

BL O/0206/25

In the matter of the Trade Marks Act 1994

- and -

In the matter of UK TRADE MARK APPLICATION No. UK00003617301

CHATSPIN

in classes 9, 38 and 42

in the name of ROCKET GLOBAL, LLC

- and -

In the matter of Opposition thereto OP000426833 by

SPIN AG

MR. ED HARRISON (of Sipara Limited) appeared for the Respondent.

MR. JOHANNES KAKOURES (of LangPatent UK Services Limited) appeared for the Appellant.

DECISION OF THE APPOINTED PERSON

1. This is an appeal from the Hearing Officer, Rosie Le Breton, dismissing the opposition brought by SPIN AG against Application 3617301 by Fox Global to register the trade mark

CHATSPIN

in the United Kingdom.

2. The Application was made under Article 59 of the Withdrawal Agreement between the UK and the EU and claims priority from an EU trade mark with a filing date of 29th July 2020.
3. The Opponent opposed the application under section 5(2) of the Trade Marks Act 1994, based on its own UK comparable registered trade mark for the word

SPINCHAT

4. This registration derives from an EU mark and is registered under no. 902169605. The registration was filed on 9th April 2001 and constitutes an earlier mark under section 6 of the Trade Marks Act 1994.
5. As a preliminary requirement of the opposition, the Opponent was required by the provisions of section 6A of the Trade Marks Act to prove that its own trade mark SPINCHAT had been genuinely used within the period of five years prior to the filing date of the application for the mark under opposition, namely between 29th July 2015 and 29th July 2020. This, of course, can include use in relation only to a limited subset of the goods or services for which it was registered, in which case the opposition would proceed as if the mark were only registered for those goods or services.
6. Here, because the earlier mark was a comparable mark deriving from an EU mark, and the relevant period under section 6A was prior to the IP completion day, which is 31st December 2020, proof of use included use in the European Union.
7. It is well established that the burden of proof of use of its own mark lies on the Opponent. The relevant principles to be applied when establishing whether this burden has been lifted have been set out a number of times in recent years, but most recently by Arnold LJ in the Court of Appeal in easyGroup v Nuclei Limited [2023] EWCA Civ 1247 at paragraphs 105-106. This was quoted in full by the Hearing Officer in paragraph 13 of her decision:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2023] 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 of the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundesvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GbmH v Maselli-Strickmode GbmH* [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 GbmH v Centrotherm Clean Solutions GbmH & 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 GbmH 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 underway, 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]."

I would only add to this a reference to the examples cited by Bacon J at first instance in that case and which the Court of Appeal quoted at paragraph 108, in which:

"Courts or tribunals in Europe have found no genuine use despite the existence of a modest number of sales under the mark. Where only a tiny number of sales has taken place in a limited geographical region in the context of a very large market for the products or services in question, this may be regarded as insufficient (depending on the circumstances) to establish genuine use even where the sales were shown to be part of a real commercial business."

8. Turning to the present case, the evidence relied on by the Opponent was a short witness statement filed by a Mr. Rott, a German national. He stated that the Opponent had established a website which operated on the domain spinchat.com in 1999, or possibly shortly before that, but certainly from 1999. As he described it, the website was a site that hosted online forums and message boards. It was said to be open to the global public and Mr. Rott said that users in the United Kingdom had joined the chat. The service was said to have been in continuous use since 1999.

9. So far as detailed evidence of use is concerned, that consisted, first of all, of a screen shot of the front page of spinchat.com, dated 9th June 2023, which included some pictures of individuals with the names of countries underneath.

It is not clear whether these people are actual users of the site; however, one individual appears above the words "United Kingdom". There is another screen shot, apparently also from 9th June 2023, said to show *"use of a board inside the website continuously over the last years"*. This board lists a number of "topics" which seem to be posted, or have been posted, by certain individuals with a number next to them which shows the number of postings on those topics. The earliest of these shows a last posting date of 1st November 2020, therefore none of them are technically probative of use in the relevant period. Mr. Rott, however, also exhibits a screen shot of the Wayback Machine internet archive, which appears to show that the website was available continuously, at least between 2002 and 2023.

10. Finally, in his statement, Mr Rott says this: *"Only with users from the United Kingdom the following sales figures were created on the website in the last five years."* This is followed by a table with amounts in Euros of each year between 2018 and 2023. The figures quoted for 2018, 2019 and 2020 (the relevant years) are respectively 1,152.10 €, 1,746.50 €, and 1,286.03 €.
11. There is a final exhibit which seems to be a review of the website posted from a reviewer in Iceland in 2023. It refers to SPINCHAT as a dating website existing since 1999. Apart from a mere description of what is visible on the site, or what appears to be text taken from the site itself, there is only one substantive comment, namely that the reviewer only received fake messages and not a single real member answered their post.
12. Turning to the reasoning of the Hearing Officer, she first noted that there was

no evidence of use at all in this case save in respect of a limited range of services, which I can summarise as relating to the provision of internet chat rooms and message boards. She proceeded to deal with the question of proof of use on the basis of the following services within Class 42, '*Operating a computer platform and providing access to a computer platform or program which facilitates Internet communication, especially in the form of communities and chats; Operating a message board system and providing access to a message board system, especially in form of virtual guestbooks and online discussion boards.*'

13. She went on to comment that the evidence of use even of these services was "*exceptionally limited and somewhat flawed*". She accepted from the evidence that there had been a website, and still was a website, under the domain spinchat.com since 1999 and that that had continued throughout the relevant period. She found that it had been used for online communication in this period though, as she said, it was unclear for what purpose (whether it was a dating site, as suggested by the reviewer in 2023, or a gaming site, which had previously been suggested). She found that it had been "open" to users globally and in the UK, and that there had been some very limited revenue generated from UK users at least between 2018 and 2020. That seems to me to be a fair summary of what was established on the evidence.

14. She then pointed out that apart from the domain name itself, which the Wayback Machine showed to be in use, there was no evidence of use of the trade mark SPINCHAT as such in the relevant period because there was no evidence of any page from the website as it existed between 2015 and 2020.

In paragraph 26 of her decision, she quoted the decision in *Awareness Limited v Plymouth City Council*, BL O/236/13, in which Daniel Alexander QC as the Appointed Person noted (I summarise) that where it was apparent that evidence of use could easily have been produced but was not, the tribunal should be particularly sceptical of being invited to draw conclusions. He also noted that evidence of use should 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...*"

15. The Hearing Officer then considered the picture on the evidence as a whole. She concluded that genuine use within the relevant period had not been proved.
16. I think I can summarise the gist of her Decision by saying there were two particular holes in the evidence. First of all, the absence of evidence showing how the mark had actually been used on the site, if at all, in the relevant period. This was something that could have been produced, for example, by showing screen shots preserved on the Wayback Machine. This would not have been a burdensome exercise for the Opponent and she considered that Mr. Rott in his statement had avoided making any direct references or statements about the way in which the trade mark itself had been used. Secondly, the very limited evidence of the existence of UK (or EU) users and the extent of use and revenue in the relevant territory.
17. On that basis she rejected the claim that the Opponent had proved use under section 6A and therefore dismissed the opposition without having to consider

the substantive question of the risk of confusion between the marks. She awarded £800 in costs.

18. In its Notice of Appeal, Spin AG produced a series of screen shots from the Wayback Machine (which had not been in their original evidence) apparently seeking to bolster the evidence of use in the way that the Hearing Officer had suggested should have been done before her, by showing that the mark SPINCHAT was, in fact, visible on the pages of the website in the relevant period 2015-2020.
19. The appeal also went into some detail about the way in which users could and did use the site for communications and chat. However, Spin AG made no application to adduce further evidence on appeal and made no such application before me at the hearing. Instead, the skeleton argument on the appeal stated: *"The facts and evidence filed with the substantiation of the appeal are not to be considered as additional facts and evidence but as supplements to the facts and evidence already filed to strengthen the corresponding arguments"*. That position was also adopted by Mr. Kakoures in his submissions before me.
20. I should say it is obviously not possible to eliminate the requirement for an application to adduce further evidence on Appeal by simply referring to it as *"supplemental"* evidence. If the evidence was not produced before the Hearing Officer it will not be considered on appeal unless an application is formally made. I have to say, it is almost self-evident in this case that such an application would have failed in any event but, since it has not been made, I

will not consider the new evidence any further.

21. Beyond the new evidence, the only argument which was made in the Notice of Appeal and in the skeleton argument is that the Hearing Officer was wrong to consider that Mr. Rott had not proved that the site had operated under the trade mark SPINCHAT throughout the relevant period.
22. The argument that was put forward was that Mr. Rott had provided a screen shot from 2023 and had stated that the website had been used since 1999 "*in a continuous and unchanged manner*". Unfortunately, that is not the effect or substance of Mr. Rott's statement. Whilst it was stated by Mr. Rott that the service had been in continuous use, there was no statement by Mr. Rott that it had been used in an "*unchanged manner*" and, therefore, it seems to me it is not possible to extrapolate from his screen shot, combined with his evidence, that the mark had been used in exactly the same way or, indeed, had been continuously used at all throughout the period on and in the website. I therefore reject this criticism of the Hearing Officer's reasoning.
23. It will be apparent that in my opinion no viable criticism of the Hearing Officer's decision, either as a matter of law or as a matter of fact, has been made and there is therefore no basis, as a matter of procedure and law on appeal, on which I could overturn it, even if I thought I might have reached a different decision myself. However, for completeness, I should say, having reviewed the evidence myself, I am satisfied I would have reached the same decision as the Hearing Officer. The evidence was extraordinarily weak in terms of its explanation of the nature of the business that was being carried out under the

mark, the turnover achieved, how such turnover was achieved, the existence or number of users in the United Kingdom or the EU, or the extent of the use of the mark in terms of promotional activity or on the website itself. All this evidence was plainly under the control of Mr. Rott and yet he had made no attempt to provide it.

24. I therefore reject this appeal against the decision of the Hearing Officer and the Opposition stands dismissed.

25. So far as the costs of this appeal are concerned, there has only been a limited exchange of documents and a short skeleton argument on both sides. There has been a very short hearing this morning. I intend to order, therefore, the payment of £500 by the Opponent.

IAIN PURVIS KC

THE APPOINTED PERSON

6 March 2025