

O/591/17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 1 341 347:
CITY FLYER 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 (RP) of trade mark registration No 1 341 347 consisting of CITY FLYER. The trade mark was filed on 14th April 1988 and completed its registration procedure on 30th March 1990. It is registered in respect of the following services:

Class 39:

Transportation of passengers and of cargo, all by air; aircraft chartering; travel agency, booking services and the provision of tourist information; all relating to air travel; all included in Class 39.

Class 42:

Booking and reservation services, all for hotels, guesthouses and for temporary accommodation; hotel and restaurant services; all included in Class 42.

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 31st March 1990 to 30th March 1995. Revocation is therefore sought from 31st March 1995. 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 the registered proprietor 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, the RP'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 CITY FLYER has been used since the year 1999 and is still in use to this day in relation to all of the services covered by the registration. The mark is used by BA CityFlyer Limited, a wholly owned subsidiary of BA. Exhibit CB1 is extracts from BA's Annual Report and Accounts for the years 2011 to 2015 confirming this.
9. CITY FLYER is used, often in combination with BA's mark BA, in connection with air travel services offering domestic and European flights operating out of three UK airports: London City, Edinburgh and Manchester. The mark is used on the flight booking service on BA's website. Exhibit CB2 is an extract from the website. It is noted that these extracts clearly show CITY FLYER in use in respect of flights. Though the information is dated after the relevant date, Mr Brown confirms that this is what the website would have looked like during the relevant period.
10. Exhibit CB3 is a picture of BA's livery, clearly showing CITY FLYER as part of this.
11. Exhibit CB4 is a selection of printed and electronic material associated with the service provided under CITY FLYER such as ticketing and in-flight magazines. It is noted that CITY FLYER is clearly displayed but that all of the material is undated.

12. Sales turnover figures are provided and are as follows: 2011 - £123 million; 2012 - £128 million; 2013 - £149 million; 2014 - £176 million and 2015 - £193 million.
13. Exhibit CB5 is an undated sample of advertising material. This is a route map showing those that CITY FLYER operate.
14. Marketing investment is, according to Mr Brown, £1.7 million per annum for the last two years (presumably 2015 and 2016).
15. According to Mr Brown, CITY FLYER is recognised among the general public. Exhibit CB6 are articles in the national press. It is noted that one is from the Independent newspaper and is dated March 2012 (the writer flew with CITY FLYER); another is from the Business Traveller and is dated June 2014 and is regarding new aircraft; a third is in respect of London City Airport, dated August 2015 and mentions CITY FLYER as one of the airlines using the airport. Exhibit CB7 is an extract from the Wikipedia website relating to the CITY FLYER service.
16. Exhibit CB8 is an extract from a recruitment website (pilot and cabin crew) regarding CITY FLYER.
17. In considering whether or not there has been genuine use, I take into account the following guidance:

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 Bunderversvereinigung 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].”

18. Though much of the evidence is undated some dated information is helpful in assessing the scale, duration and frequency of use. Sales turnover figures are also provided. National newspapers articles are in evidence, as well as details in annual accounts, all of which are dated within the final relevant period. It is clear that BA has established genuine use in these proceedings. However,

there has not been use shown across all of the services covered by the registration. In this regard, 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.”

19. Further, 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.”

20. Bearing in mind all of the aforesaid guidance, it is considered that the evidence filed only demonstrates use in respect of the following services in Class 39:

Transportation of passengers and of cargo, all by air; aircraft chartering; booking services and the provision of tourist information; all relating to air travel; all included in Class 39.

21. It should be noted that services such as booking services and tourist information in relation to air travel are considered to be intrinsic to the provision of other services such as the transportation of passengers. As such, it is considered reasonable for these services to also be preserved within the registration.

22. The remaining services will be revoked from 31st March 1995. These are:

Class 39:

Travel agency

Class 42:

Booking and reservation services, all for hotels, guesthouses and for temporary accommodation; hotel and restaurant services; all included in Class 42.

COSTS

8. 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