O/0629/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3739660
BY SAMI ASGHAR AND RAFI ASGHAR

TO REGISTER:

Kubana

AS A TRADE MARK IN CLASS 34

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 433109
BY CHANCELLOR GLOBAL LTD

BACKGROUND AND PLEADINGS

1. On 5 January 2022, Sami Asghar and Rafi Asghar ("the applicants") applied to register the trade mark shown on the cover page of this decision ("the contested mark") in the UK. The application was published for opposition purposes on 11 February 2022, and registration is sought for the following goods:

Class 34 Cartridges for electronic cigarettes; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Chemical flavourings in liquid form used to refill electronic cigarette cartridges; Electric cigarettes [electronic cigarettes]; Electronic cigarette atomizers; Electronic cigarette boxes; Electronic cigarette cartomizers; Electronic cigarette liquid [e-liquid] comprised of flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Electronic devices for the inhalation of nicotine containing aerosol; Electronic nicotine inhalation devices; Flavorings, other than essential oils, for tobacco; Flavorings, other than essential oils, for use in electronic cigarettes; Flavourings, other than essential oils; Flavourings, other than essential oils, for use in electronic cigarettes; Liquid for electronic cigarettes; Liquid nicotine solutions for electronic cigarettes; Liquid nicotine solutions for use in electronic cigarettes; Liquid solutions for use in electronic cigarettes; Liquids for electronic cigarettes; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor; Refill cartridges for electronic cigarettes; Vaporizers for smoking purposes; Electronic cigarettes for use as an alternative to traditional cigarettes; Cartridges sold filled with chemical flavorings in liquid form for electronic cigarettes; Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Electric cigarettes [electronic cigarettes];Liquid solutions for use in electronic cigarettes; Personal vaporisers and electronic cigarettes, and flavourings and solutions therefor.

2. On 29 April 2022, the application was opposed by Chancellor Global Ltd ("the opponent"), based on sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is directed at all the goods in the application.

3. The opponent relies upon its United Kingdom trade mark number 3111315, 'TREASURER CUBANA' ("the earlier mark"), which has a filing date of 1 June 2015 and a registration date of 28 August 2015. For the purpose of these proceedings the opponent relies on all the goods for which the mark is registered, namely:

Class 34 Cigars, cigarillos, filtered cigars, filtered cigarillos.

4. The earlier mark is subject to use conditions in accordance with section 6A of the Act because the mark was registered more than five years before the application date of the contested mark. The opponent has made a statement to the effect that it has used the mark in relation to all the goods relied upon.

5. The opponent claims that the marks are similar and that the respective goods are either identical or similar. Accordingly, it claims that there exists a likelihood of confusion.

6. The applicant filed a counterstatement denying the grounds of opposition and requesting that the opponent provide proof of use of the earlier mark in respect of all the goods relied upon.

7. Neither party are professionally represented. Only the opponent filed evidence. Only the applicant filed written submissions. Both parties were given the option of an oral hearing but neither requested to be heard on this matter, nor did they file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers.

PRELIMINARY ISSUES

- Grounds relied upon by the opponent

8. It is noted from the Form TM7 that the opponent is relying on sections 5(1), 5(2)(a) and (b) of the Act. However, as the marks at issue are clearly not identical, either *prima*

facie or in accordance with the guidance laid out in *Sadas,*[1] I will proceed on the basis of section 5(2)(b) only.

EVIDENCE

9. The opponent filed evidence in the form of the witness statement of Tatul Mkhitaryan, dated 23 January 2023, which is accompanied by eight exhibits. Mr Mkhitaryan is the Director of the opponent. The evidence has been adduced to prove the use that has been made of the earlier mark.

10. Whilst I do not intend to summarise the evidence here, I have read all the evidence and will return to it to the extent I consider necessary in the course of this decision.

11. 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.

DECISION

Proof of use

12. I will begin by assessing whether, and to what extent, the evidence supports the opponent's statement that it has made genuine use of its earlier mark in relation to the registered goods relied upon. The relevant period for this purpose is the five year period ending with the date of the application in issue, namely 6 January 2017 to 5 January 2022.

13. Section 6A of the Act states:

[1] *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA,* Case C-291/00

“(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."

14. Section 100 of the Act is also relevant, which reads:

"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."

15. Consequently, the onus is upon the opponent to prove that genuine use of the earlier mark was made within the relevant territory in the relevant period, and in respect of the relevant goods as registered.

16. 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 Court of Justice of the European Union ("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. 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].”

17. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the UKTM, in the course of trade, sufficient

to create or maintain a market for the goods at issue 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 goods for which use has been shown;
iv) The nature of those goods and the market(s) for them; and
v) The geographical extent of the use shown.

18. Before assessing the opponent's evidence of use, I remind myself of the comments of Mr Daniel Alexander QC, (as he then was) sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*, where he stated that:[2]

> "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:

[2] Case BL O/230/13

> "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."

19. I also note Mr Alexander's comments in *Guccio Gucci SPA v Gerry Weber International AG*.[3] Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition actions. He stated:

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

20. The comments of Mr Geoffrey Hobbs QC (as he then was) in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, where he sat as the Appointed Person, are also relevant.[4] He stated that:

[3] Case BL O/424/14

[4] Case BL O/404/13

"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 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."

21. Accordingly, whilst there is no requirement to produce any specific form of evidence, I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied that there has been genuine use of the mark.

Form of the mark

22. 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. 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 s. 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".

23. The opponent's registration is for the word mark 'TREASURER CUBANA'. Where the opponent has used its registration as registered, that will clearly be use on which the opponent can rely. However, it is noted from the evidence that the opponent's mark has also been used in the following ways:

1) Treasurer London Cubana 2) Cubana 3) Treasurer Executive

4) Treasurer Aluminium 5) 

6) 

7) 

8) 

9) 

24. In conjunction with the above case law, I remind myself that Section 6A(4)(a) of the Act enables an opponent to rely on use of a mark "in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered". Therefore, with regards to the above marks numbered 1, 5, 6, 7, 8 and 9, I acknowledge that where a registered mark is used as part of another mark or with

additional matter, this may still constitute acceptable use of the mark as registered, where this element continues to act independently as an indicator of origin.[5] Accordingly, I am of the view that use of the marks numbered 1, 5, 6, 7, 8 and 9 above, constitute use of the earlier mark as this element in these versions continues to indicate origin. Consequently, I find that use of the stated marks is use upon which the opponent can rely.

25. However, even if I am wrong in my finding, I am of the view that the addition of colours, additional text and devices does not sufficiently alter the distinctive character of the earlier mark, and therefore use of the marks numbered 1, 5, 6, 7, 8 and 9 above, constitute as acceptable variant use of the earlier mark, upon which the opponent can rely.

26. Similarly, I am of the view that marks 3 and 4 also constitute as acceptable variants of the earlier mark upon which the opponent can rely. I say this on the basis that I find the 'CUBANA' element of the mark to be lowly distinctive in terms of the goods at issue given that the average consumer of those goods will likely be cigar smokers who may be aware of the reputation and quality of Cuban cigars. Conversely, with regard to the word 'TREASURER' as this does not appear to have a meaning in relation to the goods at issue, I find this word to be the dominant and distinctive element of the mark, and therefore plays an independent role within the mark. Accordingly, omitting the lowly distinctive element and replacing it with other lowly distinctive elements, namely 'Executive' and 'Aluminium' does not in my opinion alter the distinctive character of the mark as a whole.

27. With regard to the remaining mark 'Cubana', numbered '2' above, As previously discussed, I find this element to be lowly distinctive in terms of the goods at issue. Therefore, by omitting the distinctive element of the earlier mark, namely 'TREASURER', I am of the view that the distinctive character of the earlier mark is altered. Consequently, the opponent cannot rely upon use of the mark 'Cubana' as use of the earlier mark.

[5] *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12

Genuine use

28. Whether the use shown of the earlier mark is sufficient will depend on whether there has been real commercial exploitation of the same, in the course of trade, sufficient to create or maintain a market for the goods at issue, in the UK, during the relevant five-year period.

29. 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.[6]

30. The opponent claims to have used its earlier mark in relation to all the goods relied on, namely:

Class 34 *Cigars, cigarillos, filtered cigars, filtered cigarillos.*

31. In his witness statement, Tatul Mkhitaryan states that the opponent's company was established in 2005, receiving ownership rights to the trade mark 'TREASURER CUBANA' from The Chancellor Tobacco (UK) LTD, ("the manufacturer"). He added that the opponent, in partnership with the manufacturer, have been using the earlier mark since November 2016, initially exporting their products to the USA, UAE and Croatia. He adds that products under the earlier mark became available in the UK market in 2017, which because of the nature of the goods at issue, was duly notified to HMRC (Her Majesty's Revenue and Customs, as it then was).

32. The opponent's use claims are supported by 14 invoices (Exhibit TC1), dated between 13 November 2015 and 1 March 2021. However, I bear in mind that the relevant period for the opponent to prove use of its mark is 6 January 2017 to 5 January 2022. The invoices dated within the relevant period (11 in total), originate from the manufacturer (The Chancellor Tobacco Company (UK) Limited). However, it is noted that none of the 14 invoices contained in exhibit TC1, relate to sales in the

[6] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

UK, but rather, relate to sales in the US, UAE and Croatia. These invoices are not relevant in these proceedings and will therefore not be taken into account.

33. However, it is noted that Exhibit TC2 contains an invoice dated within the relevant period, demonstrating sales of products in the UK (London). The items listed in the invoice are 'MB Blue Cigarettes', 'MB Red Cigarettes' and 'Cubana 15 outers'. These sales amount to £38,126.08. This invoice is accompanied by a declaration to HMRC, regarding the sales. However, the earlier trade mark 'TREASURER CUBANA' does not feature anywhere in the invoice, nor in the HMRC declaration.

34. In his statement, Mr Mkhitaryan submits that the opponent and manufacturer are currently in an advanced stage of developing *cigarillo* lines for the UK market which will be manufactured under the 'Treasurer Cubana' trademark. In this regard, exhibit 3 contains two photographs (undated) of the upcoming products with the relevant labels attached. He added that the opponent will also produce unique design accessories under the 'Treasurer Cubana' brand which will include, amongst other things, ashtrays, lighters and cigar humidors (exhibit TC4).

35. Further, Mr Mkhitaryan states that within the next 6 to 8 months the opponent and manufacturer plan to launch a 'Treasurer Cubana' vape line intended for the UK and international markets (Exhibit TC5), and that an additional 'Treasurer Cubana' product, aimed at both the UK and international markets is currently in the development stage.

36. In his witness statement, Mr Mkhitaryan states that exhibit TC6 contains evidence relating to the publicity received by the opponent's company and its earlier mark. However, it is noted that exhibit TC6 only actually appears to relate to the registration details of the opponent's earlier mark, obtained from the Intellectual Property Office website on 20 January 2023.

37. Exhibit TC7 contains screenshots from four online web shops, namely 'havana-cigarshop.com', 'bigforkliquorbarn.com', 'pogonkooltura.hr', 'havana-cigarshop.com'. Whilst I note that these screenshots feature 'Treasurer Cubana' *cigarillos* products and are all dated within the relevant period, only the 'bigforkliquorbarn.com' is presented in English, however, the product prices shown in this screenshot are in dollars ($). It

is not possible to substantiate from the screenshots the number of visitors to the websites, the target audience of the websites and whether any visitors to the websites were based in the UK. In addition, exhibit 7 also contains a screenshot taken from www.facebook.com, featuring a photograph showing 'Treasurer London Cubana' products being displayed on a glass shelf. The screenshot is undated and there is no information regarding where the products were being displayed and who the target audience were.

38. Exhibit 8 contains a three page 'presentation' relating to 'Treasurer London Cubana' products. The presentation is undated and contains no product price information. There is nothing to substantiate from the exhibit who the target audience was for the presentation and whether or not it was based in the UK.

39. With regards to the packaging of 'Treasurer Cubana' cigarettes/cigarillos products, in his witness statement, Mr Mkhitaryan's states that as the word 'Cubana' is separated from 'Treasurer' or 'Treasurer London', these goods are known simply as 'Cubana' amongst the opponent's customers. However, there is no evidence before me to demonstrate that this is the case.

40. With regard to the evidence of use submitted, I must now consider if it sufficiently demonstrates genuine use, whilst reminding myself that use does not have to be quantitively significant to be genuine.

41. It was the opponent's responsibility to provide proof that the mark was used in the UK during the five year relevant period. In my analysis above, I have highlighted numerous shortcomings in the evidence.

42. It is apparent from the invoice contained in exhibit TC2 that the opponent has sold cigarettes in the UK during the relevant period. Furthermore, it is noted that the invoice also makes reference to sales of 'Cubana 15 outers', although it is not clear from the evidence before me what type of goods this description relates to. However, as previously stated, the invoice does not specifically feature the earlier mark, nor the goods relied upon, being cigars, cigarillos, filtered cigars and filtered cigarillos.

43. Furthermore, with regards to exhibits TC3, TC4 and TC5, these relate to products that are currently in the development stage and therefore, do not relate to use of the earlier mark, in the UK during the relevant period. Moreover, some of the goods at issue in these exhibits, such as vapes and ashtrays, are not included in those goods relied upon by the opponent.

44. With regard to the website screenshots and the presentation contained in exhibits TC7 and TC8, I am not able to establish from this evidence who the target audience was, and whether or not it was based in the UK. As such, I am unable to determine with any accuracy, the level of use associated with these goods which is a significant issue.

45. Furthermore, neither Mr Mkhitaryan's witness statement nor the accompanying exhibits provide information regarding turnover and the amount spent on the promotion and advertising of the relevant goods under the earlier mark, in the UK, during the relevant period. Consequently, as these figures have not been submitted, it is difficult for me to assess how many of the goods at issue were sold under the earlier mark in the UK. As such, without anything to guide me on this point, I find that the evidence does not allow me to make a reasonable inference as to the quantity of the use of the relevant goods in the UK and, in the circumstances, it is not appropriate for me to do so.

46. Accordingly, taking all the above into account and bearing in mind not only section 100 of the Act but also the comments of Mr Alexander QC (as he then was) and Mr Hobbs QC (as he then was) in *Plymouth Life* and *Dosenbach*, I find that the evidence of use 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 goods for which use is claimed in the UK, during the relevant period.

47. Consequently, 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

48. Where the proof of use provisions apply, an opponent cannot rely on its earlier mark unless those provisions are satisfied. It should not have been a difficult matter for the opponent to show use of its mark, however, it did not do so. Consequently, the opponent cannot rely on its earlier mark for the purpose of this opposition. Accordingly, the opposition under section 5(2)(b) falls at the first hurdle and is dismissed accordingly. Subject to appeal, the application will proceed to registration for the full list of goods applied for.

COSTS

49. The applicant has been successful and is entitled to an award of costs. As the applicant had not instructed professional representatives, they were invited by the Tribunal to indicate whether they intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings.

50. On 20 December 2023, the applicant submitted a pro-forma for an award of the following costs:

- 4 hours – time spent considering forms filed by the other party.

- 42 hours – time spent preparing written submissions, reading and understanding legal aspects and compiling case law to back arguments.

51. With consideration of the above, I am guided in this decision by the guidance on how costs should be allocated to parties that are not represented professionally, such as the applicant.

52. It is important to note that only costs which have been incurred during, and as part of, these proceedings are relevant, such as filing official forms, evidence, written submissions etc. Accordingly, I have set out below my assessment on the applicant's claim made. However, it should be noted that a costs award is intended to be a

contribution towards costs rather than full compensation. I will make the award of costs on the basis of £19.00 per hour, which is the minimum rate of compensation allowed under The Litigants in Person (Costs and Expenses) Act 1975 (as amended).

53. It is noted that the applicant's claim of 42 hours is in respect of, amongst other things, 'reading and understanding legal aspects and compiling case law to back arguments'. Whilst the applicant has not expanded further on these activities, it is important to note that costs in relation to such activities are not recoverable. However, with regards to the 'time spent preparing written submissions', I award the applicant 4 hours.

54. I therefore award costs to the applicant on the following basis:

Preparing a statement and considering the other side's statement (4 hours)	£76
Preparing written submissions and considering the other side's evidence (5 hours)	£95
Total	**£171**

55. I therefore order Chancellor Global Ltd to pay Sami Asghar and Rafi Asghar, the sum of £171. 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 conclusion of the appeal proceedings.

Dated this 4th day of July 2024

Sam Congreve
For the Registrar