

O-493-16

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NOS. 3118345 AND 3138675
BY TECTRADE COMPUTERS LTD**

TO REGISTER THE FOLLOWING TRADE MARKS IN CLASSES 35, 37 AND 42:

Helix Protect

&



**AND IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS. 405628 & 405676 BY HEALIX INTERNATIONAL LIMITED**

Background and pleadings

1. These consolidated opposition proceedings concern two trade mark applications filed by Tectrade Computers Ltd (“the applicant”). Application number 3118345 is for the trade mark **Helix Protect**. It was filed on 17 July 2015 and was published for opposition purposes on 18 September 2015. Application number 3138675 is for the trade mark



. The application was filed on 1 December 2015 and was published on 11 December 2015.

2. The specification for application number 3118345 was amended by way of a form TM21B filed on 16 December 2016. The specifications for both marks are now identical, for a range of services in classes 35, 37 and 42.

3. The applications are opposed by Healix International Limited (“the opponent”). The oppositions are based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and are directed against the following services:

Class 42 Hosting of computer systems, on or off clients’ premises relating to data protection, storage of data and computer environments; Expert reporting services relating to IT; Analysis, monitoring and reporting of IT systems and hardware; onsite and remote information technology support services; development of information technology; computer software for application and database integration; none of the aforesaid services including the design and development of computer software and/or provision of computer programming services in the field of education courses and student study courses.

4. The opponent relies upon the same two earlier trade marks for both of its oppositions. The first is European Union trade mark number (“EUTM”) 5329743 for the trade mark **HEALIX**, which has an application date of 2 September 2006 and for which the registration procedure was completed on 7 October 2009. The mark is registered for a range of services in classes 36, 39, 42 and 44. For the purposes of these oppositions, the opponent relies upon the following services:

Class 42 Computer programming and consultancy; design, development of computer software; design and development of websites, software and technical support services.

5. The second mark on which the opponent relies is UK trade mark number 1582268 for the trade mark **HEALIX**, which has a filing date of 19 August 1994 and for which the registration procedure was completed on 18 July 1997. The mark is registered for a range of services in class 42. The opponent initially relied upon “database services; computer programming; but not including rental of modems”.

6. The opponent’s marks qualify as earlier trade marks as defined in section 6 of the Act. The opponent stated in its Notices of Opposition that it has used both of its marks in relation to all of the services relied upon. These statements were made because the earlier marks are subject to the proof of use provisions contained in section 6A of the Act. However, in its submissions dated 24 August 2016, the opponent confirmed that no use had been shown for “database services” and that those services could be disregarded.¹ Consequently, the opposition under UK mark number 1582268 is based upon the following services only:

Class 42 Computer programming; but not including rental of modems.

7. In its Notices of Opposition, the opponent claims that the opposed services are highly similar to the services of the earlier registrations and that the trade marks are also

¹ Paragraph 11.

highly similar. It considers that there is a likelihood of confusion, including a likelihood of association.

8. The applicant filed counterstatements in which it denies the basis of the oppositions. It asserts that the services are different and that there are “very apparent” differences between the marks. It put the opponent to proof of use of its marks. The applicant did not specify in the relevant box of the TM8 the services for which it required evidence of use and it was not fully clarified in its counterstatement. However, the opponent did not query the point and it is clear from the opponent’s submissions that it interpreted the applicant’s request as a request for evidence of use for all of the services relied upon.² I proceed on that basis.

9. Both parties have been professionally represented throughout, the applicant by Briffa and the opponent by Blake Morgan LLP. Both parties filed evidence. Whilst neither party asked to be heard, both parties filed written submissions in lieu of attendance at a hearing. I will bear these submissions in mind and refer to them, as necessary, below.

Evidence

Opponent’s evidence

10. This consists of the witness statement of Paul Beven, with one exhibit (PB1). Page references which follow are to that exhibit. Dr Beven is a Director of the opponent, a position which he has held since 1 August 2000.

11. Dr Beven states that “[i]n 1992 the Healix group was founded and began use of the HEALIX mark” and that the opponent company was registered in 2000.³ He describes the company as “a global provider of international medical case management; medical, security and travel assistance services and international occupational health services”,⁴

² Paragraph 3.

³ Paragraph 5.

⁴ Paragraph 6.

and says that “[o]ne of the services provided by the Company is its development and integration of Global Travel and Risk Management services providing effective solutions for employers”.⁵ At paragraph 10, Dr Beven indicates that the “significant turnover” for the company is as follows:

| Year End | Turnover (£) |
|----------|--------------|
| 2015 | 12,311,619 |
| 2014 | 10,998,635 |
| 2013 | 12,136,874 |
| 2012 | 10,045,110 |
| 2011 | 8,334,467 |
| 2010 | 6,637,892 |

There is no commentary on these figures and no breakdown to explain the extent to which this turnover relates to sales under the mark for the services relied upon or in the relevant markets.

12. At pages 4 and 5 are images taken from web.archive.org, which are said to show the earlier mark in use on the opponent’s website (healix.com) at 7 December 2013 and 8 February 2014, respectively. The mark appears as follows at the top of the web page:



The web pages include links to click for more information about “International Health & Risk” and “Medical Underwriting Tools”.

13. Dr Beven also exhibits seven articles about the opponent and the awards it has won.⁶ Of these, five are taken from www.healix.com. They are dated 3 December 2014, 19 May 2015, 21 October 2015, 6 November 2015 and 10 December 2015. The

⁵ Paragraph 7.

⁶ pp. 6-16.

remaining articles are taken from www.greatbusiness.gov.uk (not dated other than the printing date of 15 April 2016) and ipmimagazine.com, which is dated 6 November 2015. There are references to “value added data services” (p. 6), a “medical insurance product [...] which incorporates the Healix automated international medical screening service” (p. 8), an “integrated Global Travel Risk Management service” (p. 10) and Healix’s “automated medical risk assessment tool (Black Box)” (p. 12). The main focus of most of the articles is the opponent’s insurance activities.

14. Four brochures are exhibited at pages 17-62 (the brochure regarding “Global travel risk management” has been filed twice (at pp. 17-32 and pp. 38-53)). All of the brochures are introduced without comment. None of them is dated. The mark appears on the front page of the brochures as shown below:



15. There is reference, at p. 43, to the “Healix Solution: Valuable online resources and support services, helping Security Departments to effectively manage the security risks facing their global workforces” and a “global security intelligence portal” which is said to provide various resources, such as “threat reports” and “notifications and alerts”.

16. At p. 46, there is a reference to “Healix Solution: Our Travel Oracle App [...]”. This is said to provide users with “instant access to critical insight and support” and offers features such as handset tracking and secure document storage. The company also offers a “Risk Messaging and Traveller Tracking service” (p. 48), which is said to be integrated with other systems (Healix and non-Healix) and which offers information and messaging capabilities.

17. At p. 55, the opponent’s “Service over software” is promoted as providing “state of the art security technology delivered and managed by our 24/7 Global Security

Operations Centres”. It appears that these centres use various software tools to gather intelligence, which is passed to the client by way of, for example, email, the opponent’s own app or their “Global Intelligence Portal” (p. 56).

18. The “Global Intelligence & Assistance Portal” is said to provide access to the opponent’s monitoring and assistance services. The brochure describes the portal as providing a “clear and intuitive interface to current incident alerts” (p. 57).

19. The brochure at pages 59-62 details the opponent’s services in medical risk assessment. The document indicates that these include a “fully automated medical underwriting process” (p. 60). This process, along with other unspecified “Healix solutions”, can, it is said, be built into existing systems or allow existing systems to access the assessment tools. It is not entirely clear whether these tools are marketed under the “Healix” mark, either alone or in combination with other marks: there is some evidence that the opponent offers a “policy sales platform” under the mark “Safiri” (*ibid.*). At p. 61, it is indicated that the opponent provides “full IT back-up for the implementation of our screening tools”. The document states that the opponent’s risk assessment tools are available “with flexible pricing arrangements”.⁷ There is also reference to the Queen’s Award at p. 62 and, at p. 34, reference to an “online solution for assessing the health risks facing your global workforce” and “proprietary, Queen’s Award winning software”.

20. At pp. 63-64 there is a list of customers, along with some testimonials about the opponent’s “risk rating” tools. Neither of these documents is dated, save for the printing date of 15 April 2016.

21. A letter is provided at p. 65, apparently from a client of Healix. The document is not verified by a statement of truth from its author and its content must be treated as hearsay. In any event, it is dated after the relevant periods.

⁷ p. 62.

22. Dr Beven states that the opponent designs and develops its software to integrate it into the client's existing IT or to meet particular customer requirements (paragraphs 21-23). He also states that the opponent sells and develops bespoke case management systems.⁸ In support of this he exhibits a number of invoices and quotations.⁹ The invoice at p. 67 features the mark as shown at paragraph 14, above, at the top of the page. It is dated 15 January 2015 and the addressee is in London but the remaining details have been redacted. The total amount invoiced is £20,400. The amounts billed for individual goods and services are not itemised. The goods and services are described as:

“Medical, Security and Travel assistance (inc APP)
Travel Tracker (inc one data feed)
Traveller Security e-learning course
Medical Screening- set up”.

23. None of the remaining invoices or quotations is relevant, as they all fall outside the material periods or are not directed to addressees in the EU or UK (either because no address details are visible, such as at p. 69, or because the addressee is outside the EU, such as p. 70).

Applicant's evidence

24. This consists of the witness statement of Ryan Cardy, with one exhibit. Mr Cardy states that he is the Services Manager at the applicant company. His witness statement contains mainly submissions, which I will take into account but do not intend to detail here.

⁸ Paragraph 24.

⁹ pp. 67-78.

25. Exhibit RC1 consists only of nine pages. Mr Cardy provides evidence of internet search results for “helix protect” (pp. 2-3), “global travel risk management service” (pp. 4-7) and ““website design”, healix” (pp. 8-9).

26. The opponent having chosen not to file evidence in reply, that concludes my summary of the evidence, insofar as I consider it necessary.

Decision

27. The opposition is based upon Section 5(2)(b) of the Act, which reads as follows:

“5 (2) A trade mark shall not be registered if because -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Proof of use

28. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A- (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services”.

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

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

30. According to section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied for marks. The relevant periods are, therefore, 19 September 2010 to 18 September 2015 for application no. 3118345 and 12 December 2010 to 11 December 2015 for application no. 3138675.

31. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. What constitutes genuine use has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (“*London Taxi*”), Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order*

v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky' [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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].

(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].

(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].

(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]”.

32. In *Reber*, the Court of Justice of the European Union (“CJEU”) said, at paragraph 34, that:

“the General Court conducted an overall assessment of that trade mark, taking into account the volume of sales of the goods protected by the trade mark, the nature and characteristics of those goods, the geographical coverage of the use of the trade mark, the advertising on the website of Paul Reber GmbH & Co. KG and the continuity of the trade mark’s use. It thus established a certain degree of interdependence between the factors capable of proving genuine use. The General Court therefore correctly applied the concept of ‘genuine use’ and did not err in law in its assessment of that use”.

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

34. As registration number 5329743 is an EUTM, the comments of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are relevant. It noted that:

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

And

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

market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark”.

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

35. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by

it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity”.

36. In *London Taxi* Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42]

and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use".

37. The General Court ("GC") restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

38. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the assessment I am required to consider all relevant factors, including:

- i. The scale and frequency of the use shown
- ii. The nature of the use shown
- iii. The goods and services for which use has been shown
- iv. The nature of those goods/services and the market(s) for them
- v. The geographical extent of the use shown

39. The evidence shows that the opponent has used its marks as shown below on its website and in promotional material, respectively:¹⁰



40. The word “healix” features in lower case, in an unremarkable black font, along with the words “GROUP OF COMPANIES” and “INTERNATIONAL”, which are in a smaller typeface and in green. Both marks feature a device element, which consists of two green right angle devices at the top right of the word “healix”.

41. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the

¹⁰ See paragraphs 12 and 14, above.

meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the

product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)" [my emphasis].

42. It is clear from the case law cited above that use in conjunction with another mark falls within the ambit of genuine use. I consider that this applies to the present case. The words "GROUP OF COMPANIES" and "INTERNATIONAL" would, in my view, be seen as descriptive of the mode of operation of the company and would be given no trade mark significance. The word "healix" appears as a separate element from the logo, due to its position and size and the use of a different colour. I acknowledge that the mark as used is in a stylised font. However, the stylisation is slight and there are no other additions or changes to the mark which might have an effect on its distinctive character. I find that the use shown is use of the marks as registered, upon which the opponent is entitled to rely.

43. In *Awareness Limited v Plymouth City Council*, Case BL O/230/13, Mr Daniel Alexander, Q.C., sitting as the Appointed Person, stated that:

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

44. I also note Mr Alexander's comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14), where he stated:

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

45. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a

birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use”.

46. I note the opponent’s claim that “[i]t is apparent that the Applicant accepts that the Opponent has demonstrated use of the other services upon which the Oppositions are based, specifically *design, development of computer software and software and technical support services*”.¹¹ There is, however, no explicit concession to that effect. Mr Cardy states, at paragraph 8, that “there is no indication from the Statement that the Opponent offers class 42 services” before making specific submissions in relation to certain services. Bearing in mind that the applicant also submits that “the Applicant expected the Opponent to file substantial evidence showing its use of the marks in relation to its services in class 42 however the Opponent failed to do this” and an assertion that the opponent’s mark should be revoked on the grounds on non-use (a matter not before me), I do not consider it safe to assume that the applicant has conceded any genuine use of the services relied upon by the opponent.¹²

¹¹ Submissions, paragraph 8.

¹² Submissions, paragraphs 20 and 29.

47. Dr Beven states that he has been a director of the opponent since 2000. He ought, therefore, to be in a position to provide a reasonably detailed account of the use which has been made of the earlier marks. As regards use of the mark for the services at issue, there are references in the opponent's evidence to various tools, such as a "Travel Oracle App" or the "Global Assistance and Intelligence Portal".¹³ These are in general terms with little detail provided about the specifics of those services. For example, there are no examples of price lists or marketing material specific to those services. As I have mentioned above, it may be that there is co-branding in relation to certain services, though that would not be fatal. Even if I accept that the opponent has used the mark on or in relation to the services relied upon, there is virtually no evidence that such use was in the relevant periods or in the relevant markets. The website images are dated within the relevant periods but they do no more than establish that the opponent offered medical underwriting tools, which may or may not include the services relied upon. The fact that the website images have a .com domain name does not assist the opponent in establishing that the services at issue were offered in either the UK or the EU markets. None of the promotional material is dated. Even if it were, no information is given about how it was distributed or the geographical extent of any distribution. I note that the UK office address features on the last page of some brochures (pp. 32/53, 37, 58) and that at pages 32/53 and 58 it is positioned more prominently. However, the other office addresses and their contact details are also provided and, in the absence of any explanation, it is unclear whether the UK address is given prime position because the brochures were intended for the relevant market(s) or because the UK address happens to be the company's head office.

48. In terms of sales in the relevant markets, Dr Beven has provided headline figures for the company's turnover. Despite his being in a position to explain what proportion of the turnover relates to sales under the earlier marks for the services relied upon, or in the relevant markets, no information of that nature is given. Invoices are provided, only one of which concerns the UK/EU market in the relevant period. I note that the opponent's submissions state that the invoices are only examples and that the software services

¹³ pp. 43 and 57.

“are provided to the vast majority of the Opponent’s customers albeit the services are not always specifically referred to on the invoices”.¹⁴ That may be the case but, if so, it begs the question why the opponent provided only one invoice to show use in the relevant period and market, as opposed to multiple invoices for Australasia. As I indicated at paragraph 22, one invoice includes a sale of the opponent’s app to a UK addressee. It totals £20,400 but the cost of each service is not itemised. No information has been provided about the size of the relevant UK or EU markets but both are likely to be vast. One sale of £20,400 in a five-year period does not, in my view, show commercial exploitation of the mark which is warranted in the economic sector concerned. I find that the use as shown cannot be considered genuine use in relation to the services upon which the opponent relies.

Conclusion

49. The opponent has failed to establish genuine use of either of its earlier marks within the relevant periods. The oppositions fail at the first hurdle and are dismissed accordingly.

Costs

50. As the applicant has been successful it is entitled to a contribution towards its costs. I note that these are consolidated proceedings and that the applicant filed a counterstatement in each opposition. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 4 of 2007. Using that TPN as a guide but bearing in mind my comments, above, I award costs to the applicant on the following basis:

¹⁴ Paragraph 15.

| | |
|--|-------|
| Considering the notices of opposition and filing counterstatement (x2): | £400 |
| Preparing evidence and considering the other side's evidence: | £500 |
| Written submissions: | £300 |
| Total: | £1200 |

51. I order Healix International Limited to pay Tectrade Computers Ltd the sum of **£1200**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of October 2016

**Heather Harrison
For the Registrar
The Comptroller-General**