

O/1190/24

**TRADE MARKS ACT 1994
CONSOLIDATED PROCEEDINGS**

**IN THE MATTER OF TRADE MARK REGISTRATION NOS. 3073724 & 801291812
IN THE NAME OF NANCY STEIDL FOR THE TRADE MARK**

The Positive Society

IN CLASSES 35, 38, 41, 42 AND 45

**AND THE APPLICATIONS TO RECTIFY THE REGISTER
UNDER NOS. 84902 AND 84901
BY CREATIVE PLANET INTELLECTUAL PROPERTY PTY LTD**

AND

**THE APPLICATIONS FOR REVOCATION ON THE GROUNDS OF NON-USE
UNDER NOS. 504925 AND 504926
BY CREATIVE PLANET INTELLECTUAL PROPERTY PTY LTD**

Background and pleadings

1. Nancy Steidl is recorded as the registered proprietor of the expired trade mark The Positive Society, number 3073724, and registration number 801291812, also for The Positive Society.¹ Both marks cover the same services in classes 35, 38, 41, 42 and 45.² The '724 mark was filed on 23 September 2014, registered on 19 December 2014 and expired on 24 September 2024. The '812 mark was filed on 20 October 2015 and was registered on 12 January 2017.

2. On 31 May 2022, Creative Planet Intellectual Property Pty Ltd ("Creative") filed applications for revocation on the grounds of non-use against both registrations under section 46(1)(b) of the Trade Marks Act 1994 ("the Act").³ Creative claims that the marks were not put to genuine use between 31 May 2017 and 30 May 2022, claiming an effective revocation date of 31 May 2022 for both registrations.

3. Ms Steidl filed defences and counterstatements, denying Creative's claims. She states:

The positive society has been live since 2014 to present date. The positive society is an online community which houses hundreds of active members in the legal, business, professional sectors, along with private individuals as well. The online positive society houses many different sectors such as on-line vendors, chatroom services for social networking, community events, online forums for discussion, on-line social networking services etc covering the classes of the trademark. The positive society has a newsletter which has hundreds of subscribers. The website which is live since 2014 is www.thepositivesociety.com The positive society is a project which has been growing every year. The positive society is trademarked in 30 countries.

We came across the other party back at the end of 2021 into 2022 due to a trademark they were registering in the UK from Australia, which we felt was infringing on our trademark and we were simply safeguarding our trademark. A variety of letters and emails were sent back and forth. We requested they amended their trademark to avoid infringing on ours. On the 14th February 2022 we sent an email with a letter asking them to amend their trademark again. Following this email we received one more email from them asking us to confirm the name of the person on the letter which we had done numerous times. Following this no further correspondence was sent from their end. In regards to revocation application from their end, this is all new to us, as not one hard copy letter about the revocation, nor email, nor phone call was made from the other party to discuss this matter and try to resolve it.

Due to unforeseen and abrupt illness from the owner of the trademark, the trademark dispute was dropped on our end, and their trademark went through successfully. We are confused by this revocation as the trademark has been used for the past 8 years worldwide. The only reason they have submitted this trademark revocation, we can think of, is based on a revengeful and spiteful matter due to opposing their trademark, which we dropped and they proceed to have safely registered in the UK now.

¹ Trade mark UK801291812 was originally protected as an international trade mark designating the EU. The comparable UK trade mark was created on 31st December 2020 in order to replace the protection previously given to the international registration by virtue of the UK's membership of the EU. It is treated as though it was originally applied for and registered in the UK.

² The specifications are worded slightly differently, but have the same coverage.

³ The '724 mark was still registered at that point.

4. On 4 August 2023, Creative filed applications to rectify the register in respect of both the '724 and the '812 marks (together, "the contested marks").⁴ Creative states that the contested marks were assigned from The Positive Newspaper Co. Limited to Nancy Steidl with the effective date of assignment being 3 February 2022. Creative states that this date is four years after The Positive Newspaper Co. Limited was dissolved. Creative claims that upon dissolution of the company, the trade mark registrations would have passed to the Crown and that any assignment would have had to have been from the Crown/Treasury Solicitor. Creative claims that the Treasury Solicitor has no record of the company being referred to its office or of the assignment being made by the Treasury Solicitor. Creative claims that this means Ms Steidl cannot be the owner of the trade mark registrations and that the register stands in error. Evidence was attached to the applications for rectification, to which I refer below.

5. In her counterstatements, Ms Steidl denies the basis of the applications for rectification. She refers to the continuous use of the marks and states:

"While the oversight of not transferring the trademark to a new entity after the dissolution of the original business is acknowledged, it is important to emphasize this oversight does not, in any way, invalidate the trademark. The key factor is there was no intentional abandonment of the trademark. This oversight was a result of administrative and legal challenges, not a deliberate choice to disassociate the trademark from my business.

Throughout this period, the trademark has maintained its association with my business, and consumer recognition further substantiates its continuous validity. This has been documented to the Trademark Office and the opposing party on numerous occasions in detail.

⁴ At the date of issuing this decision, the '724 mark still falls within the period provided for in section 43(3) of the Act and rule 37(1) of the Trade Marks Rules 2008 (as amended), which means that it may be restored to the register for that limited period of time.

Consumer perception and recognition are paramount in establishing the ongoing strength and relevance of a trademark. The fact consumers continued to identify and associate "The Positive Society" with my products and services serves as a compelling testament to the enduring distinctiveness and functionality of the mark in the marketplace.

The pivotal moment in the course of "The Positive Society" was when I proactively sought ownership of the trademark under a new name. The trademark office's approval of this request is not merely a bureaucratic formality; rather, it is a legal affirmation of my rights to the trademark. This decision by the trademark office serves as conclusive evidence they recognized the continuous use of the trademark and validated my rightful ownership, even after the dissolution of the original business.

The decision to secure ownership under a new name in 2018 was not only a legal formality; it was a strategic and intentional move to safeguard the integrity of "The Positive Society" trademark. This action was taken with a clear intent to preserve and protect the trademark, further underscoring my unwavering commitment to upholding its validity.

In conclusion, the evidence presented strongly supports the ongoing validity of "The Positive Society". The continuous use, the documentation and evidence submitted, approval of the new registration under a different name, and consumer recognition collectively fortify the case for the legitimacy and strength of the trademark. It is my unequivocal belief that "The Positive Society" remains a valid and enforceable mark, and I am committed to defending its rights."

6. The four sets of proceedings are consolidated. Creative is represented by Wilson Gunn, a firm of trade mark attorneys. Ms Steidl represents herself. Ms Steidl filed evidence to meet the burden upon her in the revocation actions, but did not file any more evidence after the rectification applications had been filed. Creative only filed evidence with its rectification applications. A hearing was held by video conference on 13 November 2024. I make this decision after careful consideration of all the

submissions made at the hearing and the papers on file, beginning with the rectification applications.

The rectification applications

7. Section 64 of the Act reads:

“64. - (1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:

Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

(2) [...]

(3) Except where the registrar or the court directs otherwise, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.

(4) [...].

(5) [...].”

8. Creative must have a sufficient interest to apply for rectification. Since Creative is also the applicant for revocation of the contested marks, which includes consideration under section 46(1) of the Act as to whether the marks had “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 [they are] registered”, I consider Creative to have sufficient interest.

9. The evidence attached to Creative’s applications for rectification is in the form of a witness statement from Andrew Marsden, its trade mark attorney.⁵ The witness

⁵ Witness statement dated 4 August 2023 and exhibits.

statement simply introduces three exhibits. Exhibit AM1 comprises prints from the trade marks register concerning the two contested marks' history, such as filing dates, publication dates and so on. Amongst the details is the assignment history referred to earlier in this decision. It suffices to give details for the '821 mark:

Date

13 February 2022

Type

Recordal registration. Recordal type: Full assignment

Text

Full Assignment RC000276027 received on date 04/02/2022 has been recorded, resulting to the change of ownership from The Positive Newspaper Company Limited (id: 1211994, country: GB) to Nancy Steidl (id: 1681976, country: GB). The effective date of assignment is 03/02/2022.

10. Exhibit AM2 is a print from the register of Companies giving details of company number 08137456 THE POSITIVE NEWSPAPER CO. LIMITED. The details show that the company was incorporated on 10 July 2014 and dissolved on 11 December 2018.

11. Exhibit AM3 comprises copies of an exchange of correspondence between Mr Marsden and the Bona Vacantia Division of the Government Legal Department between 4 May 2023 and 9 May 2023. Mr Marsden asked the Bona Vacantia Division if the assignments were made from the Crown/Treasury Solicitor, and the Bona Vacantia Division replied that it had no record of The Positive Newspaper Co. Limited being referred to its office and was unaware of any assignments made by the Treasury Solicitor of the contested marks.

12. I note that the '724 mark was in the ownership of The Positive Newspaper Co. Limited whilst the '812 mark was in the ownership of The Positive Newspaper Company Limited. Nothing appears to turn on the slight difference: Ms Steidl filed a single form TM16 at the Intellectual Property Office to record the assignments of both contested marks and she makes no distinction between the names in her counterstatements, referring to the dissolved business in the singular. A search for The Positive Newspaper Company Limited on the register of companies returns only The Positive Newspaper Co. Limited (dissolved).

13. Registered trade marks are items of property (see section 22 of the Act) and, under section 25(1) of the Act, registered trade marks are transmissible by assignment in the same way as other personal or moveable property. They were assets of the original proprietor, The Positive Newspaper Co. Limited/The Positive Newspaper Company Limited, while that company was active and they were still assets of that company when it was dissolved. When a company is dissolved, “all assets that were owned by the company at that date, including trade marks, will have passed to the Crown as *bona vacantia* (i.e. ownerless goods). The Treasury Solicitor is the Crown’s nominee for dealing with such assets.”⁶

14. When The Positive Newspaper Co. Limited/The Positive Newspaper Company Limited was dissolved on 11 December 2018, the two trade mark registrations, as assets, would have become the property of the Crown. Ms Steidl could not, therefore, have become the owner of the registrations without the Treasury Solicitor, acting for the Crown, having assigned the registrations to her (or to an intermediary). They were not her property, or the property of her dissolved company, to assign to herself. Filing forms TM16 at the Intellectual Property Office (“IPO”) merely records assignments having taken place; the forms themselves state that they are not assignment documents. The information provided on the form is taken at face value by the IPO and the registrar does not investigate or otherwise seek to establish the legality of the claim to change of ownership unless, as has happened in this case, the recordal of the change of ownership is subsequently challenged.

15. It makes no difference that Ms Steidl has continued to use The Positive Society as a trade mark or sign. Likewise, her stated accrual of goodwill is not relevant to the rectifications. These are entirely separate issues to the legality of the assignments of the registered trade marks.

⁶ *Turbochip (UK) Limited’s application*, Case BL O/112/09, Ms Anna Carboni, sitting as the Appointed Person, at paragraph 26. See section 1012 of the Companies Act 2006: “Property of dissolved company to be *bona vacantia*”.

Outcome of the rectification applications

16. I find that the register stands in error and that it is right that the errors be corrected. The errors are that the assignments could not legally have been made. The register will be rectified by putting both of the contested marks back into the name of the original proprietors:

(i) 3073724: The Positive Newspaper Co. Limited; and

(ii) 801291812: The Positive Newspaper Company Limited

The revocation applications

17. The relevant parts of Section 46 of the Act state:

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

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

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

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of

whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

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

(4) [...]

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

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

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

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

18. The proprietor of a trade mark registration bears the burden of proving that its mark has been put to genuine use because Section 100 of the Act states:

“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.”

19. The outcome of the rectification proceedings means that Ms Steidl is not now the registered proprietor or the legal or beneficial owner of the contested marks. She is no longer a party to the revocation proceedings as they currently stand and is not now entitled to show what use has been made of the marks. I have considered whether it would be right to suspend the revocation proceedings and invite the Treasury Solicitor to state whether it has an interest in the marks in order to defend the revocation proceedings as the beneficial owner of the contested marks. However, I have decided against this course of action because the evidence filed by Mr Marsden shows that the Treasury Solicitor was unaware of the contested marks. There would be no point in re-starting the revocation proceedings because the dissolved company has obviously not used the marks and neither has the Crown; nor has the Crown given consent to anyone to use the marks.

20. The revocation applications, therefore, succeed. However, in order to give the parties the fullest picture and in case of appeal, I will give my reasons why, even if Ms Steidl was still the proprietor, the evidence is insufficient to show that genuine use was made of the marks in the UK in the relevant five year period, 31 May 2017 to 30 May 2022.

21. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:⁷

“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*

⁷ “CJEU” is the abbreviation for the Court of Justice of the European Union. 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 Trade Marks 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 caselaw of EU courts.

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].”

22. The services for which the contested marks are registered and for which Ms Steidl states genuine use has been made of the marks are:⁸

Class 35: Business information services provided online from a global computer network or the internet; providing a searchable online advertising guide featuring the goods and services of other on-line vendors on the internet; arranging subscriptions of the online publications of others; online advertisements; online advertising via a computer communications network; providing online advertising marketplaces for sellers and buyers of goods and services.

Class 38: Chatroom services for social networking; forums [chat rooms] for social networking; chat room services for social networking; providing on-line chat rooms for social networking; online document delivery via a global computer network; online messaging services; providing an online interactive bulletin board; chatroom services for social networking; forums [chat rooms] for social networking; chat room services for social networking; providing on-line chat rooms for social networking; greeting cards online (Transmission of -).

Class 41: Organizing community sporting and cultural events; publication of documents in the field of training, science, public law and social affairs; instruction in social graces; provision of social club services; social club services for entertainment purposes; electronic online publication of periodicals and books; organizing community sporting and cultural events; Provision of information relating to entertainment online from a computer database of the Internet; Providing online electronic publications; Publication of documents in the field of training, science, public law and social affairs; Instruction in social graces; Provision of social club services; Social club services for entertainment purposes; Online electronic publishing of books and periodicals; Providing

⁸ This is the specification for the '724 mark, which contains some repetition.

online non-downloadable comic books and graphic novels; Publishing, including online publishing; Online publications.

Class 42: Designing, managing and monitoring online forums for discussion.

Class 45: Social introduction agencies; Dating services provided through social networking; On-line social networking services; Social work services; Social networking services; Social introduction agencies; Dating services provided through social networking; On-line social networking services; Social work services; Social networking services.

23. Ms Steidl's witness statement is dated 4 January 2023 and she adduces nine exhibits. She states that she is the founder and owner of "the positive society", a position which she has held since 2014. Since Ms Steidl's witness statement is brief, I reproduce the substantive content below:

"2. The positive society has been using its trade mark since December 2014, online and offline. Exhibit A1 is Companies House registration of the positive society as a Ltd company. Attached at exhibit A2 are media articles and comments from members which discuss the positive society.

3. The positive society began as an online project and now have over hundreds of member part of the online community. In exhibit A3, which shows members in the positive society from the relevant period (2017 to 2022 as the request of the opposition) Within the positive society we have members which interact see exhibit A4, a shop of clothing and cups as seen in exhibit A5 which are available on in the online site. Exhibit A6 provide business owners who promote their business in the positive society. The positive society hosts a variety of dinner events offline as shown in Exhibit A7 The trade mark is clearly visible on the website. Exhibit A6 also contains images of the positive society which show the trade mark. These have been used throughout the relevant period.

4. Evidence of the publicity of the positive society and its trade mark have received is shown at exhibit A6, in the form of articles in the relevant period.

We only had word of mouth with the positive society and google AdSense was our advertising stream. In Exhibit A8 shows Google AdSense and Analytics which brings in minimal amount of revenue through Google Ads.

5. Produced at exhibit A9 is a selection of invoices dated within the relevant period which show purchases and work we required under our trade mark.”

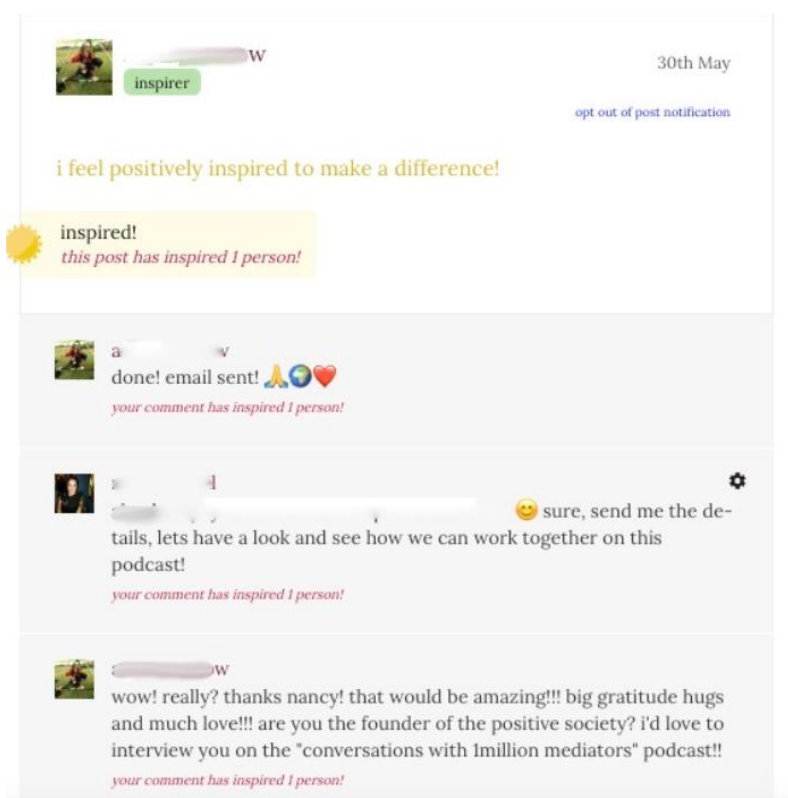
24. Taking the exhibits in turn:

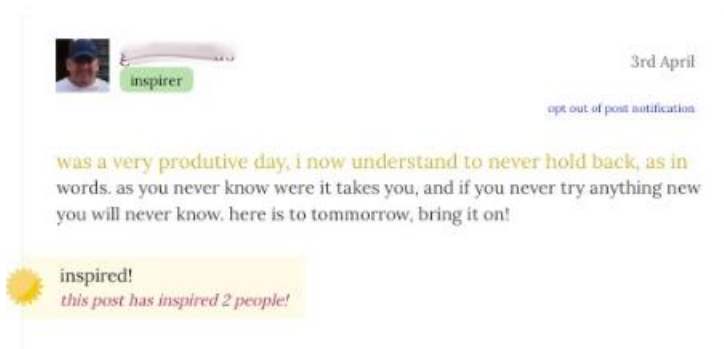
(i) Exhibit A1 comprises a screenshot of confirmation from Companies House of payment for incorporation on 27 July 2016 of the company name THE POSITIVE SOCIETY LTD (before the relevant five year period). Registration of a company name should not be confused with use of a trade mark. They are not the same thing. (Neither is registration of a trade mark the same as actual use of a trade mark.);

(ii) Ms Steidl states that Exhibit A2 comprises media articles and comments from members which discuss the positive society. The first item is dated 21 May 2019 from an individual who gives a definition for ‘society’. The item is unexplained; I am assuming it was posted on The Positive Society’s website because it appears that it could be listened to or that it was a ‘2 min read’, entitled “Positive Society...”. The second item was a text from an unknown person sent to ‘Nancy’ (presumably, Ms Steidl) on 29 December 2015, before the relevant five year period thanking her for everything she does with “the Positive Society”, and that the writer really valued her posts. The third item is dated 13 February 2017, before the relevant five year period, which seems to be about Ms Steidl on a podcast show about successful women. It does not say how many people listened to the show, where they were from or what was discussed. The fourth item looks like a Facebook post from ‘Rebuild Society Project’, reposting a launch post by ‘the positive society’, both of which are entirely undated. I note that the positive society is described as a worldwide community website. The fifth item is a Facebook post by the London West End WI thanking The Positive Society for a talk; however, there are no dates at all;

(iii) Ms Steidl states that Exhibit A3 shows membership of the positive society from the relevant period. The first page appears to show that in 2017-2018 ten people joined. In 2018-2019, a further nine people joined and a further 24 people in 2019 to 2022. At the hearing, Ms Steidl said that The Positive Society has 28,000 members, but there is no evidence to that effect, and certainly no evidence of that in the relevant five year period. A further issue, given that The Positive Society describes itself as a worldwide community website, is where the members are from and where the services are provided. Only two of the members' email addresses are clearly located in the UK. Most of them are .com email addresses and two have .fr addresses;

(iv) Ms Steidl describes the first item in Exhibit A4 as “engagement on the positive society community” from 2018. There are eighteen comments, some of which are simply people welcoming newcomers, thanking Ms Steidl, or others wishing people a nice week. Six of the comments were posted by Ms Steidl, which leaves twelve comments made by other members. The second group of items in the exhibit are collectively entitled ‘interactive posts in the positive society over the years 2017 – 2022’, shown below:





(v) Exhibit A5 refers to the sale of clothing and cups, available on the online site. The contested marks do not cover class 21 for cups or class 25 for clothing. Nor do the class 35 specifications cover retailing of cups or clothing. This exhibit is irrelevant;

(vi) Exhibit A6 appears to provide online advertisements for third party businesses, but there are no dates:



we have a range of offers hand picked for you! you may view specific offer information by clicking "see offer". if you'd like to submit an offer please let us know!



a complimentary 30 minute skype consultation with individuals who are interested in discovering how they are able to enhance their writing skills, along with a review of website content or draft e-book, to ensure professionalism of online businesses. a further 10% discount should it further into a long-term business relationship.

[see offer!](#)



special exclusive rate on half day and full day magical home transformation sessions. each session includes a beautiful complimentary jo malone candle.

[see offer!](#)



4 voice lessons offered for half the original price. if one has a desire to sing, then one must sing!

[see offer!](#)



25% off premium one-on-one health-coaching package

[see offer!](#)

(vii) Ms Steidl states that The Positive Society hosts a variety of dinner events. Exhibit A7 is said to support this statement. There are no dates other than "18.9", the date of a letter from the Anna Freud Centre thanking The Positive Society for its donation after holding a dinner. Such a date does not show in what year the dinner event took place;

(viii) Exhibit A8 shows data from Google AdSense and Google Analytics. The first page is pre-relevant date (from February 2017). The next three pages appear to provide daily figures from October 2017, February 2018 and October 2019. The number of page views or impressions are either in single or double figures, and are sometimes zero. The snapshot for August 2022 is after the relevant five year period, but showed there were only 63 users with no indication where they were located. In September 2019, there were 36 users with 43 sessions, with no indication where they were located;

(ix) Exhibit A9 comprises invoices which Ms Steidl states show purchases and work “we required under our trade mark”, rather than services provided under the mark. Three invoices dated in 2017 were for website work and another in 2019 was for domain name renewal. A further two were for website work in 2022.

25. In assessing whether genuine use has been made of the earlier mark, I am not simply making a judgment about the commercial success of the mark in relation to the services for which it is registered. It depends upon a variety of factors which includes the nature of the services and the characteristics of the market, but also the consistency of use over time and whether the use is warranted to create or maintain a share in that market. In a conventional market, relatively low numbers of sales may still qualify as genuine use in the market. The present case does not strike me as a conventional market. There are no sales figures and it is not clear to me that any charge is made for services. The second point to make is that it is also not entirely clear from the evidence what services are offered that can be mapped onto the specifications of the contested marks.

26. I have stood back and looked at the whole picture presented by the evidence Ms Steidl has provided. This is because an assessment of genuine use is a global assessment, not whether each individual piece of evidence shows use by itself.⁹ However, the collective picture is no more compelling than that provided by the individual pieces of evidence. There are a number of items which are outside of the relevant five year period and a number which are entirely undated. The assessment of genuine use is tied to a particular time period. This makes it very important that exhibits are dated or, if undated, other evidence corroborates them and makes it possible to place their use within the particular five-year period. It is also very important that the evidence which is dated shows that use took place within the relevant five-year period. The dated evidence is wholly underwhelming. For example, the post which is entitled “Positive Society...” has no explanation; there were very few members according to the evidence provided and no evidence about whether they

⁹ Case T-415/09, New Yorker SHK Jeans GmbH & Co. KG v OHIM, General Court.

were in the UK; the same is true of the comments; and there was very little traffic to the website.

27. Whilst the genuine use provisions are not there to assess economic success, nevertheless, to qualify as genuine use it must be appropriate in the economic sector concerned for preserving or creating a market share for the relevant goods or services. At the hearing, Ms Steidl referred to The Positive Society as a “project”. That is not fatal, but applying for a trade mark, which is tied to goods or services, means that the intention must be that the mark is to be used as a trade mark in relation to those goods or services. The use provisions allow for five years for trade to get up and running. That is the balance struck in the intellectual property system between granting a commercial monopoly and potentially removing it to avoid cluttering up the trade mark register with marks which are not being used, or not to the degree for which the system is designed.

28. In *James Grant Group Limited v Stephen Murphy*, Mr Daniel Alexander QC, sitting as the Appointed Person, said:¹⁰

“15. While the Appellant is right to say that trade mark law should protect small traders as much as large, it does do so, even if applied in the way that the hearing officer did. In particular, where there is a good explanation for why sales are very small in circumstances where a trader has undertaken real efforts to create or maintain a market under the mark, the fact that he or she has not succeeded in doing so will not be fatal to maintaining registration. Trade marks are, however, designed to protect a real and substantial existing or future business. A registered proprietor who is given wide rights by registration can reasonably be expected to engage or have engaged in sufficiently solid activity in order to justify the continued existence of such rights or for there to be a sufficiently solid explanation for why that has not been possible.”

29. A further issue is that for some of the five year period, the marks could not have been put to genuine use in the United Kingdom “by the proprietor or with his consent”

¹⁰ Case BL O/543/20

because after 11 December 2018, they were *bona vacantia* and belonged to the Crown. It would have been the Crown which would have had to have consented to their use and the evidence in the rectification actions shows that the Crown/the Treasury Solicitor had no knowledge of the contested marks. This means that any use commencing on or after 11 December 2018 was not with the consent of the proprietor: the Crown. That would leave a period of only 31 May 2017 to 10 December 2018 during which use could be said to be with the consent of the original solvent proprietor, of which Ms Steidl was a director. The amount of use over the whole five year period is insufficient and there was also insufficient use during the period 31 May 2017 to 10 December 2018.

Outcome of the revocation applications

30. The applications for revocation succeed. Under section 46(6) of the Act, 3073724 & 801291812 are revoked from 31 May 2022.¹¹

Costs

31. Creative has been successful in all four actions and is entitled to a contribution to its costs on the basis of the scale published in Tribunal Practice Notice 2/2016.¹² Some economy has been achieved by consolidation and repetition in the claim forms, repetition in the counterstatements and evidence, which is taken into account in the cost breakdown. I have not awarded anything for Creative's attendance at a case management conference: it resulted in the filing of the rectification actions and was not a 'win'.

Fees for TM26(N) x 2	£400
Filing revocations and considering the counterstatements x 2	£400

¹¹ Bearing in mind that the status of 3073724 is currently expired.

¹² The scale applicable to these proceedings.

Filing rectifications and considering the counterstatements x 2	£600
Considering evidence in the revocations	£250
Attending the hearing	£600
Total	£2250

32. I order Nancy Steidl to pay Creative Planet Intellectual Property Pty Ltd the sum of **£2250**. 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 these proceedings if any appeal against this decision is unsuccessful.

Dated this 17th day of December 2024

Judi Pike
For the Registrar