

O/1115/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NUMBERS 3939400 AND 3939378
BY BK SOLUTION LIMITED
TO REGISTER THE TRADE MARKS:



IN CLASS 41

AND



IN CLASS 9

AND

THE CONSOLIDATED OPPOSITIONS THERETO UNDER NOS.

OP000445282 and OP000445283

BY GENTING CASINOS UK LIMITED

BACKGROUND AND PLEADINGS

1. On 28 July 2023, BK SOLUTION LIMITED (“the Applicant”) applied to register in the UK the trade marks shown on the cover page of this decision (“the contested marks”). The applications were accepted and published for opposition purposes on 13 October 2023 and registration is sought for the following goods and services:

UKTM:3939400 (*the “400” mark*)

Class 41: Casino, gaming and gambling services; on-line gaming services; provision of online computer games; providing information on-line relating to computer games and computer enhancements for games; organisation of games and competitions.

UKTM:3939378 (*the “378” mark*)

Class 9: Downloadable computer game programs; computer game programmes; game software; gaming software.

2. On 15 January 2024, Genting Casinos UK Limited (“the Opponent”) opposed the applications in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The Opponent relies upon the following UK trade mark:

UKTM: 2050152

MAXIM'S CASINO CLUB

Filing date: 4 January 1996

Registration date: 21 February 1997

3. For the purpose of these proceedings, the Opponent is reliant upon all of the services for which the earlier mark is registered, namely:

Class 41: Casinos.

The consolidated proceedings

4. In its two separate Form TM7s and accompanying statements of grounds, the Opponent argues that the marks are similar. In the “400” mark, the Opponent argues that the services are identical and in the “378” mark, the Opponent argues that the goods are similar. Consequently, there exists a likelihood of confusion, which includes the likelihood of association.
5. The Applicant filed two separate Form TM8s and counterstatements. The Applicant denied that the marks were similar. In the “400” mark, the Applicant admitted that the Opponent’s “Casino services” were identical but denied the other services were identical. In the “378” mark, the Applicant denied that the Opponent’s services were similar to its goods.
6. The two oppositions were consolidated on 22 March 2024, under the lead case, opposition number 445282, pursuant to rule 62(1)(g) of the Trade Marks Rules 2008.
7. The Applicant is represented by Appleyard Lees IP LLP ¹ and the Opponent is represented by Reddie & Grose LLP.
8. During the evidence rounds both parties filed evidence. Neither party requested a hearing but both parties filed written submissions in lieu of a hearing.

¹ Appleyard Lees IP LLP were appointed as representative on 10 February 2025. The previous representatives for the Applicant were Wilson Gunn.

Relevance of EU law

9. 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 AND SUBMISSIONS

10. The Opponent filed a witness statement of Elizabeth Tarn, signed and dated 21 August 2024 along with an index table. Elizabeth Tarn is the General Counsel and Company Secretary at Genting Casinos UK Limited and has held this position since 9 May 2008. The witness statement was accompanied by 8 exhibits, ET01 – ET08.
11. The Applicant filed written submissions and a witness statement of Alexander Thompson, signed and dated 17 October 2024. Alexander Thompson is a Chartered Trade Mark Attorney at Wilson Gunn. The witness statement is accompanied by 2 exhibits, AT1 – AT2.
12. The Opponent filed evidence strictly in reply in the form of a second witness statement of Elizabeth Tarn, signed and dated 17 December 2024 along with an index table. The witness statement was accompanied by 3 exhibits, ET09 – ET11.

Proof of use

13. By virtue of its earlier filing date of 4 January 1996, the registration set out in paragraph 2 above, constitutes an earlier mark within the meaning of section 6(1) of the Act. As the earlier mark completed its registration procedure more

than five years before the filing date of the opposed contested marks, it is, in principle, subject to the use provisions set out in section 6A of the Act.

14. The proof of use provisions are set out in section 6A of the Act, the relevant parts of which state:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if – (a) within the relevant period the earlier trade mark has 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, or (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) 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.

(5)-(5A) [Repealed]

(6) 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.”

15. Section 100 of the Act states that:

“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.”

16. Consequently, the onus is upon the Opponent to prove that genuine use of the registered trade mark was made in the relevant period. The relevant period in which use must be established is the five-year period ending on the date of filing of the contested marks, i.e. 29 July 2018 - 28 July 2023.

17. 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 I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken 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 subcategory 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].”

18. Whether the use shown is sufficient for this purpose 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 relevant territory during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown.
- ii) The nature of the use shown.
- iii) The services for which use has been shown.
- iv) The nature of those services and the market(s) for them.
- v) The geographical extent of the use shown.

19. As indicated in the case law cited above, use does not always need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the services protected by the mark”.

Form of the mark

20. For the sake of completeness, before I move on to assess if the Opponent has shown genuine use, I must first consider if I find the use of the mark as shown in the evidence to be use of the mark as registered. As outlined in *Lactalis McLelland Limited v Arla Foods AMBA*, Case BL O/265/22, the use of the mark in a different form may also constitute use of the mark as registered. While the earlier mark is registered as a word-only mark for “MAXIM’S CASINO CLUB”, I note that some of the evidence shows use of the mark in varying forms such as “MAXIM’S,” “MAXIMS,” “MAXIM’S CASINO,” and “MAXIMS CASINO”. I find that use of the earlier mark in these variations amounts to use of the mark as registered because they do not alter the distinctive character of the mark. The distinctive element of the registered mark is the word “MAXIM’S” whereas the “CASINO CLUB” element is descriptive of the services being provided. The elements that vary are all non-distinctive alterations and therefore they are variations upon which the Opponent can rely.

Assessment of evidence of use

21. The Opponent claims to have used its earlier mark “MAXIM’S CASINO CLUB” in relation to the following services:

Class 41: Casinos.

22. I note the following from the Opponent’s evidence:

1. Exhibit ET01 contains an extract from a webpage called “Casino Guardian”, dated 16 May 2024, after the end of the relevant period, which provides information about the history, location, membership info, amenities, restaurants, games available, and licence info of “Maxim’s Casino Club”. Additionally, this exhibit contains a screenshot, using the internet archive “Waybackmachine”, of the website <http://www.maximsclub.com>. This is dated 15 December 2018 and gives information on the multi-million-pound refurbishment of “Maxims Casino Club”.

2. Exhibit ET02 contains an extract from a webpage called “THE HANDBOOK”, dated 04 July 2018, just before the start of the relevant period. The extract relates to an article titled “Are You All-In? London’s Most Exclusive Casinos” in which “Maxims Casino Club” is featured. Additionally, the exhibit includes a screenshot of a webpage called “My Local Casino”, which is undated, but gives information about “Maxims Casino Club”, as well as describing it as “one of London’s finest gaming destinations”. Additionally, in the witness statement of Elizabeth Tarn,² it is stated that in 2018 the “MAXIM’S CASINO CLUB” business experienced an annual revenue of £9.9 million.

3. Exhibit ET03 contains undated screenshots of a website called “CasinoBrokers”. The screenshots show a “for sale” advert for “Maxims Casino”, as well as a post congratulating “Sonco Gaming” on the acquisition of the casino. The witness statement of Elizabeth Tarn states that just before the relevant period, in 2017, “Maxims Casino Club” was advertised for sale as a business and remained open and operating until its sale in March 2019 for a figure of £34.6 million. The witness statement also indicates that the subject registered trade mark “MAXIM’S CASINO CLUB” was not part of the sale of the casino itself.

4. In her witness statement, Elizabeth Tarn confirms that following the sale of the casino trading as “MAXIM’S CASINO CLUB” continued. Exhibit ET04 includes an article from a website called “square mile” titled “The 6 best casinos in London – from glitzy palaces to exclusive gambling dens”. The article was published on 2 December 2019 and features a section on “MAXIM’S CASINO”. It also includes an undated screenshot from a website called “RocketReach” which provides information about “Maxims Casino Club”, as well as stating a revenue figure of \$5 million.

² First witness statement, dated 21 August 2024.

5. Again, from the witness statement of Elizabeth Tarn it is stated that up until October 2018, the registration UK00002050152 of the trade mark "MAXIM'S CASINO CLUB" was owned by "Coastbright Limited", however, prior to the sale of the casino in 2019 the registration was assigned to "Genting Casinos UK Limited". Following the sale of the casino "Genting" entered into a licence agreement with "SONCO" where they granted "SONCO" a right to use the "Licensed Rights" including the subject registration UK00002050152 "MAXIM'S CASINO CLUB". Exhibit ET05 contains an extract from the license agreement dated 21 March 2019. Only an extract was provided due to the claimed "commercially sensitive nature" of the agreement. Additionally, Ms. Tarn's witness statement explains that the license agreement contained clauses that limited "Genting's" use of the mark over a certain period, therefore preventing them from using the subject mark, amongst other licensed rights, from 21 March 2019 until 31 December 2021.

6. Ms. Tarn's witness statement also claims that the mark was in use after the sale in 2019 and at least until October 2021 when "SONCO" entered into administration. Exhibit ET06 is a screenshot, using the internet archive "Waybackmachine", of the website <http://www.maximsclub.com> dated 21 February 2020, and replicates the information regarding the multi-million-pound refurbishment of "Maxims Casino Club" that was included in Exhibit ET01, as referenced above. Exhibit ET07 is a screenshot of the webpage "CDC Gaming Reports" that states that "Maxims Casino has gone into administration in the hope that the Canadian owners can find a buyer." This exhibit is dated 28 October 2021.

7. Additionally, the witness statement of Ms. Tarn states that, with the termination of the constraint of the licence agreement in 2021, "Genting" are now using the registered mark. Exhibit ET08 shows what appears to be a wall sign showing the mark. This exhibit is undated and does not indicate where the sign is situated.

23. The Applicant filed submissions and evidence in reply to the evidence filed by the Opponent, challenging the validity of the evidence, as well as raising concerns regarding the licence agreement. These submissions were addressed by Ms. Tarn in a subsequent witness statement,³ and additional evidence exhibiting further details of the license agreement.

Conclusions from the evidence on genuine use

24. 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.⁴
25. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. (as he then was) 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.”

³ Second witness statement, dated 17 December 2024.

⁴ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

26. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. (as he then was) 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.”

27. The case law summarised in the passage from *easyGroup* quoted above makes it clear that real commercial exploitation of the trade mark must be shown. Even in a case where the use is not sham, i.e., it is not use engineered solely to preserve the trade mark registration, the use must be more than trivial if it is to be considered genuine. An example of this can be seen in *Memory Opticians Ltd's Application*, BL O/528/15, where the Appointed Person, Professor Ruth Annand, upheld the decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local, from 3 branches of an optician. There was no advertising of the goods under the mark, and the evidence indicated that they were only displayed in-store on occasion. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain a market under the mark. Consequently, it was not genuine use.
28. Where proof of use is required, it is typical to see evidence such as turnover figures. In the present case I have been provided an annual revenue figure for 2018 of £9.9 million, as well as an abstract figure of \$5 million. The \$5 million figure does not contain any information as to when this was for and therefore I cannot give it any weight. No other turnover, revenue figures or invoices for that matter have been provided. It is important to note that the relevant period begins on 29 July 2018, and whilst the revenue figure provided in Ms. Tarn's witness statement relates to 2018, there is no breakdown of how the revenue was accrued during 2018. In other words, there is no evidence to show when and how the revenue was generated. The Applicant states that it is entirely possible that all of the revenue was generated before the beginning of the relevant period. There is nothing in the Opponent's evidence to refute such a

claim. Turnover figures are considered information which should have been readily available and relatively easy to provide.

29. It is not necessarily fatal to the assertion of genuine use that there is limited evidence of revenue, if other material filed by the Opponent is sufficient to show that there has been a real attempt to exploit the mark in the sector. However, there is very little evidence of other activity in this case. Whilst I have been provided with screenshots of websites discussing the existence of “Maxims Casino”, the evidence is lacking in respect of a number of key areas. As previously mentioned, other than the revenue figure for 2018 (and the undated figure), I have not been provided with any other revenue figures for the relevant period. Additionally, I have not been provided with any advertising figures or examples of how the Opponent’s services are advertised. There is no information relating to the market share held by the Opponent, or even figures relating to the number of members, or number of users of the casino during the relevant period. Further, there is no evidence to demonstrate whether the mark had been exposed to a wide-ranging area of the UK. Again, a number of the exhibits are undated and therefore cannot be relied upon to substantiate a claim of genuine use.
30. I accept that the evidence demonstrates the history of the chain of ownership of the casino, as well as who was entitled to use the mark during the relevant period, and I also accept that there has been some commercial activity under the mark, including the sale of the casino. However, taking the evidence of use as a whole, I find that it is insufficiently solid to adequately allow me to find that the Opponent has demonstrated real commercial exploitation of the earlier mark in relation to the services for which use is claimed in the UK, during the relevant period. Even taking into account that due to clauses in the licence agreement, “Genting’s” use of its mark was limited for a certain period, put simply, I find that the use of the Opponent’s mark, the nature of the evidence and the issues discussed throughout my assessment of the same, do not, in my view allow me to make the reasonable inferences necessary in order to find in favour of the Opponent.

CONCLUSION

31. The Opponent has failed to establish genuine use of its earlier mark within the relevant period. Where the proof of use provisions apply an Opponent cannot rely on its earlier mark unless those provisions are satisfied. Consequently, as the Opponent has not proved use of its mark, it cannot rely on its earlier mark, UKTM 2050152, for the purposes of these oppositions. Accordingly, the oppositions brought under section 5(2)(b) fall at the first hurdle and are dismissed accordingly. Subject to any successful appeal, the applications by BK SOLUTION LIMITED may proceed to registration.

COSTS

32. The Applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. I award the Applicant the sum of £1350, calculated as follows:

Considering the notice of opposition (x2) and preparing the counterstatement (x2)	£400
Preparing evidence and considering and commenting on the Opponent's evidence	£600
Preparing written submissions	£350
Total	£1350

33. I therefore order **Genting Casinos UK Limited** to pay **BK SOLUTION LIMITED** the sum of £1350. This 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 final determination of the appeal proceedings.

Dated this 27th day of November 2025

**Oliver Rose'Meyer
For the Registrar**