

O/1008/24

TRADE MARKS ACT 1994

IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3946219  
BY ANDY MEDIA LTD  
TO REGISTER:

**betextra**

AS A TRADE MARK  
IN CLASS 41

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 443472  
BY TOTE (SUCCESSOR COMPANY) LIMITED

## BACKGROUND AND PLEADINGS

1. On 16 August 2023, ANDY MEDIA LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was accepted and published in the Trade Marks Journal on 6 October 2023 in respect of the services set out below:

**Class 41:** *Betting services; sports betting services; online sports betting services; casino, gaming and gambling services; online gambling services; online casino services.*

2. On 9 October 2023, Tote (Successor Company) Limited (“the opponent”) filed a notice of opposition on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at all the services in the application. The opponent relies on the following series of trade marks:



(Series of three marks)

UK registration no. 2482466

Filing date 14 March 2008; date of entry in register 8 August 2008

(“the opponent’s registration”)

Relying on the following goods and services:

**Class 9:** *Software; electronic publications; all relating to or concerning betting services, gaming services, gambling services, casino services, provision of information relating to sporting events, wagering services.*

**Class 16:** *Printed matter, printed publications, guides, magazines, newspapers, pamphlets, booklets, posters, advertisement boards; all relating to betting; bags of paper or plastic for packaging, calendars, printed tables, cards, stationery, pens and pencils, coupons, betting forms, tickets and betting slips; all relating to or concerning betting services, gaming services, gambling services, casino services, provision of information relating to sporting events, wagering services.*

**Class 36:** *Credit and debit card services relating to betting, gaming, gambling and wagering.*

**Class 41:** *Betting services; gaming services; gambling services; casino services; provision of information relating to sporting events; wagering services; information services relating to all the aforesaid.*

3. The opponent submits that the marks are very similar and phonetically the marks are the same. In relation to the goods and services, the opponent submits that the marks share the same class and operate in the same industry. Subsequently, the opponent submits that there is a likelihood of confusion.

4. The applicant filed a defence and counterstatement denying the claims made.

5. Both parties represent themselves. Neither party filed exhibited evidence. However, the opponent did file a witness statement in support of its proof of use. No hearing was requested, and neither party filed submissions in lieu of a hearing. This decision is taken following a considered review of the papers.

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived

national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

### **Preliminary issue: the applicant's pleadings**

7. The applicant's pleadings, as set out in the form TM8 and counterstatement, do not address all of the claims made by the opponent. I reproduce the relevant part of the form TM8 below:

The notice of opposition is ludicrous

If an opposer has bet in their trade mark it should not mean they can oppose any future trade marks with bet in the title as a reason for opposition the word bet is very generic.

The opposer was able to register their trade mark when there are thousands of trade marks with xtra in them so surely we can register betextra which ends extra and not xtra.

In addition we are betextra and they are betXtra there is a clear difference.

The betextra.com domain we own was first registered on 13 April 2005.

As it can be seen from the above, the applicant denies that the applied for mark is identical or similar to the earlier mark. However, the pleadings are totally silent about the claims that the goods and services are similar.

8. In SKYCLUB, BL-O-044/21, Mr Phillip Johnson sitting as the Appointed Person, concluded that the Hearing Officer was wrong to proceed on the basis that the similarity of goods and services was in issue in a case where the applicant had failed to plead against the similarity of the goods or services. In my view, the same approach applies in the present case. It follows that since the similarity of the goods and services has not been denied, it must be treated as admitted. However, as the applicant did not say to what degree it considers the goods and services to be similar (or conflicting), I will carry out my own assessment, starting from the premise that the goods and services must be similar to, at least, a low degree.

## **Evidence**

9. As set out above, the opponent filed the witness statement of Paul Green dated 26 April 2024, which is not accompanied by any exhibits. Mr Green is a Legal Officer of the opponent and states that he is authorised to make a statement on the opponent's behalf. I do not propose to summarise the witness statement in full at this stage. However, I have taken it into consideration in reaching my decision and will refer to it below, where necessary.

## **DECISION**

### **Proof of Use**

10. Section 6A of the Act is as follows:

“(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 sections 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) 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.

...”

11. Section 100 of the Act is as follows:

“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.”

12. 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 I9223, 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 subcategory 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].”

13. Proven use of a mark which fails to establish that “the commercial exploitation of the marks is real” 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.

14. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under section 6 of the Act. The opponent’s series of marks completed its registration process more than five years before the filing date of the application and, therefore, is subject to proof of use conditions. The relevant period for assessing whether there has been genuine use of the opponent’s earlier mark is the five-year period ending with the date of application for the applicant’s mark i.e. 17 August 2018 to 16 August 2023.

15. I am also guided by *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“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, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

16. I also note Mr Alexander Q.C.’s comments in *Guccio Gucci SpA v Gerry Weber International AG*, Case BL O/424/14. 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” [original emphasis]

17. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person 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 or 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.”

### Genuine use

18. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. In making my assessment, I am required to consider all relevant factors, including:

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

19. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>1</sup>

20. In its witness statement, the opponent states that it is a member of the Betfred Group. It conveys that Betfred is a global brand in the betting and gaming industry with over 50 years of history. Further, Betfred includes companies with an online and retail gambling and betting presence in the UK, Gibraltar, South Africa and the USA. The opponent states that Betfred has 1,350 betting shops and an online business with over a million active customers. Further, it outlined that it expanded into the USA across 10 states and that it is present in South Africa with over 50 betting halls for its customers, a sportsbook and a gaming website. The opponent explains that it was acquired by the Betfred group in 2011 from the 'Tote' (the government-owned pool and fixed odds betting and gaming business) and has a history going back to 1928. The opponent discloses that it operated under the brands 'Tote bookmakers' and 'Totepool' previously.

21. The opponent's registration is a series of three marks as set out below:



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<sup>1</sup> *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

I note that these marks consist of the word 'betXtra', the letter 'X' appears significantly bigger than the remainder of the letters in the mark. The marks are presented inside a rectangular background. In the first mark in the series 'betXtra' is presented in white and appears within a black rectangular background. In the second mark in the series, 'bet' is presented in red, 'X' in green and 'tra' in white, they are all presented on a dark green background surrounded by a light green border. In the third mark of the series, 'bet' is presented in red and 'Xtra' is presented in white. The word is also presented on a dark green border and appears on a light green background. The word 'BetXtra' plays the distinctive role in all of the marks in the registration. However, I note that the witness statement evidence refers to 'Betfred' rather than 'Betxtra'.

22. One of the only references made to the registration in the witness statement asserts that *"whilst Betxtra is not currently part of an active campaign, potentially it will be used in the future. As a business we constantly review our marketing and promotion materials and strategies"*. Whilst it is acceptable to clarify that the registration is not currently being used, I note that the opponent did not indicate that there was any historical usage of the mark within the relevant period.

23. It is clear from the case law above that the onus is on the opponent to show that it has used its registration in the relevant period; it is also clear that no particular documents are required for that purpose. The difficulty for the opponent is that it has only filed the witness statement, which provides no evidence of genuine use. No evidence of sales or turnover has been provided, or invoice evidence, which is plainly information which should have been available and relatively easy to provide. It is not necessarily fatal to the assertion of genuine use that there is no such evidence, if other material filed by the opponent is sufficient to show that there has been a real attempt to exploit the registration in the sector. No information is provided by the opponent regarding any advertising or promotional activity undertaken in relation to the registration. No evidence has been provided of the registration being used, to indicate the scale and frequency of its use or demonstrate what goods and services the registration is used for. No indication has been provided pertaining to the geographic scope of the registration. The witness statement does not offer any assistance in terms of genuine use of the registration.

24. On the basis of the evidence before me, I am not satisfied that genuine use has been made on or in relation to the goods and services upon which the opponent relies.

25. The consequence of my finding on use is that 2482466 may not be relied upon in these proceedings. As there is no other basis for the opposition, the action must fail.

## **CONCLUSION**

26. Subject to appeal, the opposition is dismissed and the application will proceed to registration.

## **COSTS**

27. The applicant has been successful and is entitled to a contribution towards its costs. As the proceedings commenced after 1 February 2023, it is subject to the costs schedule outlined in Tribunal Practice Notice 1/2023. However, as the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicant and invited him to indicate whether he intended to make a request for an award of costs. The applicant was informed that, if so, he should complete a Pro Forma, providing details of his actual costs and accurate estimates of the amount of time spent on various activities in the opposition. He was informed that “ *if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded*”.

28. The applicant did not file a completed Pro Forma. Therefore, I made no costs award to the applicant.

**Dated this 23<sup>rd</sup> day of October 2024**

**A Klass**

**For the registrar**