

O-0707-24

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO 3818495

IN THE NAME OF ELECYBER INTERNATIONAL PTE. LTD.

FOR THE MARK:



IN CLASSES 9, 35, 41 & 42

AND

OPPOSITION THERETO (UNDER NO. 436196)

BY

PULSE-EIGHT LIMITED

BACKGROUND

1) On 10 August 2022, ELECYBER INTERNATIONAL PTE. LTD. ('the applicant') applied to register the trade mark shown on the cover page of this decision in respect of various goods and services in classes 9, 35, 41 & 42. For reasons which will become apparent, there is no need to set out all of those goods and services here.

2) The application was published in the Trade Marks Journal on 2 September 2022 and a notice of opposition was subsequently filed, on 09 September 2022, by Pulse-Eight Limited ('the opponent'). The opponent bases its opposition upon section 5(2)(b) of the Act. It relies upon the following trade mark registration:

- **UKTM 2463580C**

(Series of 2)



Class 9: Apparatus and instruments for transmitting, receiving, recording and reproducing audio and/or visual signals and data; broadcasting apparatus; cables; leads; aerials; speakers and sound and vision amplifiers; tuners; video recorders; dvd recorders; digital television recorders; personal video recorders; set top boxes; televisions; radios; boosters for electrical current and wireless transmission and receiving apparatus; remote control apparatus; semiconductor devices; parts and fittings for the aforesaid goods

Class 38: Consultancy services relating telecommunications including television, radio and the internet.

Class 42: Professional consultancy relating to technology, including power management technology; consultancy services relating to digital hardware design, software design and industrial design.

Filing date: 08 August 2007

Date of entry in register: 13 June 2008

3) The trade mark relied upon by the opponent is an 'earlier mark', in accordance with section 6 of the Act. As it completed its registration procedure more than five years prior to the date on which the applicant's mark was filed, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods and services relied upon.

4) The applicant filed a counterstatement. It puts the opponent to proof of use of its earlier mark and denies the opponent's claims under section 5(2)(b) of the Act.

5) The applicant is currently represented by Sipara Limited¹ but was, up to and including the receipt of the submissions in lieu, represented by Lane IP limited; the opponent is without legal representation. The opponent's evidence of use consists of a witness statement in the name of Martin Ellis² with exhibit ME1 thereto. The applicant filed no evidence or submissions during the evidence rounds. Neither party requested a hearing; only the applicant filed written submissions in lieu³. The opponent filed a costs proforma in support of its request for costs⁴.

DECISION

6) 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. Hence, this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

¹ As per the Form TM33 filed on 05 February 2024

² Dated 25 September 2023

³ Dated 14 December 2023

⁴ Dated 14 December 2023

Proof of use

7) Section 6A of the Act states:

“(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.”

8) Further, Section 100 of the Act states that:

“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) Consequently, the onus is upon the opponent to prove that genuine use of its mark was made in the relevant period.

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 Bunderversammlung 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 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 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) In the instant case, the relevant period is the five-year period ending on the date of filing of the applicant’s mark, namely **11 August 2017 to 10 August 2022**.

12) Mr Ellis states that he is a director of the opponent company. The only narrative in his witness statement which pertains to use that the opponent has made of its mark is this statement: 'Evidence of the trademark in use can be found in exhibit ME1'. That exhibit consists of the following table:

	Product Group	Brief Description	Photo Evidence
DTR-HD500	Freeview+HD Recorder	TVonics Freeview Set Top Box	1)
DTR-Z500HD	Freeview+HD Recorder	TVonics Freeview Top Box Personal Video Recorder	2)
DTR-HV250	Freeview+ Recorder	TVonics Freeview Top Box Personal Video Recorder	3)
DTR-Z500AD	Freeview+ Recorder	TVonics Freeview Top Box Personal Video Recorder	
DTR-Z500	Freeview+ Recorder	TVonics Freeview Top Box Personal Video Recorder	
DTR-Z250	Freeview+ Recorder	TVonics Freeview Top Box Personal Video Recorder	4)
DTR-HC250	Freeview+ Recorder	TVonics Freeview+ Digital TV Recorder	
MDR-240	Freeview Set Top Box	TVonics Freeview Adaptor	5)
MDR-252	Freeview Set Top Box	TVonics Freeview Adaptor	6)
MDR-251	Freeview Set Top Box	TVonics Freeview Adaptor	
MDR-250	Freeview Set Top Box	TVonics Freeview Adaptor	7)
MDR-100	Freeview Set Top Box	TVonics Freeview Set Top Box	
MFR-300	Freeview Set Top Box	TVonics Freeview Set Top Box	8)
MFR-200	Freeview Set Top Box	TVonics Freeview Set Top Box	9)
DVR-150	Freeview Set Top Box	TVonics Freeview Set Top Box	10)
DVR-FP250	Freeview Set Top Box	TVonics Freeview Set Top Box	11)
DVR-FP150	Freeview Set Top Box	TVonics Freeview Set Top Box	12)

13) The table is followed by 12 undated photographs. An example of one of the products shown in the photographs is shown below:



14) This very thin evidence is lacking in numerous very important respects. Firstly, none of the evidence is dated. Therefore, I cannot tell whether the products listed in the table, and the photographs corresponding to those products, are representative of any products that were sold within the relevant period. Further, there is nothing at all before me to show that there were, in fact, any sales in the UK within that period. There are, for example, no invoices, no sales figures, no evidence of customer orders or any other kind of evidence to show that any sales were made in the UK within the relevant period. There is also no evidence of any promotional activity. The complete lack of any narrative evidence from Mr Ellis about the timing, scale and frequency of use of the earlier mark on any of the products listed in the table or any other products or services relied upon also does not assist the opponent. As the case law above makes clear, 'the use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services.' The evidence submitted by the opponent comes nowhere near satisfying me that the mark has been so used.

15) The opponent has failed to establish that its earlier mark was put to genuine use in relation to any of the goods and services relied upon in the relevant period. Consequently, the opponent cannot rely upon its earlier mark under section 5(2)(b) of the Act and the opposition must fail.

OUTCOME

16) **The opposition fails.**

COSTS

17) The applicant has been successful and is entitled to an award of costs. Using the guidance in Tribunal Practice Notice 2/2016, I award the applicant costs on the following basis:

Preparing a statement and considering the other side's statement	£300
Preparing written submissions in lieu	£300
Total:	£600

18) I order Pulse-Eight Limited to pay ELECYBER INTERNATIONAL PTE. LTD. the sum of **£600**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of July 2024

Beverley Hedley
For the Registrar,
the Comptroller-General