

O/594/17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 1 356 816:
SKYFLIERS/SKYFLYERS 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 1 356 816 consisting of SKYFLYERS/SKYFLIERS (a series of two marks). The trade mark was filed on 6th September 1988 and completed its registration procedure on 28th August 1990. It is registered in respect of the following goods and services:

Class 16:

Paper and paper articles; cardboard and cardboard articles; printed matter; printed publications; instructional and teaching materials; stationery; diaries, calendars and personal organisers; writing instruments; decalcomanias; playing cards; all relating to air travel and all included in Class 16.

Class 39:

Transportation of passengers and of cargo, all by air; airline, air travel and package holiday services; aircraft chartering; travel agency; booking services and the provision of tourist information, all relating to travel; arranging of sightseeing tours and of cruises; car rental; all included in Class 39.

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 29th August 1990 to 28th August 1995. Revocation is therefore sought from 29th August 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.”

6. 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

7. This is a witness statement, dated 25th January 2017, from Christopher Brown, a Brand Executive of BA. Mr Brown explains that the mark SKYFLYERS has been used by BA since the year 1988 and is still in use to this day in relation to all of the goods and services covered by the registration. It is used to describe a special service for children under the age of 12 travelling alone. The service includes escorting the children through the flight departure and arrivals process, as well as accompanying them whilst they are on board the aircraft. According to Mr Brown, the service has been offered by BA on all their flights into and out of the UK to short or long haul destinations during the time period September 2011 – September 2016.
8. Mr Brown explains:
 - BA markets the SKYFLYERS service in a number of ways, primarily through its website: www.ba.com. Exhibit CB1 is a bundle of sample materials showing the service on the website and a press article, dated 17th November 2013, regarding the service. The website extracts are also dated within the final relevant period
 - The mark also appears on the children's activity pack, on printed and electronic materials associated with the service, such as the in-flight

entertainment system. Exhibit CB2 is a bundle of materials showing SKYFLYERS in use on such activity packs. It is noted that some are dated 2013, which is during the final relevant period.

- Exhibit CB3 contains a bundle of materials showing the mark in use on the ba.com website during the final relevant period. Specifically, the activity packs are described (according to the age of the child), together with a reference to a SKYFLYERS kids zone, which appears to be an electronic service whereby children can choose appropriate programmes to view. The exhibit also contains a press article, dated 21st October 2015, referring to the service.
- In 2015 BA carried 44,865 children on the SKYFLYERS solo service; the associated revenue was £4.1 million.
- During 2011-2016, approximately £400,000 children's packs per annum were distributed on flights.

9. In considering whether or not there has been genuine use, I take into account the following guidance:

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 Kameradschaft '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].”

11. The majority of the evidence filed is appropriately dated and so the scale, duration and frequency of use is clear. Passenger numbers and the associated revenue figures are provided, as are distribution numbers for the activity packs. National newspapers articles, dated within the final relevant period, which refer to the SKYFLYERS service are also in evidence. It is clear that BA has established genuine use in the use of the mark SKYFLYERS in these proceedings. However, there are two registered trade marks here, a series of two with the second trade mark being SKYFLIERS. In this regard, I take into account the following:

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

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

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

12. Although this cases was decided before the judgment of the Court of Justice of the European Union ("CJEU") in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

13. It is considered that the use of SKYFLYERS can clearly be relied upon by BA as use also of SKYFLIERS. It is nothing more than an alternative spelling and does not affect the distinctive character of the trade mark in any way.

14. Having decided that there has been genuine use of the registered trade mark (series of two), it is also clear that 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.”

15. 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.”

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

Transportation of passengers, all by air; airline, air travel; booking services.

17. In respect of Class 16, the following is considered to represent a fair specification:

Printed matter; writing instruments; playing cards; all relating to air travel and all included in Class 16.

18. For the remaining goods and services, the registration will be revoked from 29th August 1995. That is:

Class 16:

Paper and paper articles; cardboard and cardboard articles; printed publications; instructional and teaching materials; stationery; diaries, calendars and personal organisers; decalcomanias; all relating to air travel and all included in Class 16.

Class 39:

Transportation of cargo, all by air; package holiday services; aircraft chartering; travel agency; the provision of tourist information, all relating to

travel; arranging of sightseeing tours and of cruises; car rental; all included in Class 39.

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**