

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

Proof of use

36. I must firstly deal with the issue of whether, or to what extent, the opponent has shown genuine use of its earlier marks. The relevant statutory provisions are as follows:

“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 relevant period .

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) 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 Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

37. The onus is on the opponent, as the proprietor of the earlier marks, to show use made of the marks because Section 100 of the Act states:

“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.”

38. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period ending with the date of the application in issue, i.e. 6 October 2013 to 5 October 2018.

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

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

[EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to

encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

40. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

41. I am also guided by *Awareness Limited v Plymouth City Council*, Case BL O/236/13, in which Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, 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.”

42. He also further stated at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to

the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

43. In addition, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“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.”

44. I note from the opponent’s evidence that:

- Several of the exhibits pre-date the relevant period for assessing genuine use of the earlier marks (6 October 2013 to 5 October 2018), while others are simply undated;
- Parts of the evidence do not show the earlier marks at all, which, therefore, does nothing to demonstrate that the opponent has made genuine use of the earlier marks;
- Several of the exhibits which do contain the earlier marks clearly show that the marks are used in relation to the opponent’s jewellery business or fashion and style consultancy business, not the goods and services upon which the opponent relies;
- No evidence has been provided by the opponent pertaining to annual sales figures, market share within the context of the relevant economic sectors, or figures for spending on promotion.

45. Following my consideration of the evidence, I find that the opponent has not proved use of the earlier marks upon which it relies. A number of the exhibits supplied by the opponent are either undated or are from 2006, 2009 or 2011 and, therefore, do not prove use of the earlier marks during the relevant period. Indeed, some of the exhibits do not show trade mark use of the earlier marks at all. For the minority of exhibits

which do show use of the earlier marks, there is no indication from those exhibits that the earlier marks have been used in relation to the goods and services claimed in classes 9, 16, 41 and 44. It is established that use must be by way of real commercial exploitation of the mark on the market for the relevant goods and services; this is inextricably linked to the core function of the mark, which is to create an outlet for the goods or services that bear the mark.³ To my mind, the evidence demonstrates that the opponent may have used the marks in respect of producing and selling jewellery as well as the provision of fashion consultancy services, none of which are covered by the earlier marks. I accept that some of the exhibits evidence packaging, business cards, leaflets and the like which bear the earlier marks. Nevertheless, the evidence does not show that the opponent has created a market for those goods. Rather, these goods bear the marks in order to promote and/or market the opponent's jewellery and its fashion consultancy. In *Abanka D.D. v Abanca Corporación Bancaria S.A.* [2017] EWHC 3242 (Ch), Mr Daniel Alexander QC, sitting as a Deputy Judge of the Chancery Division, observed:

“It is artificial to say that every time a trader in goods or services X provides information about those goods in the course of attempting to sell X, that it is thereby providing a separate service of advertising X or providing business information about X or some similarly described service. While in some cases it may be appropriate to treat the provision of advertising materials and information relating to goods or services as provision of a separate service, that is not invariably the case and depends on the facts relating to use.”

46. Although the opponent has evidenced packaging, business cards and leaflets bearing the marks, the activity of producing such goods is not provided to others: it is so that it can sell and promote the jewellery it develops and market its fashion consultancy services. Such activity is analogous to the advertising example in the *Abanka* judgment, quoted above. On this basis, I consider that the opponent's packaging, business cards and leaflets only bear the earlier marks in order to promote its own products and services and, accordingly, does not demonstrate genuine use of the marks in relation to the goods and services for which they are registered. No

³ Case C-141/13, *P Reber Holding & Co KG v OHIM*

annual turnover figures have been provided in respect of the goods and services for which the marks are registered, nor has the opponent provided any information regarding the size of the relevant markets and its market share. Therefore, it is impossible to ascertain the volume of goods and services provided during the relevant period. I appreciate that the opponent has provided an array of reasons for not providing such information. While that may be the case, and although such information is not available, it would not be determinative even if it were forthcoming due to the issues discussed above. With regards the opponent's website, and its Instagram and Twitter pages, the earlier marks are visible. However, no contextual details such as website traffic volumes or respective number of followers have been provided to illustrate the exposure of the marks to the marketplace during the relevant period. Moreover, no details on promotional spending for the goods and services at issue have been provided. Although the opponent has stated that promotion is ongoing by way of events and paid for advertising, this is not apparent from the evidence.

47. I accept that the genuine use provisions do not exist in order to assess economic success or large-scale commercial use.⁴ However, in my view, the evidence provided falls far short of the sufficiency and solidity needed to meet the standards of proof required. Accordingly, the earlier mark may not be relied upon to support the opponent's claims under Sections 5(1) and 5(2)(b) of the Act. Without establishing genuine use in relation to any goods or services for which the earlier marks are registered, it follows that the opposition must fail.

CONCLUSION

48. The opposition under Sections 5(1) and 5(2)(b) of the Act has failed in its entirety. Subject to any successful appeal, the application will proceed to registration.

COSTS

49. As the opposition has been unsuccessful, the applicant is entitled to a contribution towards its costs. The applicant has, through its representative, submitted that off-

⁴ Case T-334/01, *MFE Marienfelde GmbH v OHIM*

scale costs are appropriate, to compensate for the delays in regularising the notice of opposition and evidence as well as to deal with the “unreasonable behaviour” of the opponent. This “unreasonable behaviour”, according to the applicant’s representative, manifested in the opponent ignoring the applicant’s approaches prior to the commencement of these proceedings. Moreover, the applicant has highlighted that the opponent elected to ignore its voluntary limitation to the scope of goods and services covered by the application.

50. Tribunal Practice Notice (“TPN”) 4/2007 indicates that costs off the scale are available “to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour”. There was a delay of just over two months between the filing of the notice of opposition and it being served on the applicant. Furthermore, regularising the opponent’s evidence of proof of use required several attempts over the course of a number of months. This is clearly not an ideal state of affairs. However, the opponent has been unrepresented throughout these proceedings and did comply with the deadline for the notice of opposition even though the resulting form was deemed inadmissible. Additional time was afforded to the opponent during the evidential rounds due to mitigating circumstances which were impeding the opponent’s ability to adhere to the deadline and provide evidence in suitable format.

51. Having considered the conduct of proceedings, it is my view that off-scale costs are not appropriate in this instance. While there has been some delay, there is no evidence that the delays were a deliberate tactic and the length of time is not such as would warrant off-scale costs without a clearer explanation from the applicant of the prejudice suffered. The evidence was not disproportionate, nor entirely irrelevant and, in any case, would not have required excessive time to consider. While it would be unfortunate if the opponent refused to discuss the matter with the applicant prior to commencing opposition proceedings and failed to duly account for the applicant’s limited specification, I do not think that these amount to abusive behaviour on the part of the opponent.

52. The relevant scale is contained in TPN 2/2016. This decision has been taken from the papers without an oral hearing. The applicant did not file evidence in these proceedings but did file written submissions in lieu of a hearing. In the circumstances

I award the applicant the sum of **£1,100** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the opponent's statement and preparing a counterstatement	£200
Considering and commenting on the opponent's evidence	£500
Preparing written submissions in lieu of hearing	£400
Total	£1,100

53. I therefore order Emma Catherine Howey to pay Games Science Ltd the sum of **£1,100**. The above sum should be paid within two months of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 9th day of June 2020

James Hopkins
For the Registrar,
The Comptroller General

ANNEX: FULL SPECIFICATIONS OF EARLIER MARKS

UK00002430158

Class 3: Substances for laundry use including stain removers, soaps for cleaning (for household use), soaps for personal use, soaps for use during shaving, perfume/perfumery both personal and household, essential oils, cosmetics including make-up and nail care preparations and polish, false nails, depilatory products, pumice stone, talcum powder, sunscreen and sun-tanning preparations, skincare products, hair care including shampoos, hair colorants, false eyelash products, mouth washes, breath freshening sprays, boot wax and polish, creams for leather, bath salts, emery products, cotton wool/cotton sticks for cosmetic purposes.

Class 14: Precious metals and their alloys, goods in precious metals or coated therewith, jewellery, costume jewellery, precious stones, horological and chronometric instruments including clocks and watches, alarm clocks, stopwatches, artificial or semi-precious stones, badges, bracelets, brooches, cases for jewels and watches.

Class 16: Paper, cardboard and goods made from these materials, posters, cards, postcards, greetings cards, trading cards, invitations, diaries, calendars, photograph albums, prints, paper and plastic bags, gift boxes, storage boxes, posters, notepads, writing instruments and crayons, coasters, desk mats, gift tags and printed tags for luggage, stickers, transfers, stamps, personal organisers, address books, notebooks, office requisites, pen and pencil holders, gift wrap, gift vouchers and holders, sewing and knitting patterns, printed publications, magazines, books, pamphlets, printed guides, catalogues, programmes, photographs, stationery, instructional and teaching materials, plastic material for packaging, paper materials for packaging, tissue paper, cheque book holders, table linen of paper, ornaments of paper, card and papier maché, embroidery patterns, artist materials, paint brushes.

Class 18: Leather and imitations of leather and goods made of these materials, animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, rucksacks.

Class 24: Textiles and textile goods, bed and table covers, textile piece goods, textiles for making articles of clothing.

UK00002430156

Class 9: Audio, video, still and moving images and data recordings in compressed and uncompressed form; computer software, including software for use in downloading audio, video, still and moving images and data in compressed and uncompressed form from a computer or communication network and organisation of data; downloadable electronic publications; computer, electronic and video games programmes and equipment; mouse mats, electronic instructional and teaching apparatus and instruments, mobile phone fascias and covers; and parts for all the aforesaid goods, spectacles and sunglasses, protective clothing, television and radio signal transmitters and receivers.

Class 16: Paper, cardboard and goods made from these materials; posters, cards, postcards, greetings cards, trading cards, invitations, diaries, calendars, photograph albums, prints, paper and plastic bags, gift boxes, storage boxes, posters, notepads, writing instruments and crayons, coasters, desk mats, gift tags and printed tags for luggage, stickers, transfers, stamps, personal organisers, address books, notebooks, office requisites, pen and pencil holders, gift wrap, gift vouchers and holders, sewing and knitting patterns, printed publications, magazines, books, pamphlets, printed guides, catalogues, programmes, photographs, stationery, instructional and teaching materials, plastic material for packaging, paper materials for packaging; tissue paper, cheque book holders, table linen of paper, ornaments of paper, card and papier maché, embroidery patterns, artist materials, paint brushes.

Class 25: Clothing, footwear and headgear for men, women and children including knitted and woven items, hosiery and underwear, nightwear, sportswear, waterproof clothing, knitwear.

Class 38: Telecommunications; networking of audio, video, still and moving images and data relating to entertainment and fashion, whether in compressed or uncompressed form, and whether downloadable or non downloadable.

Class 41: Education; providing of training; entertainment, including provision of on-line electronic publications from the Internet; electronic games services; health clubs; production and rental of educational and instructional materials; publishing services (including electronic publishing services); exhibition services; organisation, production and presentation of live and pre-recorded shows, roadshows, performances, competitions, contests, games, concerts and events; provision of information and advisory services relating to any of aforesaid services; arrangement and conducting of conferences, seminars, conventions, workshops for educational and recreational purposes; computer based/assisted education and teaching services; design of educational courses, examination and qualifications; education services relating to business franchise management; education services relating to fashion, modelling, health, nutrition, physical fitness, beauty products/therapy, hairdressing products and techniques; fashion show services; freelance journalism; hosting awards; life coaching/lifestyle counselling/consultancy; mentoring (training); museum exhibitions; organisation of courses using distance learning and open learning methods.

Class 44: Hygienic and beauty care for human beings; advisory and consultancy treatment services relating to cosmetics, beauty treatment, diet, health, nutrition, slimming and the application of cosmetic products to the face, body; artificial suntanning services; barber and hairdressing/salon services including cutting, colouring, styling; information services relating to contact lenses, health assessment surveys; make-up services; manicuring; massage, pedicure services, personal hair removal; plastic surgery; reflexology; aromatherapy; Reiki services; smoking (anti) therapy; chiropody; consultancy services relating to personal behaviour; preparing psychological profiles.

Class 45: Personal and social services rendered by others to meet the needs of individuals namely: personal shopper services, arranging of wedding services, chaperoning services, clothing fashion consultancy, colour analysis for personal appearance; lifestyle counselling and consultancy (spiritual or fashion); clothing rental or hire including workwear.