BL O/0883/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK4071413
IN THE NAME OF THE INSTITUTE OF PODIATRISTS
FOR THE FOLLOWING TRADE MARK:

IN CLASSES 35, 41, 44 AND 45

AND

IN THE MATTER OF FAST TRACK OPPOSITION THERETO
UNDER NO. 600003438 BY
THE SMAE INSTITUTE (1919) LIMITED

BACKGROUND AND PLEADINGS

1. On 3 July 2024, The Institute of Podiatrists ("the applicant") filed an application for the trade mark shown on the cover page of this decision ("the contested mark") in the UK. The trade mark was published for opposition purposes on 19 July 2024 and registration is sought for the services set out in Annex 1 to this decision.

2. On 4 September 2024, the application was partially opposed under the fast track opposition procedure by The SMAE Institute (1919) Limited ("the opponent"), based upon section 5(2)(b) of the Trade Marks Act ("the Act").[1]

3. The opponent relies on its earlier UK trade mark (UKTM) number 3287986, 'Open College of Foot Health' ("the earlier mark"), which has a filing date of 6 February 2018 and a registration date of 18 May 2018. The opponent relies upon all goods for which the mark is registered, as set out in Annex 2 to this decision. The opponent claims that the word elements in the marks are the same and that the goods and services at issue are similar, with the result that there is a likelihood of confusion.

4. The applicant filed a counterstatement admitting that the respective marks contain the same words 'College of Foot Health' but denied that there exists a likelihood of confusion between the marks on the basis that the goods and services are not similar. The applicant puts the opponent to proof of use of the earlier mark.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that rule 20(4) shall continue to apply. Rule 20(4) states that:

> "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

[1] 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. See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

6. The net effect of the above is to require parties to seek leave in order to file evidence in fast-track oppositions. This would apply to evidence, which is filed later in the proceedings, and therefore would not include evidence of use which is required to be filed alongside the notice of opposition (Form TM7F). The opponent filed evidence within their Form TM7F and at a later date, also sought leave to file additional evidence. However, this request was refused by the Tribunal.

7. Rule 62(5) (as amended) states that arguments in fast-track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate costs; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary.

8. The applicant is represented by Novagraaf UK and the opponent is represented by GA Solicitors.

EVIDENCE AND SUBMISSIONS

9. As noted above, the opponent filed evidence of use with its Form TM7F, this took the form of seven exhibits (Exhibits 1 to 7). A summary of the evidence is as follows:

- Exhibit 1 – Certificate of filing of the earlier mark, issued by the UK IPO
- Exhibit 2 – Brochure extract
- Exhibit 3 – Membership letter for the professional body of the opponent
- Exhibit 4 – Extract from the opponent's 'Rule Book'
- Exhibit 5 – Certificate
- Exhibit 6 – Brochure extract
- Exhibit 7 – Table containing data relating to new members[2]

10. Both parties filed written submissions dated 6 March 2025.

[2] In its amended form TM7F, filed on 4 October 2024, the opponent made a request for Exhibit 7 to be kept confidential. However, following a request from the Tribunal for the opponent to provide reasoning for their request, the opponent confirmed that they no longer wished to keep Exhibit 7 confidential.

11. I have taken the evidence and submissions into account in reaching this decision and will refer to them below, where necessary. This decision is taken following a careful perusal of the papers.

DECISION

Section 5(2)(b)

12. Sections 5(2)(b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because-
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

13. Section 5A of the Act is as follows:

> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

14. Given its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had completed its registration process more than 5 years before the filing date of the application in issue, it is subject to the use provisions in section 6A of the Act.

Proof of use

15. I will begin by assessing whether there has been genuine use of the earlier mark in relation to the registered goods relied upon. 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."

16. The relevant period for assessing genuine use is the five-year period ending with the filing date of the application, i.e. 4 July 2019 to 3 July 2024.

17. Section 100 of the Act 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."

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

19. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax*

Brandbeveiliging BV [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR 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 services. For example, use of the mark by a single client which imports the relevant services 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]."

20. 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.

21. 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:[3]

"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

[3] Case BL O/230/13

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:

"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."

22. I also note Mr Alexander's comments in *Guccio Gucci SPA v Gerry Weber International AG*.[4] 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,

[4] Case BL O/424/14

if more reliable) “use it – and file the best evidence first time round – or lose it”.”

23. 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.[5] He stated that:

> “21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:
>
> > [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.
>
> 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100

[5] Case BL O/404/13

of the Act) with regard to the actuality of use in relation to services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

24. 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

25. 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 or an acceptable variant. 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".

26. The opponent's registration is for the word mark 'Open College of Foot Health'. I note that the opponent's mark, as registered, has not been used in its evidence, but rather in the following variations:

1) 'Open College of Foot Health Professionals'[6]

2) 'Open College'[7]

[6] Exhibits 2,3,6
[7] Exhibits 2,6

3) 

[8]

4) 

[9]

27. 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, 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.[10]

28. However, I find that in terms of the goods at issue, the addition of the word 'Professionals' to the registered mark 'Open College of Foot Health' would be perceived as an additional element that alters the distinctive character of the registration. This is because the meaning of the mark is changed from a college concerned with foot health generally, to a college for professionals concerned with foot health. Likewise, the omission of certain elements of the earlier mark, namely 'of Foot Health' in mark 2 above, also alters the distinctive character of the earlier mark. Again, this is because it changes the meaning of the mark as a whole from a college with a specific purpose, to one which is of ambiguous focus. Consequently, I am of the view that the opponent cannot rely upon the use of any of the above marks as use of the earlier mark.

29. Additionally, I note that Exhibit 4 of the opponent's evidence contains the title, 'Member of the Open College of Foot Health Professionals'. This does not appear to be trade mark use, or variant use of the earlier mark, but rather it appears to be a title that the opponent's members can use in order to designate that they belong to their association. As such, it cannot be relied upon to demonstrate use of the earlier mark.

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[8] Exhibit 3
[9] Exhibit 5
[10] *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12

30. Accordingly, as the opponent has failed to show any use or variant use of the mark relied upon in its evidence, the opposition must fail. However, in the event that I am wrong in this finding, I will now go on to consider the merits of the proof of use evidence, on the basis that the marks shown above constitute acceptable variant use of the earlier mark, upon which the opponent can rely, as that represents the opponent's best case.

Use of the mark

31. 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.

32. 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.[11] As indicated in the case law above, use does not need to be quantitively significant to be genuine.

33. The opponent claims to have used its earlier mark, 'Open College of Foot Health', during the relevant period, in relation to all the goods relied upon, namely:

Class 3 Non-medicated preparations and substances for topical application; non-medicated preparations and substances for topical application all for the treatment of hands and/or feet; non-medicated cream, lotion, gel, powder, oil and balm for topical application; non-medicated soap.

Class 5 Pharmaceutical and sanitary preparations and substances for topical application; pharmaceutical and sanitary preparations and substances for topical application all for treatment of hands and/or feet; medicated preparations and

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

substances for topical application; medicated cream, lotion, gel, powder, oil and balm for topical application; medicated soap.

34. In its counterstatement, the applicant criticises the opponent's evidence as follows:

> "The Applicant must deny that the Earlier Mark has been put to genuine use in relation to the goods for which use is claimed on the Form TM7F. For example:
>
> Exhibit 1 - this is not evidence of use of the Earlier Mark on the Opponent's Goods. It is therefore denied that this exhibit provides evidence of use of the Earlier Mark for the Opponent's Goods.
>
> Exhibit 2 - the trade marks used here are "The Journal of Podiatric Medicine", "The SMAE Institute", and the "British Association of Foot Health Professionals (BAFHP) with BAFHP logo" all for educational services and not the Opponent's Goods - the only mention of the Earlier Mark is as highlighted in the exhibit and this does not constitute evidence of use of the Earlier Mark on the Opponent's Goods. It is therefore denied that this exhibit provides evidence of use of the Earlier Mark for the Opponent's Goods.
>
> Exhibit 3 - this is a covering letter relating to a diploma (education service) which is dated 2018 (outside the relevant period) and the banner is not for the Earlier Mark (mark as registered) but for "The OPEN COLLEGE of FOOT HEALTH PROFESSIONALS". It is therefore denied that this exhibit provides evidence of use of the Earlier Mark for the Opponent's Goods.
>
> Exhibit 4 - this appears to relate to rules of membership of an association service. The highlighted wording is supposed to show use of the Earlier Mark, yet this is not the mark as registered but instead "The Open College Of Foot Health Professionals". It is therefore denied that this exhibit provides evidence of use of the Earlier Mark for the Opponent's Goods.
>
> Exhibit 5 - this is a training certificate linked to training or education services. It is titled "THE OPEN COLLEGE OF FOOT HEALTH PROFESSIONALS", so not

the Earlier Mark, nor for the Opponent's Goods. It is therefore denied that this exhibit provides evidence of use of the Earlier Mark for the Opponent's Goods.

Exhibit 6 - this brochure of the Opponent is not dated and relates to journal subscription and educational services. The words "Open College of Foot Health Professionals" are highlighted but it is not clear who this relates to, and this is also not the Earlier Mark and this exhibit is not for or linked to the Opponent's Goods. The only other mark (under the crest of the Opponent's company name) is "The Original Foot Health Institute" and that too is not the Earlier Mark. It is therefore denied that this exhibit provides evidence of use of the Earlier Mark for the Opponent's Goods.

Exhibit 6 [sic[12]] - it is not clear but this does not appear to be any reliable evidence of sales of the Opponent's Goods. It is therefore denied that this exhibit provides evidence of use of the Earlier Mark for the Opponent's Goods."

35. It is noted that Exhibit 1 contains a certificate of filing issued by the UK IPO, in relation to the opponent's earlier mark 'Open College of Foot Health'. However, this certificate merely shows that the opponent filed an application for its mark, it does not show that the mark has been used in the UK, during the relevant period, and in relation to the goods relied upon.

36. With regards to Exhibit 2, the opponent states that this relates to a brochure concerning membership with the professional body of the opponent. However, it is unclear what brochure the one-page extract has been retrieved from, nor is the exhibit dated. The extract provides information regarding 'The journal of Podiatric Medicine' and the 'British association of Foot Health Professionals'. There is no mention of the goods relied upon. Furthermore, it is not possible to discern who the brochure was made available to, and when it was made available.

37. The opponent submits that Exhibit 3 contains a membership letter for the professional body of the opponent. However, it is not clear who the intended recipient

[12] Exhibit 7

of the letter is, nor is there any mention of the earlier mark being used in relation to the goods relied upon. Furthermore, whilst I note that the exhibit is dated 6 July 2018, this is outside the relevant period.

38. The opponent states that Exhibit 4 relates to an extract taken from their 'Rule Book'. However, there is no mention of the opponent in the exhibit, or the goods relied upon. Furthermore, it is not possible to discern who the 'Rule Book' was made available to, and when it was made available. It is noted that the opponent has highlighted a section of the 'Rule Book' text, titled 'Entitlements of Membership', as the following shows:

Entitlements of Membership

7. Subject to continuing as a full member of the Association in the category to which he was admitted, the member shall be permitted for the continuance of such full membership to use the designation **M C F H P** (Member of the Open College of Foot Health Professionals) **M A F H P** (Member of The British Association of Foot Health Professionals). In any event the use of such designation is subject to the overriding discretion of the Principal to revoke or otherwise vary any such permission to use such designation.

39. Exhibit 5 comprises a blank certificate from 'The Open College of Foot Health Professionals'. From the certificate it can be ascertained that it is awarded to participants upon completion of training. The certificate includes the following information:

THE OPEN COLLEGE OF
FOOT HEALTH PROFESSIONALS

The Smae Institute (1919) Ltd

THIS CERTIFICATE IS AWARDED TO

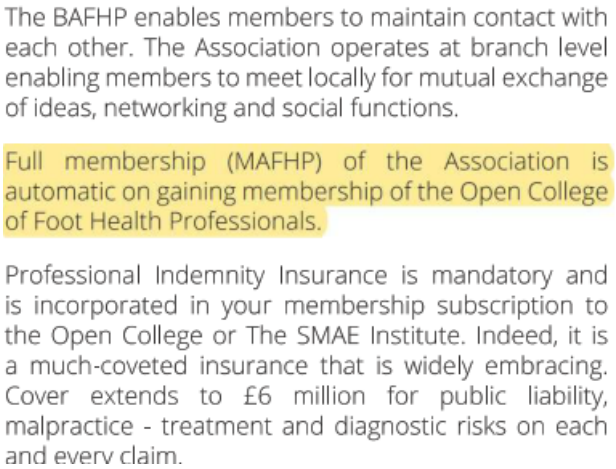
who having completed training in both the theory and practice of Foot Health and having attained a degree of proficiency deemed necessary by the Examiners is now admitted as a Member of the College of Foot Health Professionals & the Association and hereafter entitled to display the distinguishing letters ***MCFHP MAFHP*** as proof thereof.

Given under the seal of the College

40. As can be seen from the above, there is no reference to the goods relied upon by the opponent.

41. The opponent states that Exhibit 6 relates to a brochure, however no further details in this regard have been provided. I note that the undated exhibit comprises three

pages which appear to originate from the opponent, 'THE SMAE INSTITUTE – 'The Original Foot Health Institute'. The exhibit features an article titled 'Celebrating 100 years of Training to Excellence', 'Foot Health as a Profession', and includes information regarding 'The Journal of Podiatric Medicine' and 'British Association of Foot Health Professionals'. The opponent's earlier mark does not feature, nor do any of their goods relied upon. Furthermore, it is not possible to identify who the brochure was made available to, and when it was made available. It is noted that the opponent has highlighted the following text within the exhibit:



The BAFHP enables members to maintain contact with each other. The Association operates at branch level enabling members to meet locally for mutual exchange of ideas, networking and social functions.

Full membership (MAFHP) of the Association is automatic on gaining membership of the Open College of Foot Health Professionals.

Professional Indemnity Insurance is mandatory and is incorporated in your membership subscription to the Open College or The SMAE Institute. Indeed, it is a much-coveted insurance that is widely embracing. Cover extends to £6 million for public liability, malpractice - treatment and diagnostic risks on each and every claim.

42. With regards to Exhibit 7, whilst the opponent has not provided any details regarding its contents or its relevance, I note that the exhibit comprises of the following table, showing the 'Number of new members joining':

Timeframe	Number of new members joining
May – Dec 2018	146
2019	221
2020 (Covid)	86
2021	183
2022	211
2023	191
Jan – August 2024	131
TOTAL	**1168**

43. Whilst it is noted that the dates shown in the table fall within the relevant period, it is not clear from the table whether the 'new members' are individuals, businesses or organisations, etc., whether they are based within the UK, and what exactly the 'new members' are joining.

Genuine use

44. It is clear from the case law above that the onus is on the opponent to show that it has used its trade mark in the relevant period in relation to the goods for which the mark is registered. It is also clear that no particular documents are required for that purpose. However, in the present case, the difficulty for the opponent is that it has filed very few documents, only seven exhibits in total, one of which merely shows the filing details of the mark.

45. Furthermore, it is not apparent from the evidence before me whether the opponent has used its earlier mark in the UK, during the relevant period, in relation to any of the class 3 and 5 goods relied upon in this opposition. The evidence is undated, other than exhibit 3 which is dated outside the relevant period, and the table produced in Exhibit 7, which whilst it relates to dates within the relevant period, I am not able to discern with any accuracy what this information is intended to demonstrate. Additionally, I have not been provided with any invoices or turnover figures in relation to the sale of the goods at issue, nor do I have any evidence or figures relating to the promotion of the goods at issue under the 'Open College of Foot Health' mark.

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. If the mark had been put to genuine use on the goods relied upon, within the relevant period, then it should not have been a difficult matter for the opponent to show it. However, it did not.

CONCLUSION

47. The opponent has failed to establish genuine use of its earlier mark within the relevant period. Where the proof of use provisions apply, an opponent cannot rely on its earlier mark unless those provisions are satisfied. Consequently, as the opponent

has not proved use of its mark, it cannot rely on its earlier mark for the purpose of this opposition. Accordingly, the opposition under section 5(2)(b) fails at the first hurdle and is dismissed accordingly. Subject to appeal, the application will proceed to registration for the full list of services applied for.

COSTS

48. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice (TPN) 1/2023. For fast track opposition proceedings, costs are capped at £600. In the circumstances, I award the applicant the sum of £600, calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£250
Considering the other side's evidence/ submissions, and preparing written submissions	£350
Total	**£600**

49. I therefore order The SMAE Institute (1919) Limited, to pay The Institute of Podiatrists the sum of £600. 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 24th day of September 2025

Sam Congreve
For the Registrar

ANNEX 1

Class 35 Association services, namely, the promotion and provision of career information and the promotion professional standards, all in respect of chiropody and chiropodists, podiatry and podiatrists, foot health and foot health practitioners, and the care and treatment of the feet; promotion of chiropody and chiropodists, podiatry and podiatrists, foot health and foot health practitioners, and the care and treatment of the feet; compilation and provision of directories, databases and registers, including in online searchable format, in relation to chiropodists, podiatrists and foot health practitioners; business administration services, namely, membership services, including application and subscription services and member accreditation services, and the maintenance of candidate and member records in relation to training, examinations and other forms of assessment, all in relation to chiropodists, podiatrists and foot health practitioners; retail services, electronic shopping services and online retail store services, all connected with the sale of hand tools for chiropody and chiropodists, for podiatry and podiatrists, for foot health and foot health practitioners and for the care and treatment of the feet; retail services, electronic shopping services and online retail store services, all connected with the sale of nail nippers, cuticle nippers, paper coverings for couches (couch rolls), disposable aprons, disposable gloves, hygienic hand rub, pen lights, fob watches and surgical masks; retail services, electronic shopping services and online retail store services, all connected with the sale of printed matter, printed publications, books, periodical publications, magazines and journals, stationery, note pads, writing instruments, pens, instructional and teaching materials, brochures, handbooks, leaflets, pamphlets, bags, briefcases, mugs, clothing, sweatshirts, cardigans, footwear, shoes, work shoes, work wear and tunics.

Class 41 Education, examination and training services; provision of educational and training courses; educational and training examination services; organising, arranging and conducting of conferences, exhibitions, lectures, seminars, workshops, symposia and colloquia; all the aforesaid services relating to chiropody and chiropodists, podiatry and podiatrists, foot health and foot health practitioners, and the care and treatment of the feet; information, advisory and consultancy services relating to the aforesaid services.

Class 44 Chiropody; medical services; information, advisory and consultation services in relation to chiropody and chiropodists, podiatry and podiatrists, foot health and foot health practitioners and the care and treatment of the feet.

Class 45 Professional institute services, namely, professional, legal and research services relating to chiropody and chiropodists, podiatry and podiatrists, foot health and foot health practitioners; membership services, professional representation, campaigning and lobbying on behalf of the medical, chiropody and podiatry professions; representation of the medical, chiropody and podiatry professions in policy discussions regarding national healthcare and medical issues; legal information and advice services; formulating and promulgating policies and providing guidance on ethical issues in the fields of medicine and medical practice and healthcare and chiropody and podiatry; formulation, presentation and discussion of strategies and policy affecting the medical profession and public health issues; providing and arranging legal representation in employment disputes; legal consultancy services in the field of employment; legal and professional consultancy services in the field of medical ethics; consultancy and information relating to all the aforesaid services.

ANNEX 2

Class 3 Non-medicated preparations and substances for topical application; non-medicated preparations and substances for topical application all for the treatment of hands and/or feet; non-medicated cream, lotion, gel, powder, oil and balm for topical application; non-medicated soap.

Class 5 Pharmaceutical and sanitary preparations and substances for topical application; pharmaceutical and sanitary preparations and substances for topical application all for treatment of hands and/or feet; medicated preparations and substances for topical application; medicated cream, lotion, gel, powder, oil and balm for topical application; medicated soap.