

**O-0998-24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003939380  
BY TINDLE WEALTH MANAGEMENT LIMITED TO REGISTER:**

**TINDLE WEALTH**

**AND**

**TINDLEWEALTH**

**(SERIES OF TWO)**

**AS A TRADE MARK IN CLASSES 35, 36, 41 AND 45**

**AND**

**IN THE MATTER OF A FAST TRACK OPPOSITION THERETO  
UNDER NO. 600003079**

**BY JONATHAN BALCHIN DE VERE TYNDALL**

## Background & Pleadings

1. On 28 July 2023, TINDLE WEALTH MANAGEMENT LIMITED (“the applicant”) applied to register the series of trade marks shown on the cover page to this decision in the United Kingdom. The applicant seeks registration for the following services in classes 35, 36, 41 and 45:

*Class 35: Business consultancy and advisory services; business enquiries, evaluation, analysis and investigation; provision of business information; accountancy services; tax consultancy; tax planning; accountancy advice relating to tax preparation; tax advice; online data processing services; business information services provided online from a global computer network or the internet; electronic data processing; advertising and business services; accounting; business appraisal; economic forecasting; marketing; compilation of information into computer databases; distribution of prospectuses; advertising; information, advisory and consultancy services relating to all the aforesaid.*

*Class 36: Financial services; financial planning services; financial advisory services; financial analysis services; financial consultancy services; financial information services; financial management services; financial research services; provision of financial information; asset and portfolio management; investment and financial protection advice; administration and valuation of investments; valuation services; risk management; asset management; estate management; estate planning; retirement and inheritance planning; investment services; investment, investment dealing, investment holding, investment management, investment planning and investment trust services; investment advisory services; investment funds; pensions services; pension fund administration services; provision of information, advice and consultancy relating to securities, finance and investments; fund management services; pension fund services; banking services; management of private equity funds; private equity fund investment services; private banking; equity financing; offshore fund management; portfolio, mutual fund, pension and trust administration services; trust investment services; administration of funds and investments; administration and valuation of investments; corporate finance; corporate advisory services; financial affairs; monetary affairs; financial planning; asset management; asset and portfolio*

*management; provision of financial services, information and advice by means of a global computer network, the internet or an app; financial services provided by an electronic platform; wealth management services; financial planning, management and advice in relation to pensions; financial advice relating to tax planning and taxation; information, advisory and consultancy services relating to all the aforesaid.*

*Class 41: Education services; provision of training; organisation of training and educational seminars, conferences and workshops; organisation of training and educational seminars, conferences and workshops in the field of finance and wealth management; providing on-line electronic publications in the field of finance and wealth management; education and training for financial, auditing, accounting, business and management matters; computer training; arranging business conferences in connection with financial matters and wealth management.*

*Class 45: Legal services, legal advice, probate services and probate advice; inheritance planning; testamentary services; wills trust arrangements; drafting and amending of wills; retirement and long-term welfare and care solution planning; information, advisory and consultancy services relating to all the aforesaid.*

The application was published for opposition purposes on 18 August 2023.

2. On 18 October 2023, Jonathan Balchin de Vere Tyndall (“the opponent”) opposed the application in its entirety under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) using the fast track opposition procedure. The scope of the opposition has since been limited to all services in classes 35, 36 and 45<sup>1</sup>. For the purpose of the opposition, the opponent relies upon the following marks and all services for which they are registered, as laid out below:

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<sup>1</sup> In his Notice of Opposition, when asked “Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark and listed at Q5? (These should be the goods and services of the trade mark you are opposing and not the earlier trade mark)”, the opponent has answered “All goods and services”. However, in his submissions filed in lieu of a hearing he states that “It is opposed against all the services in Classes 35, 36 and 45. It is not contested in Class 41 because Jonathan has no registered Trade Mark in that Class.”

United Kingdom Trade Mark ("UKTM") 3259498

## Tyndall & Co.

Filing date: 27 September 2017

Registration date: 9 March 2018

*Class 36: Economic and financial research and consultancy services; debt collection services; financial advice; real estate advice; securities advice; investment advice; investment management; banking; Banking services in relation to the electronic transfer of funds.*

UKTM 3064431

## Tyndall & Co.

Filing date: 16 July 2014

Registration date: 31 October 2014

*Class 35: Business management consultancy services, namely, providing expert suggestions to the management of a business including a corporation so they may discuss and consider present outcomes against theoretical future efforts in order to achieve desired objectives; including specialisations, namely, business consultancy about corporate governance, information technology, human resources and welfare, virtual and remote management, marketing and industry best practices; Consulting and advisory services to business; Business advice relating to financial re-organisation; Accounting services; Tax consulting, planning and advice; Company, director, secretary and registered office services.*

*Class 45: Legal advisory services; the preparation, generation and filing of documentation relating to legal advice; provision of legal advice about matters of law,*

*legal interpretation or the application of the law to any facts, including financial advice, advice in relation to securities, derivatives, mergers and acquisitions, takeovers, issues, public offerings, prospectuses, placements, floats, financial and debt instruments, contracts for difference, listings, target companies, offshore and jurisdiction law, taxation, wills, trusts, shareholder rights and agreements and intellectual property rights; Advocacy services including representation before a court, tribunal or decision maker, including boards of directors, panels, committees, governors and office holders; Dispute resolution services, including appearing at mediations and arbitrations; legal services, namely, Migration advice, immigration consulting services, migration agent services, representation; Solicitor and barrister services; Company, foundation and trust deed registration services; Property and conveyancing services; reviewing standards and practices to assure compliance with laws and regulations; Consultancy and advisory services relating to the law; Research and advisory services relating to copyright, patents, trademarks and designs; Legal, research services; consultation services about crime prevention, security and franchising; Lodgement and filing services relating to companies, wills, trusts and foundations; Legal consultancy services relating to business; Title searching; Identity verification services.*

3. In his Notice of Opposition, when asked to explain why he considers there to be a likelihood of confusion, the opponent replied as follows (in respect of both earlier marks):

“The applicant’s mark is likely to be confused with the preexisting word mark which is similar. The applicant offers similar advisory services to the preexisting services already offered and already supplied by the opponent over a number of years. The applicant offers financial advisory services which the opponent already offers in his capacity as a registered foreign lawyer in England and Wales. The respective marks are phonetically similar and if the applicant mark is allowed to register there will exist a likelihood of confusion on the part of the public, which includes the likelihood of association with my earlier trade mark.”

4. Under the provisions laid out in section 6 of the Act, the opponent’s trade marks clearly qualify as earlier marks. In accordance with section 6A of the Act, as each had

completed its registration procedure more than five years prior to the filing date of the applicant's mark, each is subject to the proof of use requirements. The opponent made a statement of use in respect of all of the services relied upon.

5. In its counterstatement, the applicant denies both that the marks are similar and that the respective services are similar. It submits that, to the extent that any of the services *are* found to be similar, this is nonetheless offset by the dissimilarity between the respective trade marks. It also directs a number of criticisms toward the statement of use within the opponent's TM7F and denies that the opponent has demonstrated genuine use in respect of the earlier marks.

6. 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”.

7. The net effect of the above is to require parties to seek leave in order to file evidence (other than proof of use evidence which is filed with the notice of opposition) in Fast Track oppositions. As mentioned above, the opponent filed evidence alongside his Notice of Opposition, which also incorporates a statement of use. No leave was sought by either party to file additional evidence. I will return to this point later in my decision.

8. 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 cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary, though both parties elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

9. The opponent is unrepresented, whilst the applicant is represented by Fox Williams LLP.

## **Relevance of EU Law**

10. 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.

### **Section 5(2)(b)**

11. Section 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.”

12. Section 5A of the Act reads 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.”

### **The opponent's statement of use and supporting evidence**

13. The following information was provided in the statement of use completed by the opponent within his Notice of Opposition:

- Since 16 July 2014 sales achieved under the earlier mark(s)<sup>2</sup> have been “at least £214,675”.

- The estimated investment into the opponent’s promotion of his mark(s) “in the get up of the UK business on its web site, invoices, letterhead and retainer agreements” is recorded as follows:

“The estimates as to cost of promoting the Trade Mark as at year ended 31 July are approximately GBP 95,000:

2016 (from 28/7/2014) GBP 6,430

2017 GBP 6,686

2018 GBP 22,490

2019 GBP 33,265

2020 GBP 14,546

2021 GBP 8,624

2022 GBP 5,330

- Alongside his statement, the opponent filed screenshots of his website (“EXH. 2”). He states that “The web page has been running since approximately 2014. The current web page is similar to the original web page of 2014, but the page has been updated as to content since 2014.” Some extracts of the opponent’s website are reproduced below:



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<sup>2</sup> Given that the marks relied upon are identical, and that Mr Tyndall has filed a near-identical statement of use in respect of both earlier marks (the promotional figures and sales achieved, for example, are the same), it seems reasonable to conclude that the statement of use applies, collectively, to both earlier marks. In his written submissions, Mr Tyndall also refers, for example, to the “evidence before the Tribunal” demonstrating that he has “put the marks to genuine use” (my emphasis), which suggests that his assertions on use and the supporting exhibit are intended to demonstrate use of both earlier ‘Tyndall & Co.’ marks.

## Experienced Australian lawyers in London

Tyndall & Co. is a small, private and experienced firm of Australian Solicitors and Immigration Lawyers with a branch office in Mayfair, London, England. We are also Management Consultants.

**We specialise in the following non-reserved areas of law in England and Wales:**

- Australian Immigration Law
- Criminal Law
- Family Law
- Business Law – Banking, Securities, Derivatives law
- Financial Services including Investment advice incidental to the law practice (in accordance with FCA and SRA rules)

## Legal advice, documentation and representation in England and Wales: Bold and excellent

Tyndall & Co. stands by its motto “bold and excellent” in all of its services. Tyndall & Co. provides “bold” representation for the client and “excellent” legal advice and documentation.

And if legal proceedings are involved the firm will fight fearlessly for its client in arbitrations in England and Wales, and in most UK Tribunals where it can appear, with leave if necessary, and of course all Australian Courts and Tribunals.

Tyndall & Co. provides legal services, in the non-reserved areas of practice, including business law, corporate law, family law, property law, trusts, criminal law, wills, offshore law and Australian immigration law. These for example include preparing a UK Will, a London lease, a contractual agreement, or share transfers.

## Financial services

As part of, and, incidental to its law practice, Tyndall & Co. also provides financial services in accordance with the Financial Services and Markets Act 2000 (UK) and the SRA Financial Services (Scope) Rules 2001 (E&W). These services include financial consulting, investment, securities and derivatives advice, structuring strategic investments, banking and financial planning. Being part of a law firm, the financial advice comes with solid legal knowledge so as to help the client make better strategic decisions.

14. Within his statement of use, the opponent submits as follows:

“Being a law firm and management consultants, no examples of Letters of Advice, Invoices, Costs’ Agreements have been attached, due to concerns as to client privacy and to the clients’ legal profession privilege.”

15. With regard to the number of sales achieved under the earlier mark in the UK, the opponent states that:

“a forensic report by an Accountant would be required to show more detail.”

16. That concludes my summary of the opponent's evidence insofar as I consider it necessary.

### **Preliminary matter**

17. I have already noted that the applicant criticised the opponent's evidence in its counterstatement and much of these criticisms are echoed in its written submissions. Upon receipt of the applicant's written submissions in lieu of a hearing, the opponent elected to file supplementary submissions (having already filed submissions of his own), which included the following statement:

"If the Tribunal would be assisted by further affidavit evidence, in addition to the documents already provided, the Opponent proposes that the Tribunal grant a brief extension to provide further documentation by way of evidence."

18. In reply, the applicant sent an email to the Tribunal which read as follows:

"The Applicant respectfully requests that the Opponent's supplemental submissions filed on 8 August 2024 are not taken into account for the purpose of this Opposition. The Opponent had ample time to make their case in full within the timeframe of the proceedings.

In any event, should the Tribunal be minded to accept these supplemental submissions, the Applicant will respectfully oppose any request by the Opponent to be granted leave to file further evidence."

19. For clarity, the Tribunal does not provide a preliminary indication concerning the sufficiency of parties' evidence in advance of drafting a decision. Whilst the above statement does not amount to a formal request for additional time in which to file evidence, a preliminary view on the matter was issued as follows:

"When the applicant's counterstatement (TM8) was served on 12 July 2024, the official serving letters included the following wording:

'In choosing to file a fast track opposition the opponent has elected to use a procedure which does not include the routine filing of evidence, other than proof of use evidence. It is not expected that the parties will be permitted to file (further) evidence.

In accordance with Tribunal Practice Notice 2/2013 a period of one month from the date of this letter is allowed for the parties to file written submissions. Any submissions should therefore be received on or before 09 August 2024.

If either party wishes to be heard the request must be made within 14 days of the date of this letter, that is on or before 26 July 2024 and must provide full written reasons why an oral hearing is necessary.

If you do not wish to request a hearing or file written submissions, please let the Registry know as soon as possible as this will result in the case being passed for a decision from papers sooner.

Any request for leave to file evidence should be submitted within 14 days of the date of this letter, that is on or before 26 July 2024. Further guidance is provided at paragraph 7 of the Tribunal Practice Notice 2/2013.' (my emphasis)

I note that much of the applicant's criticism toward the opponent's evidence was raised in its counterstatement. Should the opponent have considered it necessary to address those criticisms by way of filing additional evidence, it was clearly given its opportunity to request leave to do as such in the serving letter cited above. The case file shows that neither party responded to the above invitation and, as a result, the case was progressed for a decision, with the parties allowed a final opportunity to file written submissions in lieu of a hearing.

With that being so, whilst I am minded to admit the opponent's written submissions (including its supplementary submissions, as they were filed within the prescribed period), I decline to set an additional period of time within which the opponent may file additional evidence. The onus is on the opponent, as it is all parties, to file its strongest evidence at the outset."

20. A period of seven days was allowed for either party to comment or challenge the view set out above. Both parties responded to confirm that they did not wish to challenge the proposed course of action nor provide further comment. I therefore take all of the parties' written submissions into account when approaching my decision (including the supplementary submissions filed by the opponent).

### **Proof of use**

21. I will begin by assessing whether the opponent has shown genuine use of the earlier marks. The relevant statutory provisions are as follows:

“6(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.”

22. Section 100 of the Act states that:

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

23. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period ending with the filing date of the application at issue, i.e. 29 July 2018 to 28 July 2023.

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable

number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de*

*minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

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

26. I have already highlighted the opponent’s concern with regard to client privacy. I reproduce an extract below from his written submissions filed in lieu of a hearing:

“36. Jonathan accepts that the onus is on the proprietor of the earlier mark/s to demonstrate proof of use.

However, it was stated in Case BL O/1160/23 PILLOW TALK:

“[...]There is no absolute requirement for particular documentation to be provided to prove use, given that the power to do so lies peculiarly in the hands of the proprietor, a tribunal is entitled to be sceptical and to reject evidence as insufficiently solid if material that is likely to exist is not provided.

37. As a Legal Practice, any information relating to our clients is covered by Client Legal Privilege. We have a legal and professional obligation to keep this information confidential. See: Solicitors Regulation Authority UK: Code of Conduct for Solicitors RELs and RFLs “6.3 You keep the affairs of current and former clients confidential unless disclosure is required or permitted by the law or the client consents.”

Furthermore, see about the duty to keep clients’ affairs confidential:

Legal Services Act 2007 (UK)

(1)(3) The “professional principles” are –

(e). That the affairs of the client should be kept confidential.

The solution offered by the Tribunal, with respect, is not helpful for a legal practitioner. The Guidance note on “Options Following an Objection to a Trade Mark Examination” ... clearly states:

“All documents connected to your application are available to public inspection after we have published it in the Trade Marks Journal. If you do not want a piece of information to be open to public inspection, you should give us detailed reasons in writing when you send us the document or within 14 days of sending it. Then, we will consider whether we agree to your request for confidentiality.”

38. To make that applicable, clearly a Legal Practitioner would be put in breach of their professional obligations at the point of disclosure.

39. Our firm maintains a strong reputation amongst our clients and the public. We are not easily able to provide evidence as this may compromise the identity and privacy of our clients, many of whom are distinguished people in the UK.

40. Outside of the evidence already provided in our original submission, we do not believe that we can provide the extensive evidence requested by Tindle Wealth to prove what they say is “genuine use” to the tribunal, without compromising our clients’ identities or their confidential information.

41. Even if we were to redact the personal details of our clients, there is still a chance they will be identifiable and as they are prominent people in the community in England, there is a risk that our ethical obligations as well as black letter law would be breached.

42. This demonstrates that there is no guarantee that our clients privacy will be protected which presents a professional dilemma. We are unable to risk that our clients' confidentiality would be breached for our own benefit.

43. Nevertheless, there is still evidence before the Tribunal of use, which we submit is adequate to demonstrate that Jonathan has put the Marks to genuine use in the past five (5) years, namely through his website which is Exhibit 2.

44. The law states that use of the mark does not need to be "...quantitatively significant to be deemed genuine, even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector..." see: Walton International Ltd & Anor v Verweij Fashion BV [2018] EWHC 1608 (Ch).

45. The economic sector, in which the earlier Mark's [sic] exist is the legal sector.

46. It is submitted that genuine use in the legal sector, as evidenced by the website in Exhibit 2, is adequate evidence to demonstrate prior use."

27. The opponent seeks to rely on the services laid out at paragraph 2 to this decision. I keep in mind, as the case law above makes clear, that there is no *de minimis* rule. However, I must take into consideration what the evidence shows and, equally, what it does not show. In his Notice of Opposition, the opponent has provided a figure showing the sales achieved under the earlier marks "since 16/7/2014". I do not have any indication of what proportion of that amount relates to services rendered during the relevant period or the proportion of sales attributable to each of the different services relied upon (in the relevant period or at all). The opponent has provided the annual expenditure concerning the promotion of his earlier marks though, whilst I do not necessarily find it insignificant, I have no context or insight into the means of such promotion nor the amount of custom it has generated. With regard to his comments regarding client privacy, though I understand the sentiment of the concern, remedies including redaction and/or a request for confidentiality were available to the opponent but, according to the case file, were not sought. The opponent could have elected to redact any identifiable information from the evidence available to him and/or requested that it be kept from public inspection, and I struggle to see why, even in the sector in

which the opponent operates, this would not have been appropriate or sufficient to relieve its concern. Still, in the alternative, there are a number of types of evidence the opponent could have elected to file to support a genuine use finding; archived website extracts, narrative evidence to support the sales figures, brochures or promotional advertisements or published articles showing that the earlier mark(s) were used during the relevant period, for example. To my knowledge, evidence of this nature would not typically comprise any confidential data which could compromise the privacy of the opponent's clients. The extracts from the opponent's website are not dated within the relevant period and, though Mr Tyndall explains that the current page "is similar to the original web page of 2014", he does not explain which aspects of the content, specifically that relating to the services offered, may or may not have been present in the relevant period. On reflection of the evidence as a whole, it is not sufficiently clear to allow me to identify precisely which services the opponent has provided its consumers, nor the scale of such provision in the relevant period. I do not find the evidence sufficient to support a finding of genuine use. Consequently, the opponent cannot rely upon its earlier marks for the purpose of the present proceedings.

## **Conclusion**

**28. The opposition has failed. Subject to any successful appeal, the application will proceed to registration in respect of all of the services applied for.**

## **Costs**

29. The applicant has succeeded and is entitled to a contribution towards its costs. Awards of costs in opposition proceedings commenced after 1 February 2023 are governed by Tribunal Practice Notice ("TPN") 1 of 2023, which also sets out scale adaptations for fast-track proceedings. Using that TPN as a guide, I award costs to the applicant on the following basis:

Considering the statement of grounds and preparing a counterstatement:	£250
Filing written submissions in lieu of a hearing:	£300

**Total:**

**£550**

**30. I order Jonathan Balchin de Vere Tyndall to pay TINDLE WEALTH MANAGEMENT LIMITED the sum of £550. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.**

**Dated this 18<sup>th</sup> day of October 2024**

**Laura Stephens  
For the Registrar**