O/0628/24

TRADE MARKS ACT 1994

IN THE MATTER OF
UK REGISTRATION NO. 3103918
IN THE NAME OF CLOCH SOLICITORS LIMITED
IN RESPECT OF THE TRADE MARK

UMPIRE

IN CLASSES 16, 25, 35, 41 & 45

AND AN APPLICATION FOR REVOCATION THEREOF
UNDER NO. 505379
BY GLOBAL UMPIRE INCORPORATED

BACKGROUND AND PLEADINGS

1. Trade mark No. 3103918 for the trade mark "**UMPIRE**" stands registered in the UK in the name of Cloch Solicitors Limited ("CSL").[1] The application for registration was filed on 14 April 2015, and the trade mark was registered on 27 January 2017, in respect of goods and services in classes 9, 16, 25, 35, 36, 41 and 45.

2. On 20 September 2022, Global Umpire Incorporated ("GUI") filed an application seeking to revoke CSL's trade mark in classes 9, 35 and 36 only on the grounds of non-use under sections 46(1)(a) and 46(1)(b) of the Act.

3. Under section 46(1)(a) of the Act, GUI claims non-use of the relevant goods and services in the five year period following the date on which the mark was registered, i.e. 28 January 2017 to 27 January 2022, with an effective date of revocation of 28 January 2022.

4. Revocation is also sought under section 46(1)(b), where GUI claims non-use of the relevant goods and services from 16 September 2017 to 15 September 2022 with an effective date of revocation of 16 September 2022.

5. CSL filed a counterstatement denying that its mark should be revoked in part for the disputed services in class 35.[2]

6. Only CSL filed evidence; neither party elected to file written submissions. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

7. In these proceedings, CSL represents itself, and GUI is represented by Pinsent Masons LLP.

[1] I note that on 12 May 2016, the original owners, Philip Adamson Hannay and Laura Anne Scanlan Hannay, filed form TM16 requesting the transfer of ownership to CSL, with effect from 30 March 2016. Confirmation of the recordal of the assignment was issued on 23 May 2016.
[2] See below under "Preliminary issues".

Preliminary issues

8. On 18 January 2023, being the same date on which the amended (and accepted) form TM8(N) was filed by CSL, CSL further filed form TM23 to partially surrender its registration in respect of goods in class 9 and services in class 36 in their entirety, and to partially surrender services in respect of class 35. On 28 February 2023, the Tribunal issued a letter to confirm the resulting specification of the registration following the partial surrender. It also stated that as the requested date of revocation was earlier than the date of the partial surrender, proceedings would continue unless the application for revocation was withdrawn by GUI. However, as GUI made no request for the withdrawal of its application for revocation, proceedings have accordingly continued to the subsequent stages.

9. As CSL have made no defence in regard to the (surrendered) disputed goods and services in classes 9 and 36, those goods and services will therefore be revoked from the earliest date requested, being 28 January 2022.

10. I will now proceed to consider whether there is sufficient evidence of use in relation to the remaining disputed services in class 35 for which a defence has been made.

EVIDENCE

11. CSL filed evidence by way of a witness statement dated 12 June 2023 in the name of Philip Hannay, alongside five exhibits, labelled PH1-01 to PH1-05. Mr Hannay is director of CSL.

12. I note that in the witness statement, Mr Hannay specifically states that the statement is directed only at use made of the registration in connection with the class 35 services covered by the registration within the periods 28 January 2017 and 27 January 2022, and 16 September 2017 and 15 September 2022.

13. I have read and considered all of the evidence and I will refer to the relevant parts at the appropriate points in the decision.

DECISION

14. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Section 46

15. Section 46 of the Act states:

> "46. - (1) The registration of a trade mark may be revoked on any of the following grounds-
>
> > (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
> >
> > (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
> >
> > (c) […]
> >
> > (d) […]
>
> (2) For the purpose of subsection (1) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade

mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in 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) […]

(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 existing at an earlier date, that date".

16. Section 100 of the Act states that:

"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".

17. As CSL's mark is a UKTM, the relevant territory in which use must be shown is the UK. As noted previously, under section 46(1)(a) the relevant period for assessing whether there has been genuine use is 28 January 2017 to 27 January 2022 ("the first relevant period"), while the relevant period under section 46(1)(b) is 16 September 2017 to 15 September 2022 ("the second relevant period").

18. In view of the above dates, I will focus upon the second relevant period, given that a finding of genuine use during this period will be sufficient to avoid revocation of the mark under section 46(1)(b), and, by virtue of section 46(3), section 46(1)(a), even if the evidence in relation to the earlier period is deemed insufficient.

19. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].
>
> 106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(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]; *Ferrari* at [33].

(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].”

Evidence of use

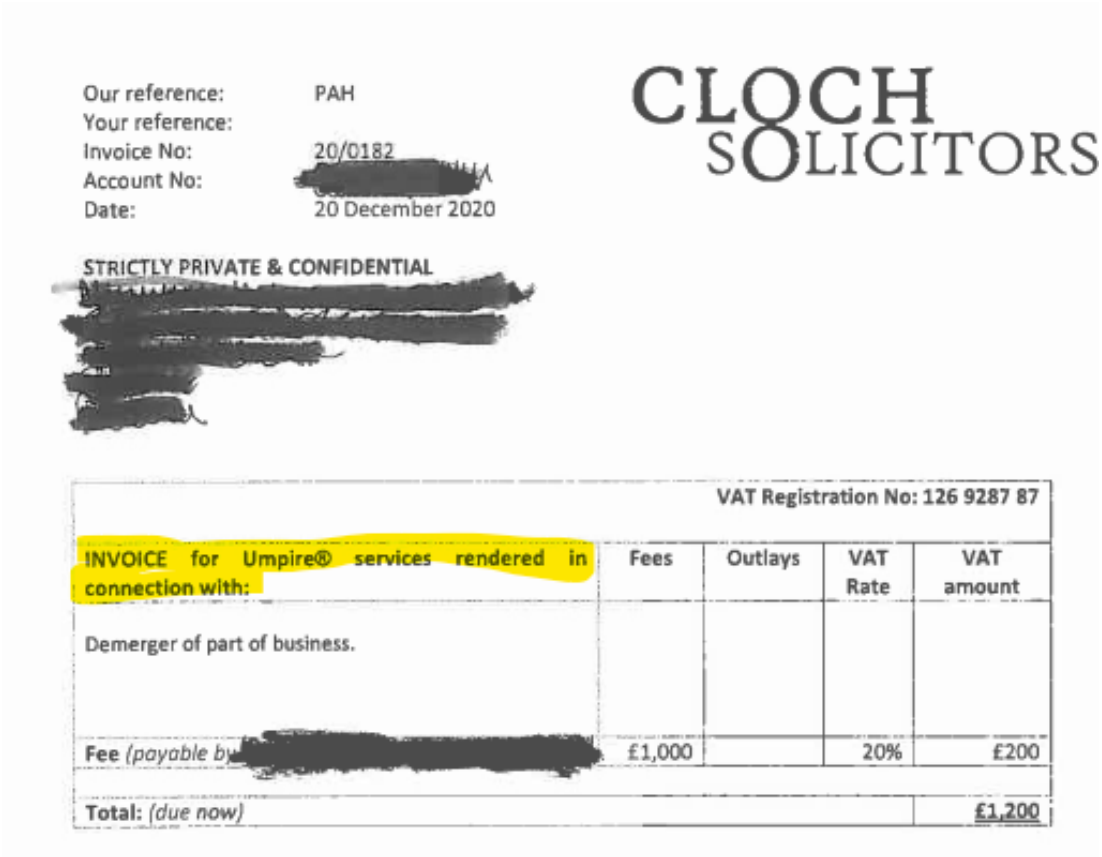
20. I must consider whether, or the extent to which, the evidence shows genuine use of the mark in relation to the disputed services. In its notice of defence, CSL has claimed that use has been made of the following services in class 35:

Advertising; office functions; business research; business management; business assistance; provision of business advice and information; business appraisals; business investigations and enquiries; business administration; commercial advice; compilation and provision of company information; statistical information, data processing, document reproduction; preparation of reports; maintaining and indexing;

information, consultancy and advisory services relating to the aforesaid, including such services provided online from a computer network and/or via the Internet and/or extranets; employee relocation services; consultancy relating to mergers and acquisitions; business enquiries and investigations; advisory services relating to business management, business organisation and franchising; provision of information relating to commercial business and the preparation of reports; compilation and provision of business information; services relating to the analysis, evaluation, creation and brand establishment of trademarks, trade names and domain names namely consultancy services for the aforesaid; business analysis, research and information services; market research; collection and systemisation of business data; ***wholesale services in relation to computer software; retail services in relation to computer software;*** *mediation and conclusion of commercial transactions for others; mediation of advertising; mediation of agreements regarding the sale and purchase of goods; mediation of contracts for purchase and sale of products; mediation of trade business for third parties.*[3]

21. In his witness statement, Mr Hannay provides background information on what he describes as "the UMPIRE project" in which he states the mark "UMPIRE" first featured as a prospective trade mark for one of a number of the "Registered Proprietor's" in-house projects, resulting in an application for the registered trade mark currently in dispute being filed. He proceeds to explain how the name "UMPIRE" was used as a corporate name, and further states that use of the "UMPIRE" mark was restricted to certain invoices issued by "the Registered Proprietor", stating that an estimated £10K of invoices included the mark for class 35 services. Exhibit PH1-04 has been provided in support of these claims:

[3] I note that the services in bold were surrendered, as per form TM23 filed on 18 January 2022, but were included at question 7 of the form TM8(N) of the same date, which lists the class 35 services being defended.



Our reference: PAH
Your reference:
Invoice No: 20/0182
Account No: [redacted]
Date: 20 December 2020

CLOCH SOLICITORS

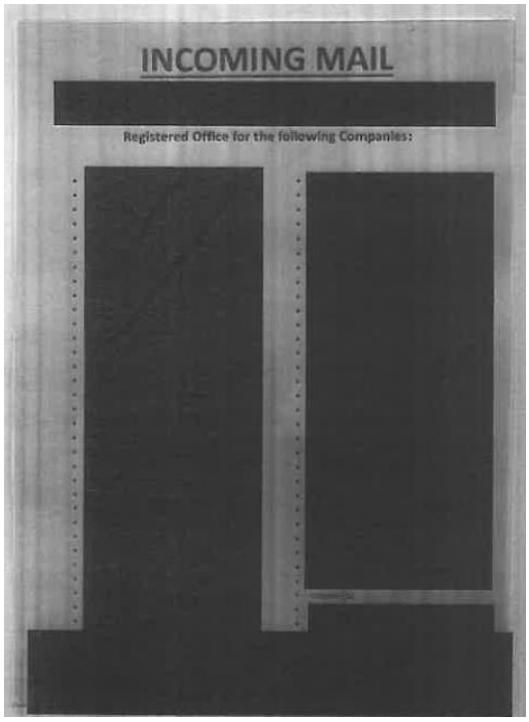
STRICTLY PRIVATE & CONFIDENTIAL

[redacted]

VAT Registration No: 126 9287 87

INVOICE for Umpire® services rendered in connection with:	Fees	Outlays	VAT Rate	VAT amount
Demerger of part of business.				
Fee *(payable by* [redacted]	£1,000		20%	£200
Total: *(due now)*				£1,200

22. As far as the remaining supporting exhibits are concerned, PH1-01 is a print out from the Companies House website showing details of a company called SKEICH LTD (showing its status as 'dissolved'), which has a registered office address c/o Cloch Solicitors, while exhibit PH1-02 shows a different entry from the same website for an active company (as at the date the page was accessed, being 8 June 2023) in the name of UMPIRE LTD, also with its registered office address being c/o Cloch Solicitors. Exhibit PH1-03 is described in paragraph 5 of the witness statement as "public facing notice on registered office door for UMPIRE LTD.". However, as shown below, there is no legible relevant information within either photograph, which I also note is undated:



23. Finally, exhibit PH1-05 shows a certificate of registration for UK trade mark number 3879034 in the name of Umpire Ltd, which has an effective date of registration of 16 February 2023 for the mark "**Signed Security**" in class 35. While Mr Hannay has explained that the mark is for a proposed service of the ongoing UMPIRE brand, I see no relevance of this exhibit in relation to the issues before me.

Assessment on genuine use

24. Whether the use shown is sufficient to constitute genuine use will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the services at issue in the UK during the relevant five-year period. The factors which I must consider include the following:

- The scale and frequency of the use shown
- The nature of the use shown
- The services for which use has been shown
- The nature of those services and the market(s) for them
- The geographical extent of the use shown

25. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself. It is possible for an accumulation of evidence to show use, even if individual items of evidence would on their own be insufficient proof: see *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T- 415/09, paragraph 53. However, where there is no use of the mark in respect of the goods as registered, it follows there has been no genuine use of the mark: *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13.[4]

26. Under question 8 of the form TM8(N), 'Counterstatement by the defendant', the form clearly states that "if a defence is based on "proper reasons for non-use" then this should be clearly set out in the counterstatement". In this box, CSL have stated that "Reference is made to the attached counter-statement". However, I see nothing in the counter statement which mentions any reasons for non-use. Given the brevity of the counterstatement, I will re-produce the main points, as follows:

1. The Applicant has raised revocation proceedings with the object of having the Registration revoked in part.

2. The Proprietor has (without admission) voluntarily surrendered part of the Registration. It is unclear if the revocation action is maintained (post surrender). Clarity is sought in that regard.

3. In any event, the Proprietor denies that the Registration should be revoked in part, or at all.

4. The Proprietor reserves further comment until the Applicant's case is clearly and accurately stated.

Conclusions

5. Application CA000505379 to revoke the Registration – insofar as its object is directed at the remaining terms in class 35 – must be rejected in full.

27. To my mind, although CSL admits that "work on the UMPIRE project temporality paused" [sic],[5] it has not expressly pleaded non-use. Mr Hannay also states that "in 2021 the project was resurrected in a new form with new focus", which to my mind

[4] At [22].
[5] Paragraph 6 of Mr Hannay's witness statement.

suggests that the defence of proper reasons for non-use is not being advanced. Consequently, I must make my decision based on the evidence of actual use, or lack thereof, of the mark in relation to the services which are subject to the application for revocation.

28. As outlined earlier under paragraphs 22 and 23, exhibits PH1-01 to PH1-03 and exhibit PH1-05 do not provide any evidence to show use by CSL, being the registered proprietor, of "UMPIRE", as a trade mark, during the relevant period, or in relation to the disputed services. The only exhibit that has any direct relevance in these proceedings is PH01-4, being the invoice as shown under paragraph 21 of this decision. The invoice, which is headed as CLOCH SOLICITORS, is dated 20 December 2020 and is in relation to services provided under Umpire for "demerger of part of business", which I accept would fall in class 35 under the broad term "business management". The total amount due for this service is shown as £1,200. While Mr Hannay asserts that around £10,000 of invoices included the UMPIRE mark for class 35 services, this figure has not been broken down to show how much was billed for each particular service under the disputed class 35. No overall sales or turnover figures for the services being provided under the mark during the relevant periods have been provided. There is no evidence of marketing spend and nothing to show the frequency or geographical spread of sales in relation to those services.

29. In *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander Q.C. (as he was then) as the Appointed Person stated that:

> "22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. **A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive.** By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, **the evidence must be sufficiently**

> **solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken**, having regard to the interests of the proprietor, the opponent and, it should be said, the public". (**My emphasis**).

30. I also note Mr Alexander's comments in *Guccio Gucci SPA v Gerry Weber International AG*, Case BL O/424/14, where he stated that:

> "56. The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of procedural error. … . The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it - and file the best evidence first time round - or lose it". (Original emphasis)

31. I acknowledge that, as per the principles outlined under paragraph 19 of this decision, use of the mark must be more than token, although that use need not always be quantitatively significant for it to be deemed genuine.[6] I also bear in mind that it is not for me to assess economic success or large-scale commercial use, and that there is no *de minimis* rule - even minimal use may qualify as genuine use if it is use warranted, in the economic sector concerned, to maintain or create market shares for the relevant goods.[7] Conversely, even proven commercial use may not be sufficient for a finding of genuine use.[8]

32. Having considered the evidence as a whole, I find that it falls well short of what is required to demonstrate genuine use of the mark in relation to the services for which use is claimed. Exhibit PH1-04 notwithstanding, which consists of a single invoice for the sum of £1,200, the exhibits clearly do not show use of "UMPIRE" as a trade mark

[6] *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].
[7] *Naazneen Investments Ltd v OHIM*, Case T-250/13 at [49].
[8] At [115(8)].

in the UK during the relevant period for the Class 35 services at issue. I see nothing in the witness statement of Mr Hannay which supports genuine use of the mark. Neither do I have any information as to how much has been invested in promoting the mark in relation to it being used in the UK market, nor any indication as to how or where potential customers were able to access the services under the mark in the UK. There are no other examples provided within the evidence demonstrating use of the mark in relation to any of the disputed services for which the mark is registered. Although I have no indication as to the size of the market in the UK in respect of the class 35 services, I would expect it to be substantial. Even had the estimated sum of £10,000 been broken down in relation to each of the services provided under the "UMPIRE" mark, the amount does not indicate to me real commercial exploitation.

33. As such, the evidence does not allow me to find that CSL has demonstrated genuine use on any of the disputed services in class 35 for which it is registered under the mark for which revocation is sought.

CONCLUSION

34. The application for revocation of UK00003103918 succeeds under section 46(1)(a) and section 46(1)(b). As explained earlier in this decision, although the goods in class 9 and the services in class 36 and some of the class 35 services have been surrendered, because this was made after the application for revocation, subject to any successful appeal, CSL's registration is revoked in relation to all the disputed services in class 35, as well as the disputed, but undefended goods and services in classes 9 and 36, with effect from the earliest date requested, being 28 January 2022.

35. The trade mark stands registered for the remaining, undisputed goods and services in classes 16, 25, 41 and 45.

COSTS

36. In these consolidated proceedings, GUI has been successful in its application for revocation of CSL's mark and is therefore entitled to a contribution towards its costs

based upon the scale published in Tribunal Practice Notice ("TPN") 2/2016, as was relevant at the time the application was filed.

37. Taking all of the above into consideration, and applying the guidance in the TPN, I award GUI the sum of £400, which is calculated as follows:

Official fee (Application for revocation):	£200
Preparing the application for revocation and considering the counterstatement:	£200
Total:	**£400**

38. I therefore order CSL to pay GUI the sum of £400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 3rd day of July 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General