BL O/558/22

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 421444

IN THE NAME OF INTIME EXPRESS LOGISTIK GMBH

TO TRADE MARK APPLICATION No. 3488993

IN THE NAME OF IN TIME EXPRESS EUROPE SL

DECISION

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1. In Time Express Europe SL ("the Applicant") applied under number 3488993, with a filing date of 4 October 2016, to register the following sign as a trade mark for use in the United Kingdom in relation to *"Transportation and delivery of goods; freight and cargo transportation and removal services"* in Class 39:

2. The application for registration was opposed by inTime Express Logistik GmbH ("the Opponent") under s.5(4)(a) of the Trade Marks Act 1994 on 14 September 2020.

3. In its Form TM7 Notice and Statement of Grounds of Opposition, the Opponent pleaded as follows:

> 2. … the Opponent has used inTime since as early as 2000 throughout the UK, both as part of its company name, and as an integral element of its wider branding associated with the core transport, freight, delivery and logistics services it provides. InTime forms the dominant component of the Opponent's branding, and is also used in combination with the additional elements as both "inTime AGILE LOGISTICS" and "inTime EXPRESS LOGISTIK GmbH" in the UK. The period of 20 years in which the Opponent has operated and provided the contested services across the United Kingdom has resulted in marked brand exposure to consumers in the industry, and is evidenced by the notable annual turnover figures generated in that time period. Furthermore, the use of the inTime trade mark in connection with the inTime Express Logistik/inTime Agile Logistics mobile app has further increased the association of the word with the Opponents inTime brand in the eye of the consumer. This association has been reinforced over the years through significant media and marketing campaigns.
>
> 3. Accordingly, the mark inTime has long been associated with the Opponent for services relating to the transport of goods, including business-to-business express delivery, in the logistics sector in both the United Kingdom and in the wider European Union for many years. As a result, the Opponent has acquired significant goodwill in the inTime name (and associated combination trade marks) when used in relation to transport, freight, delivery and logistics services.
>
> 4. The Opponent therefore enjoys significant goodwill in INTIME/INTIME EXPRESS LOGISTIK/INTIME AGILE LOGISTIC. As such, use of the Application Mark in relation to identical services would constitute a misrepresentation to the public as to the commercial origin of the services in question,

which would clearly cause damage to the Opponent.

4. The Applicant raised no positive case in answer to the objection to registration in its Form TM8 Defence and Counterstatement filed on 17 October 2020. It simply put the Opponent to proof of the averments made in the Grounds of Opposition.

5. The Opponent's evidence in the proceedings consisted of: (1) a Witness Statement with 5 Exhibits dated 8 January 2021 provided by Mr Torsten Hertner (its Head of Operational Controlling); and (2) a second Witness Statement with 1 Exhibit dated 6 September 2021 provided by Mr Hertner in reply to the witness statement evidence filed by the Applicant.

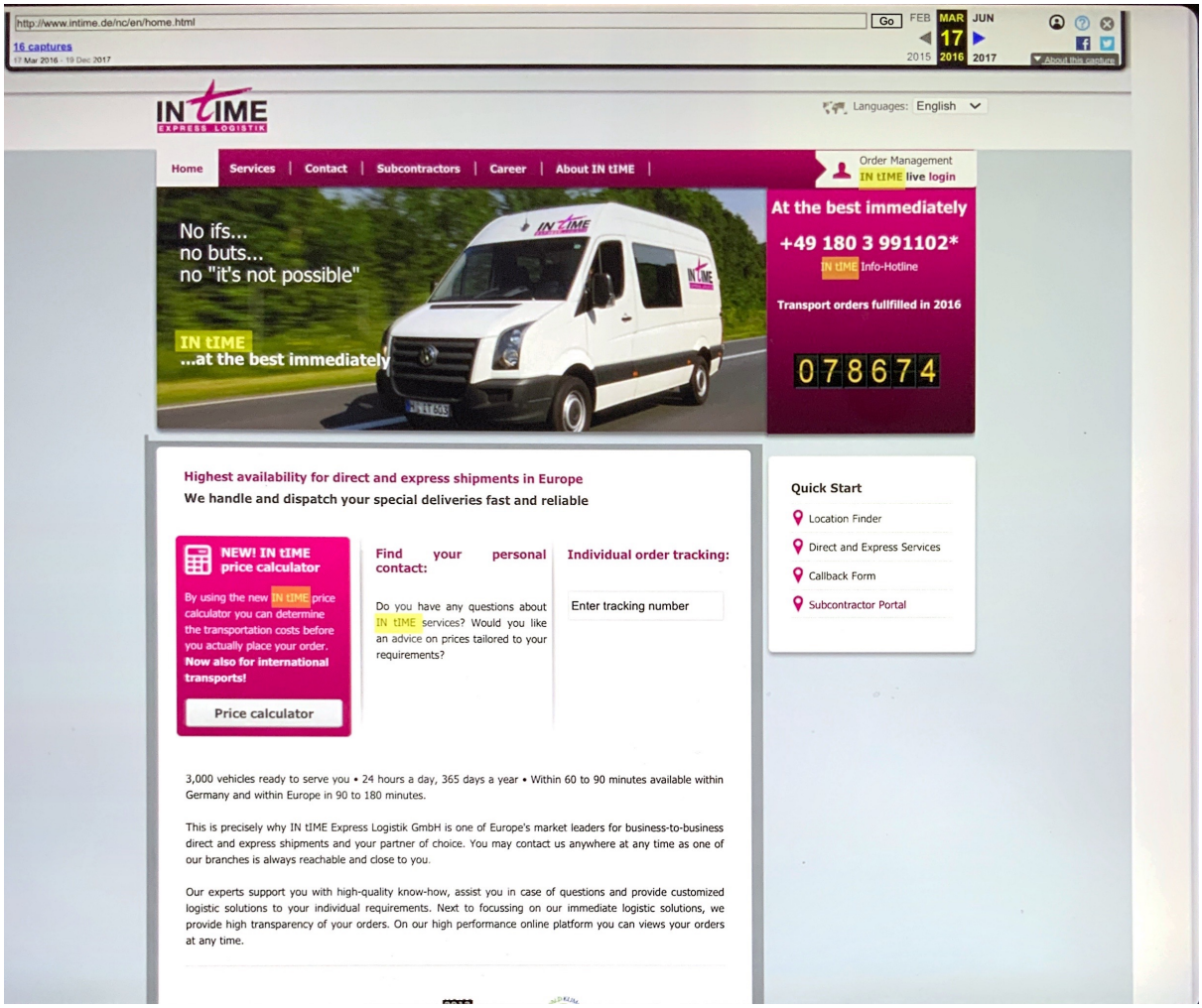
6. Mr Hertner gave evidence in his Witness Statements to the following effect:

   (i) the Opponent "is a leading provider of transport services in the field of express, direct and specialist transport operating under the '**inTime**' trade mark within the UK since and even before the year 2000" and "has become one of the most-established and well-reputed market leaders in agile logistics in the United Kingdom.": first Witness Statement, paras 3 to 5;

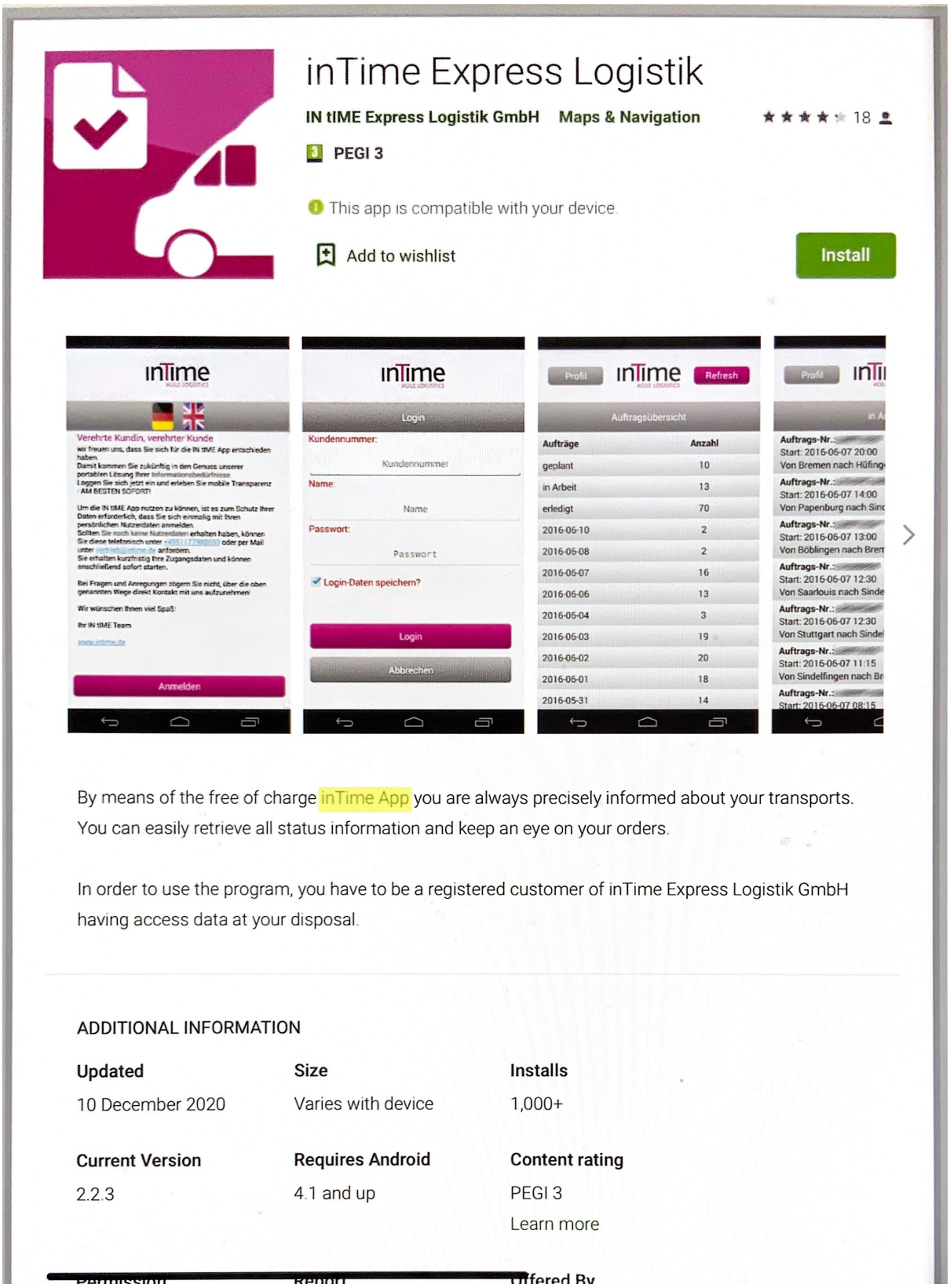
   (ii) the designation '**inTime**' formed the dominant feature of the Opponent's branding on its website and it "featured on each of **inTime** vehicles within the total fleet that transport goods in and out of the UK" (Exhibit TH2) and in driver and customer applications (Exhibit TH3): first Witness Statement, paras 6 and 7;

(iii) his Exhibit TH4 provided "a breakdown of **inTime**'s annual turnover from sales derived in the UK for the years 2000 to 2019. The first spreadsheet tab shows turnover derived from imports in to the UK, while the second spreadsheet tab displays turnover derived from exports out of the UK" and he provided examples of related invoices for the period 2000 to 2019 in his Exhibits TH5 and TH6 showing "use of the '**inTime**' trade mark by **inTime**": first Witness Statement, paras 8 to 12; second Witness Statement, paras 6 to 8.

7. This image is taken from Exhibit TH2:



8. This image is taken from Exhibit TH3:



9. These were the spreadsheet figures provided in Exhibit TH4 showing the year on year breakdown of *"turnover derived from imports in to the UK"* and the year on year breakdown of *"turnover derived from exports out of the UK"*:

Country of Destination: GB

Period	GB
2000	163,086
2001	217,676
2002	247,182
2003	501,859
2004	690,477
2005	1,146,964
2006	1,339,810
2007	2,461,609
2008	2,416,154
2009	2,574,898
2010	4,212,121
2011	4,787,814
2012	3,927,607
2,013	5,350,312
2014	6,018,794
2015	6,395,450
2016	5,342,918
2017	7,013,395
2018	5,774,082
2019	4,503,335

Country of Origin: GB

Period	GB
2000	34,725
2001	9,988
2002	40,500
2003	60,197
2004	589,076
2005	291,656
2006	438,062
2007	956,907
2008	618,294
2009	477,094
2010	724,246
2011	988,330
2012	632,693
2,013	726,953
2014	753,545
2015	1,003,739
2016	629,846
2017	1,361,468
2018	1,348,769
2019	1,030,173

10. I understand that Exhibit TH5 as originally filed on 8 January 2021 contained a total of approximately 344 pages of sample invoices. The Registry wrote to the Opponent on 24 February 2021 stating: *"... I must advise you that the Registry is unable to accept your evidence due to you exceeding the restriction on the volume of evidence that may be filed in trade mark proceedings before the IPO, without seeking permission from the Registrar, as introduced in TPN 1/2015."* The Opponent dealt with that by removing a significant amount of invoices from Exhibit TH5 and re-filing it on 2 March 2021 with a page count of 256 pages. Mr Hertner said in para. 7 of his second Witness Statement that *"only the key documents were therefore included"*. In para. 39.7 of its

Skeleton Argument for this Appeal, the Opponent comments that the re-filing resulted in a reduction of the number of pertinent invoices included in the Exhibit for the period to which this Appeal relates.

11. The Applicant's evidence in the proceedings consisted of: (1) a Witness Statement with 10 Exhibits dated 27 April 2021 provided by Mr Javier Alvarez Alvarez (its General Manager); and (2) a Witness Statement with 4 Exhibits dated 20 May 2021 provided by Ms Julia House (Chartered Trade Mark Attorney and a Director of the Applicant's then agents of record).

12. Mr Alvarez gave evidence in his Witness Statement to the following effect:

    (i) the sign graphically represented in the contested application for registration is a simplified version of the **IN TIME** Trade Mark which the Applicant has been actively using since it was incorporated in 2004 in relation to the transportation and delivery of goods and freight and cargo transportation and removal services, primarily in the Spanish market and also across Europe including in the United Kingdom: paras 1 to 4, 12, 13 and 28;

    (ii) the Applicant and the Opponent have customers in common in the UK, but "No incidents of confusion have arisen in the United Kingdom": para. 11;

    (iii) "Valuable goodwill and reputation have built up in my Company's IN TIME Trade Mark through the use of this Mark over a number of years in the United Kingdom, **the existence thereof seeming to precede any relevant reputation of the Opponent, at the relevant date of the Opposition since, as I have stated, the Opponent has not provided proof, beyond a Witness Statement,**

of the real and relevant use of its IN TIME trademark as legally required.

This point will be expanded upon below.": paras 13 to 30 (emphasis added);

(iv) "In light of these observations and evidence, the notion that the Opponent has sufficient goodwill in the United Kingdom, so as to sufficiently substantiate their Opposition under Section 5(4)(a) is highly disputed": para. 30.

13. The Applicant's evidence was accompanied by written submissions dated 20 May 2021 in which it asserted what I shall call its "no protectable goodwill defence": *"the Opponent has failed to submit cogent evidence to demonstrate goodwill in the 'inTime' Trade Mark or the other word Marks being relied upon … in order to substantiate the Opposition … the Applicant disagrees that the evidence adduced by the Opponent has proved the existence of an established business in the United Kingdom … let alone the alleged level of customers in this country, such that would be indicative of the goodwill that is being claimed."* (original emphasis)

14. What I shall call the Applicant's "no conflict defence" emerged during the evidence stages in the following manner:

(i) in his first Witness Statement dated 8 January 2021, Mr Hertner said nothing at all about the Applicant's trading activities in the United Kingdom and said only this in relation to the elements of liability for passing off: *"In my view, due to **inTime's** longstanding use of 'inTime' for transport and logistics services, the registration of the Applicant's UK Trade Mark Application … would result in a misrepresentation to the public as to the commercial origin of the services provided, and consequent damage to **inTime**"*: para. 14;

(ii) in his Witness Statement dated 27 April 2021, Mr Alvarez gave evidence to the effect that the Applicant's trading activities had included use of the contested trade mark in the United Kingdom since 2004, with the Applicant and the Opponent having customers in common, without any apparent instances of confusion;

(iii) in her Witness Statement dated 20 May 2021, Ms House introduced into the present proceedings at Exhibit JH4 a copy of the written observations dated 15 March 2021 which the Opponent had filed at the EUIPO in response to the Applicant's Opposition No. B 003064152 to its (the Opponent's) EU Trade Mark Application No. 017898425 to register the following mark *inter alia* for transport services in Class 39:

(iv) in part 4 of its written observations at Exhibit JH4, the Opponent compared its mark with the Applicant's mark shown in para. [1] above and contended that: *"there is no likelihood of confusion as there is no sufficient similarity between the opponent's trademark and the applicant's trademark"*; *"the word element 'in time' ... is a rather weak or even indistinctive element of the overall sign"; "The term 'in time' is commonly used in courier and transport services to refer to the timely delivery of the cargo"*; *"the weak or indistinctive character of the term 'in time' centres the focus of trademark comparison to the other word and*

graphic elements of the trademarks at issue"; *"even small variations in the signs are enough to break out of the scope of protection of the earlier trademark"*;

(v) these contentions were repeated by the Applicant in the present proceedings and set up against the Opponent in answer to its objection under s.5(4)(a) in the Applicant's written submissions dated 20 May 2021 and 14 December 2021;

(vi) in his second Witness Statement dated 6 September 2021, Mr Hertner said nothing in response to the Applicant's 'no conflict defence' other than: *"There has been no 'peaceful coexistence' between the Applicant and* ***inTime*** *in the United Kingdom (or any other territory)"* (para. 5); and he included no invoices from any year prior to 2010 in the *"additional sample invoices"* he provided at pp. 7 to 139 of his Exhibit TH6.

15. The Opposition proceeded to a hearing on 16 December 2021 before Ms Rosie Le Breton acting for the Registrar of Trade Marks. The Opponent was professionally represented at the hearing. In its Skeleton Argument it identified "***the relevant date***" for the purpose of determining the sustainability of its objection to registration under s.5(4)(a) as the filing date of the application for registration: **4 October 2016**. I am told by Counsel for the Opponent that this was not questioned or discussed by the Hearing Officer at any point during the hearing. The requirements for actionability in passing off were addressed sequentially in its Skeleton Argument: 'Goodwill' (paras. 11 to 24); 'Misrepresentation' (paras. 25 to 29); 'Damage' (paras. 30 to 32).

16. The Applicant elected to file written submissions in lieu of attendance. In its written submissions dated 14 December 2021 it sought to introduce some additional items of

evidence which the Hearing Officer disregarded for having been filed informally and without permission. There is no appeal against her decision to exclude those items from consideration. The Applicant maintained its "no conflict defence" in addition to its "no protectable goodwill defence":

> As we said, no evidence has been provided on the existence of reputation, goodwill or renown of the opposing trademarks whose concurrence could give rise to "*misrepresentation*" or "*misleading*" to the consumer public.
>
> Further, not a single case of confusion between the conflicting marks has been alleged and proved. As we have stated and proven in our witness statement and provided invoices, the Applicant has been using his trademark since 2004, also in the UK. Therefore, it is at least curious that given the time that in theory the conflicting marks have coexisted in the market (since 2004), if the opposing brands are so recognized and reputed as to benefit from the action of "passing off" and if so much risk of confusion, misrepresentation or misleading exists, it should have been possible to provide a case of confusion or "misrepresentation" or "misleading". However, there is no evidence in the procedure of the concurrence of this requirement.
>
> As a consequence of the absence of proof of the two previous requirements, no harm has been produced nor is it possible to produce any damage to the Opponent. As we say, not even the slightest indication has been provided that the Opponent has lost any transport service due to the coexistence with the Applicant's trademarks in the UK market.
>
> As a complement to the previous allegations, we must add that, as has already been stated in our initial allegations, in UK territory and for the English consumer public, the "IN TIME*"* elements to identify transport services have little distinctive character due to their descriptive character on the nature of the services offered: on time (punctuality). That is why the concurrence of the trademark Application of graphic elements that are completely different from those used by the opposing trademarks should be sufficient for both signs to peacefully coexist in the market.

17. The Hearing Officer rejected the Opposition for the reasons she gave in a written decision issued under reference BL O/186/22 on 4 March 2022. She ordered the Opponent to pay £1,500. to the Applicant in respect of its costs of the Registry proceedings.

18. She rejected the Opposition on the basis: (1) that "**the relevant date**" for the purpose of assessing whether the Opponent was entitled to object to the contested application for registration on the basis of s.5(4)(a) was **18 November 2004** (in accordance with her finding that this was the date of commencement of the Applicant's *"**behaviour complained of**"* in the United Kingdom: paras. [37], [39] and [41]); and (2) that the evidence on file was not sufficient to establish that the Opponent had carried on business so as to build up or acquire a protectable goodwill in the United Kingdom prior to that date: paras. [42] to [60].

19. The Opponent now appeals under s.76 of the 1994 Act contending that it met the threshold for claiming a protectable goodwill in the United Kingdom for the purposes of its objection under s.5(4)(a), that the Hearing Officer's decision to the contrary was wrong and should be set aside and that its objection to registration should be upheld. The Applicant has filed written submissions in lieu of attendance in which it maintains that the Hearing Officer's Decision was correct for the reasons she gave.

20. **Section 5(4)(a) of the 1994 Act** provides that: "A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented — (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered

trade mark or other sign used in the course of trade, where the condition in **subsection 4A** is met; …".

21. **Subsection 4A** confirms that: "The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application." It serves to ensure that s.5(4)(a) of the Act is implemented consistently with the relevant provisions of the Trade Marks Directive (now Art. 5(4)(a) of Directive (EU) 2015/2436; formerly Art. 4(4)(b) of Directive 2008/95/EC; previously Art. 4(3)(b) of Directive 89/104/EEC) hence compatibly with 'the principle of the primacy of the earlier exclusive right': Case C-245/02 Anheuser-Busch Inc v Budejovicky Budvar NP EU:C:2004:717 at paras [98], [99]; Case C-122/21 X BV v Classic Coach Company vof EU:C:2022:428 at para. [40].

22. The question raised by the Opponent's objection to registration was whether use of the contested trade mark by the Applicant for services in Class 39 of the kind listed in its application for registration was at "**the relevant date**" i.e. **the filing date of 4 October 2016** (there being no claim to priority from any earlier date) liable to be prevented by the enforcement of rights which the Opponent could at that point in time have asserted against the Applicant in accordance with the law of passing off.

23. The trade mark had (with immaterial variations) been used by the Applicant for such services in the United Kingdom since November 2004 (see paras [39] to [41] of the Hearing Officer's Decision). That made it necessary to consider the greater or lesser impact of the principle that there could at "**the relevant date**" be no objection under s.5(4)(a) to the application for registration encompassing use of the trade mark by the

Applicant in a context and manner which previously was not — or which had previously ceased to be — actionable in passing off at the suit of the Opponent:

(i) the Court of Appeal confirmed in Maier v ASOS Plc [2015] EWCA Civ 220 at para. [165] (per Kitchin LJ) that: *"…The party opposing the application or the registration must show that, as at the date of the application (or the priority date, if earlier) a normal and fair use of the [contested] trade mark would have amounted to passing off. But if the [contested] trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date when it began.*"

(ii) the reasoning in paras [41], [42] and [57] to [64] of the Judgment of the CJEU in Case C-122/21 X BV v Classic Coach Company vof (above) points to the conclusion that: *"In a situation where a right relied on by a third party is no longer protected under the laws of the Member State concerned, it cannot be held that that right constitutes an 'earlier right' recognised by that law …"*.

24. The Applicant and the Opponent were traders with convergent claims to unregistered rights, in each case apparently founded upon years of concurrent use of their respective marks and signs in the area of trading activity covered by the Class 39 wording of the application for registration. Conflicts existing or arising between them within that area of trading activity fell to be determined consistently with the principles applied for the purpose of resolving issues as to priority in actions for passing off. Where there is conflict: (a) the senior user prevails over the junior user; (b) the junior user cannot deny the senior user's rights; (c) the senior user can challenge the junior user unless and until

it is inequitable for him to do so (Croom's Trade Mark Application [2005] RPC 2; BL O/120/04 (28 April 2004) at paras [45] and [46]).

25. Point (c) allows for use which might originally have been actionable in passing off to be treated as acceptable having regard to the state of equilibrium which has subsequently arisen in the relevant section of the market. This recognises that consumers tend to adjust their perceptions and adapt over time to the reality of concurrent use of marks and signs. In such circumstances, a claim for passing off is liable to fail on the basis that the claimant and the defendant are each entitled to continue using the business indicia they have been using.

26. The Opponent will have been the senior user for the purposes of the present Opposition if the business activities to which Mr Hertner attested in his witness statements were conducted over the period from 2000 to 2004 in a manner and on a scale sufficient to establish goodwill in the United Kingdom in accordance with the criteria for protection identified by the Supreme Court in Starbucks (HK) Ltd v British Sky Broadcasting Group Plc [2015] UKSC 31 at paras [47], [48] and [51] to [53] per Lord Neuberger PSC.

27. Having confirmed the requirement for '*actual goodwill in this jurisdiction, and … such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question*' (para. [47]), Lord Neuberger went on to consider '*what constitutes sufficient business to give rise to goodwill as a matter of principle*' (para. [51]) and stated *'… The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill,*

the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant. ...' (para. [52]).

28. Consistently with those observations it is appropriate to test for the existence of goodwill by reference to the incidence of people in the United Kingdom booking / purchasing / receiving the claimant trader's goods or services and to do so with due regard for the proposition that a small (but not trivial) goodwill can be sufficiently *'**significant**'* to qualify for protection: see Wadlow The Law of Passing Off 6th Edn (2021) paras. 3-31 to 3-36 and 3-196 to 3-207. The general tenor of the case law on this point is summed up by Professor Wadlow in the proposition: ***'If the claimant can prove as a matter of fact that he has more than a trivial number of customers in England then the question of whether he owns goodwill is resolved in his favour'*** (para. 3-204).

29. The Hearing Officer accepted in para. [44] of her Decision that the sample invoices provided by Mr Hertner supported his narrative statements to the effect that the Opponent had offered its services to consumers in the UK during the period 2000 to 2004. She said:

> Mr Hertner's statement that the opponent has offered its services in the UK since at least 2000 is also supported

> by the invoices provided to UK consumers for the period between 2000 – 2004. There are seven of these in total comprising one to an address in Coventry, four to an address in Bridgend, and two to an address in Dover, with approximate value ranging between 200 – 1200 Euros. There are also a few additional invoices showing a UK location as either a 'to' or 'from' destination on the body of the same, although these are addressed to customers outside of the UK. Whilst it is possible UK consumers receiving or sending goods may also be users of the opponent's services even if they do not pay the invoice, I note these additional invoices do not display VAT codes, and I also note that possible users of the services in these locations will not have been exposed to the invoices themselves. Overall, the level of business to the UK prior to the relevant date as evidenced by the invoices alone is small, but I keep in mind that I must consider the sum of the evidence provided, and not each element in isolation.

30. To that should be added the details of collections and deliveries made in the course of rendering cross-border transport services between 2000 and 2004 as recorded in the sample invoices in Exhibit TH5:

(p.19) 12.04.2000 Buhl to Coventry €713.60

(p.20) 08.02.2000 Burgebrach to Hayes €1,170.86

(p.21) 04.07.2000 Uedem to Durham €723.84

(p.22) 06.06.2000 Hannover to Reading €593.61

(p.25) 12.04.2000 Leicester to Bahlingen €613.55

(p.26) 13.04.2000 Slough to Ulm €664.68

(p.27) 29.03.2000 Wellingborough to Ingoldtadt €997.02

(p.28) 04.05.2001 Hagen to Wigan €1,022.58

(p.33) 02.04.2001 Ilsfeld to Basingstoke €750.50

(p.34) 01.03.2001 Ilsfeld to Middleton €847.47

(p.34) 02.03.2001 Walsall to Berlin €690.24

(p.35) 05.02.2001 Bielefeld to Liverpool € 735.11

(p.37) 12.02.2001 Bebington to Hamburg €562.42

(p.38) 08.02.2001 Birmingham to Wien €741.37

(p.39) 19.01.2001 Cardiff to Hagen €310.35

(p.40) 13.09.2002 Braunschweig to Birmingham €1,328.40

(p.40) 14.09.2002 Walsall to Kitzingen €1,360.38

(p.42) 01.10.2002 Salzgitter to Milton Keynes €576.00

(p.43) 07.08.2002 Wolfsburg to Crewe €808.52

(p.44) 02.07.2002 Warburg to Burnaston €746.13

(p.45) 11.11.2002 Bretten to Cardiff €959.04

(p.46) 14.11.2002 Sutton Coldfield to Bretten €758.16

(p.47) 18.10.2002 Middlesbrough to Giesen €590.00

(p.47) 18.10.2002 Tamworth to Gronau €674.52

(p.50) 05.09.2002 Dover to Batilly €285.00

(p.52) 12.05.2003 Salzgitter to Darlington €880.44

(p.53) 15.04.2003 Nurtingen to Birmingham €863.17

(p.54) 21.03.2003 Markranstadt to Crewe €1,666.65

(p.56) 04.02.2003 Hannover to London €80.00

(p.56) 05.02.2003 Hildesheim to Maidenhead €250

(p.58) 05.06.2003 Crumlin to Augsburg €1,148.99

(p.59) 12.05.2003 Hamburg-Barmbeck to Maidenhead €1,490.00

(p.59) 13.05.2003 Bath to Hannover €95.00

(p.60) 13.05.2003 Maidenhead to Braunschweig €40.00

(p.63) 26.03.2003 Manchester to Wiesbaden €781.92

(p.69) 10.06.2003 Wiesbaden to South Benfleet €494.34

(p.75) 08.04.2004 Langenhagen to Solihull €1,200.00

(p.77) 16.04.2004 Hannover to Birmingham €752.25

(p.78) 19.04.2004 Hannover to Solihull €752.25

(p.81) 30.04.2004 Hannover to Solihull €601.86

(p.82) 16.02.2004 Gottingen to Bridgend €2,200.00

(p.83) 12.03.2004 Friedberg to Bradford €760.86

(p.84) 05.05.2004 Redditch to Burscheid €500.00

(p.85) 03.04.2004 Cross Hills to Gyor €1,582.74

(p.86) 08.03.2004 Harlow to Swarzedz €901.56

(p.87) 02.02.2004 Llanelli to Bratislava €1,647.36

31. With reference to the turnover figures which Mr Hertner had provided, the Hearing Officer said (para. [54]): "*I am willing to accept they relate to the import and export of goods into and out of the UK for the periods given. Whilst I therefore accept that, with reference to the UK invoices and statements from Mr Hertner, it is likely a portion of these figures will be attributable to business with UK customers, it is not clear at what level that business would have been.*"

32. I agree with the Hearing Officer that it was not clear what the level of business with UK customers would have been. But in the context of Mr Hertner's evidence as a whole, it was apparent from the size of the spreadsheet figures for inbound and outbound transportation services provided in Exhibit TH4 (see para. [9] above) taken together with the information relatedly provided by way of the sample invoices in Exhibit TH5 (see paras. [29] and [30] above) that the incidence of people in the United Kingdom booking / purchasing / receiving the Opponent's cross-border transport services between 2000 and 2004 was not liable to be dismissed as trivial.

33. In para. [56] the Hearing Officer said: "*Whilst I therefore find it difficult to determine from the evidence exactly how the 'inTime' mark would have been displayed on the original invoices between 2000 – 2004, I accept Mr Hertner's statement that the transactions will have been undertaken under the 'inTime' mark in some capacity.*" Once she had accepted Mr Hertner's statement to that effect, it ceased to be realistic, for the legal and factual reasons I have referred to in paras. [26] to [32] above, for the Hearing Officer to conclude that the Opponent had a cross-border business with no protectable goodwill in the United Kingdom at the commencement of the Applicant's trading activities in November 2004.

34. It follows, in my view, that it was not reasonably open to the Hearing Officer to treat the Opposition as completely unmaintainable on the basis stated in para. [59]:

> Considering the sum of the evidence provided, it is my view that whilst this suggests that the opponent offered services for the transportation of goods to its customers prior to the relevant date, and that this was likely offered under the sign 'intime' in some capacity, the evidence has only assisted in establishing a very small amount of trade to customers within the UK during this period, by way of a few invoices to UK customers. Without confidence that the import and export figures actually relate to UK customers, and with very little in the way of supporting evidence, I cannot find the trade with customers in the UK to have been more than minimal. Further, even if this trade did amount to a small amount of goodwill being held in the opponent's business prior to the relevant date, and it is my view that in any case this would be no more than nominal, the evidence offers little to assist a finding that the signs relied upon, namely the two word marks, had become distinctive of the opponent's business and that goodwill at the relevant date.

35. The last sentence of that paragraph was inconclusive. The Opponent's objection to registration remained to be substantively determined. The parties have had the

opportunity to file evidence and make submissions in respect of it. Neither side has suggested that the objection should be remitted to the Registrar for determination. The Opponent wishes to have the Appeal determined in line with the principles I have referred to in para. [24] above: Transcript p.28, line 23 to p.29, line 12. It submits that if the Hearing Officer had not erred in the respects in which I have found she erred, she would have carried on with her assessment and in doing so *"found that there was enough reputation to give rise to a misrepresentation and damage"* and upheld the objection to registration: Skeleton Argument, paras. 41 to 44. I can safely assume that the Applicant continues to rely on its "no conflict defence" summarised above. In the circumstances, I shall proceed to determine the matter now on the basis that the Opposition as a whole is presently before me.

36. I broadly agree with the contentions made by the Opponent and repeated by the Applicant as noted in paras. [14(iv)] and [14(v)] above. I take as my starting point the proposition that the words "**IN TIME**" are, in themselves, origin neutral in terms of the message about standards of service that people in the United Kingdom would instinctively understand them to be conveying when used with reference to the provision of transport services.

37. Mr Hertner introduced himself in para. 1 of his first Witness Statement as *"an authorized Officer of inTime Express Logistik GmbH (hereinafter referred to as **inTime**)".* He used that abbreviation throughout the text of his Witness Statements. His Exhibits TH2 and TH3 were put forward as showing *"the dominant use of 'inTime' in **inTime**'s branding"* in support of his position that *"**inTime**'s 'in Time' trade mark would therefore have been easily recognisable and well known as designating **inTime** as the origin of those transport services. Furthermore, you can see that it is typical for*

*the business to refer to itself in shorthand as **inTime** only, and as such, this is how our consumers would recognise us. … it is clear from this evidence that **inTime** commonly refers to itself as 'inTime' as a badge of origin."*: first Witness Statement, paras. 6 and 7.

38. I consider that this over-stated the position, at least so far as the United Kingdom was concerned. The evidence on file was sufficient to support the conclusion that people in the market for transport services in the United Kingdom had come to recognise and remember the Opponent's and the Applicant's marks and signs as identifiers of trade origin for their respective "**IN TIME**" services, with the words "**IN TIME**" contributing (and none the less so as a result of the way in which they were accentuated in visual representations) to the specific individuality of their respective marks and signs as a whole. However, the basic expression "**IN TIME**" was not shown to have acquired an independent distinctive character in its own right.

39. The fact that a designation is recognised and associated with a trader's goods or services does not necessarily imply that it is distinctive in the sense of individualising such goods or services to a single economic undertaking: Kerly's Law of Trade Marks and Trade Names 16th Edn (2018) paras.10-027 to 10-032; Wadlow paras. 8-60, 8-61. Whilst the evidence in the present case was sufficient to establish awareness in the nature of recognition and association (that people in the market for transport services in the United Kingdom who were familiar with the Opponent's or Applicant's marks and signs were likely to verbalise them by means of the words "**IN TIME**") it was not sufficient to establish perception of the kind required for a finding of distinctiveness (that people in the market for transport services in the United Kingdom expected such services to be those of the Opponent or those of the Applicant or those of any particular

trader if, when or because they were referred to simply and solely as "**IN TIME**" services).

40. It was established that the Opponent and the Applicant had been operating two separate businesses providing differently branded "**IN TIME**" transport services in the United Kingdom between 2004 and 2016. If there was (and there is no evidence indicating that there was) any prevalence of the Opponent being mistakenly linked to the "**IN TIME**" transport services provided by the Applicant or *vice versa* in the minds of people in the market for such services in the United Kingdom, that would more likely than not have been a consequence of their concurrent use of marks and signs imbued with the origin neutral message conveyed by the words "**IN TIME**".

41. Confusion attributable to nothing more than the concurrent use of origin neutral messaging can properly be characterised for the purposes of the law of passing off as confusion without misrepresentation, especially when (as in the present case) there is no evidence or accusation of any impropriety in the junior user's decision to adopt its branding for use in the United Kingdom in the first place: Kerly paras. 20-097 to 20-099; Wadlow paras. 4-29, 4-30.

42. Beyond that, the parties each appear to have built up and acquired a substantial goodwill and reputation in the United Kingdom by means of their business activities as providers of cross-border transport services under and by reference to their respective "**IN TIME**" marks and signs. There is nothing in the evidence on file indicating or suggesting that at any time prior to "**the relevant date**" (**4 October 2016**) either side raised any objections or concerns in relation to the ongoing use of the designation "**IN TIME**" by the other of them in the United Kingdom. They both appear to have been

content for the concurrent use of their respective "**IN TIME**" marks and signs in the United Kingdom to continue. The Applicant's trade mark application listed the Class 39 services of interest to it in terms which appear to have been proportionate and fair relative to the actuality of its business activities in the United Kingdom between November 2004 and October 2016. In the circumstances, I consider that it would have been inequitable at "**the relevant date**" for the Opponent to assert any right it might previously or otherwise have had to object by virtue of the law of passing off to the Applicant using "**IN TIME**" as part of the contested trade mark for such services

43. For the reasons I have given in paras. [36] to [42] above, I consider that the objection to registration under s.5(4)(a) should have been rejected on the basis that the Opponent did not at "**the relevant date**" have any or any enforceable right by virtue of the law of passing off to prevent use of the contested trade mark by the Applicant for Class 39 services of the kind listed in its Trade Mark Application No. 3488993. The Appeal therefore stands dismissed.

44. In its written submissions for the purposes of this Appeal, the Applicant adhered to its "no protectable goodwill defence" and maintained that the Hearing Officer's Decision was correct for the reasons she gave. I have decided that the Hearing Officer erred in upholding that defence. It does not appear from its written submissions that the Applicant has incurred any or any significant costs additional to those which it incurred in the proceedings below in respect of its "no conflict defence". That defence can for practical purposes be taken to have been covered by the costs award of £1,500 which the Hearing Officer made in its favour. I see no reason to make any further award in the Applicant's favour in respect of the Appeal. Although the Opponent has succeeded in overturning the Hearing Officer's reasoning and approach to the Applicant's "no

protectable goodwill defence", it has not achieved a better outcome in terms of the end result of the Opposition. In the circumstances, I propose to make no order for costs in relation to the proceedings before me and leave the Hearing Officer's order for costs unchanged in respect of the proceedings at first instance.

45. In the result, the Appeal is dismissed with no order for costs.

Geoffrey Hobbs QC

30 June 2022

Ms Ashton Chantrielle, instructed by Marks & Clerk LLP, appeared on behalf of the Opponent (Appellant)

Mr James Mitchiner of Mitchiners filed written submissions on behalf of the Applicant (Respondent)