

O/355/20

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. UK00003024436
IN THE NAME OF O2 WORLDWIDE LIMITED
FOR THE FOLLOWING TRADE MARKS (SERIES OF 2):**

GURU

Guru

IN CLASSES 35, 36, 37, 38, 41 AND 42

AND

**AN APPLICATION FOR REVOCATION
UNDER NO. 502566
BY JOSHI WORLDWIDE IP LIMITED**

BACKGROUND AND PLEADINGS

1. The trade marks **GURU/Guru** (series of 2) (registration no. 3024436) (“the Contested Registration”) stands registered in the name of O2 Worldwide Limited (“the proprietor”). The application for the Contested Registration was filed on 2 October 2013 and the registration procedure was completed on 14 February 2014. The Contested Registration stands registered for the services set out in the Annex to this decision.

2. On 17 April 2019, Joshi Worldwide IP Limited (“the applicant”) sought revocation of the Contested Registration on the grounds of non-use. Under section 46(1)(a) of the Trade Marks Act 1994 (“the Act”), the applicant claims non-use in the five-year period following the date on which the marks were registered, i.e. 15 February 2014 to 14 February 2019. The applicant requests an effective date of revocation of 15 February 2019. The revocation is directed against all services for which the Contested Registration is registered.

3. The proprietor filed a counterstatement defending its registration for all services for which the Contested Registration is registered.

4. Only the proprietor filed evidence in chief. The applicant filed evidence after the evidence rounds had concluded, to which the proprietor filed evidence in reply. I shall refer to this evidence below. A hearing took place before me on 28 May 2020, by video conference. The proprietor was represented by Mr Julius Stobbs of Stobbs IP and the applicant was represented by Mr Aaron Wood, instructed by Joshi Worldwide IP Limited. Both parties filed skeleton arguments.

EVIDENCE

5. The proprietor filed evidence in the form of the witness statement of Mr Peter Holmes dated 12 November 2019. Mr Holmes is Director of Brand of a group of subsidiary companies which include the proprietor. I have read Mr Holmes’ evidence in its entirety and will refer to it below where appropriate.

6. On 1 May 2020, late evidence was filed on behalf of the applicant in the form of the witness statement of Mr Wood dated 1 May 2020, which was accompanied by 2 exhibits. The purpose of this statement was to call into question the reliability of an exhibit that had been filed by Mr Holmes. On 4 May 2020, late evidence was also filed on behalf of the proprietor in the form of the witness statement of Ms Claire Louise Breheny dated 4 May 2020. Ms Breheny is one of the attorneys acting on behalf of the proprietor. The purpose of her evidence was to reply to the criticisms made by Mr Wood.

7. On 7 May 2020, the Tribunal wrote out to the parties as follows:

“It is the Tribunal’s preliminary view that the witness statement of Aaron Ronald Wood dated 1 May 2020 and the witness statement of Claire Louise Breheny dated 4 May 2020 should be admitted into proceedings. If either party wishes to challenge this preliminary view then they should do so within the next 7 days.

If the preliminary view is challenged, it will be dealt with as a preliminary point at the hearing listed for 28 May 2020.”

8. No correspondence was received from either party challenging the preliminary view given. Further, at the start of the hearing, I asked for confirmation that no challenge was being made. Both Mr Wood and Mr Stobbs confirmed that that was correct.

PRELIMINARY ISSUES

Disclosure of without prejudice material at a hearing

9. At the end of the hearing I invited the parties to make submissions on costs. In response to this, Mr Stobbs referenced an offer that had been made during the course of what, at the hearing, both parties agreed was correspondence marked “without prejudice save as to costs”. Since the hearing, Mr Wood has suggested that this correspondence was, in fact, “without prejudice”. Following the hearing, Mr Wood wrote to this Tribunal inviting me to consider whether a) it would be necessary for me to recuse myself as a result of the information disclosed by Mr Stobbs at the hearing

or b) whether it was necessary to redact or remove the part of the transcript which related to this statement.

10. I have considered the points raised by Mr Wood. However, I do not consider it necessary to do either. Mr Wood seeks to rely upon the judgment in *Berg v IML London Ltd* [2002] 1 WLR. In that case, the court considered the question of whether a decision maker should recuse themselves if they had had sight of without prejudice information. Burnton J emphasised that where a decision maker has seen without prejudice material, this does not give rise to a question of partiality or bias. Rather, a decision maker should recuse him or herself only if, subjectively, the knowledge acquired as a result of seeing that material prevents the decision maker from fairly continuing with the case or, objectively, a fair-minded and informed observer would conclude that there was a real possibility or danger that he or she could or should not continue with the case. I have considered these questions fully. As I noted at the hearing, it is not uncommon for without prejudice material to accidentally come before a decision maker. I take Mr Wood's point that, in this case, the disclosure was intentional on the part of Mr Stobbs. However, I do not consider that that affects my ability to put the matter from my mind and to decide this case on its merits. Further, I do not consider it necessary to redact or remove the affected part of the transcript. The disclosure in question came at the end of the hearing and I have simply not needed to revisit that part of the transcript in the preparation of this decision.

11. Notwithstanding this, I consider it important to note that Mr Stobbs' decision to disclose the information in question was entirely inappropriate. As an experienced attorney, Mr Stobbs is no doubt aware of his professional obligations. Parties are entitled to engage in settlement negotiations without concern that admissions or concessions made during the course of those negotiations may be brought before the final decision maker and relied upon to their detriment. That is the very purpose of without prejudice privilege. The correct approach in such circumstances, as indicated by Mr Wood both at the hearing and subsequently, would have been for Mr Stobbs to draw my attention to the fact that he wished to make costs submissions based upon without prejudice save as to costs material and to request the opportunity to make written submissions in this regard after the substantive decision had been issued.

Criticisms of Mr Holmes' evidence

12. As a preliminary point, I wish to address the criticisms made of Mr Holmes' evidence and the submission that it should be treated with caution. The criticisms levied at Mr Holmes' evidence seemed to focus upon three main points:

- a. That Mr Holmes had exhibited an erroneous document to his witness statement obtained from the Wayback Machine (specifically, within Exhibit PH2);
- b. That Mr Holmes has been criticised in previous decisions of this Tribunal in relation to his evidence; and
- c. That Mr Holmes had been careless in the preparation of his evidence and that this had resulted in it containing a number of errors.

13. I will address each of these points in turn.

14. In his witness statement, Mr Wood explained that the printout from the Wayback Machine Internet Archive dated 3 July 2017, within Exhibit PH2, showed an image of an Apple Watch Series 4 under the heading "Popular Devices". The purpose of Mr Wood's statement was to note that the Apple Watch Series 4 was not launched until September 2018 and so the date recorded by the Internet Archive could not possibly be accurate. Mr Wood also provided a screen shot of a page he initially thought to be the same, but which Ms Breheny notes actually relates to a different web address. In her statement, Ms Breheny accepted that there did appear to be an issue with the printout in question in that it displayed more recent technology than the date would suggest. In covering correspondence, the proprietor also noted that the Internet Archive is commonly relied upon in these proceedings without issue.

15. At the hearing, Mr Wood confirmed that his purpose in this regard was not to suggest that there had been any deliberate attempt by Mr Holmes to mislead the Tribunal. Rather, that his evidence should be treated with caution. Mr Wood suggested that, perhaps, insufficient care had been taken by Mr Holmes in the preparation of his statement which had led to him overlooking this discrepancy. I recognise that there is

clearly an error with the page in question. However, as noted by the proprietor, the Internet Archive is commonly relied upon in proceedings of this kind and is generally considered an accurate and reliable source of information. Whilst I recognise the printout in question must be treated with caution, I do not consider that it calls into question the reliability of Mr Holmes' evidence in its entirety.

16. In his skeleton argument, Mr Wood listed three decisions of this Tribunal in which Mr Holmes' evidence has been criticised.¹ However, the criticisms made of Mr Holmes' evidence in those cases did not relate to his credibility as a witness. They related to the provision of information from outside of the relevant period, the provision of information that was not apparently relevant to the issues in that particular case, or the failure by the proprietor to narrow the issues prior to the hearing. I do not, therefore, consider that these assist the applicant in calling into question the reliability of Mr Holmes' evidence.

17. Finally, a number of specific criticisms were made of Mr Holmes' evidence, in particular:

- a. That Mr Holmes had been too vague about the relationship between the various companies associated with the proprietor. I accept that the explanation given by Mr Holmes is far from clear. However, what is clear is that any use made by any of these group companies was use with the proprietor's consent and, consequently, can be taken into account for the purposes of assessing genuine use. I do not, therefore, consider this to be of significance.
- b. That Mr Holmes had not been clear enough about his specific role within those companies. Mr Holmes states that he has been "associated" with the companies since 1 February 2007, and that he is now Director of Brand. However, he does not state whether he had been in that role since that date or whether he has been associated in different ways. Again, I accept that Mr Holmes could have given a more thorough account of his employment

¹ O/220/14 at para 7, O/278/14 at paras 3 to 5, O/189/15 at paras 56 to 61

history with the proprietor and its associated companies. However, the key fact is that he is currently Director of Brand and, therefore, clearly has access to the necessary documents in order to provide the information that he has. I do not consider this to be an issue.

- c. That Mr Holmes has made errors within his statement. For example, he describes the number of “mentions” made of the Contested Registration on social media, when in fact the supporting document refers to “volume”² or where Mr Holmes refers to the YouTube TV Channel as the “most popular ‘how to’ channel on YouTube” when it is, in fact, only described as the most popular channel on YouTube in the UK.³ Regarding the latter, in the context of a statement intended to prove use in the UK, I see no issue with the statement made. I have noted these points, but do not consider them sufficient to call into question the reliability of Mr Holmes’ statement as a whole.
- d. That Mr Holmes seeks to provide expert evidence by making the statement: “I believe the evidence exhibited to this statement establishes evidence of use of the Mark in the UK between the relevant period of 15 February 2014 and 14 February 2019”. Whether there has been genuine use is, of course, a legal question, however to my mind, this is merely a statement by Mr Holmes of the proprietor’s position in these proceedings. I do not consider that this line of argument assists the applicant.
- e. That Mr Holmes describes a 21% uplift in ‘clicks’ (which he describes as a rise in searches) in the week following an advertising campaign and a 44% uplift after that. Mr Wood notes that a review of the supporting documentation suggests that ‘clicks’ are not the same as ‘searches’ and that in fact the agency that prepared the document suggested that these might have been attributable to “to some changes in ad copy” in addition to the campaign itself. I note the point with regard to ‘clicks’ and ‘searches’, but I see no fundamental issue with the statement made by Mr Holmes in relation

² Witness Statement of Peter Holmes dated 12 November 2019, para. 23 and Exhibit PH13

³ Witness Statement of Peter Holmes dated 12 November 2019, para. 29 and Exhibit PH17

to the effect of the campaign. In any case, the figures provided in that report show an increase in activity in relation to the Contested Registration, even if not all were as a result of the proprietor's advertising campaign.

18. Taking all of this into account, whilst I note the points made by Mr Wood, I do not consider that it would be appropriate to place any less weight on Mr Holmes' evidence because of these submissions.

MY APPROACH

19. Although a counterstatement was filed in respect of all services covered by the Contested Registration, at the hearing, Mr Stobbs accepted that only some of the services were now defended. Specifically, those set out in a covering letter with the proprietor's evidence (although I note that letter did not actually state that there had been a change in the proprietor's position in this regard) and replicated in Mr Stobbs' skeleton argument. I, therefore, consider the Contested Registration to be undefended in relation to the following services for which the marks will be revoked:

Class 35 Retail services and online retail services connected with scientific, nautical, surveying, cinematographic, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, for conducting, switching, transforming, accumulating, regulating or controlling electricity, automatic vending machines and mechanisms for coin operated apparatus, cash registers, calculating machines, fire-extinguishing apparatus, protective clothing, protective helmets, televisions, glasses, spectacle glasses, sunglasses, protective glasses and cases therefor, contact lenses, camera lenses, MP3 players, audio tapes, audio cassettes, audio discs, audio-video tapes, audio-video cassettes, audio-video discs, video tapes, video cassettes, video discs, CDs, DVDs, electronic publications (downloadable), mouse mats, magnets, magnetic cards, encoded cards, printed matter, books, magazines, paper, stationery, clothing, footwear, headgear, household or kitchen utensils and containers, jewellery, precious stones,

horological and chronometric instruments, musical instruments, apparatus for lighting, textiles and textile goods, leather and imitations of leather, handbags, rucksacks, purses, bags and sports bags, travel bags, backpacks, duffel bags, boot bags, holdalls, wallets, purses, credit card holders, games and playthings, gymnastic and sporting articles, meat, fish, poultry, game, coffee, tea, cocoa, sugar, rice, beers, mineral waters, aerated waters and other non-alcoholic drinks, alcoholic beverages, matches.

Class 36 Real estate affairs; Debit card services; Financial management; Financial sponsorship; Issue of tokens of value; issuing of tokens of value relating to customer loyalty schemes.

Class 38 Paging services [radio, telephone or other means of electronic communication]; Rental of facsimile apparatus; Rental of modems; Teleconferencing services.

Class 41 Organisation of shows [impresario services]; Organization of sports competitions; Production of music; Publication of books; Publication of electronic books and journals on-line; Publication of texts, other than publicity texts; Recording studio services; Recreation facilities (Providing -); Recreation information; Rental of sound recordings; Rental of video cassette recorders; Rental of videotapes; electronic games services provided by means of any communications network; sporting and cultural activities provided by means of telecommunications networks; provision of musical events; entertainment club services; discotheque services; presentation of live performances; night clubs; rental of music venues and stadiums; casino services; ticket reservations for entertainment, sporting and cultural events; ticket information services for entertainment, sporting and cultural events; ticket agency services;

Class 42 Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; Construction drafting;

Consultancy in the design and development of computer hardware; Providing search engines for the internet; Research and development for others; computer software design; computer system design; creating and maintaining websites for others; services of information brokers and providers, namely product research for others; weather forecasting; monitoring of network systems in the field of telecommunications.

20. For the avoidance of doubt, there is no evidence of use in relation to any of these services. I will, therefore, proceed with my assessment of this case based upon the defended services only.

DECISION

21. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

[...]

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that -

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.”

22. Section 100 is also relevant, which reads:

“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.”

23. 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 Bunderversvereinigung 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 Merken 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].”

24. 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 not, therefore, genuine use.

Form of the mark

25. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, the Court of Justice of the European Union (“CJEU”) found that “use of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark”, but that “a registered trade mark that

is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)".

26. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

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

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

27. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

28. The evidence shows a number of different uses of the Contested Registration. Clearly, there are examples of the Contested Registration being used as registered (GURU/Guru) which will be acceptable use by the proprietor.

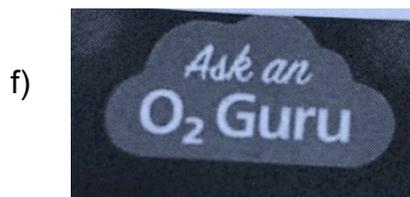
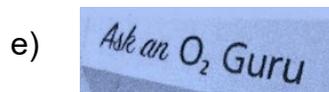
29. I also note the following ways in which the mark has been used:

a) O2 GURU/O2 Guru

b) O2 Gurus



d) O2 Guru TV



30. In his skeleton argument, Mr Stobbs directed me to a number of cases in which use of a mark in combination with a house mark had been found to be acceptable use. Mr Wood took me through a number of these cases at the hearing. For example, I note paragraph 34 of *Kathmandu Limited v Orlando Herry* (O/411/16) in which it was stated:

“34. [...] The earlier mark is found at the bottom of the packaging, often separated by a number of lines of text which identify the product, its features and/or its composition (see Exhibit KL6). Although the mark is used on the same swing tags and packaging as the device and the “Kathmandu” mark, there is sufficient separation between the various marks that “live the dream” in this context will be seen as a separate trade mark.”

31. Mr Wood sought to distinguish the present case from the cases relied upon by Mr Stobbs based upon the positioning of the respective marks on the goods in question. He suggested that where marks are separated in terms of distance on a product, they will clearly be identified as separate marks. However where, such as in this case, the marks are used side by side or combined within a device, they are unlikely to be seen as independent elements. I accept that in the above case the separation between the marks did, of course, assist in demonstrating that the marks were used independently of each other. However, it is not correct to say that marks must be used in a way that is physically distant in order to be considered use of the mark as registered or acceptable variant use. Each case must be decided upon its own merits, based on the way in which the mark in issue has actually been used and whether it retains an independent distinctive role that is indicative of origin within the composite mark.

32. The judgments in *Colloseum* and *Nirvana* make it clear that there are a number of questions that I must ask myself in determining whether the examples shown above amount to use of the marks as registered or acceptable variant marks. Firstly, I must ask myself whether the proprietor has used the Contested Registration. Clearly, it has. In each of the above marks the word GURU/Guru is clearly visible. I do not consider that the addition of the letter ‘S’ at the end of the word has an impact upon this. Similarly, I do not consider that the use of colour has any impact as registration of a mark in black and white covers use of that mark in any colour. Mr Wood correctly stated that this is not the end of the matter. There are, of course, circumstances in which a mark can be used as registered as part of a composite mark, but the way in which it has been used means that it is no longer indicative of the origin of the goods or services (for example, the word KNIGHT is used as registered within the mark

BLACK KNIGHT but no longer retains an independent distinctive role and does not continue to be indicative of origin).

33. This brings me on to the second question I must ask myself: does the way in which the proprietor has used the mark continue to indicate origin? In my view, the word GURU/Guru in all of the above marks clearly retains an independent distinctive role and, consequently, will distinguish the trade source of the services in relation to which the composite marks are used. Both parties noted, in this regard, that the O2 mark has enhanced distinctive character by virtue of the use made of it. When considering whether the word GURU retains its independent role in the combination “O2 GURU”, it is important to remember that marks will only form a unit where their use in combination results in a different meaning to the meanings of their separate components.⁴ In my view, they must create a different meaning over and above their trade mark meaning. Any enhanced distinctiveness attributable to the O2 mark would simply serve to reinforce GURU as an O2 mark i.e. O2’s GURU brand. This is a trade mark meaning and does not mean that these elements form a unit with any clear inherent meaning. By way of analogy, MONDEO will play an independent distinctive role in the mark FORD MONDEO. The mark O2 is likely to be viewed by the average consumer as two numbers, or a combination of a letter and a number. When used in combination with the word GURU, these elements will not carry any clear inherent meaning so as to form a unit. I accept that there may be some consumers who recognise the mark O2 as a chemical symbol for oxygen. However, even for those consumers, the marks still do not form a unit. Consequently, I consider that the word GURU has an independent distinctive role in all of the composite marks. I conclude that GURU was indicative of the origin of the services in all of the uses shown in the proprietor’s evidence. I do not consider that the addition of stylisation and/or various background devices alters this finding.

34. Mr Wood also suggested that the fact that O2 had acquired enhanced distinctive character through use, and that GURU should be considered inherently lacking in distinctive character, impacted upon the question of whether O2 GURU/Guru counted as use of GURU. In particular, Mr Wood made the following submission:

⁴ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

“We say that the distinctiveness of the GURU mark has some relevance, because where you have an element which is of a very low level of inherent distinctive character, then smaller changes can alter the distinctive character of the mark. Clearly, they have put a strong, another element at the front, O2, which itself has at least inherent distinctiveness at an average degree, and I am sure my friend would want to say that it has distinctiveness at a very high level, either inherently or due to the use made of it over many years by his client. [...] they simply cannot be use of an acceptable variant, because O2 has that added distinctiveness.”

35. For the avoidance of doubt, GURU is a registered trade mark and must, therefore, be treated as distinctive of the registered services (at least to some degree). Secondly, as noted above, it may very well be the case that O2 is more distinctive than GURU. However, this does not prevent GURU from distinguishing the origin of the registered services when used in combination with O2. When used in combination, it is likely that GURU will be seen as a secondary mark (i.e. O2’s GURU mark as explained above), but it still distinguishes the services offered by the proprietor, or with its consent. Consequently, the argument that O2 is more distinctive than GURU does not prevent me from finding that the composite marks are use of the mark GURU as registered as per *Colloseum*.

36. As I have found the above marks to amount to use of the Contested Registration as registered, I do not consider it necessary to go on to consider whether they are acceptable variant uses of the Contested Registration as per *Nirvana*. Nonetheless, in the event that I am wrong in my finding that the composite marks are use of the GURU/Guru mark as registered, I will make the following observations. The question posed by the caselaw around variant use does not require consideration of whether the mark as used as a whole differs in its distinctive character to the mark registered *solus*. If that were the case, use in combination with additional matter could only ever be acceptable use where the additional matter was, itself, non-distinctive. Clearly, that is not the case. The law in this regard requires three questions to be asked:

- a. What is the distinctive character of the registered mark?

- b. What are the differences between the mark used and the registered mark?
- c. Do the differences identified alter the distinctive character of the registered mark?

37. In this case the distinctive character of the Contested Registration lies in the word GURU/Guru. There are no other elements to contribute to its distinctive character. The differences between the Contested Registration and the uses shown in the proprietor's evidence involve the addition of various words or images (such as O2, TV or a cloud device). None of these alter the distinctive character of the word GURU/Guru itself. The word GURU/Guru is still very clearly present in all of the uses shown in the proprietor's evidence. As noted above, I do not consider that the addition of the letter 'S' at the end of the word has any impact, nor does the use of colour. Consequently, these differences do not alter the Contested Registration's distinctive character.

38. I therefore consider all of the above uses to be use of the Contested Registration upon which the proprietor can rely.

Sufficient Use

39. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself⁵.

40. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded 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". I accept Mr Stobbs' submission that the absence of turnover figures in this context does not, in itself, prevent there from having been genuine use.

⁵ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

41. Mr Holmes' evidence is that there are around 450 stores nationwide which offer services under the Contested Registration. The services are also provided by telephone, Twitter and live-chat facilities through the proprietor's website. Printouts from the Wayback Machine Archive show the Contested Registration in use on the proprietor's website (www.o2.co.uk/help/guru) dating back to 2014.⁶ These display the mark GURU/Guru as well as other composite marks listed below. They promote the proprietor's service, saying "Meet the O2 Gurus", "Book an O2 Guru Bytes workshop", "Book a Guru session in our stores – Pick up some tips to get your phone problems fixed, face to face" and "We know your phone is more than just a phone. And our expert Gurus are dedicated to helping you get the most out of it. From backing up your data, to advice on taking amazing photographs". There are also examples of the Contested Registration in use on the proprietor's social media platforms throughout the relevant period.⁷ Mr Holmes confirms that the proprietor's O2 GURU TV YouTube channel was launched in 2011 and has provided a print out from that site dating back to 2014.⁸ This channel displays the GURU/Guru mark or a composite version, as listed below. It states "Welcome to O2 Guru TV the home of O2's friendly tech experts on YouTube. We're here to provide help and inspiration so you can make the most of your technology and gadgets". Various published articles have been provided which refer to the services offered under the Contested Registration by the proprietor.⁹

42. Mr Holmes also gives evidence that there have consistently been a large number of employees engaged in providing services under the Contested Registration. Specifically, he states that in 2016 there were 264 employees, in 2017 there were 263 employees and in 2018 there were 250 employees. Mr Holmes also states that "the amount of GURU employees has remained consistent since launch, whereby for comparison, there were also around 250 personnel in 2010." However, Mr Wood referred to an article taken from the proprietor's own website which stated that there were only 150 employees in 2011.¹⁰ Mr Holmes' suggestion that the figures had remained consistent since launch (at around 250 employees) is clearly not correct.

⁶ Exhibit PH2

⁷ Exhibit PH2

⁸ Exhibit PH5

⁹ Exhibit PH7

¹⁰ Exhibit PH6

However, I see no reason to doubt the precise figures given for the years 2016, 2017 and 2018.

43. A sample flyer has been provided which was issued in 2014 in relation to a store in Cambridgeshire.¹¹ This clearly displays an acceptable use of the Contested Registration. Mr Holmes confirms that this is representative of similar flyers used for other stores during the same period. I take Mr Wood's point that no information is provided about how widely these flyers were distributed. Details have been provided regarding a number of marketing campaigns undertaken in relation to the Contested Registration. For example, in June/July 2014 an advertising campaign was conducted at a cost of around £479,000. Following that campaign, a report commissioned by the proprietor found that traffic to the proprietor's GURU website had increased by 61% and radio adverts had reached 14,163,000 listeners.¹² Similarly, an advertising campaign was undertaken with a budget of £4.46million in September and December 2014.¹³ I note Mr Wood's submission that at least some campaigns run by the proprietor seem to have been aimed at other marks such as "Be More Dog" and the proprietor's house brand. However, where there is also evidence of the campaigns promoting the GURU brand, I do not consider it significant that the campaigns promoted multiple marks.

44. Text adverts for services provided under the Contested Registration were sent to the proprietor's customers in 2016 and 2017.¹⁴ At least one of these is described by Mr Holmes in the exhibit itself as having been sent to "all customers". I note that Mr Holmes has provided UK customer numbers for the proprietor for the years 2016 and 2017 (25.463million and 25.004million respectively). If these texts adverts were sent to even a small proportion of these customers, this would be a significant advertising reach. I do note Mr Wood's submission that the example provided was clearly not the final version because it contained lorem ipsum text. However, I also accept Mr Stobbs' submission that adverts of this kind (i.e. sent by text message) are difficult to retrieve once they have actually been sent. Further, Mr Holmes confirms that the proprietor's

¹¹ Exhibit PH8

¹² Exhibit PH15

¹³ Exhibit PH16

¹⁴ Exhibit PH10

official Twitter account mentioned the Contested Registration more than 1,700 times between May 2016 and April 2018. More than 9,500 references were made to the phrase “O2 GURUS” on social media platforms (including Twitter, Google Plus, Facebook and Instagram) between January 2016 and May 2018.¹⁵ Whilst I note Mr Wood’s concern as to the accuracy of terms such as ‘mentions’ made in Mr Holmes’ statement, whatever the type of reference being made this is clearly not an insignificant number.

45. I note the figures provided by Mr Holmes for views of, and subscribers to, the proprietor’s YouTube Channel.¹⁶ Views were between 281,137 in 2018 and 2,483,233 in 2014 and subscribers were between 27,133 in 2014 and 35,497 in 2019. Mr Wood submitted at the hearing that we have no way of knowing where these viewers are located i.e. whether these can be considered customers based in the UK. Nonetheless, it seems to me a reasonable inference that at least a proportion of these views and subscribers will be from the UK public, given the other evidence which clearly is focused upon promotional activities directed at UK customers.

46. I also note the viewing figures provided in relation to the websites “o2.co.uk/help” and “o2.co.uk/guru”.¹⁷ These sites are clearly UK based websites and are, therefore, undoubtedly aimed at the UK public. The viewing figures were between 1,149,947 in 2015 and 8,363,097 in 2018. Mr Wood noted at the hearing that only one of these web addresses actually refers to the Contested Registration. I invited Mr Stobbs to direct me to a printout from the “o2.co.uk/help” page within the evidence which might suggest that the Contested Registration was in use on that site, even if it was not present in the domain name. He was not able to do so. Consequently, I agree with Mr Wood that it must be accepted that only a proportion of these figures relate to a site upon which the Contested Registration is displayed.

47. As noted by Mr Wood, there are clearly flaws with the proprietor’s evidence. However, taking the evidence as a whole, I am satisfied that it is sufficient to establish

¹⁵ Exhibit PH13

¹⁶ Witness Statement of Peter Holmes dated 12 November 2019, para. 30 and para. 31

¹⁷ Witness Statement of Peter Holmes dated 12 November 2019, para. 32

that there has been genuine use of the Contested Registration during the relevant period.

48. In reaching this conclusion, I have taken into account the submissions of Mr Wood that the GURU/Guru service is merely an add-on to the service offered by the proprietor under its other marks i.e. O2. In Mr Wood's words, the role of an O2 Guru is "to provide the ultimate customer experience". In this regard, Mr Wood directed me to the *Pathway*¹⁸ case, in which Mr Justice Carr considered whether the provision of office facilities was merely an adjunct to the rental of office space and therefore not genuine use in relation to those services. This was far from the main focus of that case. However, Mr Justice Carr upheld the Hearing Officer's decision that these services were merely an adjunct, i.e. the proprietor was not using the mark to create or maintain a market for the provision of office facilities.

49. In *Pathway* both services were offered under the same mark. Further, the services were very closely aligned and the provision of office facilities was a service only offered to customers of the office rental services. The present case, in my view, can be distinguished from that case for a number of reasons. In this case, the services provided under the GURU/Guru mark and the services offered under the O2 mark are clearly distinct. The services offered under the O2 mark appear to be telecommunications and retail services, whereas the services provided under the GURU mark are technical and/or advisory in nature. The proprietor is attempting to create or maintain a share in the market for these services offered under the GURU mark. It will, of course, be competing with other undertakings who offer a similar service, probably for a fee. The fact that the proprietor does not charge upfront for its services is not fatal. For example, a supermarket does not charge for its retail services upfront. Rather, it hopes to gain remuneration for those services by making sales of goods within the retail environment. This does not mean that the supermarket is not making genuine use of its mark in relation to retail services; on the contrary, it will quite clearly be trying to create or maintain a share in the market for those services. I note that Mr Holmes makes reference to the fact that the service is offered, not just to O2 customers but also to the wider public including prospective customers. To my mind,

¹⁸ [2018] EWHC 3608 (Ch)

the fact that the proprietor might obtain remuneration for these services through the sale of products or services within the O2 shop, does not mean that they are not still competing for a share in the market for the technical and advisory services offered under the GURU mark. This is further reinforced by the fact that the proprietor is, of course, using different marks for its technical and advisory services on the one hand and its retailing and telecommunications services on the other. Taking all of this into account, I do not consider that this line of argument assists the applicant.

Fair Specification

50. I must now consider whether, or the extent to which, the evidence shows use for the services for which the Contested Registration is registered.

51. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

52. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

53. I will now consider the defended services in turn.

Class 35

Retail services and online retail services connected with photographic, optical, apparatus and instruments apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, data processing equipment and computers, apparatus for the transmission of sound and image, telecommunications apparatus, mobile telecommunication apparatus, mobile telecommunications handsets, computer hardware, computer application software, computer software, computer software downloadable from the Internet, PDAs (Personal Digital Assistants), pocket PCs, mobile telephones, laptop computers, telecommunications network apparatus, drivers software for telecommunications networks and for telecommunications apparatus, headphones, GPS navigation devices, computer software recorded onto CD Rom, SD-Cards (secure digital cards), cameras, mobile telephone covers, mobile telephone cases;

54. Retail services involve the selling of goods to the public. I have seen no evidence that the proprietor is engaged in providing retail services of any kind to the public under the Contested Registration. The fact that the proprietor may provide these services under one of its other trade marks is irrelevant.

Information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

55. I accept that it may be the case that under the Contested Registration, the proprietor offers information and advice about goods sold through the proprietor's O2 retail outlets. However, this cannot be considered, to my mind, the same as providing information and advice about the retail services themselves. I do not, therefore, consider that this assists the proprietor. I have seen no evidence that suggests the proprietor provides information and advice in relation to retail services under the Contested Registration.

Class 36

Insurance; Financial affairs; Monetary affairs; Financial consultancy; Financial information; Financing services; Funds transfer (Electronic -); Financial information and advice relating to tariffs; financial payment services; payment processing services; electronic payment services; automated payment services; payment collection agencies; processing of payment transactions via the Internet; money transfer services; electronic funds transfer services; bill payment services;

56. At the hearing, Mr Stobbs accepted that there were no exhibits that he could direct me to which demonstrated use in relation to the class 36 services. In this regard, Mr Stobbs submitted:

“Obviously, part of the retail offering is around the provision of financial insurance relating to the products that you are buying. They are financial offerings, the gurus do advise on those and Mr Holmes confirms that they do.”

57. I do not consider that the confirmation on the part of Mr Holmes, in the absence of any supporting documentation, is sufficient to demonstrate that the Contested Registration has been used in relation to these services. The assertion that the proprietor may offer insurance in relation to its products, in the absence of any evidence, is not of assistance to the proprietor.

Charitable fund raising;

58. Mr Holmes notes that the proprietor has partnered with the NSPCC to try to provide advice about children’s safety online through the services offered under the Contested Registration. An article dated 4 January 2019 from the NSPCC website states: “Get help from an O2 Guru. Anyone can get free online safety advice from O2’s friendly experts in-person at an O2 store. They can help you set up parental controls, or teach you how to make a phone safe for a child.”¹⁹ A similar article on the proprietor’s website dated 8 March 2018 states: “And if you need more help on anything, from setting up

¹⁹ Exhibit PH11

parental controls to reporting online bullying, you can call our free helpline [...] or visit an O2 Guru in one of our stores.” Mr Holmes notes that the website receives around 400,000 unique users per annum and that 2,800 online safety appointments were booked under the Contested Registration in 2016 and just under 2,000 in 2018.

59. I agree with Mr Wood, that the fact that the proprietor has engaged in promotional activities in association with a charity (in this case, the NSPCC) does not amount to the proprietor actually providing charitable fund raising services under the Contested Registration. The purpose of the proprietor’s involvement in this collaboration is to direct customers to its services, rather than to engage in fund raising itself. Mr Stobbs submitted that the fact that this collaboration served to raise the profile of both the GURU brand and the NSPCC, was relevant. I disagree. Ultimately, there is no suggestion that charitable services are actually offered under the marks.

Information and advice relating to finance and insurance; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

60. I note Mr Stobbs’ submission that the “Gurus” advise on the insurance products provided by the proprietor to its customers. However, there is no evidence that these insurance products are actually provided and, further, no evidence that the “Gurus” advise on them. Similarly, there is no evidence that the proprietor provides information or advisory services in relation to any of its other class 36 services.

Class 37

Installation, maintenance and repair of telecommunications apparatus and equipment; installation, maintenance and repair communications networks, computer networks and data networks; installation, maintenance and repair of computer hardware; installation, maintenance and repair of computers and computer peripherals; computer and telephone battery recharge services.

61. The proprietor's social media platforms suggest that a service is operated by the Gurus, by which customers can contact them through social media or book appointments with them in order to discuss issues that they are having with their devices.²⁰ For example, I note the following comments:

"That would depend on what new phone you purchased and how the documents have been backed up [...]. Your phone may just need a full back up and restore completing to resolve the issue, the Guru can certainly do this in store."

"If you book an appointment Will, the in store Guru will be able to check if you have completed any back ups that can be restored back through to your phone to bring the contacts back."

"We'd have to look at the handset and the issue. Please book to see a Guru..."

62. Only part of the conversations have been provided and so it is difficult to determine the full context of these conversations. However, it does appear that appointments can be booked with a Guru in order to address ongoing maintenance issues with mobile devices. There is no suggestion that this services is limited to O2 customers only.

Information and advisory services relating to the aforesaid services; Information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

63. As noted above, it appears that Gurus can be contacted via the proprietor's social media platforms for questions to be asked about mobile devices. These appear to, in the first instance, lead to information and advice being provided online to customers. However, where this is not able to resolve the problem, an opportunity is provided for the customer to book an appointment with a Guru in store. There are also a number of examples from the proprietor's YouTube channel which show videos providing

²⁰ Exhibit PH12

information about the installation of mobile devices such as how to set up your sim card in an iPhone and how to transfer your data from an Android phone to an iOS phone and vice versa.²¹

Class 38

Telecommunications; Cellular telephone communication; Communications by computer terminals; Communications by fiber [fibre] optic networks; Communications by telephone; Computer aided transmission of messages and images; Electronic bulletin board services [telecommunications services]; Electronic mail; Message sending; Providing telecommunications connections to a global computer network; Providing user access to global computer networks; Satellite transmission; Telephone services; Transmission of digital files; Voice mail services; Telecommunications services; mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; fixed line telecommunication services; provision of broadband telecommunications access; broadband services; Internet access services; email and text messaging services; services of a network provider, namely rental and handling of access time to data networks and databases, in particular the Internet; communications services for accessing a database, leasing of access time to a computer database, providing access to computer databases, rental of access time to a computer database; operation of a network, being telecommunication services; the provision of discussion forums; operating web logs [blogs]; operating message boards.

64. I recognise that at least some of these services might be a reasonable description of the services provided by the proprietor under its other trade marks. However, there is no evidence of any of these services being provided under the Contested Registration. I do not, therefore, consider that the proprietor has shown genuine use in relation to these services.

²¹ Exhibit PH5

Providing internet chatrooms.

65. In this regard, Mr Stobbs submitted:

“We say that is a clear part of the GURU service. You can go online and chat with these gurus. That is exactly the nature of a chat room.”

66. I accept that the proprietor offers the function to converse with its employees under the Contested Registration via an online chat service. However, that is not, to my mind, the same as providing internet chatrooms. By way of analogy, the fact that a business offers an email address through which customers can contact it for advisory services does not mean that that business is providing email services. Rather, the chat function offered by the proprietor it is an alternative means of providing information to customers rather than using more common methods such as telephone or email. The provision of internet chatrooms would involve the commercial provision of a platform to enable other people to use the chatroom with third parties. These will be offered by specialist providers. There is no evidence that the proprietor is attempting to create or maintain a share in the market for these services.

Rental of message sending apparatus; Rental of telecommunication equipment; Rental of telephones;

67. I have reviewed all of the documents to which Mr Stobbs directed me with regard to these services. The only point that I can identify from any of these documents which is in anyway related to the rental of equipment is the fact that customers are allowed to try out devices and equipment in store before they buy it. This is, quite clearly, not an attempt to create or maintain a share in the market for these services. There is no evidence that the rental of any equipment is provided under the Contested Registration.

Television broadcasting services; broadcasting services relating to Internet protocol TV; provision of access to Internet protocol TV; broadcasting services; webcasting.

68. In this regard, Mr Stobbs submitted:

“TV Broadcasting, we say everything to do with our O2 Guru TV Channel on YouTube is TV broadcasting. [...] We are not saying that we do more than a TV channel on YouTube, but we say that is TV broadcasting and does support the specification relating to broadcasting. Broadcasting services, TV broadcasting, broadcasting services relating to internet protocol TV and webcasting, et cetera, are all part of that service that is provided through O2 Guru TV.”

69. To my mind, the activities described by Mr Stobbs are clearly not sufficient to show use in relation to the services covered by the Contested Registration. The services described in the specification would cover the commercial provision of those services to a third party. The fact that the opponent uses a third party video hosting platform to display videos on something called “the O2 Guru TV Channel” is not sufficient to show use in relation to these services.

Information about telecommunication; information services provided by means of telecommunication networks relating to telecommunications; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

70. I have seen no evidence about information and advice being provided in relation to any of these services under the Contested Registration.

Class 41

Education; Providing of training; Arranging and conducting of colloquiums; Arranging and conducting of conferences, congresses, seminars, symposiums and workshops; Coaching [training]; Organisation of exhibitions for cultural or educational purposes; Practical training [demonstration]; Tuition relating to telecommunications apparatus and instruments; information services relating to education, training, entertainment, provided by means of telecommunication networks; provision of education, instruction, tuition and training; arranging and conducting of courses, seminars and workshops;

arranging and conducting of courses, seminars and workshops in relation business start-ups; personal development and leadership training services; mentoring services; provision of education, instruction, tuition and training provided on-line from a computer database or the Internet;

71. Mr Holmes notes that apprenticeships are offered for people training to be Gurus to ensure they have the tools to be able to advise customers effectively, and this is confirmed by an article dated 19 September 2016.²² However, as Mr Wood submitted at the hearing, this is clearly not use in relation to the provision of these services. This is something that the proprietor offers new employees, but cannot be said to be the provision of these services for the purposes of creating or maintaining a share in the market. I do not, therefore, consider that this assists the proprietor.

72. There are examples of the proprietor providing “tech drop-in sessions” and events intended to educate customers about online safety under the Contested Registration.²³ One example, shown on social media states “Join our tech workshop to discover how to take the perfect picture”. Similarly, an article from The News confirms that O2 Gurus will be running tech workshops, to provide information to people on topics such as how to get started on a device and how to download apps.²⁴

73. Mr Stobbs referred me to the judgment of Mr Justice Carr in *Property Renaissance* (cited above). In particular, Mr Stobbs directed me to paragraphs 62 and 63 of that judgment, in which Mr Justice Carr stated as follows:

“62. Titanic Huddersfield submits that “educational services” should be amended to the “provision of information relating to education, educational programmes”. However, Mr Nicholl’s evidence at [41] of his second statement is that employees of Titanic Quarter Ltd have delivered lectures at Ulster University since 2006. In particular, he refers to a lecture given in October 2013 by Mr Eyre, the slides for which are at Exhibit JN18 and show extensive use of

²² Exhibit PH4

²³ Exhibit PH3

²⁴ Exhibit PH7

the “Titanic Quarter” mark. These are educational services, and not just information about such services.

63. Mr Nicholl was cross-examined, but none of this evidence was challenged. In my judgment, this shows genuine use of the Titanic Quarter trade mark in respect of the disputed services in class 41. I consider that the average consumer would fairly describe the services considered above in terms of the current specification. I do not consider that the specification requires amendment.”

74. I note that in that case, Mr Justice Carr was giving particular consideration to whether the services in question were education services per se or the provision of information in relation to those services. However, I accept that the provision of a number of lectures was found to be ‘education services’ at large. However, in this case, the only evidence relates to a series of workshops provided on very limited topics. I do not consider that the evidence goes far enough for the average consumer to consider these services ‘education services’ at large. Rather, in my view, they would be viewed in narrower terms in the context of workshops specifically. I consider that it is appropriate to limit the specification accordingly.

Organization of competitions [education or entertainment];

75. There is an example of a competition being run under the Contested Registration.²⁵ No detail is provided about what this related to. In any event, this does not appear to be a service provided to third party customers to create or maintain a share in the market for the services, but rather a competition being run by the proprietor itself in order to promote the Contested Registration. I do not, therefore, consider that this assists the proprietor.

76. I also note that there is an example of a competition being run as part of a radio show with which O2 had involvement.²⁶ However, that competition is marketed under

²⁵ Exhibit PH3

²⁶ Exhibit PH14

the O2 brand, rather than the Contested Registration. In any event, again, this appears to be promotional activity rather than an attempt to create or maintain a share in the market for the services in question.

Provision of news information;

77. A printout from the proprietor's YouTube Channel states "The Latest Tech News and Reviews", followed by a series of videos.²⁷ However, the description of this service appears to relate to the provision of information and advice about the latest technology, rather than the provision of an actual news service itself.

Entertainment; Entertainment information; Film production, other than advertising films; Production of radio and television programmes; Production of shows; Radio entertainment; entertainment services provided by means of telecommunication networks; Interactive entertainment services; television production services, television programming services; television production and television programming services provided by means of Internet protocol technology; provision of entertainment by means of television and Internet protocol television; production, presentation and distribution of audio, video, still and moving images and data; production, presentation and distribution of audio, video, still and moving images and data provided on-line from a computer database or the Internet;

78. In terms of the production of shows, film production and similar services, the same points apply as outlined in relation to the broadcasting services. These are not services being provided by the proprietor to a third party. The fact that the proprietor may create its own shows for use on its YouTube channel is not sufficient to amount to an attempt to create or maintain a share in the market for those services.

79. I note that there is a reference to an "O2 Business Radio Show" which was operated in conjunction with LBC, a radio talk show, in 2014.²⁸ I do not consider this to amount to the provision of radio entertainment services. The fact that O2 partnered

²⁷ Exhibit PH5

²⁸ Exhibit PH14

with a radio provider for a particular part of their show does not amount to the provision of radio services. In any event, apart from Gurus being guests on the show, there is no suggestion that this show was offered under the Contested Registration.

80. With regard to the entertainment services covered by this part of the specification, Mr Stobbs noted that, as well as being informative, the proprietor's YouTube channel also includes entertainment content. I am skeptical about this submission. There are examples of videos on the proprietor's YouTube channel which include videos about how to use technology to create music tracks and what games famous individuals like to play on their telephones.²⁹ Whilst I recognise that this information may be presented in an entertaining and novel way, it is ultimately, the provision of information about the device or application itself rather than the provision of entertainment services. I do not consider that the average consumer would conclude that the proprietor provides any entertainment offering.

Rental of audio equipment.

81. As noted above, there is no evidence that the rental of any equipment is offered under the Contested Registration.

Publishing services (including electronic publishing services); non-downloadable electronic publications;

82. I have seen no evidence that the proprietor offers any form of publishing service (electronic or otherwise) under the Contested Registration.

Information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

²⁹ Exhibit PH5

83. I have seen no evidence that information and advisory services are offered in relation to the proprietor's class 41 services under the Contested Registration.

Class 42

Computer programming; Monitoring of computer systems by remote access; computer programming services; services of a programmer; recovery of computer data; consultancy in the field of computer hardware; computer programming; duplication of computer programs; installation of computer software; maintenance of computer software; updating of computer software; computer systems analysis; consultancy in the field of computer software; conversion of data or documents from physical to electronic media; data conversion of computer programs and data (not physical conversion); hosting computer sites (web sites); technical services relating to projection and planning of equipment for telecommunications.

84. As noted above, there is evidence that the proprietor is engaged with the provision of services relating to the setup of mobile devices. An inevitable part of that service will be the installation of computer software associated with those devices. There is also reference on the proprietor's website to the fact that the Gurus can assist in backing up mobile phones to protect the user's data. Other than this, I see no evidence of the proprietor providing any of these services under the Contested Registration.

Computer virus protection services;

85. I note that there are references to online safety throughout the proprietor's evidence. However, this appears to be focused upon ensuring that children are safe online. I have seen no evidence that suggests that the proprietor is engaged in the provision of computer virus protection services under the Contested Registration.

Computer rental; Rental of web servers; computer rental; rental of computer software; rental of computer hardware; rental of data processing apparatus and computers;

86. As noted above, there is no evidence to demonstrate that the rental of any equipment is offered under the Contested Registration.

Technical research; research in the field of telecommunication technology;

87. I have seen no evidence to suggest that the proprietor offers research services under the Contested Registration.

IT services;

88. This is a broad term, covering a variety of services. Other than the services referred to above in relation to the installation and maintenance of mobile devices, I have seen no evidence that the proprietor actually offers IT services as such under the Contested Registration. It certainly has not provided the breadth of services that would justify a finding that a broad term such as this would be part of a fair specification.

Services of engineers;

89. There is no evidence to suggest that the proprietor offers the services of engineers under the Contested Registration.

Expert advice and expert opinion relating to technology; technical support services relating to telecommunications and apparatus information and advisory services relating to the aforesaid.

90. As noted above, there are examples of the proprietor providing reviews and information about mobile devices and applications on its YouTube channel. For example, the proprietor's YouTube TV Channel appears to provide opinions about the top features on certain devices, or the best applications for those devices.³⁰ I recognise that the evidence shows that the Gurus that provide this information are widely advertised as being experts in the field. There is also evidence of the proprietor providing technical support under the Contested Registration through its social media

³⁰ Exhibit PH5

channels as noted above, with the option of a follow up meeting with a Guru to assist customers if remote technical advice does not resolve the issue.

Information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

91. I have seen no evidence that the proprietor provides information about expert opinion or about technical support services under the Contested Registration, over and above actually providing these services itself.

92. Taking all of this into account, I consider that a fair specification for the Contested Registration is as follows:

Class 37 Installation and maintenance of mobile devices; Information and advisory services relating to installation and maintenance of mobile devices.

Class 41 Arranging and conducting workshops in relation to mobile devices and software applications for mobile devices.

Class 42 Installation of computer software for mobile devices; Expert advice and opinion relating to mobile devices and software applications for mobile devices; recovery of computer data; technical support services relating to mobile devices.

CONCLUSION

93. The Contested Registration will remain registered for the following amended specification:

Class 37 Installation and maintenance of mobile devices; Information and advisory services relating to installation and maintenance of mobile devices.

Class 41 Arranging and conducting workshops in relation to mobile devices and software applications for mobile devices.

Class 42 Installation of computer software for mobile devices; Expert advice and opinion relating to mobile devices and software applications for mobile devices; recovery of computer data; technical support services relating to mobile devices.

94. The Contested Registration is revoked for non-use in relation to the remainder of its specification.

95. The effective date of revocation is 15 February 2019.

COSTS

96. Whilst I note that Mr Stobbs made a request for off-scale costs, as his client has been mostly unsuccessful I do not find that it is necessary to consider this matter any further. As the applicant has enjoyed the greater degree of success, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In this regard, I make the following observation.

97. At the start of these proceedings, the proprietor filed a Counterstatement defending its registration in full. During the evidence rounds, the proprietor filed a covering letter with its evidence setting out which parts of its evidence it considered showed use for various services covered by its specification. However, as noted above, parts of its specification were not referred to in this letter at all. Notwithstanding that, there was no clear indication by the proprietor that it was formally abandoning the Contested Registration in respect of the omitted services until the day of the hearing when I asked Mr Stobbs for confirmation on this point. In my view, this will undoubtedly have led to increased preparation costs for the hearing, as the applicant would have had to prepare submissions in relation to the full breadth of the proprietor's specification. Parties have an obligation to conduct proceedings efficiently and proportionately, and where a decision has been taken not to defend a mark in relation to part of its

specification, that should be made clear at the earliest possible opportunity. Consequently, I make an award of costs at the top end of the scale in respect of preparation for the hearing.

98. Further, I note that the disclosure made by Mr Stobbs at the hearing regarding without prejudice correspondence led to an additional round of correspondence following the hearing. That correspondence focused upon Mr Wood's suggestion that I should consider either recusing myself or redacting the hearing transcript. As noted above, I have done neither. However, had Mr Stobbs not made the disclosure that he did, Mr Wood would not have felt the need to raise the point at all. Consequently, I have made an award in the applicant's favour in relation to written submissions made following the hearing.

99. In the circumstances, I award the applicant the sum of **£3,400** as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice and considering the proprietor's counterstatement	£300
Preparing evidence and considering the proprietor's evidence	£1,000
Preparation for and attendance at hearing	£1,600
Written submissions following the hearing	£300
Official fee	£200
Total	£3,400

100. I therefore order O2 Worldwide Limited to pay Joshi Worldwide IP Limited the sum of £3,400. This sum should be paid within 2 months of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th day of July 2020

S WILSON

For the Registrar

ANNEX

The Contested Mark stands registered for the following services:

Class 35

Retail services and online retail services connected with scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (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, apparatus for the transmission of sound and image, telecommunications apparatus, mobile telecommunication apparatus, mobile telecommunications handsets, computer hardware, computer application software, computer software, computer software downloadable from the Internet, PDAs (Personal Digital Assistants), pocket PCs, mobile telephones, laptop computers, telecommunications network apparatus, drivers software for telecommunications networks and for telecommunications apparatus, protective clothing, protective helmets, televisions, headphones, GPS navigation devices, computer software recorded onto CD Rom, SD-Cards (secure digital cards), glasses, spectacle glasses, sunglasses, protective glasses and cases therefor, contact lenses, cameras, camera lenses, MP3 players, audio tapes, audio cassettes, audio discs, audio-video tapes, audio-video cassettes, audio-video discs, video tapes, video cassettes, video discs, CDs, DVDs, electronic publications (downloadable), mouse mats, magnets, mobile telephone covers, mobile telephone cases, magnetic cards, encoded cards, printed matter, books, magazines, paper, stationery, clothing, footwear, headgear, household or kitchen utensils and containers, jewellery, precious stones, horological and chronometric instruments, musical instruments, apparatus for lighting, textiles and textile goods, leather and imitations of leather, handbags, rucksacks, purses, bags and sports bags, travel bags, backpacks, duffel bags, boot bags, holdalls, wallets, purses, credit card holders, games and playthings, gymnastic and sporting articles, meat, fish, poultry, game, coffee, tea, cocoa, sugar, rice, beers, mineral waters, aerated waters and other non-alcoholic drinks, alcoholic beverages,

matches; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

Class 36

Insurance; Financial affairs; Monetary affairs; Real estate affairs; Charitable fund raising; Debit card services; Financial consultancy; Financial information; Financial management; Financial sponsorship; Financing services; Funds transfer (Electronic -); Issue of tokens of value; Financial information and advice relating to tariffs; information and advice relating to finance and insurance; financial payment services; payment processing services; electronic payment services; automated payment services; payment collection agencies; processing of payment transactions via the Internet; money transfer services; electronic funds transfer services; bill payment services; issuing of tokens of value relating to customer loyalty schemes; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

Class 37

Installation, maintenance and repair of telecommunications apparatus and equipment; installation, maintenance and repair communications networks, computer networks and data networks; installation, maintenance and repair of computer hardware; installation, maintenance and repair of computers and computer peripherals; computer and telephone battery recharge services; information and advisory services relating to the aforesaid services; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

Class 38

Telecommunications; Cellular telephone communication; Communications by computer terminals; Communications by fiber [fibre] optic networks; Communications

by telephone; Computer aided transmission of messages and images; Electronic bulletin board services [telecommunications services]; Electronic mail; Information about telecommunication; Message sending; Paging services [radio, telephone or other means of electronic communication]; Providing internet chatrooms; Providing telecommunications connections to a global computer network; Providing user access to global computer networks; Rental of facsimile apparatus; Rental of message sending apparatus; Rental of modems; Rental of telecommunication equipment; Rental of telephones; Satellite transmission; Teleconferencing services; Telephone services; Transmission of digital files; Voice mail services; Telecommunications services; mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; fixed line telecommunication services; provision of broadband telecommunications access; broadband services; broadcasting services; television broadcasting services; broadcasting services relating to Internet protocol TV; provision of access to Internet protocol TV; Internet access services; email and text messaging services; information services provided by means of telecommunication networks relating to telecommunications; services of a network provider, namely rental and handling of access time to data networks and databases, in particular the Internet; communications services for accessing a database, leasing of access time to a computer database, providing access to computer databases, rental of access time to a computer database; operation of a network, being telecommunication services; the provision of discussion forums; operating web logs [blogs]; operating message boards; webcasting; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

Class 41

Education; Providing of training; Entertainment; Sporting and cultural activities; Arranging and conducting of colloquiums; Arranging and conducting of conferences, congresses, seminars, symposiums and workshops; Booking of seats for shows; Coaching [training]; Entertainment information; Film production, other than advertising films; Organization of competitions [education or entertainment]; Organisation of exhibitions for cultural or educational purposes; Organisation of shows [impresario

services]; Organization of sports competitions; Practical training [demonstration]; Production of music; Production of radio and television programmes; Production of shows; Publication of books; Publication of electronic books and journals on-line; Publication of texts, other than publicity texts; Radio entertainment; Recording studio services; Recreation facilities (Providing -); Recreation information; Rental of audio equipment; Rental of sound recordings; Rental of video cassette recorders; Rental of videotapes; Tuition relating to telecommunications apparatus and instruments; Interactive entertainment services; electronic games services provided by means of any communications network; entertainment services provided by means of telecommunication networks; information services relating to education, training, entertainment, sporting and cultural activities provided by means of telecommunication networks; provision of news information; television production services, television programming services; television production and television programming services provided by means of Internet protocol technology; provision of entertainment by means of television and Internet protocol television; provision of musical events; entertainment club services; discotheque services; presentation of live performances; night clubs; rental of music venues and stadiums; casino services; ticket reservations for entertainment, sporting and cultural events; ticket information services for entertainment, sporting and cultural events; ticket agency services; provision of education, instruction, tuition and training; production, presentation and distribution of audio, video, still and moving images and data; publishing services (including electronic publishing services); non-downloadable electronic publications; arranging and conducting of courses, seminars and workshops; arranging and conducting of courses, seminars and workshops in relation business start-ups; personal development and leadership training services; mentoring services; provision of education, instruction, tuition and training provided on-line from a computer database or the Internet; production, presentation and distribution of audio, video, still and moving images and data provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

Class 42

Scientific and technological services and research and design relating thereto; Industrial analysis and research services; Design and development of computer hardware and software; Computer programming; Computer rental; Computer virus protection services; Construction drafting; Consultancy in the design and development of computer hardware; Monitoring of computer systems by remote access; Providing search engines for the internet; Rental of web servers; Research and development for others; Technical research; IT services; computer programming services; services of a programmer; recovery of computer data; consultancy in the field of computer hardware; computer programming; duplication of computer programs; computer rental; computer software design; installation of computer software; maintenance of computer software; updating of computer software; rental of computer software; rental of computer hardware; computer system design; computer systems analysis; consultancy in the field of computer software; conversion of data or documents from physical to electronic media; creating and maintaining websites for others; data conversion of computer programs and data (not physical conversion); hosting computer sites (web sites); services of engineers; expert advice and expert opinion relating to technology; rental of data processing apparatus and computers; technical services relating to projection and planning of equipment for telecommunications; services of information brokers and providers, namely product research for others; weather forecasting; research in the field of telecommunication technology; monitoring of network systems in the field of telecommunications; technical support services relating to telecommunications and apparatus information and advisory services relating to the aforesaid; information and advisory services relating to the aforesaid services provided on-line from a computer database or the Internet; information and advisory services relating to the aforesaid services provided over a telecommunications network.

