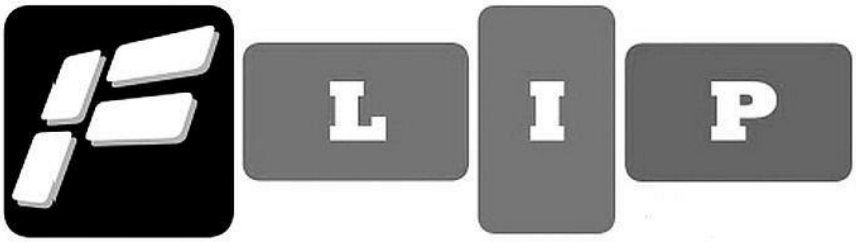
O/1069/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK REGISTRATION
NO. 801288378
BY
MICROSOFT CORPORATION
IN RESPECT OF THE FOLLOWING TRADE MARK:



IN CLASS 9

AND

AN APPLICATION FOR REVOCATION
UNDER NO. 506197
BY
FLIP GMBH

BACKGROUND & PLEADINGS

1. The (figurative) trade mark[1] ("**contested mark**") shown on the front page of this decision stands registered in the name of Microsoft Corporation ("**the registered proprietor**"), having been assigned on 2 August 2022 from the owner, JooJoo Enterprises Limited.[2] Prior to this assignment, the mark was owned by Mr Kim Charles Halliday, the original applicant of the registration, who assigned the registration to JooJoo Enterprises Limited on 27 September 2021. The registered proprietor claims priority from the Australian Trade Mark registration no. 1687755 (with a priority date of 16 April 2015), which has a designation date of 30 September 2015 and for which protection in the EU was granted on 20 December 2016. I note that on 19 June 2024 the applicant filed a Form TM23 to partially surrender some goods of its registration, which was published on 16 July 2024 and now stands as follows:

> **Class 9:** Educational computer software downloaded from the Internet; computer apparatus for educational use; training guides in electronic format; training guides in the form of a computer program; educational computer software including application software (Apps); computer software relating to flash cards; including all of the foregoing relating to portable computers.

2. On 16 June 2023, Flip GmbH ("**the applicant**") sought revocation of the contested mark on the grounds of non-use under sections 46(1)(a) and (b)

[1] On 31 January 2020, the UK left the EU. Under Article 56 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable trade marks (IR) for all right holders with an existing International Registration designating the EU ("IR(EU)"). As a result, the contested mark was originally protected in the UK as an IR(EU) and is now automatically converted into a comparable trade mark (IR). Comparable trade marks (IR), created under Schedule 2B of the 1994 Act, are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

[2] This change of ownership is recorded on the IPO database on 11 August 2022, with an effective date of 2 August 2022.

of the Trade Marks Act 1994 ("**the Act**").[3] Under section 46(1)(a), the applicant claims non-use in the five-year period following the date on which the mark was registered, i.e. 21 December 2016 to 20 December 2021 ("the first relevant period"). The applicant requests an effective date of revocation of **21 December 2021**. Under section 46(1)(b) the applicant claims non-use in respect of the registered mark for the following periods:

a. 21 December 2016 to 20 December 2021 ("the first relevant period"), claiming an effective date of revocation of **21 December 2021**;

b. 16 March 2017 to 15 March 2022 ("the second relevant period"), claiming an effective date of revocation of **16 March 2022**;

c. 16 June 2018 to 15 June 2023 ("the third relevant period"), claiming an effective date of revocation of **16 June 2023**.

3. The registered proprietor filed a counterstatement defending its registration for all the goods for which the contested mark is registered, on the basis that it has been genuinely used during the relevant periods.

4. Only the registered proprietor filed evidence. This will be summarised to the extent that it is considered necessary. The applicant filed written submissions, which will not be summarised but will be referred to as and where appropriate during this decision.

5. The registered proprietor asked to be heard on the matter, and a hearing took place before me, by video conference, on 16 September 2024. Both parties filed skeleton arguments prior to the hearing. Ms Kara Tompsett of CMS Cameron McKenna Nabarro Olswang LLP, attended on behalf of the

[3] 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.

registered proprietor, and Ms Lara Brandani of Palmer Biggs IP, attended on behalf of the cancellation applicant.

EVIDENCE

Registered Proprietor's Evidence

6. The registered proprietor's evidence consists of a witness statement, dated 6 October 2023, in the name of Camillo Gatta together with Exhibits marked CG1-CG24. Mr Gatta is the Assistant General Counsel and Head of Trade Marks of the registered proprietor in these proceedings. Whilst I have read the evidence in full, I do not propose to reproduce or summarise it here but will refer to the salient points below, to the extent that it is considered appropriate.

LEGISLATION

7. Section 46 of the Act states:

> "(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."

8. Section 100 of the Act states:

"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."

9. As the contested mark is a comparable mark (IR), pursuant to paragraph 8 of Part 1, Schedule 2B of the Act, the registered proprietor may rely upon use of the mark in the EU for any parts of the relevant periods which fall prior to IP Completion Day, being 31 December 2020.

Relevant Case Law

10. 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]."

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

Form of the mark

12. Before considering whether the registered proprietor has made genuine use of the mark and, if so, for what goods, I shall deal with the question of the form of the registered mark.

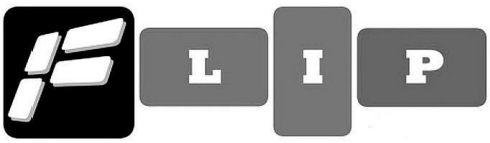
13. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under section 46(2). He said:

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).
>
> 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
>
> 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.
>
> 16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose

figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still."

14. For convenience, I reproduce the registered mark below:



The registered figurative mark consists of the word element "FLIP" in block capitals with a highly stylised and more prominent 'F' letter compared to the rest of the letters, which appear in a standard typeface. The first letter is enclosed in a square black box, and the rest are placed within various horizontal or vertical boxes in grey. I bear in mind that words are generally more distinctive than figurative elements, as the average consumer more easily refers to marks by the word than by describing figurative elements.[4] However, I note that the word element "FLIP" is a commonplace and dictionary word meaning 'to turn upside down'. I consider that the word element is not highly distinctive. Further, the presentation of the mark, namely the stylisation of the 'F' letter together with the boxes of different

[4] See *Wassen International Ltd v OHIM* (SELENIUM-ACE), Case T-312/03, paragraph 37.

sizes, is a striking part of the registered mark and contributes significantly to its distinctive character. Consequently, the word element and the figurative elements of the mark in combination give the mark its distinctive character.

15. There are no examples of use of the mark in its registered form. Nonetheless, the mark has been used in a variety of forms. The forms in the following table are shown in the evidence:

i.	
ii.	
iii.	FLIP
iv.	FLIP FLASH CARDS
v.	FLIPFEST
vi.	Flipgrid/FLIPGRID
vii.	Microsoft Flip/ MicrosoftFlip
viii.	

16. The parties disagree about whether the above forms, as used by the registered proprietor, are acceptable variants.

17. Ms Brandani submitted (in summary) that the evidence does not show use of the trade mark as registered, and the above are not variants forms falling under the exception in section 46(2).

18. Ms Tompsett, on the other hand, submitted that the use of the word alone does amount to genuine use of the registration. In addition, she highlighted that adding or subtracting figurative elements does not alter the distinctive

character of the mark in the eyes of consumers, as they are not indicative of the commercial origin of the goods at issue.

19. First, I will consider both the logo  and "FLIP FLASH CARDS" in plain word format shown in 'i' and 'iv', respectively. Ms Tompsett submitted that the additional word elements "FLASH CARDS" are wholly descriptive in the context of educational software, particularly in the form of electronic flash cards. In addition, she drew my attention to the UK IPO's 'Guidance on Revocation (non-use) Proceedings' where it is mentioned that "*using a mark registered in black and white in particular colour(s) makes no difference*."[5] Ms Tompsett, thus, stated that the use of the colourful figurative elements together with the additional words "FLASH CARDS" should be considered an acceptable variation of the registration.

20. Exhibits CG4 and CG5 show use of the above variant on *flipflashcards.com* within the relevant period on packs of (digital) cards. In this regard, I note that the additional word elements "FLASH CARDS", positioned underneath the letter 'P' in significantly smaller font, will be perceived as descriptive of the goods and will not affect the distinctiveness of the mark. Further, the difference in colour between the mark as registered and the figurative variant has minimal impact on its distinctiveness. This is because it will be recognised for what it is, namely a different colour, which does not send any other message about trade origin. In my view, the figurative variant shows use of a different colour scheme with non-distinctive matter added. Thus, I consider this to be an acceptable variant use in accordance with the guidance in *Lactalis.*

21. The use of "FLIP FLASH CARDS" in plain word format differs from the registered mark due to the absence of the figurative elements and the presence of the additional word elements "FLASH CARDS". Although the

[5] See https://www.gov.uk/government/publications/trade-marks-revocation/revocation-non-use-proceedings.

use of the additional descriptive word elements “FLASH CARDS”, as explained in the preceding paragraph, does not alter the distinctiveness of the mark, it is my view that the absence of the figurative elements will materially detract from its distinctiveness. The figurative elements of the registered mark, particularly the highly stylised letter “F”, are sufficiently prominent that their omission changes the distinctive character of the mark. As such, I find that the use of “FLIP FLASH CARDS” in plain word form is not an acceptable variant use of the mark as registered.

22. Similarly, the use of the word element “FLIP” in plain word form of the registered mark, as shown in ‘iii’ above, does alter the distinctiveness of the registered mark. Again, in this instance, the figurative elements of the mark are absent. I consider that this is not a minor difference, and such use alters the distinctive character of the mark. Therefore, the presentation of the mark in plain word form cannot be considered an acceptable variant.

23. As displayed above, the forms in ‘v-vi’ show use of the plain word “FLIP-” conjoined with the additional word elements “-FEST” and “-GRID”. I also note that the figurative elements are absent in these forms. In the skeleton argument, Ms Tompsett submits that the addition of the element “-GRID” is wholly descriptive and will be understood as meaning “network”,[6] which does not alter the distinctive character of the mark in the form in which it was registered. However, in the absence of evidence, I am not prepared to accept that the term “GRID” will be understood as having descriptive qualities. In my view, the word “FLIP” functions as a qualifier to the subsequent words, thereby establishing a conceptual relationship between the word components rather than functioning as a standalone term or prefix to a descriptive word. When viewed as a whole, each of these forms evokes a different conceptual message as opposed to “FLIP” solus, as previously defined in this decision. Specifically, the conjoined term “FLIPGRID” is likely to be perceived as denoting a grid that can be flipped, whereas “FLIPFEST” may evoke the notion of a party or lots of flips.

[6] See paragraph 46 of the skeleton argument.

Moreover, when considering the forms FLIPFEST and FLIPGRID, part of the distinctiveness emanates from joining the two words to form a new one. In addition, as I have already held, the distinctiveness of the registered mark derives not only from the word “FLIP” but from its stylisation, which is wholly absent in the “FLIPGRID” and “FLIPFEST” variants. This alone changes the distinctive character of the mark for the reasons given above. Consequently, I find that FLIPFEST and FLIPGRID are not acceptable variants of the registered mark as per *Lactalis*.

24. There is also use in the form shown in ‘vii’ (Microsoft Flip). Again, in this instance, while the word element “FLIP” is present, the figurative elements are absent, and there is the additional word element “Microsoft” at the beginning of the variant form. The absence of the figurative elements clearly alters the distinctive character of the mark as registered. Such use does not qualify as an acceptable variant use. For completeness, I note that the form consisting of the conjoined elements “MicrosoftFlip” is not acceptable for the same reasons.

25. There are multiple differences between the registered mark and the form shown in ‘viii’ above, 

. The latter consists of the word element ‘Flip’ presented in title case, bold font, and a standard typeface, with the addition of a chat device at the beginning of the mark. I also note that the distinctiveness of this form lies in the combination of the word element and the chat device. Although the verbal element FLIP is present, the absence of the distinctive figurative elements present in the registered mark will significantly detract from the distinctiveness of the mark. Therefore, I consider that this form does alter the distinctiveness of the registered mark and is not an acceptable variant.

26. Considering the example in ‘ii’ above,  , the initial and stylised letter ‘F’ is isolated without the rest of the letters of the verbal element “FLIP” and the figurative elements, and as a result this use alters the distinctive

character of the mark. Therefore, I find that this is also an unacceptable variant of the mark.

Sufficiency of use

Preliminary Points

27. At the hearing, there was a debate about whether the registered proprietor can rely on the FLIPGRID sign to demonstrate use of the mark before the rebranding of the registered mark. I note that the registered proprietor cannot rely on its use of the FLIPGRID sign prior to the acquisition of the registered mark, as this is an entirely different sign from the registered mark, and there is no suggestion that the registered proprietor's use was with the consent of the original owner.[7] However, the registered proprietor may rely on such use only after the acquisition of the registered mark, provided it qualifies as an acceptable variant. Nonetheless, I previously concluded in this decision that FLIPGRID is not an acceptable variant, rendering any use associated with it irrelevant.

28. There was also a discussion at the hearing about whether the registered proprietor claims use for the term "*computer apparatus for educational use*" and the quasi-limitation "*including all of the foregoing relating to portable computers*". It became clear at the hearing that "*computer apparatus for educational use*" should have been surrendered in the TM23. Also, Ms Tompsett further explained that the latter "*including all of the foregoing relating to portable computers*" was not surrendered on the grounds that it would not make any difference, and the term suggests a subset of goods. However, Ms Tompsett noted that the registered proprietor would not feel strongly regarding the retention or deletion of that term. Based on the above submissions, the registered proprietor accepted that there has been no use for "*computer apparatus for educational use*", and I will not, therefore, consider this term any further in my assessment.

[7] See for example *ABP Technology Ltd v Voyetra Turtle Beach, Inc. & Anor* [2021] EWHC 3096 (Ch).

As to the quasi-limitation "*including all of the foregoing relating to portable computers*", I consider this to be a subset of the preceding goods and, if necessary, will return to this matter when I make an assessment on a fair specification.

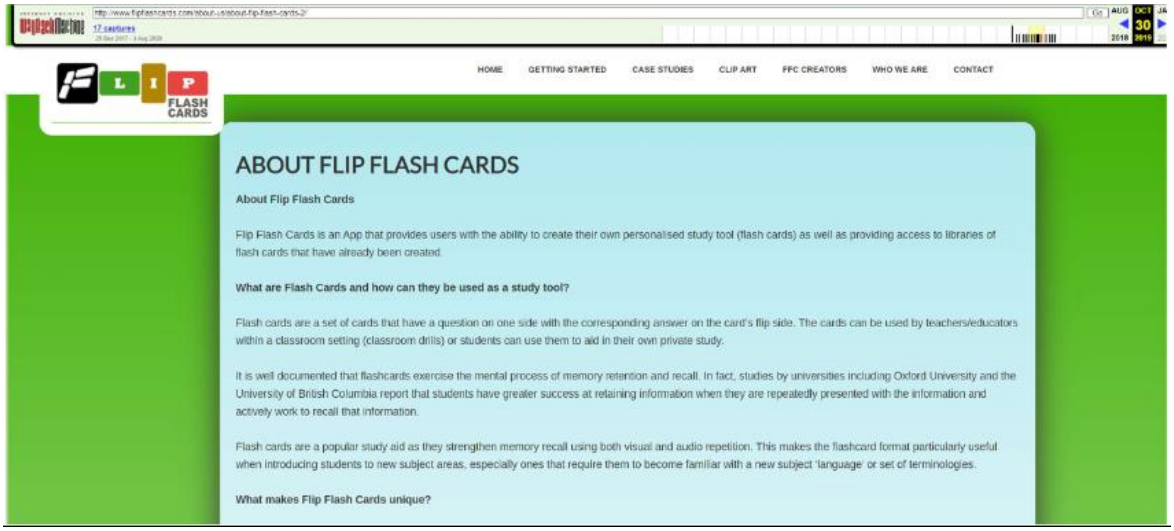
The evidence

29. It is very clear from the evidence filed that the relevant use of the mark and its acceptable variant relates only to the first relevant period.

30. In his witness statement, Mr Gatta provides the history and background of the "FLIP" mark, stating that:

> "*4.1 Mr Kim Charles Halliday, established Flip Flash Cards Pty Ltd in Australia in 2008 after researching the international educational market and observing a lack of adequate study learning aids. In 2010, Flip Flash Cards Pty Ltd developed an app offering learning aids for SCUBA diving.*
>
> *4.2 Between 2012 and 2016 Flip Flash Cards Pty Ltd broadened the scope of the app to allow individual users of Apple iPhone, iPod Touch, iPad and Android mobile phones and tablets to create their own packs of flash cards. The application, Flip Flash Cards, allowed individuals, teachers, trainers and business owners to become the creators of their own flash cards, through a simple touch screen process. The Flip Flash Cards app was created with the intention to make the learning experience fun, challenging and rewarding*."

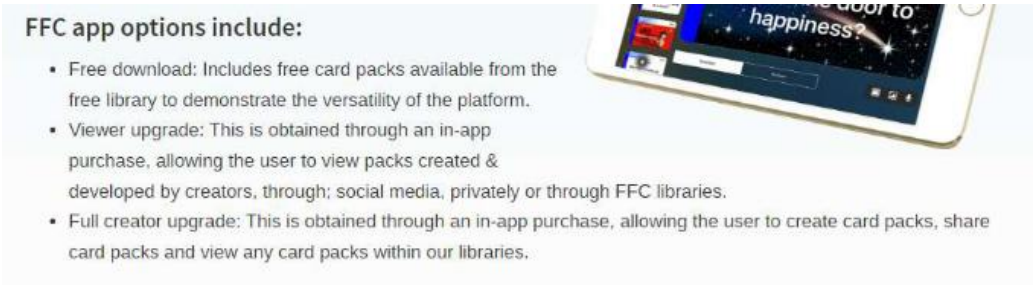
31. **Exhibit CG4** contains screenshots from the *flipflashcards.com* website taken from the WayBack Machine Internet archive dated between 18 June 2018 and 16 August 2021, displaying various sections, including 'About us', 'Tutorial Packs', 'Create with Flip Flash Cards!', and 'Free Packs', of the website in relation to the Flip Flash Cards app.

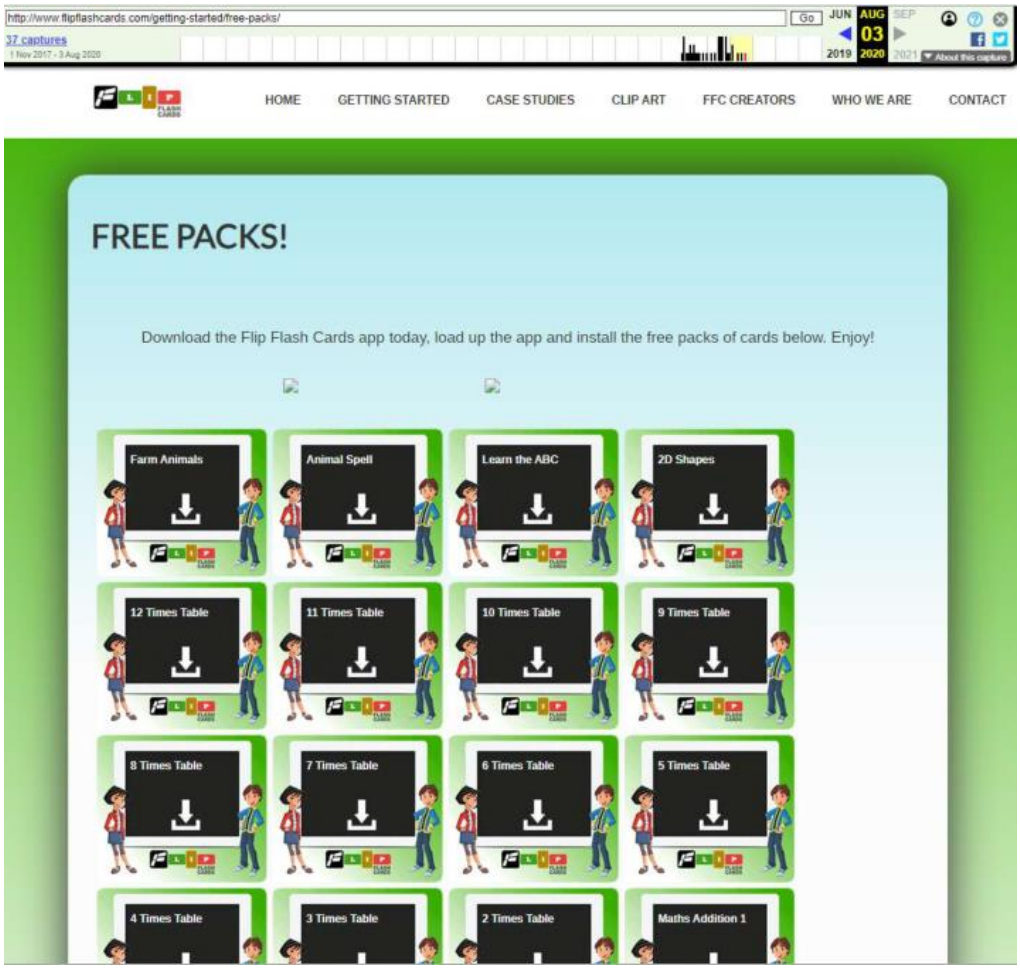


I note from the above screenshot that the app is described as follows:

> "*Flip Flash Cards is an App that provides users with the ability to create their own personalised study tool (flash cards) as well as providing access to libraries of flash cards that have already been created.*
>
> *[…]*
>
> *The Flip Flash Cards App is a powerful m-learning aid as it allows users the ability to access their digital flash cards anywhere and anytime using their mobile devices*."

Further, based on this Exhibit, the Flip Flash Cards App offered the following three packs:





32. Apart from the free card packs shown above (**Exhibit CG5**), users could also obtain other packs through in-app purchases. At the hearing, I asked Ms Tompsett if the registered proprietor had any turnover figures as to the sales from the in-app purchases to which Ms Tompsett responded that it was difficult to gather any such data regarding purchases during Mr Halliday's use. The applicant highlighted in its written submissions the uncertainty regarding whether the website was targeted at or viewed by the relevant UK or EU public, which I agree constitutes a significant gap in the evidence.

33. **Exhibit CG6** includes printouts dated 10 June 2023 of a report generated by *appstor.io,* providing data and statistics about Mr Halliday's Flip Flash Cards app on Apple's App Store. The report demonstrates screenshots bearing an acceptable variant and states that the app was initially released

on 3 February 2016 and last updated in 2020[8]. It also notes that the app was available for free in various countries, including the UK. The report mentions that monthly application downloads exceeded 6,000, and the estimated app cost (as described in the Exhibit) exceeded 2,000 USD. However, these figures are not broken down by year or territory, and there is nothing indicating what proportion, if any, originates from the UK (or the EU for the relevant period). Additionally, the report contains no total figures or any context regarding how long the stated download rate was maintained. Therefore, this Exhibit is of limited evidential value.

34. Lastly, I also note that, at the hearing, Ms Tompsett explained the challenges the registered proprietor faced in collecting historical data as to the geographic location of the end users. She pointed out that the nature of the registered goods (software and mobile apps), made it challenging since they "*naturally evade traditional territorial limitations*". She also mentioned the registered proprietor's unsuccessful attempts to obtain such data from Mr Halliday, who referred them to Mr France, the software developer of the Flip Flash Cards app. Unfortunately, Mr France passed away before the registered proprietor could establish contact,[9] leaving no alternative means to obtain such data.

Assessment and conclusions

35. I have previously set out the legislative provisions under section 6A of the Act relating to proof of use, and the evidential burden on the registered proprietor under section 100. In determining whether there is real commercial exploitation of the mark, the assessment must take into account a number of factors.[10] A finding of genuine use does not depend on economic success or large-scale commercial use;[11] rather, it is

[8] Calculated based on the printout date of the Exhibit.

[9] This reference is made in accordance with the Registry's letter dated 18 November 2023, which also confirmed that Exhibit CG7 remains confidential.

[10] See *easyGroup Ltd v Nuclei Ltd & Ors* above.

[11] *MFE Marienfelde GmbH v OHIM*, Case T-334/01.

concerned with the sort of use that is regarded as "warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark".

36. Throughout these proceedings, including the written procedure, the applicant's critique of the proprietor's evidence is extensive, making a series of points about the inadequacies and deficiencies of the evidence filed. It is worth noting that even though the registered proprietor had the opportunity to file evidence in reply, it elected not to.

37. While the onus is on the registered proprietor to have filed evidence of genuine use of its mark, I must consider what the evidential picture as a whole shows me, not whether each piece of evidence shows use by itself.[12] Although there is no requirement for the registered proprietor to produce any specific form of evidence, in *Awareness Limited v Plymouth City Council*, Case BL O/236/13, 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

[12] *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

He continued:

"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."

38. My account of the evidence in this decision made clear that I found there to be significant gaps in the evidence. The question is whether I consider the evidence taken as a whole convinces me that there has been genuine use of the registration in the UK (or the EU) for the relevant period.

39. Exhibits CG4 and CG5 show use of the mark in an acceptable variant on the website *flipflashcard.com.* I note the *.com* domain, which does not demonstrate the goods are targeted towards the UK (or the EU) market. In my view, having in mind the case-law criteria,[13] the mere fact that the website or the app was accessible to UK/EU consumers is insufficient on its own to establish that the use was directed at customers in the UK or EU, and it is incumbent on the registered proprietor to provide solid evidence to support actual use of its trade mark in the UK/EU by way of its website/app. While I recognise the practical obstacles in gathering such data, as Ms Tompsett pointed out during the hearing, no information has been provided to show whether the website was specifically targeted at

[13] See *Lifestyle Equities CV and another (Respondents) v Amazon UK Services Ltd and others* [2024] UKSC 8, at [24] to [31], and *Warner Music UK Ltd v TuneIn Inc.* [2019] EWHC 2923 (Ch), at paragraph 17.

consumers in the UK/EU, nor does it present any in-app purchases generated directly from users to the webpage/app. I note that where the evidence of sales is not particularly compelling – such as in this instance, where only monthly download figures for an unspecified period and an "app cost" of over 2,000 USD are provided – it is all the more important that other types of evidence are adduced to support the claim to use. Consequently, I find that the evidence of use in the first relevant period is insufficient to establish genuine use.

40. Although there is no sufficient evidence of use of the mark during the first relevant period, section 46(3) provides that a trade mark shall not be revoked under sections 46(1)(a) or (b) where use of the mark is "*commenced or resumed after the expiry of the five year period and before the application for revocation is made* […]". Therefore, it suffices if the registered proprietor has shown genuine use of the mark during the third relevant period of alleged non-use. However, the evidence filed in relation to the third relevant period shows only use under variants that I have found to be unacceptable, thereby failing to demonstrate any relevant use.

41. I have considered the evidence as a whole. While it is possible for an accumulation of evidence to show use, even if individual items of evidence would on their own be insufficient proof, in my view, the above examples of use provided with the witness statement fall short of representing efforts to create and maintain a share of the UK (or the EU) market for the goods relied upon.

OUTCOME

42. The application for revocation on the grounds of non-use therefore succeeds. Consequently, the trade mark is revoked for all the goods in Class 9. The effective date of revocation is **21 December 2021**.

COSTS

43. As the applicant for revocation has been successful, it is entitled to a contribution towards its costs. At the hearing, Ms Brandani requested costs at the highest end of the scale without putting forward any reasons to justify such a request. I will, therefore, award costs as I consider appropriate, while taking all matters into account. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. The sum is calculated as follows:

Official fee	**£200**
Preparing a statement and considering the other side's statement	**£400**
Considering and commenting on the other side's evidence	**£650**
Preparing for and attending the hearing	**£950**
Total	**£2,200**

44. I therefore order Microsoft Corporation to pay to Flip GmbH the sum of £2,200. 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 12th day of November 2024

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General