

O/487/20

TRADE MARKS ACT 1994

IN THE CONSOLIDATED MATTERS OF

APPLICATION NO. 3372170 BY ARENA 8 LTD TO REGISTER:

ARENA 8

AS A TRADE MARK IN CLASSES 9, 41 & 43

AND

THE OPPOSITION THERETO UNDER NO. 600001077 BY OWEN PERKINS

AND

THE APPLICATION FOR REVOCATION BY ARENA 8 LTD UNDER NO. 502588

AGAINST UK REGISTERED TRADE MARK NO. 3000211

Arena 100

OWNED BY OWEN PERKINS

BACKGROUND AND PLEADINGS

1. Arena 8 Ltd applied to register **ARENA 8** (“the 8 mark”) as a trade mark in the United Kingdom on 1 February 2019. The application was accepted and published on 22 February 2019 in respect of the following goods and services:

Class 9

Computer application software relating to exercise, fitness training, fitness advice and guided workouts; electronic publications; CDs; DVDs featuring fitness information and recorded fitness classes; downloadable content featuring fitness information and fitness classes; downloadable software in the nature of a mobile application that provides access to information and advice in the fields of diet, weight loss, diet planning and lifestyle wellness.

Class 41

Sport and fitness services; sports entertainment; provision of facilities for sport and fitness; gymnasium club services; physical training; gym instructor services; yoga instruction; pilates instruction; health and wellness training; physical fitness instruction for adults and children; exercise classes; health club services; personal fitness training services; sports camps; sports coaching; sports training; information relating to sports and fitness; provision of information on fitness via an online portal; providing sports news; provision of educational and advisory services relating to health and nutrition; fitness education; organisation of events for cultural, entertainment and sporting purposes; organisation of sporting activities and sporting competitions; information, advisory and consultancy services relating to the aforementioned services.

Class 43

Provision of food and drink; juice bars; café services; bar services; catering services; information, advisory and consultancy services relating to the aforementioned services.

2. On 4 March 2019, Mr Owen Perkins (who at the time was unrepresented) opposed the mark under the fast-track procedure. The opposition is based on section 5(2)(b) of

the Trade Marks Act 1994 (“the Act”) and concerns all services in Class 41 of the application. Mr Perkins is relying upon UK Trade Mark No. 3000211, **Arena 100** (“the 100 mark”), which was registered on 4 October 2013 for goods and services in Classes 29, 41 and 44. The services relied upon for the opposition are as follows:

Class 41

Gymnasiums; Sport camps; Sporting activities; Sports coaching services; Sports education services; Sports facilities (leasing of-); Sports information services; Sports tuition, coaching and instruction.

3. As the 100 mark completed its registration more than five years before the application date for the 8 mark, it is subject to the proof of use requirements set out in section 6A of the Act.

4. Mr Perkins claimed that the marks and services were similar and that consequently there was a likelihood of confusion. He also stated that he had used his mark, but provided no examples of the mark in use, which should be submitted with the notice of opposition under the fast-track procedure. If no examples are available, the opponent is required to give a statement of how the mark was used in the relevant period and why no examples can be provided. Mr Perkins said:

“The brand has been developed with a digital platform as its basis. The bespoke platform is in its final stages of beta testing and will be rolled out to market in the next quarter of 2019. The accompanying physical locations are also due for this period.”

5. As is not uncommon with a notice of opposition filed by an unrepresented party, the form contained several deficiencies which the Tribunal required Mr Perkins to remedy. He was informed that, if proof of use of the mark were not provided, the opposition may be converted into a standard opposition.

6. On 12 March 2019, Mr Perkins replied stating that he wanted to use the TM7 form attached to his letter. In completing this form, he stated that the mark had not been

used in the five-year period ending on the date of application for the 8 mark. In answer to the invitation to give proper reasons for non-use, he stated:

“The trade mark has been used in conjunction with building the Arena 100 brand. A web platform, fitness clothing and fitness wear, branding accessories (including bags/socks/mugs/fitness bags), physical site location plans, white papers and technical specifications have been built. Evidence of which can be shared.

Due to the size of the brand it has taken significant time and financial investment to get to this stage – I am due to go live with the brand within the next 3 months.”

7. Arena 8 filed a defence and counterstatement on 1 July 2019, denying that the marks are similar and that there is any likelihood of confusion. It also notes that the 100 mark has not been used and denies that Mr Perkins has provided any proper reasons for this non-use.

8. On 3 May 2019, Arena 8 had filed an application to revoke the 100 mark for reasons of non-use under section 46(1)(a) and (b) of the Act. It sought revocation in respect of all goods and services for which the 100 mark is registered from 5 October 2018 or 31 January 2019. It claims that the reasons stated by Mr Perkins for non-use constitute usual preparations for starting a business and that settled case law establishes that these do not amount to proper reasons for non-use.

9. Mr Perkins filed a defence and counterstatement on 2 August 2019 denying the claims made. He states that the mark had been in use in relation to a social media platform that provides users with the services relied upon in the opposition.

10. On 22 August 2019, the Registry wrote to both parties consolidating the proceedings.

11. Both parties filed evidence. I shall summarise this to the extent that I consider it necessary. Arena 8 also filed written submissions on 23 December 2019. I shall not summarise these but will refer to them where appropriate in my decision.

12. The consolidated matters came to be heard before me on 8 September 2020 via video link. Arena 8 was represented by Jamie Muir Wood of Counsel, instructed by The Trademark Cafe Limited. Mr Perkins was represented by Ian Silcock of Counsel, instructed by Wilson Gunn.

PRELIMINARY ISSUE

13. In his skeleton argument, Mr Silcock states that:

“In support of the Opposition, Mr Perkins claims use of the Earlier Mark in respect of all of the services covered by the Earlier Registration in Class 41, as required by the fact that the Earlier Registration was entered on to the Register more than five years prior to the Application Date.”

14. This statement is based on reading both the TM7F for the fast-track proceedings and the TM7 together and construing them to mean that Mr Perkins was in fact claiming use in respect of the Class 41 services. Mr Silcock submitted that such a construction should be accepted by the Tribunal and gave notice that, in the event that the Tribunal disagreed, Mr Perkins would request permission to amend the TM7 form to tick the box claiming use of the earlier mark. He added that this would be a purely technical amendment that would not affect the substance of either side’s case or the basis upon which either side has presented their case to date.

15. It had been the view of the Tribunal that the TM7 form had replaced the TM7F.¹ The latter was only added to the bundle for the hearing after Mr Silcock had asked for this to be done. In the TM7, Mr Perkins has stated that he has not used the earlier mark and given reasons for non-use. In these circumstances, I held that he was bound

¹ Indeed, Mr Perkins refers in paragraph 6 of his first witness statement to filing a notice of opposition on 12 March 2019 and does not mention the TM7F.

by the pleadings he made on that form and invited Mr Muir Wood for Arena 8 to make submissions on the request to amend the TM7.

16. Mr Muir Wood submitted that the requests to amend pleadings ought to be made at as early a point as possible and noted that, although Mr Perkins had not been represented when he opposed the 8 mark, he had obtained legal representation shortly afterwards, as shown by the defence to Arena 8's application for revocation of the 100 mark. That said, Mr Muir Wood acknowledged that a re-amendment of the pleadings as requested would not seriously prejudice the interests of his client. The written submissions already filed and oral submissions prepared dealt with the legal arguments to be made if either use or proper reasons for non-use were claimed.

17. While there had been ample time before the hearing to resolve any confusion as to the nature of the pleadings, I was prepared to grant Mr Perkins's request to amend them, as the relevant legal arguments had already been addressed by both Counsel in their skeleton arguments and no further evidence would be required.

EVIDENCE

Mr Perkins's evidence in chief

18. Mr Perkins's witness statement is dated 20 October 2019. He has been the owner of Arena 100 since 2010 when it was founded. The circumstances in which the company was started are described as follows:

"11. The Company came into being back in 2010, when a discussion with a group of friends about the state of their gym moved into a discussion about improvements to the health and fitness industry in general. With a passion for physical exercise and popular culture, they defined a gap in the market in the creation of an online space where people like them could unite.

12. This vision led to the creation of the Company under the name ARENA 100, with a primary focus on fitness and nutrition and with the aim of

providing like-minded individuals with the tools and knowledge to increase and maximise personal health.

13. The Company offers access to personal trainers and nutritionists and information about training, exercising and nutrition. In addition, the Company also provides access to online forums for users to enter into discussion and feel part of a community.”

19. Exhibit OP1 is an undated extract from the company’s business plan setting out the following milestones:

2010: Initial concept drawn up.

2011: Brand identity and name identified.

2013: Legal steps taken to protect brand identity. Product/business model shift.

2014 – present: Product facelift and technological advances.

March 2016: Soft launch of mobile/web platform.

20. Exhibit OP2 is a print-out from the company’s website arena100.co.uk explaining the start of the business, while Exhibit OP3 is a copy of the mission statement, although it is not clear where this has been published. The mark is shown in the following form and also as “Arena 100”. “A100” is also used as an abbreviation.



21. Mr Perkins states that a large amount of time and effort has been expended in building the ARENA 100 brand. He supplies a set of invoices that he says demonstrate the development of the brand and its presence in the marketplace. They are as follows:

Date	Details
May 2014	An invoice for £108 for an annual subscription to a mail forwarding company (Exhibit OP4).
August 2014 July 2016-September 2016	Three invoices for \$1,144, \$1,320 and \$682 for unspecified services. Three invoices for \$350, \$1,575 and \$788 for website refinement and enhancement. The 2014 and 2016 invoices are from two different individuals. Mr Perkins states that they are "IT consultants and web designers". (Exhibit OP5).
November 2014- November 2016	Four invoices for €725, €725, €150 and €800 for graphic design services (Exhibit OP6).
February 2017- October 2017	Four invoices for £200, £140, £20 and £420 for video filming and editing. (Exhibit OP7). The exhibit also contains an undated video proposal.
January 2017- February 2017	Two invoices for \$240 and \$200 for copy writing (Exhibit OP8).
November 2017	One invoice for 500AED for a video edit (Exhibit OP9).
December 2012 – August 2013	Two invoices from a domain name registry relating to the domain names arena100.co.uk, arena100me.co.uk, and arena100.com (Exhibit OP10).

22. Exhibit OP11 is a long print-out which Mr Perkins describes as the web analytics for the arena100.co.uk. However, there is little analysis here but over 70 pages of raw data. They show that between 25 October 2017 and 20 August 2018 there were 17,082 unique visitors to the site and that this rose to 48,280 between 27 September 2018 to 23 July 2019. Other information includes top requested files, top pages not found and top referring sites. With regard to the latter, over 91% of referrals came from arena100.co.uk in the first period and 89% in the second.

23. Exhibits OP12 are extracts from arena100.co.uk including information on sports, fitness and nutrition. Exhibit OP13 is the profile page of a personal trainer, and allows users to book sessions with her. All are undated, although Exhibits OP13-OP15

contain a 2017 copyright stamp. Exhibits OP14-OP16 include the mark in the form shown in paragraph 20 above, and Exhibits OP12-OP13 contain the following mark:



24. Exhibits OP17-OP28 are articles that Mr Perkins says are drawn from the website arena100.co.uk and date from March and May 2016 and March 2018. Like the pages mentioned above, they concern sports, fitness and nutrition and contain the mark shown in paragraph 20.

Arena 8's evidence

25. Arena 8's evidence is in the form of a witness statement from Ms Joanna Lucas Munce, a chartered UK and European trade mark attorney at Arena 8's representatives, The Trademark Cafe Limited. It is dated 23 December 2019.

26. Ms Munce states that she has carried out internet searches using Google for the words "ARENA 100". The first three pages of the results can be found in Exhibit JLM1 and contain no reference to Mr Perkins's company.

27. Exhibit JLM2 contains a definition of the word "ARENA" from www.dictionary.com.

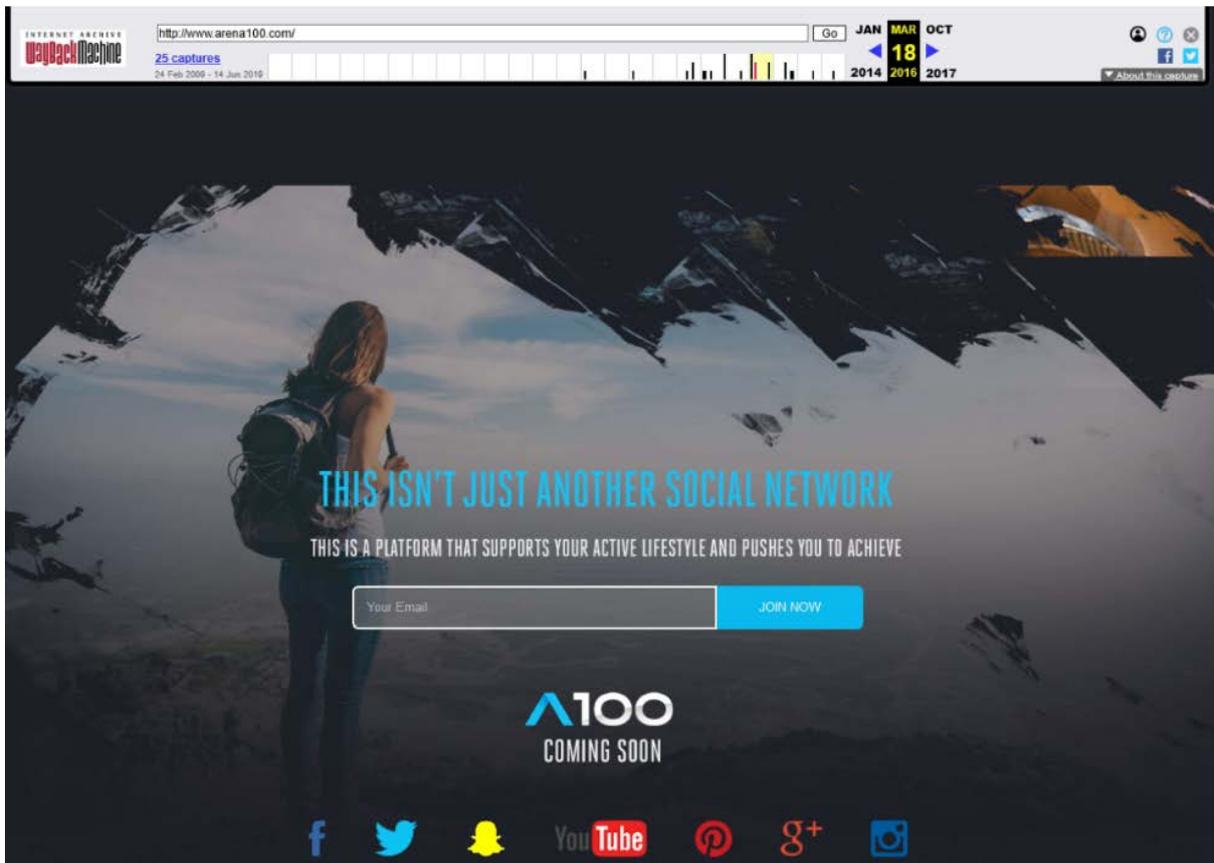
28. In Exhibits JLM3 and JLM4, Ms Munce provides the results of internet searches of Google for the word "ARENA" in combination with the words "GYM" and "FITNESS".

29. Exhibits JLM5 and JLM6 contain the results of searches of the Wayback Machine Internet Archive for the domain names www.arena100.com and www.arena100.co.uk respectively. The captures are as follows:

arena100.com

- 24 February 2009, a page consisting of sponsored listings;
- 10 February 2011, a page stating that the domain is for sale;
- 18 March 2016, the page reproduced below;

- 11 October 2017 and 14 June 2019, two pages stating that the app is offline for maintenance.

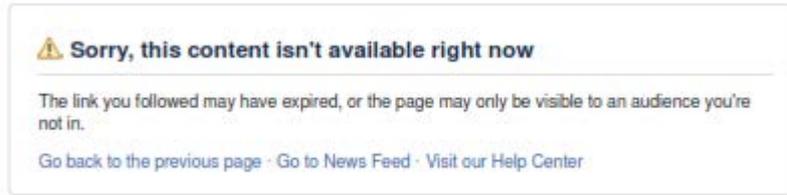


arena100.co.uk

- 21 July 2013, a page showing that the domain is registered with a company called 123-reg;
- 20 October 2016, a blank page with the 123-reg branding; and
- 11 August 2018 and 23 December 2018, advertisements for the services of 123-reg.

30. Ms Munce states that she has also searched the social media accounts for ARENA100 and that they are almost inactive.² As of 20 December 2019, there were no posts on Instagram and the Twitter account was protected. However, only two tweets had been made and the account had four followers. A search of Facebook produced the message below:

² Exhibit JLM7.



Mr Perkins's evidence in reply

31. The aim of Mr Perkins's second witness statement dated 20 February 2020 is to address issues raised by Arena 8 in its evidence and written submissions.

32. It will be recalled that Mr Perkins had claimed to be in the process of beta testing the web platform. Arena 8 had submitted that beta testing should be understood as only internal use of the mark. Mr Perkins states that he considers that the term means:

“... the use of the website and its services by the end consumers to gain feedback on the efficacy of the products and services being provided.”³

Exhibit OP1R contains a link to a YouTube video, which has not been viewed, in line with the Tribunal's practice.⁴ However, I have read the written explanation from the Instabug blog and productplan.com, which can be found at pages 5-21 of the exhibit. Mr Perkins states that his company

“... has been engaged with an open beta test for the versions of the ARENA 100 platform, necessitating the involvement of any interested person in the marketplace, who can sign up and use the platform.”⁵

33. Mr Perkins also states that the reason that Ms Munce's Google searches failed to produce any reference to his company in the first 300 hits is that he had not yet engaged with search engine optimisation and that the results do not in themselves prove that there has been no genuine use of the mark.

³ Paragraph 3b.

⁴ See *Tribunal Practice Manual*, section 4.8.4: “Evidence containing references to website links are not acceptable as the Hearing Officer will not undertake any independent research.”

⁵ Paragraph 3b.

34. In response to Arena 8’s submissions about the lack of financial data, Mr Perkins says:

“... this is largely due to continued updates and improvements to the ARENA 100 platform, meaning that revenue streams have not yet been maximised and optimised to date. However, this does not mean that there has been no genuine use of the mark in the relevant periods.”⁶

35. The remainder of the evidence, including all the exhibits, relate to what Mr Perkins describes as “the sale of promotional items”.⁷ He says that the .com site contained a Shopify-driven retail element which was active from October 2012 to February 2016. Exhibit OP3R includes invoices associated with the construction of this earlier website.

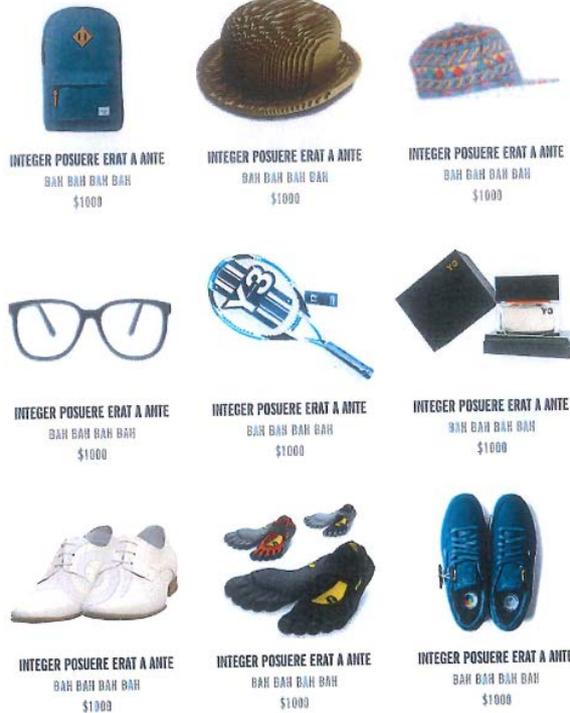
36. Exhibit OP2R contains print-outs which Mr Perkins describes as an overview of the earlier iteration of the website. However, it appears that what is shown is a mock-up, as it contains standard place-holder text and the store element shows all the goods being sold for the same price (\$1000):



⁶ Paragraph 7.

⁷ Paragraph 5.

ACCESSORIES



37. Exhibits OP4R to OP7R relate to the design of an image, its appearance on a T-shirt and a selection of 8 invoices showing sale of the T-shirt dating from October 2014 to February 2015. The mark does not appear on the T-shirt.

DECISION

38. I will deal first with the application for revocation, as if this succeeds the opposition will fall away. At the hearing, Mr Silcock confirmed that Mr Perkins was only contesting the application with respect to the following services:

Class 41

Sporting activities; Sports coaching services; Sports education services; Sports information services; Sports tuition, coaching and instruction.

Class 44

Nutritional advisory and consultation services; Nutritional advisory services; Nutritional guidance.

Application for Revocation of the 100 Mark

Legislation

39. Section 46 of the Act is as follows:

“(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;

(b) that such use has been suspended for an uninterrupted period of five years, 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 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 were existing at an earlier date, that date.”

40. Section 100 of the Act is also relevant. It says:

“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.

Case law

41. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch);

“114. *The law with respect to genuine use.* 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 *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 Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *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].

Approach to the evidence

42. Much of the time at the hearing was spent in submissions on the appropriate weight I should attach to the evidence that I have summarised in paragraphs [18]-[37] above and the inferences that I should draw from it. Mr Silcock noted that Arena 8 had not applied to cross-examine Mr Perkins on his evidence and submitted that:

“... Arena 8’s evidence and written submissions stop a considerable distance short of challenging its veracity.”⁸

⁸ Skeleton argument, paragraph 26.

43. Mr Silcock drew my attention to the decision of the Appointed Person, Richard Arnold QC (as he was then), in *Pan World Brands Limited v Tripp Limited (EXTREME Trade Mark)*, BL O-161-07:

“36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness’s evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness’s evidence.

37. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] BusLR 864 and *EINSTEIN Trade Mark* (O/068/07). Another recent example is *Scholl Ltd’s Application* (O/199/06). I consider that hearing officers should guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically).”

44. I shall bear in mind these comments during my consideration of the evidence. I shall also take account of two later decisions of different Appointed Persons. In *PLYMOUTH LIFE CENTRE*, BL O/236/13, Mr Daniel Alexander QC, sitting as the Appointed Person, stated that:

“The burden lies on the registered proprietor to prove use ... However, it is not strictly necessary to exhibit any particular kind of documentation, but if

it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”⁹

45. In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated that:

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

‘[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for

⁹ Paragraph 22.

example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

Has the Proprietor of the 100 mark shown genuine use?

46. As the judge’s summary in *Walton* makes clear, genuine use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, to create or preserve an outlet for the goods or services bearing the mark. Mr Silcock submitted that the absence of sales figures did not mean that any use was not genuine. I agree that the courts have not specified particular types of evidence that must be provided.

47. Mr Silcock submitted in his skeleton that:

“In essence, the evidence shows the significant scale of Mr Perkins’ investment in, and use of the Earlier Mark on and in respect of the websites, and relation to the provision of information via the websites, at <arena100.com> and <arena100.co.uk>, with a view to establishing those sites as a platform, under the brand, providing access to online information,

connections, and user forums, in the fields of personal health, fitness, and nutrition.”¹⁰

48. The word mark **ARENA 100** appears on the website pages in Exhibits OP14-OP28, either on its own or in combination with a device and I accept that Mr Perkins had been beta testing the platform. Mr Silcock referred me to Exhibit OP11 and paragraph 20 of Mr Perkins’s first witness statement, particularly the figures of 17,082 unique visitors between 25 October 2017 and 20 August 2018 and 48,280 between 27 September 2018 and 23 July 2019. It is, however, difficult to draw any conclusions from this information. Both Counsel gave different interpretations of the data at the hearing. Mr Silcock submitted that the fact that the majority of referrals came from arena.co.uk showed that people were entering the web address and had learned of it through word of mouth. Mr Muir Wood, on the other hand, submitted that the high number of referrals could have been achieved by people following links to other content on the website. I have no information to help me decide which of these is the more plausible explanation.

49. I can see evidence of the development of a web platform containing information on sports, health and nutrition. There is one example of an individual’s profile. In addition, there is the website data I have set out above which shows activity, even if it does not tell me where this activity took place, who was doing it and whether the use was genuine.

50. Mr Perkins says that he was conducting “open” beta testing. This is defined in Exhibit OP1R as follows:

“Beta tests can either be open or closed. In an open beta test, anyone is able to use the product and is usually presented with some messaging that the product is in beta and given a method for submitting feedback. In a closed beta, the testing is limited to a specific set of testers, who may be composed of current customers, early adopters and/or paid beta testers.”¹¹

¹⁰ Paragraph 20.

¹¹ Page 17.

What is absent in the evidence is any indication of publicity or invitations to take part in a beta test. It seems to me that this is evidence that would have been straightforward for Mr Perkins to supply.

51. I accept that Mr Perkins was making preparations to launch the website. Genuine use can include use for goods or services which are about to be marketed if preparations to secure customers are under way, particularly in the form of advertising campaigns: see *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01, paragraph 37. However, I cannot see from the evidence before me how potential customers would have been able to find out about the services to be offered under the mark. In response to the evidence of the Google searches performed by Ms Munce, Mr Perkins stated that he had not yet engaged with search engine optimisation and so these results do not prove that there is no genuine use of the mark. Exhibits JLM5 and JLM6, the results of searches of the Internet Archive, suggest that no content was available. It is true that these print-outs are snapshots at a particular date, but again if content had been available on other dates it would have been easy for Mr Perkins's representatives to supply them in the evidence in reply.

52. It is clear that Mr Perkins has invested significant sums in developing the website but viewing the evidence as a whole I find that he has not shown that the mark has been genuinely used in the meaning of trade mark law. Consequently, the mark will be revoked with effect from 5 October 2018.

The Opposition

53. As Mr Perkins's mark has been revoked, the opposition falls away.

Conclusion

54. Trade mark no. 3000211 will be revoked with effect from 5 October 2018.

55. As the opposition has fallen away, trade mark no. 3372170 would under normal circumstances go forward to registration. However, there is another opposition

outstanding against this mark and so registration of Arena 8's trade mark is dependent on the outcome of that opposition.

Costs

56. Arena 8 Limited has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2006. In the circumstances I award Arena 8 the sum of £2100 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

<i>Preparing a statement and considering the other side's statement:</i>	<i>£400</i>
<i>Preparing evidence and considering and commenting on the other side's evidence:</i>	<i>£800</i>
<i>Preparing for and attending a hearing:</i>	<i>£700</i>
<i>Official fees:</i>	<i>£200</i>
<i>TOTAL:</i>	<i>£2100</i>

57. I therefore order Owen Perkins to pay Arena 8 Ltd the sum of £2100. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 1st day of October 2020

**Clare Boucher,
For the Registrar
The Comptroller-General**