

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 1 373 287:
CONCORDE IN THE NAME OF BRITISH AIRWAYS PLC

AND

IN THE MATTER OF AN APPLICATION FOR REVOCATION BY
MICHAEL GLEISSNER

Background and pleadings

1. British Airways Plc (BA) is the registered proprietor of trade mark registration No 1 373 287 consisting of CONCORDE. The trade mark was filed on 13TH February 1989 and completed its registration procedure on 26th March 1993. It is registered in respect of the following goods:

Class 14:

Precious metals and their alloys; jewellery; precious stones; all included in Class 14; but not including jewellery containing horological or chronometric instruments.....Medals of precious metal or coated therewith.

Class 16:

Magazines, brochures, luggage labels, tickets, luggage tags, pens, pencils, writing pads, notepaper, photographic albums, paper bags, playing cards; all included in Class 16.....Wallpaper pattern books, but not including any such books in the form of printed publications.....Copper etchings.

Class 18:

Carrier bags of plastics material, all in the nature of shopping bags.

Class 20:

Wall plaques made principally of plastics.....Key chain fobs and badges, all made wholly or principally of acrylic plastics...Ornaments made of plastics, in the form of aircraft.

Class 21:

Small domestic utensils and containers, and jugs, none made of precious metal or coated therewith; trays (domestic utensils); dishes, mugs, cups included in Class 21, table plates, combs, coffee percolaters (non-electric) and vacuum flasks; but not including hot water bottles or any goods of the same description as hot-water bottles. entry cancelled under section 34 (1) (d) of the Trade Marks Act, 1938, in respect of "Vacuum Flasks". entry cancelled under section 34 (1) (d) of the trade marks act, 1938, in respect of goods of the same description as vacuum flasks.

Class 25:

Articles of clothing for women and girls, but not including footwear, gloves or shirts or goods of the same description as gloves or shirts.

Class 26:

Embroidered badges

Class 27:

Wall coverings (in the nature of wall hangings) made of non-textile materials; wallpaper and ceiling paper.....Wall coverings (in the nature of wall hangings), wallpaper and ceiling paper.

Class 28:

Toy balloons.....Toys, games (other than ordinary playing cards) and playthings; kits of parts (sold complete) for making toys; but not including toy balloons, toy land vehicles or toy watercraft.

Class 34:

Smoker's ash trays (not of precious metal or coated therewith).....Pyrophoric lighters for smokers.

Class 39:

*Airline transportation services; car hire services; all included in Class 39.
PARTIALLY REVOKED IN RESPECT OF: Car hire services.*

2. Michael Gleissner seeks revocation of the trade mark registration on the grounds of non use based upon Section 46(1)(a) and (b) of the Trade Marks Act 1994. BA filed a counterstatement denying the claim.
3. Revocation is sought under Section 46(1)(a) in respect of the 5 year time period following the date of completion of the registration procedure, namely 27th March 1993 to 26th March 1998. Revocation is therefore sought from 27th March 1998. Revocation is also sought under Section 46(1)(b) in respect of the time period 5th September 2011 to 4th September 2016. Revocation is therefore sought from 5th September 2016.
4. Only BA filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision.
5. A Hearing took place on 10th October 2017 with the RP represented by Mr Pendered of Maucher Jenkins, BA's trade mark attorney. The applicant for revocation, Michael Gleissner represented himself alongside his colleague Mr Afean Samad.

Legislation

6. Section 46(1) of the Act states that:

“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;

(c).....
.....

(d).....

(2) For the purpose of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and 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 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 existed at an earlier date, that date.”

7. . 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.”

BA's evidence

8. This is a witness statement, dated 25th January 2017, from Christopher Brown, a Brand Executive of BA. He explains that CONCORDE became famous as the name of BA's supersonic transatlantic travel service, which BA operated with a fleet of CONCORDE aircraft from 1976 to 2003. According to Mr Brown, BA have continued to keep the name CONCORDE alive, for example as a heritage brand in their visitor centre and also as the name given to their lounges for First class passengers at Heathrow airport in the UK and at JFK airport in New York.

9. According to Mr Brown, CONCORDE, has been used by BA or its licensees in relation to various merchandising products. In particular, between 5th September 2011 and 4th September 2016, the mark has been used in respect of Class 14, Class 16, Class 20, Class 25, Class 28 and Class 39. During the aforementioned period, BA granted licenses to some eight companies for the sale of aircraft models and toys bearing the BA trade mark branding and livery, including the CONCORDE mark. BA has, according to Mr Brown, also granted licenses to various museums for the sale of CONCORDE related giftware items in their shops. The revenue in respect of these activities is around £100,000 per annum. Exhibit CB1 is a schedule of licenses. Here it is noted that the items licensed are die cast models of CONCORDE planes, pull back CONCORDE models, plastic model kits, play sets and aircraft miniatures. Exhibit CB2 shows a bundle of materials showing model CONCORDE planes for sale. It is noted that these appear to be model kits to build an aircraft once purchased and a plastic (already assembled) model set. Exhibit CB3 is a bundle of materials showing items for sale in museums that house CONCORDE aircraft leased from BA. It is noted that there are several references to ties being offered for sale. Further, there is evidence of cufflinks, earrings, baseball caps, t-shirts, pens, sticky note pads, a CONCORDE gift set which includes a model of a CONCORDE and (what appears to be) a

book about the CONCORDE aircraft being offered for sale. The exhibit ends with the inclusion of several pages regarding BA's first class lounges available at select airports.

10. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice:

Ansul at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

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

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

Conclusion – Non use

11. It is considered that the evidence of use filed by BA is not without its defects. There is, for example, no evidence of advertising and marketing activities. Revenue figures are provided and though they are not broken down in respect of categories of goods, there are also examples of merchandising products offered for sale contained in the evidence. These are limited in scope, but they are clearly offered to the UK market (the amounts are in £ sterling). Further, all of the evidence is dated within the later of the relevant periods.
12. However, the evidence does not demonstrate genuine use in respect of all of the goods and services for which CONCORDE is registered. In this regard, the following guidance is taken into account:
13. 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.”
14. 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.”

15. Bearing in mind the above guidance, the following is considered to represent a fair specification, based upon the use shown in the evidence:

Class 14:

Cufflinks; earrings.

Class 16:

Pens, notepaper.

Class 20:

Ornaments made of plastics, in the form of aircraft.

Class 25:

Articles of clothing for women and girls, namely hats, tops and t-shirts.

Class 28:

Toys, namely die cast models of aircraft; kits of parts (sold complete) for making toys, namely aircrafts; but not including toy balloons, toy land vehicles or toy watercraft.

16. The application for revocation therefore fails in respect of the above but succeeds in respect of the remaining goods and services, for which no use has been shown. The revoked goods and services therefore are:

Class 14:

Precious metals and their alloys; jewellery; precious stones; all included in Class 14; but not including jewellery containing horological or chronometric instruments.....Medals of precious metal or coated therewith.

Class 16:

Magazines, brochures, luggage labels, tickets, luggage tags, pencils, writing pads, photographic albums, paper bags, playing cards; all included in Class 16.....Wallpaper pattern books, but not including any such books in the form of printed publications.....Copper etchings.

Class 18:

Carrier bags of plastics material, all in the nature of shopping bags.

Class 20:

Wall plaques made principally of plastics.....Key chain fobs and badges, all made wholly or principally of acrylic plastics....

Class 21:

Small domestic utensils and containers, and jugs, none made of precious metal or coated therewith; trays (domestic utensils); dishes, mugs, cups included in Class 21, table plates, combs, coffee percolaters (non-electric) and vacuum flasks; but not including hot water bottles or any goods of the same description as hot-water bottles. entry cancelled under section 34 (1) (d) of the Trade Marks Act, 1938, in respect of "Vacuum Flasks". entry cancelled under section 34 (1) (d) of the trade marks act, 1938, in respect of goods of the same description as vacuum flasks.

Class 25:

Articles of clothing for women and girls, but not including footwear, gloves or shirts or goods of the same description as gloves or shirts.

Class 26:

Embroidered badges

Class 27:

Wall coverings (in the nature of wall hangings) made of non-textile materials; wallpaper and ceiling paper.....Wall coverings (in the nature of wall hangings), wallpaper and ceiling paper.

Class 28:

Toy balloons.....Toys, games (other than ordinary playing cards) and playthings; but not including toy balloons, toy land vehicles or toy watercraft.

Class 34:

Smoker's ash trays (not of precious metal or coated therewith).....Pyrophoric lighters for smokers.

Class 39:

*Airline transportation services; car hire services; all included in Class 39.
PARTIALLY REVOKED IN RESPECT OF: Car hire services.*

17. The registration in respect of these goods and services will be revoked from 27th March 1988.

18. The registration survives in respect of:

Class 14:

Cufflinks; earrings.

Class 16:

Pens, notepaper.

Class 20:

Ornaments made of plastics, in the form of aircraft.

Class 25:

Articles of clothing for women and girls, namely hats, tops and t-shirts.

Class 28:

Toys, namely die cast models of aircraft; kits of parts (sold complete) for making toys, namely aircrafts; but not including toy balloons, toy land vehicles or toy watercraft.

COSTS

19. Though not consolidated due to the differing attacked trade marks, these proceedings have travelled with 7 other cases between the same parties. Further, they were all heard at a single oral Hearing. For ease of reference, the respective costs awards in respect of all 8 cases will be detailed under separate cover. It should be noted that the substantive appeal period for all 8 cases will run from the date of the subsequent costs decision.

Dated this 22nd day of November 2017

Louise White

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