

**o/0831/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. UK914583231**

**BY**

**CONTEXTE**

**IN RESPECT OF THE TRADE MARK**

**CONTEXTE**

**IN CLASSES 9, 16, 35, 38 & 41**

**AND THE APPLICATION FOR THE REVOCATION THEREOF**

**UNDER NO. 505581**

**BY THOMSON REUTERS FOUNDATION**

## BACKGROUND AND PLEADINGS

1. The trade mark shown on the cover page of this decision (“the Contested Mark”) stands in the name of CONTEXTE (“the Registered Proprietor”). As a comparable mark based upon an earlier EUTM, owned by the Registered Proprietor, the mark enjoys the same filing and registration dates as the earlier EUTM,<sup>1</sup> 23 September 2015 and 29 February 2016 respectively. The Contested Mark stands registered for the following goods and services:

Class 9: Downloadable software; Electronic publications, downloadable; applications software for mobile telephony apparatus; Software for integration of applications and databases.

Class 16: Printed matter, namely printed publications, Magazines, Newspapers, Periodicals, Newsletters, Diagrams, Books and manuals.

Class 35: Advertising management; Arranging newspaper subscriptions for others; Business information; Dissemination of advertising matter; Compilation of statistics; Market studies; Opinion poll; Computerised file management; Exhibitions for commercial or advertising purposes; Collection and systematic ordering of data in a central file; Sales promotion for others.

Class 38: Computer aided transmission of messages and images; Communications by computer terminals or by fibre optic networks; Electronic advertising services (telecommunications); News or information agencies; Providing Internet chat rooms; Providing access to information held in data banks; Broadcasting of audio-visual and radio programmes; Transmission by satellite, radio wave, cable, networks, and in particular via the Internet, of sound, images and data.

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<sup>1</sup> On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMS.

Class 41: Arranging and conducting of colloquiums, lectures or congresses; Publication of electronic books and journals on-line; Publication of texts, other than publicity texts; Electronic publication of newspapers, magazines and periodicals online or in electronically downloadable format; Multimedia publication of books, specialist magazines and newspapers; Publishing house services, other than printing; Production of radio programmes and Audio-visual.

2. On 24 November 2022, Thomson Reuters Foundation (“the Cancellation Applicant”) filed an application for revocation against all of the goods under sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (the Act).

3. In the application for revocation, the Cancellation Applicant claims that the contested mark was not put to genuine use in the five years after registration of the mark (section 46(1)(a)) and, under section 46(1)(b), that use has been suspended for an uninterrupted period of five years between the following two periods:

6 May 2016 – 5 May 2021

29 September 2017 – 28 September 2022

4. The Registered Proprietor denied the Cancellation Applicant’s claims within their counterstatement and stated that the mark was in use for all goods and services for the periods stated.

5. Both parties provided evidence in these proceedings. A hearing was requested and attended by the Cancellation Applicant. The Registered Proprietor was not in attendance however, they did provide submissions in lieu of attendance. This decision is taken following a careful consideration of the papers before me.

6. The Registered Proprietor is represented by Albright IP Limited and the Cancellation Applicant is represented by HGF Limited. Ashton Chantrielle of counsel represented the Cancellation Applicant at the hearing.

7. 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**

8. The Registered Proprietor provided evidence in the form of a witness statement by Mr Jean-Christophe Boulanger, the President of Contexte, dated 19 June 2023 and accompanied by 16 Exhibits. There was also a witness statement from Katia Rapinel-Tombois who is a translator and provided translations of two of the exhibits. The main purpose of the evidence was to show use of the Contested Mark.

9. The Cancellation Applicant filed a witness statement dated 21 August 2023 by Claire Jones, a Chartered Trade Mark Attorney from HGF Limited, the Cancellation Applicant's legal representative. This was accompanied by 5 exhibits. The main purpose of this evidence was to rebut some of the Registered Proprietor's evidence.

10. The Registered Proprietor provided submissions in response to the Cancellation Applicant's evidence, particularly in relation to the comments regarding untranslated exhibits.

## **Preliminary Issue**

11. Within the Registered Proprietor's evidence and subsequent submissions they confirmed that they would be providing proof of use of the following goods and services only:

Class 9: Downloadable software; electronic publications, downloadable; software for integration of applications and databases.

Class 35: Arranging newspaper subscriptions for others.

Class 38: Computer aided transmission of messages and images; electronic advertising services (telecommunications); news or information agencies; providing access to information held in data banks; transmission by satellite, radio wave, cable, networks, and in particular via the Internet, of sounds, images and data.

Class 41: Publication of electronic books and journals on-line; publication of texts, other than publicity texts; electronic publication of newspapers, magazines and periodicals online or in electronically downloadable format; multimedia publication of books, specialist magazines and newspapers; publishing house services, other than printing.

12. Further the Registered Proprietor confirmed that they will not be filing proof of use in relation to any of the class 16 goods nor the remaining goods and services from classes 9, 35, 38 and 41. Therefore, the application for revocation is successful in relation to these goods and services with the effective date being 1 March 2021.

## **DECISION**

### **Sections 46(1)(a) and 46(1)(b)**

13. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

14. 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.”

15. Given that the proprietor’s mark is a comparable mark, paragraph 8 of part 1, schedule 2A is relevant. It reads:

“8.— Non-use as defence in infringement proceedings and revocation of registration of a comparable trade mark (EU)

(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the "five-year period") has expired before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM ; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union”.

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 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 Bunderversvereinigung 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].”

17. I remind myself that there are three periods of use requested by the Cancellation Applicant. The first is the five years following the date of the completion of the registration, namely 1 March 2016 to 28 February 2021. There are also the two periods that the Cancellation Application has noted within its Form TM26N as follows: 6 May 2016 to 5 May 2021 and 29 September 2017 to 28 September 2022. I note that there is a significant overlap in all of the above use periods.

## **Evidence**

18. During the hearing, the Cancellation Applicant made numerous references to the fact that many of the evidential exhibits were in French (or translated from French) or that the French version was used (e.g. the French version of the website). Given that the contested mark is a comparable mark, I can take into account use within the EU

prior to IP completion day (as per paragraph 15 above) and therefore, I do not find these comments to have assisted in the Cancellation Applicant's case.

19. Mr Boulanger stated within his witness statement that he founded Contexte in 2013 and that it provides "expert and independent political journalism covering news stories and current events throughout the European Union and United Kingdom". He explains that Contexte's journalists post their articles on the Contexte website which are then advertised on social media.

20. Mr Boulanger provided historical subscription figures, but I will focus on the figures from the relevant periods. He states that in 2017 the Registered Proprietor reached subscription revenues of over €1 million euros, in July 2019 it exceeded €2 million, in October 2020 it exceeded €3 million, and in March 2022 it exceeded €7 million.

21. Mr Boulanger goes on to say that the Registered Proprietor expanded and opened its Belgian subsidiaries in June 2019. Further, they launched a software product in September 2020 called Contexte SCAN which was used to monitor French parliamentary activity.

22. Mr Boulanger referenced Exhibit JCB1 which he states shows a list of Contexte's subscribers and their location with subscribers in the UK highlighted. It was pointed out by the Cancellation Applicant that this list appears to have been produced outside the relevant date due to the date at the top of the document showing as "2023-02-23". Further, it was commented that the list does not identify why the consumers are subscribed, nor when the subscription began. The list shows approximately 1160 subscribers with eight being highlighted as UK subscribers. Further, Exhibit JCB2 is a list of client accounts in location order as of October 2022 which shows 32 client accounts in the United Kingdom generating a turnover of 32,729.60 Euros (although it is not clear if this is per annum or in total).

23. Exhibit JCB3 is a list of the number of readers of 'Contexte's Briefings' and shows 1.46% of readers being from the United Kingdom. However, this is undated and I have not been provided with any information regarding when this figure was taken from. Mr

Boulanger explains that the Contexte Briefings' are the daily newsletters emailed to all subscribers which covers current affairs and news stories across Europe.

24. In relation to advertising, Mr Boulanger contends that Exhibits JCB5 & 6 shows expenditure of 1439.28 Euros on Twitter and 25,000 Euros on LinkedIn with 1.3 million 'impressions' on Twitter and 900,000 views on LinkedIn. I do note, and agree with, the Cancellation Applicant's assertions that there is no evidence of the advertising itself and therefore, how the mark is used. Further, in relation to the 'impressions' on Twitter, these all appear to have occurred in one event after January 2022. Mr Boulanger states that Exhibit JCB13 shows the Twitter advertising campaigns between 12 January 2015 and 30 November 2022. However, as pointed out by the Cancellation Applicant, there is no detail as to what was in those advertising campaigns nor how the mark was used within them.

25. The Registered Proprietor has provided sample invoices sent to UK clients between 30 November 2020 and 14 November 2022. Mr Boulanger, states the invoices are in relation to the subscription for the daily newsletter and access to the Registered Proprietor's website. I note the mark is used as follows at the top left of every invoice:

## CONTEXTE

26. I have extracted the following information from the sample invoices:

Date	Invoice Number	Location	Amount (in Euros)
30/11/2020	202011047	London	158.55
14/12/2020	202012101	London	223.18
11/01/2021	202101195	London	3895.00
14/01/2021	202101214	London	590.00
14/01/2021	202101226	London	95.87
18/01/2021	202101238	London	8673.00

13/04/2021	202104586	London	135.39
12/07/2021	202107877	London	94.03
13/09/2021	2021091007	London	95.47
15/09/2021	2021091034	London	7000.00
08/11/2021	2021111279	London	8998.00
10/11/2021	2021111285	London	146.10
10/12/2021	2021121437	London	102.58
17/01/2022	2022011625	London	9106.60
30/01/2022	2022011696	London	640.00
14/03/2022	2022031897	London	128.20
16/05/2022	2022052108	London	123.22
12/07/2022	2022072322	London	159.25
15/08/2022	2022082416	London	3000.00
26/08/2022	2022082432	London	6780.00
20/09/2022	2022092519	London	148.33
22/09/2022	2022092529	London	3454.00
17/10/2022	2022102653	London	3391.00
14/11/2022	2022112790	London	150.35

27. Exhibit JCB9 is a series of 'Wayback Machine' extracts of the website [www.contexte.com](http://www.contexte.com). I note that during the evidence rounds the Cancellation Applicant raised concerns that this exhibit (along with several others) was machine translated rather than translated by an official translator. I note that the Registry provided a preliminary indication which stated that the Registered Proprietor would not be asked to re-file and that it would be the Hearing Officer's decision as to the validity of the exhibits the screenshots comprise articles dated within the relevant period and that the contested mark is used on the page as a header and sub header. Mr Boulanger states within his witness statement that the webpages contain news bulletins and briefings and this statement was not challenged by the Cancellation Applicant. Further, the Cancellation Applicant provided Wayback Machine screenshots of the same pages in French. I note that these screenshots show political figures such as French President Emmanuel Macron, and issues such as Budgets which all point to the content being news related.

28. The following mark is shown at the top of the screenshots:

# CONTEXTE

And periodically with other matter such as:

## CONTEXTE POUVOIRS

## CONTEXTE ENVIRONNEMENT

29. As mentioned above, the articles show the dates at the beginning of the line which are mostly within the relevant dates, for example (from both the Cancellation Applicant's evidence and the Registered Proprietor's evidence);

[04.06.21 JUSTICE - ENVIRONNEMENT \(/WEB/20210609024926/HTTPS://WWW.CONTEXTE.COM/JUSTICE-ENVIRONNEMENT/\)](#)

### Why the European Commission is blocking access to environmental justice

[11.10.22 STRATÉGIE EUROPÉENNE DES DONNÉES DE SANTÉ](#)

### Les États membres s'orientent vers une plus grande liberté sur l'espace européen des données de santé

30. The Registered Proprietor has provided the following turnover figures and confirmed these are solely generated by the subscribers as there are no advertising or brand partnership revenues.

Turnover in K Euros				
2018	2019	2020	2021	2022
1,609	2,023	2,807	3,877	+5,000

31. Exhibit JCB12 shows a screenshot of the 'CONTEXTE SCAN' home screen which Mr Boulanger explained was launched in September 2020 and is a 'software for legal monitoring available to all Contexte customers'.

32. Exhibits JCB15 and 16 are promotional materials. They show the mark on the landing pages. However, I note I have not been provided about where this promotional material was used, when it was used, how it was made accessible to consumers and how many consumers would have had access to it further, as the Cancellation Applicant noted in the hearing, these exhibits are undated, as well as the fact they appear to be machine translated.

## **Analysis**

33. The mark, as registered, has been shown on the website (Exhibit JCB9), on the invoices (Exhibit JCB8) and on the promotional material (Exhibits JCB15 &16. I note it is also used on the website alongside other wording such as 'POUVOIRS', 'SCAN' and 'ENERGIE' however, the word 'CONTEXTE' retains an independent distinctive role in the mark and therefore, this is also acceptable use.<sup>2</sup>

34. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the comparable mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. In making this assessment, I am required to consider all relevant factors, including:

- The scale and frequency of the use shown;
- The nature of the use shown;
- The goods and services for which has been shown;
- The nature of those goods/services and the market(s) for them; and
- The geographical extent of the use shown.

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<sup>2</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paras 31-35

35. 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.<sup>3</sup>

36. As noted above, Mr Boulanger has stated that subscription revenues have grown from 1million Euros in 2017 to 5million Euros in 2022. The Registered Proprietor has shown that it has UK readers/subscribers and that these make up 1.46% of their consumers. In reading this alongside Exhibit JCB2, which states that as of October 2022 there were 32 client accounts in the United Kingdom, it gives an idea of the level of subscribers. I note that the Registered Proprietor also have readers/subscribers throughout the EU. 64.14% being in France and 13.91% being in Belgium. The invoices are dated throughout the relevant period.

37. Use of the mark seems mostly to have been on the Registered Proprietor's website as per Exhibit JCB9 and the promotional material. It was also used on the invoices sent to subscribers as shown above.

38. The price point of the subscriptions is not clear. However, I consider that news/current affairs websites generally would have a very widespread consumer base. Subscription models may have a smaller share of those due to the potential for free versions elsewhere.

39. Taking into account all of the above, I am satisfied that the opponent has demonstrated genuine use of its earlier mark during the relevant period. Although the price point isn't clear, there is evidence of sales throughout the relevant period on a subscription basis which is likely to be renewed subscriptions and there is a spread of sales in the UK and the EU.

### **Fair Specification**

40. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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<sup>3</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

41. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular

goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

42. As a reminder, the Registered Proprietor claimed that their evidence would show use of the following goods and services:

Class 9: Downloadable software; electronic publications, downloadable; software for integration of applications and databases.

Class 35: Arranging newspaper subscriptions for others.

Class 38: Computer aided transmission of messages and images; electronic advertising services (telecommunications); news or information agencies; providing access to information held in data banks; transmission by satellite, radio wave, cable, networks, and in particular via the Internet, of sounds, images and data.

Class 41: Publication of electronic books and journals on-line; publication of texts, other than publicity texts; electronic publication of newspapers, magazines and periodicals online or in electronically downloadable format; multimedia publication of books, specialist magazines and newspapers; publishing house services, other than printing.

43. The Registered Proprietor has provided evidence of turnover and customer engagement through paid which I consider amounts to genuine use. In class 9, the contested mark is registered for 'electronic publications, downloadable'. I note the evidence shows that the subscribers have access to Contexte's articles. Mr Boulanger states within his witness statement that the articles from Contexte are electronic and downloadable. Therefore, I consider that they have shown use for this term.

44. Regarding the class 35 service 'arranging newspaper subscriptions for others', whilst the evidence shows that the Registered Proprietor does offer a subscription service, this is a subscription to their own service and not for third parties, as per the Cancellation Applicant's submissions in their skeleton argument, and therefore, they have not used the trade mark for the class 35 service.

45. There is no evidence to suggest that the Registered Proprietor offers 'Computer aided transmission of messages and images; electronic advertising services (telecommunications); providing access to information held in data banks; transmission by satellite, radio wave, cable, networks, and in particular via the Internet, of sounds, images and data' in class 38.

46. I consider that the term 'news or information agencies' would mean an organisation that gathers and compiles news for distribution to others. In this case that news is distributed to its subscribers. The evidence shows that the Registered Proprietor has reporters who write news articles which are then sent to subscribers either in a newsletter or are available to them on the website. I therefore consider that the Registered Proprietor has shown use of this service.

47. I remind myself that for use to be genuine, there must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue. From Mr Boulanger's witness statement, I note he states that the software is "available to all Contexte customers, both in the European Union and United Kingdom". However, I have been given no evidence as to how many of Contexte's customers have made use of the software nor how many of the subscriptions have been made in order to use of the software. Therefore, I cannot say

that they have used the mark to the level required for ‘downloadable software; software for integration of applications and databases’.

48. Throughout the evidence, Mr Boulanger and the exhibits state that Contexte is a news subscription service and that they have “news articles, bulletins and briefs written by Contexte journalists published on our website”. There is no evidence that they publish books, journals or other types of texts nor do they act as a publishing house and therefore, I cannot find that they have proved use of the following services in class 41, namely Publication of electronic books and journals on-line; publication of texts, other than publicity texts; publishing house services, other than printing.

49. Regarding the term ‘electronic publication of newspapers, magazines and periodicals online or in electronically downloadable format’, the screenshots from the website shows that they publish news articles i.e. content of a newspaper and therefore I consider they have shown use for this. Further, I consider that periodicals is a term that would cover newspapers as they are a regular publication and magazines can contain news articles and current affairs articles. I therefore consider it to be fair to allow them to retain this term also.

50. My understanding of ‘multimedia’ within ‘multimedia publication of books, specialist magazines and newspapers’ means that the publications would be distributed in different formats such as audio, video, traditional print and electronically. I have not been provided with any evidence from the parties to assist me any further with that definition. I have only been provided with evidence showing the website availability (i.e. the electronic version) and no other types have been shown. Therefore, I cannot find them to have made use of this terms.

## **Conclusion**

51. The application for revocation has been successful in relation to the following goods and services (including those goods and services for which the Registered Proprietor did not seek to provide evidence for) and the date for revocation will be 1 March 2021:

Class 9: Downloadable software; applications software for mobile telephony apparatus; Software for integration of applications and databases.

Class 16: Printed matter, namely printed publications, Magazines, Newspapers, Periodicals, Newsletters, Diagrams, Books and manuals.

Class 35: Advertising management; Arranging newspaper subscriptions for others; Business information; Dissemination of advertising matter; Compilation of statistics; Market studies; Opinion poll; Computerised file management; Exhibitions for commercial or advertising purposes; Collection and systematic ordering of data in a central file; Sales promotion for others.

Class 38: Computer aided transmission of messages and images; Communications by computer terminals or by fibre optic networks; Electronic advertising services (telecommunications); Providing Internet chat rooms; Providing access to information held in data banks; Broadcasting of audio-visual and radio programmes; Transmission by satellite, radio wave, cable, networks, and in particular via the Internet, of sound, images and data.

Class 41: Arranging and conducting of colloquiums, lectures or congresses; Publication of electronic books and journals on-line; Publication of texts, other than publicity texts; Multimedia publication of books, specialist magazines and newspapers; Publishing house services, other than printing; Production of radio programmes and Audio-visual.

52. I consider that the Registered Proprietor has shown genuine use for the following goods and services and therefore, retain their registration for the same:

Class 9: Electronic publications, downloadable;

Class 38: News or information agencies

Class 41: Electronic publication of newspapers, magazines and periodicals online or in electronically downloadable format

## Costs

53. The Cancellation Applicant has been largely successful and is therefore entitled to a contribution to its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the Cancellation Applicant the sum of £1750. The sum is calculated as follows:

Official fee	£200
Preparing application for revocation and considering the other side's statement	£350
Preparing evidence and considering and Commenting on the other side's evidence	£500
Preparing for and attending a hearing	£700
<b>Total</b>	<b>£1750</b>

54. I therefore order CONTEXTE to pay Thomson Reuters Foundation, LLC the sum of £1750. The above sum should 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 28<sup>th</sup> day of August 2024**

**L Nicholas**  
**For the Registrar**