

O/0920/24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3841670
BY NEST COMMUNICATION SAS
TO REGISTER:**



AS A TRADE MARK IN CLASSES 16, 35, 41 AND 42

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 440000
BY NEST ONE GMBH**

BACKGROUND AND PLEADINGS

1. On 21 October 2022, NEST COMMUNICATION SAS (“the applicant”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK. The application was published for opposition purposes on 6 January 2023. Registration is sought for goods and services in Classes 16, 35, 41 and 42 (see annex for the full list of goods and services).

2. On 29 March 2023, the application was opposed by NEST one GmbH (“the opponent”), based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at all the goods and services in the application.

3. The opponent relies upon its comparable UK trade mark number 909237355,¹ ‘NEST one’ (“the earlier mark”), which has a filing date of 9 July 2010 and a registration date of 24 December 2010. For the purpose of these proceedings the opponent relies on all the services in classes 35, 38, 41, 42 and 43 for which the mark is registered (see annex for the full list of services).

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

5. The opponent claims that the marks at issue are highly similar to each other and that the respective goods and services are highly similar. As a result, the opponent claims that there exists a likelihood of confusion on the part of the average consumer.

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

¹ The opponent’s comparable mark is based on an earlier EUTM. 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 and IRs designating the EU.

7. The opponent is represented by IRLE MOSER RECHTSANWÄLTE PARTG and the applicant is represented by Wynne-Jones IP Limited. Only the opponent filed evidence and, in doing so, also filed written submissions. Both parties were given the option of an oral hearing but neither requested to be heard on this matter, nor did they file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers.

EVIDENCE

8. The opponent's evidence came in the form of the witness statement of Lars Debbert, dated 8 November 2023. Mr Debbert is the Managing Director of the opponent, a position he has held since 2013. Mr Debbert's statement is accompanied by three exhibits, labelled Exhibit 1 to Exhibit 3. The evidence has been adduced to prove the use that has been made of the earlier mark.

9. It is noted that the opponent's written submissions² contained a request for the evidence to be kept confidential. However, following a request from the Tribunal for the opponent to provide reasoning for their request, the opponent confirmed that the confidentiality request had been erroneously included in their submissions and should therefore be ignored.

10. Whilst I do not intend to summarise the evidence or submissions here, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary in the course of this decision.

DECISION

Relevance of EU law

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained

² Dated 8 November 2023.

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.

Proof of use

12. I will begin by assessing whether, and to what extent, the evidence supports the opponent's statement that it has made genuine use of its earlier mark in relation to the registered services relied upon. The relevant period for this purpose is the five year period ending with the date of the application in issue, namely 22 October 2017 to 21 October 2022.

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

14. Section 6A is also relevant. It reads:

“(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.”

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

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. As the opponent’s mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) 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 section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

17. As previously stated, given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions.

18. Consequently, the onus is upon the opponent to prove that genuine use of the earlier mark was made within the relevant territory in the relevant period, and in respect of the relevant services 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 Court of Justice of the European Union (“CJEU”) in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v 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. 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].”

20. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”³ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

21. As the opponent’s mark is a comparable mark based upon an earlier EUTM, use of the same in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment.⁴ As a result, the relevant territory between 22 October 2017 and 31 December 2020 is the EU (which includes the UK as, at that time, it was a Member State) and between 1 January 2021 and 21 October 2022, the relevant territory is the UK only. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union (“CJEU”) noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade

³ *Jumpman* BL O/222/16

⁴ See paragraph 4 of Tribunal Practice Notice 2/2020

mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

22. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the services 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 services for which use has been shown;
- iv) The nature of those services and the market(s) for them; and
- v) The geographical extent of the use shown.

23. 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:⁵

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken,

⁵ Case BL O/230/13

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.”

24. I also note Mr Alexander’s comments in *Guccio Gucci SPA v Gerry Weber International AG*.⁶ Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition actions. He stated:

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

⁶ Case BL O/424/14

25. 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.⁷ 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 of the Act) with regard to the actuality of use in relation to goods covered by the registration. The evidence in question can properly be assessed for

⁷ Case BL O/404/13

sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

26. 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.

27. 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 services at issue, in the relevant territory, during the relevant five-year period.

Assessment of proof of use

28. I remind myself that 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.⁸

29. In his witness statement, Mr Debbert states that the opponent’s company has used the mark ‘NEST one’ since 2010 in relation to all the registered services (see annex for the full list of services).

30. Mr Debbert states that turnover figures covering a three year period between 2018 and 2020, are as follows:

2018	3.586.888,67
2019	6.028.812,77
2020	3.841.087,87

31. Whilst the above figures, shown in euros, are significant, it is noted that these figures are not supported by any invoices, nor has Mr Debbert provided a breakdown of these figures or supplementary evidence that would enable me to apportion any

⁸ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

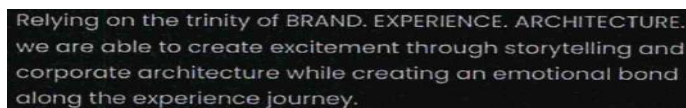
volume of sales to any particular service in Classes 35, 38, 41, 42 and 43. Furthermore, neither the witness statement nor the exhibits provide information regarding the approximate cost of the services at issue. Therefore, despite the opponent's claims in its statement of grounds and the claims made by Mr Debbert in his witness statement that the earlier mark has been used on each of the services relied upon, I am unable to establish, with any certainty, what services the above figures relate to, and where and to who those services were provided.

32. With regards to exhibit 1, in his witness statement, Mr Debbert submits that the 38 pages of screenshots taken from 'The Wayback Machine', (a digital archive website) demonstrate the publicity of the opponent, the services they offer, the clients they work for, and the projects they have been involved in.

33. The Wayback Machine screenshots are taken from the opponent's website 'www.nest-one.com' and are dated between 2018 and 2021, which is within the relevant period. The earlier mark 'Nest one' features throughout the exhibit. However, it is noted that the text contained in 18 of the 38 pages of the exhibit is in German without any accompanying translations and therefore in terms of these pages, it is not possible to establish what use is being demonstrated.

34. Throughout the exhibit the statement 'WE CREATE EXCITEMENT THROUGH BRAND. EXPERIENCE. ARCHITECTURE.' can be seen. Furthermore, the following statements about the opponent are present on some of the screenshots:

Page 3 of exhibit 1:



Relying on the trinity of BRAND. EXPERIENCE. ARCHITECTURE. we are able to create excitement through storytelling and corporate architecture while creating an emotional bond along the experience journey.

Page 8 of exhibit 1:



ABOUT US
We are an owner-managed communications agency that utilizes the three core principles of BRAND, EXPERIENCE and ARCHITECTURE to create unique brand spaces.

Page 9 of exhibit 1:

WE CREATE BRAND SPACES THAT EXCITE
We provide the full range of services as a strategic and creative agency through our interdisciplinary team and international network.

We believe that true excitement determines the value of brands and that people can only get excited about something if they can experience it with all their senses.

Page 10 of exhibit 1:

OUR HISTORY
In 2002, we staged a new urban, live experience format – Rangavilas – in the middle of an abandoned industrial area on the banks of the Elbe River in Hamburg. It marked the birth of a new city quarter now called "HafenCity", and it was the launch of our mission: to transform ideas and messages into emotional spaces of experiences.

Page 11 of exhibit 1:

NEST ONE was born out of this excitement.



INSPIRING EXPERIENCES REQUIRE ENTHUSIASTIC MINDS

For the past 20 years NEST ONE develops and produces successfully emotional brand experiences in space. At the location Hamburg architects, interior designers, communication and product designers, strategists, conceptioners, consultants, editors and scenographers engage themselves for customized solutions.

35. With regard to the opponent's clients, a number of brands are mentioned in the screenshots, such as Porsche, VW, NIVEA, Hyundai, and Mercedes-Benz, etc. However, whilst it is clear from the screenshots that the opponent's mark is being used in some capacity, I find that the website screenshots, which mainly consist of images, lack sufficient context and detail, and therefore I am not able to ascertain with any accuracy what services are actually being provided and/ or demonstrated. Further, I am unable to establish how many consumers viewed the webpages and the geographical location of such viewers, on the basis that the opponent has not provided any such data.

36. In his witness statement Mr Debbert states that exhibit 2 demonstrates a variety of projects that the opponent has been involved with, whilst offering the respective services relied upon. The exhibit consists of 66 pages. Each page contains the footnotes 'NEST ONE' and 'AGENCY PRESENTATION'.

37. The following statement is found on page 3 of the presentation:

**NEST ONE
BRAND. EXPERIENCE. ARCHITECTURE.**

WE PRESENT BRANDS AS A SPATIAL EXPERIENCE.

RELYING ON THE TRINITY OF **BRAND. EXPERIENCE. ARCHITECTURE** WE ARE ABLE TO INSPIRE THROUGH **STORYTELLING** AND **CORPORATE ARCHITECTURE** WHILE CREATING AN EMOTIONAL BOND ALONG THE **EXPERIENCE JOURNEY**. HERE WE THINK CONSEQUENTLY FROM THE LOGIC OF A CONVERGENCE OF **REAL AND DIGITAL**.

WE PROVIDE THE FULL RANGE OF SERVICES AS A STRATEGIC AND CREATIVE AGENCY THROUGH OUR INTERDISCIPLINARY TEAM AND NETWORK.

NEST ONE

AGENCY PRESENTATION

38. It is clear from the exhibit that the opponent has worked with various clients, such as, Porsche, Hyundai, Volkswagen, Radinn, and Nivea. In terms of these clients the presentation states that the following services were provided by the opponent:

Concept development, visitor journey, content development and curation, content developing and editing, content production, experience architecture, interactive exhibits, interaction, interactive and communication design, project management, planning and implementation, planning and consulting, interior design, content training for employees, creative lead, development, conception, creation, planning and implementation, concept, Architectural design, Implementation planning of the exhibition stand, development and implementation of interactive exhibit (kaleidoscope installation), Onsite management & coordination, Project management; Strategy, Communication concept, content production, architectural concept, planning and execution, implementation of content, project management, event conception, F&B concept, event and process management; Concept development, customer journey, content development and curation, experience architecture, interactive exhibits, interactive and communication design, project management, planning and implementation, concept development, customer journey, stand architecture, communication design, strategy development, concept development, CI and branding, customer journey, content strategy and curation, event planning and implementation, interactive and communication design, partner and sponsoring relations, development of an editorial concept and a magazine structure within the framework of the overriding leadership campaign, strategy consulting, concept development, structure development and evolution, content strategy, topic scouting and definition, assignment

and content editing, line editing and translation, video and photo production, project management, guideline creation (interior design, customer experience), event management, social-media services and PR and marketing.

39. However, whilst the inclusion of the above services in the agency presentation is noted, it is not clear how these services relate to the range of services relied on by the opponent in these proceedings, namely those listed in Classes 35, 38, 41, 42 and 43 (see annex for the full list of services). Further, the opponent has not provided any context with regards the above list of services, other than the comment made by Mr Debbert in his witness statement that the exhibit '*demonstrates a variety of projects that the opponent has been involved with, whilst offering the respective services relied upon*'. As such, I find it difficult to establish with any certainty, which, if any, of the services relied upon are being demonstrated in the exhibit. In addition, there is no indication as to the cost of the services, nor can it be established where in the relevant territory the services were provided.

40. It is noted that the 66 page 'agency presentation' was produced in Hamburg, Germany, and is dated 31 August 2023. Whilst this date falls outside the relevant period, the contents of the presentation relate to projects carried out by the opponent within the relevant period. However, with regards to the presentation, whilst I am able to establish that it was published in Hamburg in 2023, it is not possible to discern who the presentation was made available to, and where it was made available.

41. With regard to exhibit 3, Mr Debbert states that it shows, as an example, the August issue of a trend report, which the opponent has published monthly for the last ten years, which summarises the latest developments in brand building and marketing. The report is titled 'TRENDREPORT AUGUST 2023 HAMBURG' and features the following reports:

- 'THE TOWER OF THE FUTURE' – which relates to the British architectural firm Zaha Hadid Architects and their unveiling of their design for the Daxia Tower in China.

- ‘A MOTORCYCLE TEST RIDE IN THE METAVERSE’ - which relates to German carmaker BMW’s motorcycle division who in collaboration with digital agency Lobeco have ventured into Web 3.0 and built a world on ‘Spatial’ in order to launch its new model, the BMW CE 02., BMW unveiling BMW Motorrad Meta Ride.
- ‘PAYING WITH THE PALM OF YOUR HAND’ – which relates to online retailer Amazon and their plans to bring their Amazon One payment system, (which features biometric identification that allows shoppers to use the palms of their hand for authentication and payment), to all its Whole Foods stores in the U.S. by the end of the year.
- ‘THE MAGIC WINDOW FOR TRANSLATING’ – which relates to the Japanese printing company Toppan who have developed an innovative voice translation system called VoiceBiz UC, and have already installed it at the Seibu-Shinjuku railway station in Tokyo.
- ‘AUTHENTIC REACTIONS IN ADVERTISING’ – which relates to the American fast food company McDonald’s who have conducted an innovative advertising campaign in the UK involving the recording of real-time reactions of customers and have displayed these reactions on digital advertising boards. The campaign, called “A second of happiness,” was specifically developed to promote the delivery service and relied on cameras hidden in the caps worn by delivery people.
- ‘YOUR BURRITO TWIN’ – which relates to the U.S. fast-food chain Chipotle who have launched an email campaign allowing customers to meet their “Food Twins”. Called “Doppelgänger” in the U.S. The campaign is based on the concept that each person chooses a dish at Chipotle that suits their individual tastes and preferences – and that no matter how unique a Chipotle order may seem, somewhere out there, someone else is ordering the exact same thing.

- ‘LUXURY FASHION GOES TO MARS’ – which relates to the Belgian artist Job Smeets, who decorated the display windows of French luxury fashion brand Hermès with characters celebrating the “dystopian” summer. The window installations, called “Life on Mars,” can be admired in Hermès stores across France.
- ‘SHOES MADE OF BANANA PEELS’ – which relate to the Swiss startup Kuori who has produced alternative plastics, and shoes, from food waste. The report states that industrial designer Sarah Harbarth developed the concept for the cleantech startup while studying at the School of Art and Design at the University of Applied Sciences Northwestern Switzerland (FHNW) in Basel and at the Berlin University of the Arts.
- ‘CONCRETE THAT CAN STORE ENERGY’ – which relates to engineers at the Massachusetts Institute of Technology (MIT) in the U.S., who have developed a form of concrete that could serve as a battery in the future, meaning that new buildings could theoretically also be used as energy storage units.
- ‘AI DESIGNS PLATES FROM WASTE’ – which relates to Space10, a Copenhagen-based research and design lab (that works closely with IKEA, and London-based product design studio Oio), who have created “Products of Place,” a speculative plate series based on hyperlocal design. The designers used the text-based AI chat tool ChatGPT to find and use the most common materials in a given location. These materials then became the basis for plates that the image-based AI tool Midjourney designed.

42. Whilst it is noted that the opponent produced and published the report, none of the reports (as listed above) feature the opponent or the earlier mark, but rather, the reports merely showcase the latest developments in brand building and marketing, etc.

43. Further, the ‘TRENDREPORT’ is dated ‘August 2023’, which is outside the relevant period. Additionally, whilst I note that the ‘TRENDREPORT’ was produced in

Hamburg, it is not possible to ascertain from the evidence I have before me, who the report was made available to, and where and how it was made available. Accordingly, as the evidence contained in the exhibit makes no reference to the mark relied upon, I fail to see how it is of any assistance to the opponent's case. Even ignoring this issue, there is nothing to suggest how this evidence translates to actual use of the trade mark 'NEST one' in respect of the services at issue in the relevant territory and during the relevant period.

Conclusions on use

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

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

46. The yearly turnover figures provided for 2018, 2019 and 2020, have not been supported by any invoices, nor has the opponent attempted to indicate how much of its overall sales relate to the wide-ranging services relied upon in these proceedings, which have very different natures and fall within different classes. Further, there is nothing before me that points to any promotional activity undertaken or any advertising expenditure incurred by the opponent. While such evidence is commonly of assistance in proving genuine use of a trade mark, the lack of such evidence is not necessarily fatal to such a claim. However, in the present case, I find that the supporting evidence of the opponent lacks anything upon which I can pin a solid finding of genuine use. On this point, I remind myself of the pertinent points of Mr Daniel Alexander Q.C. (as he then was), in *Awareness Limited v Plymouth City Council*, Case BL O/236/13 ("*Plymouth Life*"), (see paragraph 22 above).

47. I find the evidence contained in the three exhibits sparse and shows very little use of the earlier mark 'NEST one' and I am not able to establish from this evidence who the target audience was and whether that audience was based in the relevant territory,

namely the EU and the UK. As such, I am unable to determine with any accuracy, the level of use associated with these services which is a significant issue.

48. 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 services for which use is claimed in the relevant territory, during the relevant period. Put simply, the nature of the evidence and the issues discussed throughout my assessment of the same, do not, in my view allow me to make the reasonable inferences necessary in order to find in favour of the opponent.

49. Case law does not specify particular types of documentation that must be adduced in evidence. When considering the evidence, I am 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”: (see *PLYMOUTH LIFE CENTRE*, BL O/236/13, paragraph 22).

Conclusion

50. 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 purposes of this opposition. Accordingly, the opposition under Section 5(2)(b) of the Act falls at the first hurdle and is dismissed accordingly. Subject to appeal, the application will proceed to registration for the full range of goods and services applied for.

Costs

51. The applicant has been successful and is therefore entitled to a contribution towards its costs based upon the scale set out in Tribunal Practice Notice (“TPN”)

1/2023. Applying the guidance in that TPN, I award the applicant the sum of £550, calculated as follows:

Considering the notice of opposition and preparing the counterstatement	£250
Considering the other side's evidence and written submissions	£300
Total	£550

52. I therefore order NEST one GmbH to pay NEST COMMUNICATION SAS the sum of £550. 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 20th day of September 2024

**Sam Congreve
For the Registrar**

Annex

Opponent's services (UK00909237355)	Applicant's goods and services (UK00003841670)
<p><u>Class 35</u> Advertising agency services; planning and design of advertising activities; organisation and arranging of advertising events; marketing; organization of fairs and exhibitions for commercial or advertising purposes; display services for merchandising; good and service presentations; distribution of means of publicity; distribution of samples; rental of sales stands; rental of advertising space; providing of addresses for advertising purposes; business consultancy; sponsoring in the form of advertising; presentation of companies on the Internet and other media; public relations; arranging and conducting of trade fairs and exhibitions for commercial or advertising purposes; organisational planning, arranging and conducting of company and product presentations; employment agencies; rental of exhibition spaces.</p> <p><u>Class 38</u> Telecommunications; providing access to information on the Internet; News agencies.</p> <p><u>Class 41</u> Entertainment; sporting and cultural activities; events agencies, namely planning, arranging and conducting of balls, live performances, entertainment shows, conferences, congresses, fashion shows, beauty contests; seminars, symposiums, workshops (providing of training) and competitions for entertainment purposes; modelling for artists; production of films and audio recordings for multimedia presentations; production of shows; theatre productions; rental of audio and video apparatus; rental of lighting apparatus for theatrical sets or</p>	<p><u>Class 16</u> Printed matter; paper stationery; printed publications; brochures; newspapers; periodicals; magazines, newsletters; catalogues; leaflets; flyers; prospectuses; books; manuals; booklets; albums; photographs; paper flyers; printed reports; printed forms; Photo-engravings; prints, drawings, graphic representations and reproductions, posters; photographs; advertising models in paper and/or cardboard; printed news releases; printed visuals.</p> <p><u>Class 35</u> Business management; assistance to commercial or industrial firms in the conduct of their business; professional business consultations; business advice, information or intelligence; research services and monitoring of business data; business assistance services; information and business consulting in the field of multimedia and communication; advertising agencies; information services relating to advertising; communication consulting (advertising); market research and analysis services; qualitative and quantitative studies in the context of market research; promotion services; public relations services; management and research in commercial matters; market research; provision of statistical data relating to business; opinion polling; demonstration of goods; distribution of samples; distribution of samples (leaflets, printed matter, flyers, samples); consultancy services regarding business strategies; commercial presentation services; advisory services in business organization and management; consultancy relating to the establishment and running of</p>

television studios; show scenery (rental of-); rental of stages; rental of motion picture and television scenery; computer animation.

Class 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; consultancy with regard to the design of homepages and Internet pages; designing and creating homepages and Internet pages; graphic-design services; industrial design; Fashion design; architecture; interior design and interior decoration; commercial design services; furnishings consultancy; construction drafting; product design and development; styling services; technical project studies; installing webpages on the Internet, for others.

Class 43 Providing of food and drink and temporary accommodation; outside catering; bars; party planning (providing of food and drink); banqueting services; Rental of portable buildings; rental of meeting rooms; Rental of tents.

businesses; consultancy relating to the establishment and running of innovating businesses; planning concerning business management, namely searching for partners for business establishments; business management and organization consultancy in communications strategies, marketing, advertising, public relations and multimedia; design of advertising logos; brand creation services; brand strategy services; business assistance and consultancy relating to corporate identity; development of marketing strategies; development of marketing concepts; business auditing; sales promotion for third parties; institutional advertising; advertising and marketing services, namely: creation, development and dissemination of advertising and promotional materials via direct mail, press, radio, television, mobile devices, a global computer network and other interactive media; design, writing and publication of advertising texts; film directing of advertising films; advertising services namely, production, post-production, editing, publication, distribution, rental and projection of audio, video and cinematographic works for advertising purposes; scriptwriting for advertising purposes; management of commercial and advertising multimedia content; dissemination of advertising matter; bill-posting; updating of advertising material; document reproduction; advertising sponsorship; advertising space buying services; services of renting and buying advertising space on all means and all communication media; advertising through mail order; production of television and radio advertisements or advertisement provided online via a computer network; organization and conduct of exhibitions and trade fairs; event management services for commercial or advertising purposes; conducting virtual trade show exhibitions online; consulting and

	<p>professional advice regarding the organisation and management of events for commercial or advertising purposes; constitution and management of data files; compilation, processing and analysis of statistics and mailing lists; telemarketing; computerized file management; arranging subscriptions to telecommunication services for others; arranging subscriptions to telecommunication services [for others]; web indexing for commercial or advertising purposes; web site traffic optimization; search engine optimization for sales promotion; search engine optimization for promoting the websites of others; marketing services in the field of web site traffic optimization; online community management services; social media strategy advice; social media community management; career networking services; commercial intermediation services; searching for partners, namely: business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding; advisory services relating to search for advertising sponsorships; arranging of business introductions; assistance relating to business organisation, namely: consultation services relating to industrial strategy.</p> <p><u>Class 41</u> Publishing services; publishing services for internal and external institutional communication, marketing, advertising, public relations and multimedia; publication of the editorial content of sites accessible via a global computer network; on-line publishing services; publication of electronic books, texts, magazines, visuals, periodicals, newsletters; production, presentation, distribution of television and radio programs containing advertisements, interactive entertainment, films and audio and video recordings; photography ;multimedia entertainment software</p>
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	<p>publishing services; organization and conducting of symposiums, conferences, congresses, forums, seminars, symposia, teleconferences, videoconferences, training for entertainment or cultural purposes; training in marketing strategies; provision of audio and visual media via communications networks; entrepreneurship training; innovation training; training in project management; educational services in the nature of coaching, in particular, in the field of business creation, initiation and development of entrepreneurial projects.</p> <p><u>Class 42</u> Illustration services (drawing); research and design services for new products; design, creation, hosting, updating and maintenance of websites and website content for third parties; design and implementation of web sites and e-commerce software applications and computer network systems ; software as a service (SAAS), namely, advertising and marketing software; software as a service (SAAS), namely: software for tracking, monitoring and reporting on media, press, social media; software for development of technologies, data and analysis tools in the advertising field; database design and development; creating and designing website-based indexes of information for others [information technology services]; computer programming; design, creation, hosting and maintenance of home pages and websites for others; data centre services relating to the electronic storage of data or documents; managing the web sites of others; design and graphic arts design for the creation of web sites; graphic design of logotypes, graphic charters, visual, promotional, digital identities, communication media, signs; design (industrial aesthetics); design, creation, hosting and maintenance of websites</p>
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	<p>for others; conversion of computer programs and data, other than physical conversion; conversion of data or documents from physical to electronic media; computer-aided design of graphic illustrations, videos; conversion of images from physical to electronic media; information services, advice and technical assistance in the computer field ; technical consultation in the field of information technology, data processing; design and implementation of software for optimizing website traffic.</p>
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