

O-177-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 83168
BY VRL INTERNATIONAL LIMITED FOR REVOCATION
OF REGISTRATION NO. 2246364 STANDING IN THE NAME OF
NOVA HOTELS LIMITED**

BACKGROUND

1. Registration No. 2246364 for the trade mark BREEZE stands registered in the name of Nova Hotels Limited (Nova). The trade mark was applied for on 22 September 2000 and the registration procedure was completed on 23 February 2001. The trade mark is registered for the following services in class 39.

Transport services; travel arrangements.

2. On 27 February 2008, VRL International Limited (VRL) applied for revocation of the registration. They did so in the following terms:

“2. The Registered Trade Mark was not put to genuine use in the United Kingdom by the Registrant or with its consent, in relation to the services for which it is registered, within five years following the date of completion of the registration procedure, and there are no proper reasons for non-use. The Applicant relies on section 46(1)(a) of the Trade Marks Act 1994. This ground provides that the revocation will take effect from 24 February 2006.

3. In the alternative, if any such use is shown, it has been suspended for an uninterrupted period of five years, from 28 February 2003 to 27 February 2008, and there are no proper reasons for non use. The Applicant relies on section 46(1)(b) [of the Act]. This ground provides that the revocation will take effect from 28 February 2008.”

3. On 6 June 2008, Nova filed a Form TM8, counterstatement and evidence. In their counterstatement they say:

“1. The Proprietor submits that the Mark has been put to genuine use in the form as registered, or alternatively, in a form differing in elements which do not alter the distinctive character of the Mark in the form in which it was registered within the UK in relation to the services for which it is registered during the relevant period by the Proprietor and/or by former proprietors of the Mark or with their consent.”

4. Both parties filed evidence which is summarised below and both seek an award of costs in their favour. While neither party requested to be heard, both filed written submissions in lieu of a hearing which I will refer to as appropriate later in this decision. After a careful consideration of all the material before me, I give this decision

EVIDENCE

Nova’s evidence accompanying the Form TM8

5. This consists of a witness statement, dated 5 June 2008, from Sujit Shah who is Nova’s Sales and Marketing Director; Mr Shah confirms that the information in his statement comes from either his own knowledge or from his company’s records.

6. Mr Shah explains that Nova own and operate hotels and resorts and provide related services; as examples, he explains that they own the Breezes Beach Club & Spa and the Palms Hotel (both of which are in Zanzibar). He adds that Nova have associated companies in both the UK and Sweden i.e. Breeze Travel Limited and Breeze AB. He states that these companies are involved in advertising, promotion and offering resorts, hotels and safaris as well as other products and services, including those offered by members of the Nova group or related companies. He adds that these companies provide other administrative services such as the transportation and distribution of brochures and promotional items.

7. Mr Shah notes that Nova were not the original applicants for registration of the trade mark; the original applicant was, he says, a company called Breeze Aviation Limited (BAL). He adds that in early 2006 the trade mark was assigned by BAL to London Docklands Heliport Limited (LDH); it was subsequently assigned to Nova in June 2006. This chronology is supported by an extract taken from the Trade Marks Registry's (TMR) database provided as exhibit 1.

8. Mr Shah explains that as neither BAL or LDH have any connection with Nova, he is unable to provide direct information about the use made of the trade mark by these companies in the relevant periods. That said, he states that internet searches suggest that BAL (which he says is referred to as Breeze) provided travel services and transport arrangements specifically in the field of aviation.

9. Exhibit 2 consists of copies of press articles dating from October and November 2004 which Mr Shah says comment on BAL's use of the trade mark BREEZE in connection with services to be offered from its then newly opened helipad in East London. The documents provided are as follows:

Two pages from www.flightglobal.com (Flight International) dated 5 October 2004. The article which is entitled:

"Breeze plans fresh network after opening second London helipad",

explains that:

"UK start-up Breeze Aviation is planning a network of charter and scheduled business helicopter flights from a new east London helipad which opened last month."

It goes on to say, inter alia:

"The company last year acquired the former Ford factory's helipad in Dagenham....and started unlicensed operations last month..."

10. This is accompanied by three pages from www.ebanmagazine.com (European Business Air News) dated 10 November 2004. This article which is entitled:

"Newly opened London Docklands helipad looks east for inspiration",

provides further information in the same vein and, in the body of the article, refers to, for example: “operated by Breeze Aviation”, “Breeze commercial director Ed Moodie...”, “Ford saw Breeze’s proposals..” and “called the Breeze Partnership Programme...”

11. Mr Shah goes on to say that since 2006 the trade mark has been used in the UK by Nova or its associated companies (with its consent) in a number of ways. He explains that Breeze Travel Limited and Breeze AB sell safaris as well as holidays at hotels and resorts in Africa. These holidays are in hotels operated not only by Nova’s associated companies but also in the hotels and resorts of third parties. Exhibit 3 consists of a flyer which was distributed from Nova’s stand at the World Travel Market event held in London in November 2007; approximately 50 such flyers were distributed. Exhibit 3 consists of two pages. The first contains the following wording at the top of the page:

“Travel with the Breeze”.

Further down the page it says, inter alia:

“Our special safari itineraries offer the ultimate gateway to include your entire family.”

The second page contains the word “Breeze...” at the top of the page, at the bottom left is a reference to Breeze AB, and at the bottom right a reference to:

“Breeze Travel Limited
99 Kenton Road, Kenton
Harrow, Ha3 OAN
UK
Email: info@breezes-zanzibar.com
Tel: +46 709 795 999.”

12. Mr Shah explains that exhibit 4 consists of invoices issued by Breeze AB to Breeze Travel Limited and by Breeze Travel Limited to other companies in the Nova group or related companies, in connection with the transportation and distribution of brochures and promotional items. Exhibit 4 consists of a range of invoices from Breeze AB to Breeze Travel UK dating from 18 August 2007 to 25 February 2008. Of the fourteen invoices provided thirteen refer to “Transport Service” with one referring to “Transport of brochures to Germany”. The value of the invoices range from a low of £41.12 (10 October 2007) to a high of £1,121.74 (27 September 2007). The remaining seventeen invoices are from Breeze Travel UK to Breezes Beach Club in Zanzibar (fifteen invoices), one invoice to Palacina in Nairobi and one invoice to Palms in Zanzibar. All refer to “Transport Service” or “Transport of brochures” and have values ranging from a low of \$32.76 (10 October 2007) to a high of \$2,225.61 (27 September 2007).

VRL’s evidence-in-chief

13. This consists of a witness statement, dated 23 September 2008, from Louise Gellman who is a solicitor and partner in the firm of Nabarro LLP, VRL’s professional representatives in these proceedings. Ms Gellman confirms that unless she indicates otherwise the information in her

statement comes from her own knowledge. Ms Gellman's evidence and the associated exhibits consist of a critique of Mr Shah's evidence together with submissions on the issues that arise in the context of the law and relevant authorities. I do not propose to summarise her criticisms and submissions here, but will of course keep them in mind when reaching a decision. That said, the following quotations from Ms Gellman's statement will, I hope, give a sense of why, in VRL's view, Nova have not made genuine use of their BREEZE trade mark in relation to the services for which it stands registered:

"This is not surprising since, as Ms Shah explains, [Nova] operates in "the field of owning and operating hotels and resorts and offering related services" and one of its properties operates under the name Breezes Beach Club & Spa..In that business [Nova] uses the name BREEZES (plural) and not BREEZE (singular)."

"The materials provided by [Nova]....in relation to alleged use by [BAL] simply discuss plans for a new helipad in London and do not demonstrate genuine use of BREEZE in relation to the services covered by the Registration."

"The evidence filed...to show genuine use of BREEZE by [Nova] is also insufficient. It relates only to token or internal use and is not sufficient to maintain the registration."

"....that the materials filed by [Nova] purporting to show use by it and its associated companies following [Nova's] acquisition of the Registration represent nominal use or internal (non-consumer facing) use only.."

14. Ms Gellman concludes her statement in the following terms:

"The evidence presented by [Nova] is not sufficient to prove genuine use of BREEZE in relation to the relevant services during the relevant period. This applies to both the part of that period during which the Registration was in the hands of [BAL] and the period of ownership by [Nova]. The evidence presented is insufficient in terms of quality and quantity. The use is small, largely internal and does not demonstrate use with a sufficiently significant commercial purpose to justify the claim of genuine use."

Nova's evidence-in-support

15. This consists of two witness statements. The first, dated 28 November 2008, is from the same Sujit Shah mentioned above. In response to comments from Ms Gellman on exhibit 3 (the flyer) to his first witness statement Mr Shah says, inter alia:

"..Ms Gellman concedes...that arranging safari expeditions amounts to "travel arrangement". I should explain that we do not operate safaris ourselves. The safaris referred to on the flyers distributed at the World Travel Market in November 2007 are third party safaris intended to be bought from operators based in East Africa and Southern Africa and to be designed to our customers' requirements..."

16. The second witness statement, dated 26 November 2008, comes from Edward Moodie who was a Director and the Commercial Manager of BAL. Mr Moodie explains that he was appointed as a Director of BAL on 31 January 2003 and that he held this position until BAL was formally dissolved on 10 November 2006. He confirms that the information in his statement comes from either personal knowledge, from BAL's archives, or from computer data and information to which he has access.

17. Mr Moodie explains that BAL was incorporated on 14 September 2000 as a helicopter start-up operation. The nature of the business was, he says, to provide scheduled and non-scheduled air transport with the business plan including a shuttle service between Heathrow airport and Canary Wharf, Heathrow airport and the Paris central heliport and the provision of commuter flights between London and Sheffield, Manchester and Liverpool. Mr Moodie states that the events surrounding 9/11 delayed these plans.

18. Mr Moodie states that in late 2003 or early 2004, BAL entered into a lease arrangement with Ford Motor Company in Dagenham to use the helipad located on their corporate site. BAL obtained planning permission for change of use from the local council to use the helipad for commercial activities. Exhibit EM1 consists of a summary of the application details, from which I note the application was received on 28 August 2003 and approved with conditions on 16 March 2004. The applicant is listed as BAL with the proposal described, inter alia, as: ..Change of use from corporate to commercial use for helipad." Exhibit EM2 consists of pages taken from www.aviation-links.co.uk (The AirNet Web") on 7 August 2008 on page 8 of which under the heading "Heliports" there appears the following text:

"London Docklands Helipad (Breeze)."

19. Mr Moodie goes on to say that BAL had various formal and informal arrangements with the London City Airport, the Metropolitan Police Air Unit and Customs and Immigration, and that they were members of the British Helicopter Advisory Board (BHAB). He states that both the London City Airport and the BHAB knew BAL by and often referred to them as "Breeze."

20. Mr Moodie says that BAL opened for business in September 2004. They operated the helipad at the Dagenham site and permitted third parties to land and take off from the helipad in return for a fee. He states that approximately six third party operators used the helipad and eight or nine flights went ahead. Two of these third party operators were PremiAir Aviation and Biggin Hill Helicopters. It was at this time that BAL encountered funding difficulties; they went into administration in February 2005 and were dissolved in November 2006.

21. Mr Moodie states that prior to its ceasing to trade, BAL used the BREEZE trade mark to advertise, promote and market the company and the word appeared prominently on all business plans, business cards, letterheads, invoices and promotional material; unfortunately no examples of this documentation survives. He adds that BAL also developed and used a circular logo consisting of a rotor swirl surrounding the BREEZE trade mark. This logo, together with the word BREEZE was, he says, used on the internet and on promotional flyers. He adds that some two thousand flyers were printed and approximately a thousand were distributed by direct mail to various helicopter and jet operators using Biggin Hill, Farnborough and Denham

airports, Stapleford and Redhill aerodromes, the Helicopter Emergency Services (HEMS), the Metropolitan Police Service and RAF Northolt.

22. Mr Moodie explains that BAL was featured in the press and the launch of its London dockland helipad in September 2004 received publicity. In addition to the documents provided as exhibit 2 to the statement of Mr Shah, Mr Moodie states that articles were featured in The Wharf publication (which he believes was published in September 2004), Air and Business Travel News (exhibit EM5) and in the Dutch publication Scramble 308 in January 2005 (exhibit EM6). I note that exhibit EM5 consists of a page taken from www.abtn.co.uk dated 27 September 2004 and contains references to “the Breeze helipad” and www.flybreeze.com, and that while exhibit EM6 contains a reference to “De firma Breeze Aviation is in het...” the document is entirely in the Dutch language and has not been accompanied by an English translation.

23. At exhibit EM7 Mr Moodie provides a copy of what appears to be an undated extract from “the essential Venue Guide for London Eastside” which, at page 57 under the heading “How to get there”, includes references to: “The Breeze Helipad” and www.flybreeze.com

24. Mr Moodie explains that BAL operated the website mentioned above, which featured information about BAL and its services, which he says prominently featured the BREEZE trade mark and the BREEZE logo and which was frequently updated. Exhibit EM8 consists of an incomplete screen shot of the BAL website obtained using the Wayback Machine internet archive which I note contains a reference to Breeze Aviation. Exhibit EM9 (also from the Wayback machine) shows the dates and frequency of when information was uploaded to the website. I note that in the period 2002 to 2005, the site was updated six times, the first update was on 8 June 2002 and the last on 17 October 2005.

25. Mr Moodie adds that BAL owned a Jaguar motor car that was used to transport clients from the client lounge to the BREEZE helipad and which he says bore a BREEZE bumper sticker in the back window; he explains that no photographic evidence of this survives.

26. Mr Moodie concludes his statement in the following terms:

“I can confirm from my own knowledge that [BAL] used the BREEZE trade mark extensively during the time period in which [BAL] actively traded from September 2004 to February 2005 and prior to trading, the BREEZE mark was used in all advertising, promoting and marketing material.”

VRL’s evidence-in reply

27. This consists of a witness statement, dated 5 March 2009, from the same Louise Gellman mentioned above. As Ms Gellman’s statement and the associated exhibits consist (primarily) of submissions on Mr Shah’s second statement and the evidence of Mr Moodie, it is not necessary for me to summarise it here; as above I will of course keep it in mind when reaching my decision. However, the following extracts from her statement are indicative of VRL’s view of

Nova's evidence-in-support. In relation to the evidence of Mr Moodie, Ms Gellman says, inter alia:

"..[BAL's] planned business was to operate helicopter flights but these plans were never implemented. Rather [BAL] operated a helipad in the Docklands area of London.."

"...and 8 or 9 flights went ahead.."

"It seems that [BAL] never operated a "transport service" or provided "travel arrangements" as such. It did not transport people or goods itself under the trade mark BREEZE or make travel arrangements. Rather, it provided a facility (a helipad) to third parties who provided those services to consumers (presumably under the third parties' respective trade marks)."

"The evidence shows that the service provided by [BAL] was provided to third party transport providers (helicopter flight operators). [BAL] provided approximately six helicopter operators with a facility to land and take off, together with some basic ancillary services. There is no evidence to suggest that these third parties operated under the trade mark BREEZE."

"Mr Moodie explains that [BAL's] services included a car service from the client lounge to the BREEZE helipad. This kind of service falls within "transport services", but the use was very small and it is unlikely that it would have been understood as a branded service by the few passengers that used it."

28. In relation to the second statement of Mr Shah, Ms Gellman says, inter alia:

"It is agreed that the arrangement of safaris may amount to travel arrangement services, but the question is whether the flyers are sufficient evidence of genuine use of BREEZE in relation to those services noting in particular that only 50 flyers were distributed in the relevant period.

The use of the flyer is small scale and may constitute token use only. No evidence of actual bookings or arrangement made for safaris under the trade mark BREEZE has been provided by [Nova]. Indeed, [Nova's] operations under the name BREEZES BEACH CLUB are far more significant and it has been in dispute with VRL regarding the rights to the BREEZES trade mark...."

29. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

The Law

30. Section 46 reads as follows:

“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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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 existed at an earlier date, that date.”

31. Section 100 of the Act is also relevant and reads:

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

The relevant five year periods

32. The application for revocation is based on sections 46(1)(a) and (b) of the Act; the registration procedure for the trade mark in suit was completed on 23 February 2001. The relevant periods are therefore, under 46(1)(a): 24 February 2001 to 23 February 2006 (with revocation to take effect from 24 February 2006), and under 46(1)(b): 28 February 2003 to 27 February 2008 (with revocation to take effect from 28 February 2008).

The authorities on genuine use

33. In their written submissions there appears to be no dispute between the parties that the two leading authorities on the guiding principles to be applied in determining whether there has been genuine use of a mark are: *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);

- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

34. I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

35. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

36. And finally the comments of the Court of First Instance in *Reckitt Benckiser (España), SL v OHIM*, Case T- 126/03 are relevant where it held that:

"45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely

and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

37. In reaching a conclusion in these proceedings I note the following comment which appears in Nova's written submissions:

"30. Ms Gellman points out that the invoices exhibited to Mr Shah's evidence were internal documents. This is not disputed. These documents have been exhibited to demonstrate the proprietor's interest in and use of the BREEZE mark. Given the internal nature of the documents [Nova] accept that they will not count as evidence of genuine use of the mark for the purposes of these proceedings."

38. In view of that helpful concession, I need make no further mention in this decision to exhibit 4 to Mr Shah's first witness statement. I will now consider the evidence which remains in the context of both time periods mentioned above and in relation to the services for which Nova's trade mark stands registered i.e. transport services and travel arrangements.

39. In these proceedings Nova are relying on the evidence of use made of the BREEZE trade mark by BAL (prior to their acquisition of the trade mark in June 2006) which is contained (primarily) in the witness statement of Mr Moodie. They also rely on their own use of the trade mark as contained (primarily) in the first witness statement of Mr Shah and exhibit 3 thereto.

Use by BAL

40. In their written submissions Nova comment on the use made of the BREEZE trade mark by both themselves and BAL. In relation to the use by BAL they say, inter alia:

"10. Mr Moodie explains that ...the business of [BAL] was to provide scheduled and non-scheduled air transport..."

"11...However, those plans were affected by the events surrounding the terrorist attacks on 11 September 2001."

“12..In September 2004 [BAL] launched its helipad service from the site. Mr Moodie explains that [BAL’s] business involved third party operators using the helipad in return for a fee...Mr Moodie in his statement explains that between September 2004 and February 2005....approximately 6 third party operators used its helipad and around 8 or 9 flights went ahead.”

13. Mr Moodie states...that [BAL] made prominent use of the BREEZE mark in connection with this business...”

“16...The tribunal is, therefore, entitled to take into account not just the use made of the mark during the period in which [BAL] actively traded, but also its use of the mark during the period in which it was preparing to offer its services.

17. It is clear from Mr Moodie’s evidence that the launch of the BREEZE business in September 2004 involved intensive preparations and dealings with numerous third parties over an extended period...Mr Moodie’s statement refers to the company’s formal and informal arrangements with London City Airport, the Metropolitan Police, Customs and Immigration and the [BHAB]. In addition, the company was clearly active in arranging interviews with the press, internet and other advertising and the company’s website, and discussing business opportunities with other third parties.

18. ...There is clearly no suggestion the [BAL’s] activities were in any way “token” or “sham” and the extent of its trading activity under the mark is clearly sufficient to count as genuine use.”

“19. So far as the nature of [BAL’s] use of... is concerned...Ms Gellman suggests that certain of the references to the mark in the evidence are intended as an abbreviation of the company name [BAL] or are in the form “Breeze Aviation”. The alleged significance of this is not entirely clear. To the extent that [VRL] seeks to argue that the examples of use of BREEZE relied on should not count as genuine use of the mark, we submit this is misconceived.

20. It is possible that there may be some type of attack on the basis that BREEZE was not being used in relation to the services specified because it is a company name and not a trade mark based on the decision of the ECJ in *Celine SARL v Celine SA* (Case C-17/06).”

Following a passage in which Nova refer to the decision of the ECJ and to which I will return later in this decision, they go on to say:

“21. Paragraph 22 of Celine makes it clear that in the case of goods, where the company name is affixed to the goods which the proprietor markets, there is a presumption that this amounts to use “in relation to the goods”. However, where it

is not affixed, the “link” in paragraph 23 must mean at the very least that the public assumes that the company is responsible in some way for the marketing of the goods or services being provided.

22. In the present case, the mark relates to services rather than goods. Mr Moodie’s evidence is clear that [BAL] used BREEZE as a trade mark. BREEZE was affixed to the majority of the documentation used by [BAL] during the relevant period and, from his description of the BREEZE logo, it could hardly be clearer that this would be seen as a trade mark.

23. So far as the names “Breeze Aviation” and/or “Breeze Aviation Limited” are concerned, to the extent that these names were used, we submit that these fall within section 46(2) and should count as use of BREEZE. In the context of a company providing services in the field of aviation, the suffix “Aviation” is likely to be regarded as highly descriptive. BREEZE would be seen, we submit, as the distinctive element and “Breeze Aviation” does not alter the distinctive character of BREEZE in connection with such services. The designation “Limited” merely indicates the legal status of the company. Looked at in the round, it is clear that BREEZE has been used to indicate a trade connection between Breeze Aviation and the services it offered.”

25. So far as the scope of the mark is concerned [VRL] suggests that if the use of the mark made by [BAL] is considered genuine....then the services covered should be cut back to “operation of helipads” or “provision of helipad services.”

26. It is clear from Mr Moodie’s evidence that the services offered extended beyond operating a helipad...[BAL’s] services and planned services covered a variety of transport related services, including a VIP Lounge and crew room, internet access, parking and a car service...[BAL] was at the time involved in discussions with a number of third party operators with a view to providing helicopter charter/sightseeing services which we submit constitute travel arrangements..[BAL’s] use should be considered sufficient to maintain the mark for all the services concerned.”

41. In their written submissions VRL comment on BAL’s use in, inter alia, the following terms:

“9. [BAL] did not operate a “transport service” or provide “travel arrangements” as such. It did not transport people or goods itself under the trade mark BREEZE or make travel arrangements. Rather it provided a facility (a helipad) to third parties who provided those services to consumers (presumably under the third parties’ respective trade marks)...There is no evidence to suggest that these third parties operated under the trade mark BREEZE.”

“10. Furthermore, the majority of the uses of “Breeze” referred to in the evidence are shorthand references to the company [BAL] and not uses of the mark to denote the origin of the services.”

“11. All of the uses of BREEZE....were in connection with a short lived helipad service and there is no evidence that the uses would be of the scale necessary to preserve or create market share in the transport and travel sector generally. For example, a mere 1000 flyers were distributed and [BAL's] business was in Operation for a few months only.”

12. There is no evidence to show that [BAL] provided travel arrangement services under the trade mark BREEZE or that it did anything at all with a view to creating, let alone maintaining, any market share in travel arrangement.”

“13. Mr Moodie discusses a car service (arguably a “transport service”)..this use was very small scale and it is unlikely that it would have been understood as a branded service by the few passengers that used it.”

42. The key events in the life of the BREEZE trade mark the subject of these proceedings appears to me to be as follows:

14 September 2000: BAL incorporated as a helicopter start-up operation;

22 September 2000: Application for registration filed;

23 February 2001: Registration procedure completed;

24 February 2001: Period under section 46(1)(a) begins;

28 February 2003: Period under section 46(1)(b) begins;

28 August 2003: Application filed for a change of use of the helipad located at the Ford Motor Company in Dagenham;

16 March 2004: Planning application approved with conditions;

September 2004: BAL open for business;

February 2005: BAL enter Administration;

February 2006: The registration is assigned to LDH;

23 February 2006: Period under section 46(1)(a) ends;

June 2006: Nova acquire the registration in suit;

10 November 2006: BAL dissolved;

November 2007: The flyer is used at the World Travel Market event;

27 February 2008: Application for revocation filed and period under section 46(1)(b) ends.

43. In his evidence Mr Moodie explains that having been incorporated in 2000, BAL's intentions were (at that time) to provide scheduled and non-scheduled air transportation by helicopter. While the events of 11 September 2001 delayed these plans, it appears that as a result of market research conducted by BAL, their Managing Director John Wollmer contacted Ford Motor Works in Dagenham. Following a meeting with Ford management, BAL submitted, on 28 August 2003, an application to the London Borough of Havering for a change of use (from corporate to commercial) for the helipad located on the Ford site. The application was approved with conditions on 16 March 2004. The helipad which incorporated a reception building, secure parking and which provided a limousine service between the reception building and the helipad opened for business in September 2004. During the period September 2004 and February 2005 (when BAL went into administration) approximately six third party operators used the helipad and eight or nine flights went ahead.

44. Mr Moodie states that during its period of trading, BAL used the BREEZE trade mark to advertise, promote and market themselves, adding that BREEZE was used as a trading name, appearing on business plans, business cards, letterheads, invoices and promotional items. In his statement Mr Moodie says:

“..I have looked for examples, but unfortunately have not been able to locate any. Following [BAL] ceasing to trade, I did not retain much stationery or paperwork relating to the company. Most of my documents from this period relating to BAL were saved on a laptop which I no longer have.”

45. He also mentions that BAL used a circular logo which consisted of a rotor swirl surrounding the BREEZE trade mark, adding that this logo and the BREEZE trade mark were used on flyers (approximately one thousand of which were distributed to various helicopter and jet operators) and on their website. While I note from the evidence of Mr Moodie that the website www.flybreeze.com appears to have been live from 2002 to 2005, the evidence of Ms Gellman (exhibit LPG10) suggests that it was last updated on January 5 2008.

46. As the case law I have referred to earlier indicates, what matters when determining whether genuine use has been made of a trade mark is not just what (in this case BAL) planned to do i.e. to provide scheduled and non-scheduled air transportation by helicopter, but the objective circumstances of the case i.e. what BAL actually did. It seems to me that all of the evidence provided by BAL indicates that between September 2004 and February 2005 they operated a helipad service on Ford's Dagenham site. As part of that service they installed a temporary reception building and provided both secure parking and a car to transfer clients to and from the helipad; in the event, only eight or nine flights actually went ahead during the period in which BAL traded. While efforts were made to promote the service (most notably the flyer and the website), it is also clear from the press articles provided that the prospect of a new helipad in London created a good deal of interest amongst those in the aviation community.

47. While no monetary amounts have been provided of the income generated by the operation of the helipad, in his statement Mr Moodie makes it quite clear that a fee was charged (the absence of such figures is not fatal to Nova in any case). In reaching a conclusion I must of course also consider the competing submissions on the form of the trade mark used by BAL. The trade mark as registered is the word BREEZE in block capital letters. Unfortunately as none of the documents used by BAL in the course of their business survive, I must rely on the evidence of Mr Moodie when he says that:

“..we actively used the BREEZE trade mark to advertise, promote and market the company.”

And:

“BREEZE was extensively used as a trading name, and appeared prominently on all business plans, business cards, letterheads, invoices and promotional material.”

48. I must also keep in mind VRL’s criticisms of this evidence. The only concrete examples I have of the use made by BAL are in exhibit EM8 to Mr Moodie’s statement and exhibit LPG10 to the statement of Ms Gellman. In these exhibits BAL are referred to as “Breeze Aviation” and “Breeze”. Given Mr Moodie’s comments reproduced above and keeping in mind the comments of Mr Richard Arnold QC sitting as the Appointed Person in *Extreme Trade Mark* (BL O/161/07) when he said, inter alia:

“...A statement by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark has been used would not in my view constitute bare assertion. As counsel for the applicant accepted, it might not be possible for a trade mark proprietor to produce documentary evidence: for example all the records might have been destroyed in a fire”,

and in the absence of cross-examination of Mr Moodie, I am prepared to accept that BAL did use their BREEZE trade mark in the form in which it is registered during the period in which they traded. Given that finding, I do need to go on to consider the use by BAL in the context of the findings of the court in *Celine*, nor is it necessary for me to determine whether use by BAL of “Breeze Aviation” or “Breeze Aviation Limited” is qualifying use within the meaning of section 46(2) of the Act.

49. Having concluded that BAL did use their BREEZE trade mark during the period in which they traded, that use is, in my view, primarily use in relation to the operation of a helipad. While I note that BAL provided a car to transport passengers to and from the helipad, I do not, for essentially the reasons mentioned by VRL in paragraph 13 of their submissions (paragraph 41 above), think this assists Nova. In reaching a conclusion on whether BAL have made genuine use of their BREEZE trade mark, and if so what constitutes a fair specification of services, I must now apply the considerations listed at paragraphs 33-36 above to that conclusion. It seems to me that the operation of a helipad must be regarded as a niche activity aimed at a very specific customer base .The evidence indicates that when their initial plans for the trade

mark were disrupted by the events surrounding 9/11, BAL conducted market research and re-directed their attention to the provision of a helipad service. This initially involved them in discussions with Ford and later with the various organisations mentioned in paragraphs 18-20 above. BAL made the trade mark known by distributing flyers and by creating and maintaining the website at www.flybreeze.com. Given the references to BAL in the trade journals exhibited, their efforts were clearly not without success.

50. Considering all these factors, it appears to me that nothing about BAL's use of the BREEZE trade mark can be characterised as token or sham; it was clearly activity aimed at creating or preserving a market for their services. While the use took place over a relatively short period of only six months or so, it is clear from the case law that use need not be quantitatively significant for it to be deemed genuine, nor am I required to assess whether BAL's use of the BREEZE trade mark was commercially successful.

51. In short, I am satisfied that in the periods specified by VRL (in relation to both sections 46(1)(a) and (b) of the Act), BAL made genuine use of the BREEZE trade mark in relation to the operation of a helipad, and that the phrase "transport services" is sufficiently broad to include such a service.

52. I note that in their written submissions VRL say:

"26. If the Registrar decides that the use by [BAL] did constitute use of the trade mark BREEZE, it can only be capable of maintaining a registration for a very narrow sub-category of services in class 39 (that is, the operation of a helipad). This follows the approach of the Court of First Instance in [the case mentioned in paragraph 36 above]...

27. Therefore, if [Nova] is not stripped of all protection...the scope of registration should be reduced to cover "operation of helipads" "or provision of helipad services" only in class 39. This may be considered a sub-category of the relevant services and is readily understood as a discrete service by consumers. Indeed, this is apparent from the evidence provided by Mr Moodie."

53. While in their written submissions Nova argue that the specification of the registration should be preserved in totality, given the broad meanings attributable to the general phrases "transport services" and "travel arrangements", and notwithstanding the aspirations BAL may have initially had for their BREEZE trade mark, when one approaches the question objectively Nova's submissions are, in my view, unrealistic. Rather having applied the appropriate guidance, and for essentially the reasons highlighted in VRL's submissions, a fair specification which is neither too pernickety or too restrictive would, in my view, be:

"operation of a helipad".

Use by Nova

54. Before I can determine whether this is the final specification for which Nova's registration is to be preserved, I must now consider the use made by Nova themselves. In relation to their own use Nova say, inter alia:

"27. ..The first is a flyer distributed at the World Travel Market event in November 2007.."

"28. [VRL] concede that [Nova's] arrangement of safaris amounts to travel arrangement services..."

"29..We therefore, submit that the use of BREEZE on the flyer in question ought to be treated as genuine use of the mark for travel arrangement services."

55. In relation to Nova's use of the BREEZE trade mark, in their submissions VRL say, inter alia:

"15. In his evidence, Mr Shah explains the nature of the activities of [Nova's] associated companies he claims have put the mark BREEZE to genuine use as "advertising, promoting and offering resorts, hotels, safaris and other products and services". The advertisement, promotion and offering of resorts and hotels do not fall within class 39. Rather they fall within classes 35 and 43, and are not therefore covered by the registration.

16. The arranging of safari expeditions does fall within class 39 and might be included in the term "travel arrangement". However, the only reference to safaris in the evidence..is in respect of the flyer shown in exhibit 3 to Mr Shah's first witness statement....this was on a very small scale and does not demonstrate "genuine use". If the mark BREEZE had been used in relation to the arrangement of safaris, then invoices, website materials, notepaper and the like should be available to [Nova]."

"21. Mr Shah seeks to demonstrate that proper use aimed at end-consumers took place in the form of flyers distributed at the World Travel Market in November 2007. This is a trade fair for the holiday and travel sector. The witness explains that a mere 50 flyers were distributed to attendees of [the event].

22. The use of the flyer is small scale and may constitute token use only. Furthermore, no evidence of actual bookings or arrangements made for safaris under the trade mark BREEZE has been provided by [Nova]....."

"23. Finally, the alleged use by [Nova] of in relation to the arrangement of safaris is very small and, even when taken with the uses by [BAL], cannot be sufficient to maintain the mark in the relevant sector..."

56. In his first statement Mr Shah explains that Nova have associated companies in both the UK (Breeze Travel Limited) and in Sweden which use the trade mark with Nova's consent. He adds that:

".. these companies were incorporated to organise and sell safaris as well as holidays at hotels and resorts in Africa including not only hotels operated by [Nova's] associated companies but also hotels and resorts operated by third parties.."

57. In support he provides at exhibit 3 a copy of a flyer which I have described in detail at paragraph 11 above. VRL accept that arranging of safaris would fall within the phrase "travel arrangements."

58. Unlike the use made of the trade mark by BAL, VRL do not take appear to take any issue with the form in which Nova say they have used their BREEZE trade mark. If that is right, that in my view is a sensible approach. The trade mark is presented in upper and lower case on both pages of the flyer i.e. "Breeze", and although the presentation of the trade mark on the second page is in a cursive script, both variations would, in my view, clearly fall within the variations permitted by section 46(2) of the Act. What VRL do take exception to is what they consider to be the small scale use of the flyer and the lack of supporting evidence.

59. In the absence of evidence, I consider it appropriate to take judicial notice of the fact that the size of the market for the arrangement of travel (in general) must be vast. While the size of the market for the arranging of safaris must be smaller, this market is, in my view, still likely to be of a significant size.

60. Earlier in this decision I referred to the comments of the Appointed Person in *Extreme*. I did so because, in my view, his comments were apposite bearing in mind the position in which Mr Moodie found himself at the point at which he was asked to make his statement on Nova's behalf. However, the same considerations do not apply to Mr Shah. Although he does not indicate in either of his statements how long he has been associated with Nova, it is clear that as the Sales and Marketing Director he is in a senior position within the company and he confirms that he has access to Nova's books and records.

61. The only concrete evidence Mr Shah provides of use by Nova is the flyer mentioned above. In the *NODOZ* case [1962] RPC 1 at page 7 line 34 to 41 Mr Justice Wilberforce said:

"The respondents are relying upon one exclusive act of user, an isolated act, and there is nothing else which is alleged or set up for the whole of the five year period. It may well be, of course, that in a suitable case one single act of user of the trade mark is sufficient; I am not saying for a moment that that is not so; but in a case where one single act is relied on it does seem to me that that single act ought to be established by, if not conclusive proof, at any rate overwhelmingly conclusive proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established."

62. Although this was a case decided under the 1938 Act, I note that in the *Extreme* case mentioned above the Appointed Person accepted that the principle this case establishes is

equally applicable to considerations under the 1994 Act. While the facts of the respective cases are, of course, quite different, the only point I wish to take from the above case, is that the fewer the acts being relied upon to support a claim to genuine use (or the evidence provided in support of such a claim), the more cogent the evidence and the supporting explanation needs to be.

63. As VRL point out, in the context of the market concerned the distribution of 50 flyers at a single exhibition appears extremely small. That said, the flyers might have proved successful and could have resulted in a number of enquiries and subsequent bookings. While the use of the flyer is clearly external to Nova and is aimed at creating or preserving a market for the services, I am not (as Nova point out) provided with any information (such as booking forms, invoices etc) indicating whether the flyers actually resulted in any enquiries or bookings being made. Unlike Mr Moodie of BAL, this is the sort of information (whether provided in narrative form or as supporting documentation) which should have been readily available to Mr Shah.

64. Although, as I commented above, use need not be quantitatively significant for it to be considered genuine, in the absence of the sort of additional information I have mentioned above, I do not, given the single flyer relied upon and the characteristics of the market concerned, feel that the use by Nova is sufficient to justify the preservation of the registration either for the specification for which it stands registered or in a more limited form. As the onus in proceedings such as this is on Nova, I have concluded that their own use of the BREEZE trade mark does not assist them.

Conclusions

65. I have concluded that Nova have only established genuine use in relation to the operation of a helipad. That being the case, given that VRL's attack was based on sections 46(1)(a) and (b) of the Act, and as there is nothing to suggest that any use has taken place on any other services since the date of completion of the registration procedure, the registration will, under the provisions of section 46(6)(b) of the Act, be revoked from 24 February 2006 **other than for** the following services in class 39.

“Operation of a helipad.”

Costs

66. As the application for revocation has been substantially successful, VRL are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide and keeping in mind VRL's substantial success in these proceedings, I award costs to them on the following basis:

Preparing a statement and considering the other side's statement:	£250
Preparing evidence and considering and commenting on the other side's evidence:	£750

Written submissions:	£300
Official fee:	£200
Total:	£1500

67. I order Nova Hotels Limited to pay to VRL International Limited the sum of £1500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 25th day of June 2009

C J BOWEN
For the Registrar
the Comptroller-General