

O/0721/26

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO.
UK00907270275 IN THE NAME OF SAVANT SYSTEMS, INC.
FOR THE TRADE MARK:**

SAVANT

IN CLASS 9

AND

**AN APPLICATION FOR INVALIDITY UNDER NO.
506947 BY SAVANT GROUP LIMITED**

BACKGROUND AND PLEADINGS

1. Savant Systems, Inc. (“the proprietor”) is the proprietor of the UK trade mark shown on the cover page of this decision (“the contested mark”). The contested mark was applied for on 29 September 2008 and granted registration on 21 July 2009. It stands registered for the following goods:

Class 9: Universal computerized controller which controls electronic products and household systems, namely, audio/visual players and recorders, display monitors, televisions, Internet connections, computer networks, lighting systems, security systems and heating, ventilating, air conditioning (HVAC) systems.

2. On 29 January 2024, Savant Group Limited (“the applicant”) applied to have the contested mark declared invalid. The application was brought under section 47 of the Trade Marks Act 1994 (“the Act”) and is reliant upon the grounds governed by sections 5(2)(a), 5(3) and 5(4)(a) of the Act. Under the section 5(2)(a) and 5(3) grounds, the applicant relies on the following mark:

SAVANT

UK registration no. 900032318¹

Filing date 1 April 1996; registration date 25 May 1998

Seniority dates (UK): 12 April 1986 and 1 October 1986

Registered for the following goods and services:

Class 9: Computer software.

Class 41: Educational, instructional, training and teaching services relating to databases, data processing, computers, information apparatus

¹ The applicant’s mark is a comparable mark based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

and instruments; information and advisory services relating to the aforesaid services.

Class 42: Computer software services; computer programming services; analytical and research services including technical analysis relating to communication and communication services and to information services, computers, data processing, databases, communication apparatus and instruments; consultancy, information and advisory services relating to the aforesaid including computer software, data processing and databases.

3. Under the section 5(2)(a) ground, the applicant relies only on its class 9 goods and class 42 services. It argues that the marks at issue are identical and that the goods at issue are identical and/or similar. As such, it is claimed that there exists a likelihood of confusion on the part of the relevant public.
4. Turning to the section 5(3) ground, the applicant claims that it enjoys a reputation in all of the goods and services for which its mark is registered. It is argued that the identity of the marks and the identity/similarity of the goods and services at issue would lead consumers to make a link between them. The applicant's position is that use of the contested mark would take unfair advantage of the applicant's mark or that it would cause a detriment to its distinctive character. It is noted that while a detriment to repute was initially pleaded, it was subsequently withdrawn.
5. Lastly, under the section 5(4)(a) ground, the applicant relies on the sign "SAVANT" ("the applicant's sign") which it claims to have used throughout the UK since 1986 in respect of "computer software" and "computer software services". As a result of its use, the applicant claims that it enjoys a protectable goodwill in its business and that the sign relied upon is distinctive of and/or associated with the applicant's business. As a result, it is claimed that use of the contested mark would cause a misrepresentation amongst the relevant public and that, consequently, this would

cause damage to the applicant by way of lost sales, damage to reputation and loss of exclusivity.

6. The proprietor filed a counterstatement wherein it generally denied the claims against it. That being said, it did accept that the marks at issue were identical. In addition, the proprietor sought to put the applicant to proof of use for the mark relied upon.
7. Both parties filed evidence in chief in these proceedings, with the applicant also filing evidence in reply. A hearing took place before me on 29 July 2026, by video conference. The applicant was represented by Mr Joshua Marshall of 8 New Square, as instructed by Marks & Clerk LLP, who have represented the applicant throughout these proceedings. The proprietor was represented by Mr Thomas Lunt of 3 New Square, as instructed by Meissner Bolte (UK) Limited, who have represented the proprietor throughout these proceedings.
8. 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.

EVIDENCE

9. The applicant's evidence in chief came in the form of the witness statement of Isobel Woodend dated 18 June 2024. Ms Woodend is the Group Accountant of the applicant, a position she has held since 1 April 2021. Ms Woodend's evidence is accompanied by six exhibits, being IW1 to IW6, and was adduced in order to prove genuine use, a reputation and goodwill in the mark/sign relied upon.

10. The proprietor's evidence came in the form of the witness statement of Mr Bruce Myers dated 23 August 2024. Mr Myers is the Executive Vice President and Chief Business Officer of the proprietor. He has been employed by the proprietor since 15 June 2005. His statement is accompanied by 12 exhibits, being BM01 to BM12, and was adduced in order to demonstrate the proprietor's own use of the contested mark.
11. The applicant's evidence in reply came in the form of the witness statement of Matthew Parr dated 22 October 2024. Mr Parr is a Chartered Trade Mark Attorney at the applicant's representative firm. His evidence is accompanied by four exhibits, being MP1 to MP4, and was adduced to introduce three prior decisions of the Tribunal into these proceedings and a confirmation of a withdrawal of another set of proceedings.
12. I do not intend to summarise the parties' evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

PRELIMINARY ISSUE

13. It is noted that there are separate ongoing proceedings between the present parties (and third parties that are connected to them) currently before the Tribunal. These include three cancellations brought by the proprietor against the applicant's marks (one of which being the earlier mark relied upon here) under numbers 508421, 508422 and 508423 and an opposition brought by a company called Savant Limited (being a party connected to the applicant) under number 450554. The issue of consolidation of those proceedings and the present proceedings came before the Tribunal and, on 6 May 2025, the Tribunal issued a preliminary view wherein it proposed to consolidate the three invalidations (being 508421, 508422 and 508423) with one another but to keep the present case and opposition number 450554 separate. This preliminary view was opposed by the proprietor and a Case

Management Conference (“CMC”) was held before me on 29 May 2025. My decision was to maintain the preliminary view, the reasons for which were given in a letter dated 2 June 2025. It is noted that additional issues relating to excess evidence, without prejudice correspondence and a request to strike out came up at the CMC. However, those issues did not pertain to the present proceedings so are of no relevance here.

14. As above, it is noted that the applicant’s mark is presently subject to a cancellation application (under number 508423). This means that if the present decision succeeds in respect of the section 5(2)(a) and/or 5(3) grounds only, it will be provisional pending the outcome of those proceedings. Alternatively, this decision will be final either on the basis of success of the section 5(4)(a) ground or upon the failure of all grounds. I set out at the hearing that in the event that this decision is provisional, I will reserve the position on costs.

DECISION

Invalidity proceedings

15. Sections 5(2)(a), 5(3) and 5(4)(a) of the Act have application in invalidation proceedings by virtue of section 47(2) of the Act, which states as follows:

“47. –

[...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) 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

(b) 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.

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Proof of use

16. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a

valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

17. The use conditions that govern the present proceedings are set out in my reproduction of section 47 of the Act above.

18. Section 100 of the Act is also relevant. It reads:

“100. 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.”

19. As the applicant’s mark is a comparable mark, paragraph 9 of Part 1, Schedule 2A of the Act is also relevant. It reads:

9 - (1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the “five-year period”) has expired before IP completion day—

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 47 to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day—

(a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 47 to the United Kingdom include the European Union.

20. Given its filing date, the applicant’s mark qualifies as an earlier trade mark under the above provisions. The applicant’s mark completed its registration process more than five years prior to the filing date of the contested mark and more than five years prior to the filing of the application at issue. As above, the proprietor requested that the applicant provided proof of use for its mark. Therefore, the applicant is required to prove that it has genuinely used its mark.

21. 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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].”

22. In addition to the above case law, I refer to three additional cases that cover the issue of genuine use. The first is the case of *Awareness Limited v Plymouth City Council*, Case BL O/236/13 (“*Plymouth Life*”), wherein Mr Daniel Alexander Q.C. 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.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

23. Secondly, I refer to *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, wherein Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors.

The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

24. Lastly, I refer to the following comments of Mr Iain Purvis KC, sitting as the Appointed Person, at paragraph 37 in the case of *LACD* (O/0725/25) wherein he set out that:²

“37. [...] To my mind, given the way the evidence was presented, no complaint could have been made if the Hearing Officer had refused to do such a ‘deep dive’ into the evidence at all. Having done so however, she was perfectly

² While only an excerpt of paragraph 37 is reproduced here, I refer generally to the entirety of paragraphs 37 to 39 of Mr Purvis KC’s decision.

entitled to draw only limited conclusions from what she found. This was not, as was suggested, an ‘over-forensic approach’. The burden of proof in use cases is on the proprietor and it is not the role of the tribunal to fill in obvious gaps in the evidence. Here, as I have said, Mr Rimbeck had not even gone to the trouble of explaining in either of his witness statements how if at all the Marks were applied to the goods (for instance by a consistent policy of labelling, supply in branded packaging etc.)”

25. As per section 47(2B) of the Act (reproduced above), there exist two relevant periods for proving genuine use in invalidation applications. In the present case, these are 30 September 2003 to 29 September 2008 (being the five-year period ending with the filing date of the contested mark) (“the first relevant period”) and 30 January 2019 to 29 January 2024 (being the five-year period ending with the filing date of the invalidation application) (“the second relevant period”). The provisions of the Act set out that use must be demonstrated for both relevant periods in order for the applicant to be permitted to rely on its mark for the purposes of the invalidation proceedings.

26. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”³ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

Evidence of use

27. Whilst there are two distinct relevant periods, I consider it appropriate to set out my summary of the entirety of the evidence before looking at whether such use is genuine for each of the relevant periods.

³ *Jumpman* BL O/222/16

28. The evidence sets out that the applicant was established in 1980 and that the 'SAVANT' branding has been used since no later than 1986. It is stated that, since incorporation, the applicant has provided both goods and services to its customer base, which includes national and local government authorities and corporations of various sizes. The goods that the applicant claims to have used its mark for include computer software, computer hardware, computer systems, printed materials and publications. As for its services, the applicant claims to have used its mark on software design and development, IT support, software testing, mobile application development and the provision of training.

29. In respect of its turnover, the applicant has provided its revenue under the SAVANT brand for the years 2017 to 2023. This is as follows:

Year	Turnover (£)
2017	3,592,926
2018	3,585,616
2019	3,852,682
2020	5,196,388
2021	5,261,486
2022	5,773,232
2023	6,024,959
Total	33,287,289

30. It is noted that there is no breakdown as to how the above turnover can be accurately apportioned to the goods and services for which the applicant claims to have used its mark for.

31. In addition to the above, I note that the evidence comprises the following:

- a. **Exhibit IW1** - A range of undated printouts describing various software products offered by the applicant. Whilst undated, some pages include

reference to certification and standardisation in 2013 and 2015, respectively, thereby implying that the printouts came after those dates. Further, the printouts make reference to the applicant being established 'over 35 years ago'. Given that the narrative evidence of Ms Woodend states that the applicant was established in 1980, this would imply the printouts as being from 2015 at the earliest.

- b. **Exhibit IW2** - Invoices from 4 September 2017 to 1 December 2023. The invoices cover sales to different UK undertakings and demonstrate sales of software (seemingly as a service), the provision of software licences and other services including updating and maintenance of software. It is noted that some invoices cover the sale of physical goods such as printers and cables, which are not at issue here.
- c. **Exhibit IW3** - Various reports regarding partnerships that the applicant has participated in. These include an NHS report regarding technology driving blood supply with a handwritten note stating that it is from June 2021, a business continuity software report from 2016 and a case study regarding 'blood tech modernisation' which refers to a mission 'having kicked off at the beginning of 2021', thereby indicating that it is from after that date.
- d. **Exhibit IW4** – This evidence begins with a list of activities (along with their corresponding dates) of the various marketing efforts undertaken by the applicant. The activities are dated between 15 July 2019 and 13 September 2022. Accompanying the list are a number of pages that correlate to the activities described on the list. For example, there is an entry on the list regarding a 'Scotland Maternity & Midwifery' conference in November 2019. In the accompanying documents, a tweet is shown dated 18 November 2019 regarding the applicant's preparation for said conference. Further, this exhibit includes a range of invoices for various marketing activities undertaken during this time.

- e. **Exhibit IW5** - Press releases posted on the applicant's website between 28 February 2018 and 27 April 2020. The content of the releases relate to the applicant winning a tender in February 2018, a partnership with Lancaster University in May 2018, the applicant's acceptance onto the UK Government Digital Marketplace G-Cloud 10 and Digital Services 3 framework in October 2018, attendance at a British Blood Transfusion Society event in October 2018 and work relating to the COVID-19 pandemic in April 2020. Each page includes a copyright date of '1998 to 2021'.
- f. **Exhibit IW6** - A range of printouts from the applicant's website at various dated between 25 July 2017 and 12 November 2023. These are obtained from the internet archive facility, the Wayback Machine. The copyright dates for these printouts are shown as '2017' for the 2017 printout and '1998 to 2018' up until '1998 to 2021' for the years 2018 to 2021. It is noted that the lattermost copyright date (being '1998 to 2021') is also shown on the printouts from 2022 and 2023.

32. As above, there are two relevant periods for me to consider and I repeat the point that it is a requirement of the legislation cited above that use must be demonstrated in both for the section 5(2)(a) and 5(3) grounds of this decision to proceed. The relevant periods at issue do not overlap and, as such, I consider it necessary to assess them individually, beginning with the first relevant period.

33. By its own admission at the hearing, the applicant's evidence in respect of the first relevant period is relatively thin. Having considered the evidence myself, I am of the view that categorising the evidence as 'relatively thin' is generous. In short, there has been no attempt to actually show any use during the first relevant period. Instead, the applicant has simply requested that use be found for the first relevant period based on a series of inferences stemming from its later use.

34. As set out above, there is no evidence of turnover from prior to 2017. It is noted that the figures for 2017 are in excess of £3 million and I consider it reasonable to infer that turnover of multiples of millions of pounds would not have risen to that level over the course of one year. Therefore, I accept that it is likely that the turnover in the years prior to 2017 would have steadily risen to that level over a period of time. That being said, the first relevant period expired in 2008. This is nine years prior to the start of the period for which turnover is provided. It is my view that such a gap is significant and, without anything from that time to assist me further, it is not reasonable to infer that use from 2003 to 2008 would have been at an equivalent level, or at any level that could reasonably be said to be genuine for that matter. Indeed, it would not be a reasonable inference to draw that there has been any use at all during that period, simply based upon use shown from 2017 onwards. On this point, if the applicant wished to rely on use for the years 2003 to 2008, it was for the applicant to provide cogent evidence of such.

35. Whilst on the topic of the applicant's turnover, it is noted that, as above, there is no breakdown provided. This presents a further problem for the applicant because, firstly, the invoices provided at Exhibit IW2 include goods that are not covered by the specification relied upon (being a range of physical class 9 goods such as printers and cables, for example). Secondly, the narrative evidence of Ms Woodend even discusses class 41 services (such as training) that are also not at issue under the section 5(2)(a) ground.⁴ Such an issue means that there is no way for me to accurately determine how the 2017 to 2023 turnover can be apportioned to the relevant goods and services. This makes it even more difficult for the above inference that there is use between 2003 to 2008 to be drawn. This is because even if it could be said that a respectable turnover existed during 2003 to 2008 based on the 2017 to 2023 turnover, there is no way for me to determine how much use there was for software or computer services, as opposed to the other types of goods or service covered by the evidence.

⁴ While this service is relevant to the section 5(3) ground, I do not consider that the vague claim as to use assists the issue of use, let alone a reputation.

36. In addition, there is no marketing evidence from the first relevant period. Again, I do not consider it reasonable for me to simply infer that because there were activities from 2019 onwards (being the marketing evidence covered in Exhibit IW4) that there must also have been some activity between 2003 and 2008.

37. I turn now to the various printouts explaining the nature of the applicant's software (at Exhibit IW1) its partnerships (at Exhibit IW3), press releases (at Exhibit IW5) and website pages (at Exhibit IW6). At the hearing, Mr Marshall asked me to make an inference that because the printouts demonstrate the provision of software goods (and other software related services) from 2015 onwards, that said goods were available during the relevant period. Such an inference is, in my view, entirely unreasonable. While I accept that the goods and services covered by these documents will have been offered and sold from 2015 onwards, I do not consider that they assist in my determination of the use shown in the first relevant period. Firstly, the burden for proving use falls solely on the applicant and to suggest that goods being available from 2015 onwards means that they must have also been available between 2003 and 2008 is simply unsupportable. Secondly, it is my understanding that the relevant market for software goods and services is fast paced and involves goods and services that evolve rapidly. As such, I consider it reasonable to find that the position with regard to what software was available between 2003 and 2008 is likely to have been very different compared to the position from 2015 onwards. This provides a further reason as to why I do not consider the proposed inference to be a reasonable one.

38. At the hearing, much was made of the copyright date for the various printouts provided by the applicant. While it is noted that the majority of the printouts show copyright dates stemming from 1998, I fail to see how this is of any assistance to the applicant. I accept that the website may have been created and copyrighted at that time but there is nothing to suggest what the website looked like, or offered, during the first relevant period. In short, it is simply not possible to infer that the

presence of an earlier copyright date suitably demonstrates that goods covered by printouts from 2015 onwards were sold at sufficient volume between 2003 and 2008.

39. Lastly, it is noted that the applicant's narrative evidence sets out that it has used the SAVANT mark in relation to a range of different goods and services. For ease of reference, the statement of Ms Woodend sets out that:

"2. [...] Since incorporation, the [applicant] has provided products and services including software development, IT support, software testing and mobile application development under the trade mark SAVANT. The word mark SAVANT has been used by [the applicant] since no later than 1986, comprising 38 years of continuous use.

[...]

4. The Company has used the trade mark SAVANT throughout the UK in relation to computer software, computer hardware and computer systems, printed materials and publications, the design and development of computer software, and the provision of training."

40. In short, I consider that the above statements are bare assertions. It has long been established that a 'bare assertion' that a mark has been used is not sufficient for genuine use.⁵ On this point, I note that to avoid being a 'bare assertion' a statement must be, according to Richard Arnold QC, sitting as the Appointed Person, in *Pan Worlds Brands Ltd v Tripp Ltd*⁶ at paragraph 31:

⁵ *Moo Juice TM* [2005] EWHC 2584 (Ch), [2006] RPC 18

⁶ [2008] RPC 2

“A statement by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark has been used...”

41. The above comments of Ms Woodend clearly do not satisfy these requirements as she has failed to set out where, in what manner and in relation to precisely what goods and services the applicant's mark was used during the first relevant period. As such, I am not minded to give such a statement any real weight, especially in light of a complete lack of supporting evidence from 2003 to 2008. Even if this statement were not bare assertion, it provides me no insight as to the scale of use to enable me to assess whether it meets the requirements of 'genuine' use.

42. Taking all of the evidence into account and bearing in mind not only section 100 of the Act but the comments set out in the cases of *Plymouth Life*, *Dosenbach* and *LACD* (reproduced above), I can see no basis for inferring that there was genuine use of the applicant's mark during the first relevant period. As a result, I find that the applicant has failed to provide genuine use for the first relevant period. The consequence of this is that regardless of whether there is genuine use in the second relevant period, the applicant is unable to rely on its mark for the purposes of its section 5(2)(a) and 5(3) grounds of invalidation. Said grounds, therefore, fail.

Section 5(4)(a)

43. Section 5(4)(a) of the Act states as follows:

“5(4) 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,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

44. Subsection (4A) of section 5 of the Act states:

“(4A) 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.”

45. I am of the view that I can deal with the present ground relatively briefly. I say this because the *prima facie* relevant date for my assessment of section 5(4)(a) is the date on which the proprietor filed the contested mark, being 29 September 2008. For the same reasons set out above, the applicant’s evidence falls far short of demonstrating any use prior to the relevant date for the present ground and certainly does not establish use that would amount to a protectable goodwill by that date.⁷ As a result, I find that the present ground fails in its entirety.

CONCLUSION

46. The application fails and, subject to any successful appeal against my decision, the contested mark may remain registered for all of its goods and services.

⁷ It is noted that the proprietor’s evidence alleges that it used ‘SAVANT’ from 2005 onwards. I accept that this could be deemed an earlier relevant date for section 5(4)(a) in the event that such use constitutes an earlier date when the behaviour complained about began. However, given the complete lack of any evidence from prior to 2015, I do not consider it necessary to give this any further consideration as the existence of any earlier relevant date has no bearing on the present ground given the lack of goodwill at the *prima facie* relevant date.

COSTS

47. As the present decision is not provisional, I do not need to reserve the position on costs. That being said, it is noted that, at the hearing, the proprietor proposed that the costs in this matter be reserved until the other proceedings between these parties (being those discussed at paragraph 13 above) are concluded. While this request is noted, these are standalone proceedings that have reached finality. As such, I see no reason why the costs should be reserved. I will, therefore, make a costs award in the ordinary way.

48. The proprietor has succeeded and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In considering the issue of costs, I appreciate that the proprietor's evidence was not discussed in any detail in my decision. However, this is not a criticism of the evidence filed but was solely due to the fact that each ground of the application failed at the first hurdle. In addition, the proprietor was still required to consider the evidence in chief and in reply of the applicant. Therefore, I consider it necessary to award the proprietor its costs for this task.

49. As set out at paragraph 13 above, there was a CMC in this matter. I remind myself that my post-CMC letter dated 2 June 2025 reserved the position of costs for the CMC until the conclusion of the proceedings. As the CMC was requested by the proprietor and given that my decision was to uphold the preliminary view of the Tribunal, I am of the view that the proprietor is liable for the costs of the same. I have explained above that additional issues beyond the consolidation point were raised at the CMC but those related to the separate proceedings referred to above, so are not issues that I need to concern myself with here. Given the overall position that the proprietor is entitled to its costs for successfully defending the application, I will factor the costs of the CMC by reducing my below award accordingly.

50. In the circumstances, I award the proprietor the sum of £1,450 as a contribution towards its costs. The sum is calculated as follows:

Considering an application for invalidity and preparing the counterstatement:	£250
Reviewing evidence of applicant and filing its own evidence:	£800
Preparing for and attending a hearing:	£800
<i>(Reduction of costs associated with the CMC:</i>	<i>-£400)</i>
Total:	£1,450

51. I hereby order Savant Group Limited to pay Savant Systems, Inc. the sum of £1,450. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 11th day of August 2026

A COOPER

For the Registrar