

O/587/17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 1 305 290:
CLUB WORLD IN THE NAME OF BRITISH AIRWAYS PLC

AND

IN THE MATTER OF AN APPLICATION FOR REVOCATION BY
MICHAEL GLEISSNER

Background and pleadings

1. British Airways Plc (BA) is the registered proprietor of trade mark registration No 1 305 290 consisting of CLUB WORLD. The trade mark was filed on 27th March 1987 and completed its registration procedure on 10th April 1990. It is registered in respect of the following services in Class 39:

Airline, air transportation services, package tour and package holiday services, all included in Class 39.

2. Michael Gleissner seeks revocation of the trade mark registration on the grounds of non use based upon Section 46(1)(a) and (b) of the Trade Marks Act 1994. BA filed a counterstatement denying the claim.
3. Revocation is sought under Section 46(1)(a) in respect of the 5 year time period following the date of completion of the registration procedure, namely 11th April 1990 to 10th April 1995. Revocation is therefore sought from 11th April 1995. Revocation is also sought under Section 46(1)(b) in respect of the time period 5th September 2011 to 4th September 2016. Revocation is therefore sought from 5th September 2016.
4. Only the registered proprietor filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision.
5. A Hearing took place on 10th October 2017 with the RP represented by Mr Pendered of Maucher Jenkins, BA's trade mark attorney. The applicant for revocation, Michael Gleissner represented himself alongside his colleague Mr Afean Samad.

Legislation

6. Section 46(1) of the Act states that:

“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) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(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.”

7. Section 100 is also relevant, which 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.”

BA's evidence

8. This is a witness statement, dated 24th January 2017, from Christopher Brown, a Brand Executive of BA. He explains that the mark CLUB WORLD has been used by BA since the year 1987 and is still in use to this day in respect of the services covered by the registration. The mark is used to denote BA's premium, cabin class travel offerings for passengers on long haul flights to and from the UK. The mark appears on materials such as menus, and on printed and electronic materials, such as signage, boarding passes, amenity kits and instructional guides. Exhibit CB1 is a bundle of such sample materials. It is noted that CLUB WORLD is clearly displayed.
9. According to Mr Brown, the mark appears extensively on BA's website. Exhibit CB2 is a bundle of sample extracts from BA's website dating from the years 2011, 2012, 2013 and 2014. It is noted that CLUB WORLD refers to business class seats upon BA flights.
10. Passenger numbers and revenue figures are provided. Between 2011 – 2015, BA CLUB WORLD passenger numbers were around 2.5 – 2.7 million per annum. Sales turnover for the same period was £3.2 million per annum.
11. Exhibit CB3 contains a bundle of samples of advertising materials. CLUB WORLD is clearly visible on all of the materials, which are, in the main, dated within the final relevant period. The materials include press releases regarding new routes, technological advances on flights, cabin refurbishments and other material advertising the overall CLUB WORLD flight experience.
12. Exhibit CB4 are examples of articles regarding CLUB WORLD appearing in the national press. These include the Telegraph and the Independent.
13. Exhibit CB5 are sample extracts regarding CLUB WORLD in BA's published annual accounts for the years 2011-2015.

14. In considering whether or not there has been genuine use, I take into account the following guidance:

In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, 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 Bundervsvereinigung 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].”

15. The evidence is clear as to scale, duration and frequency of use. Revenue figures and passenger numbers are provided. National newspapers articles are in evidence as well as details in annual accounts, all of which are dated within the final relevant period. It is considered that BA has clearly made genuine use of its mark CLUB WORLD in respect of airline and air transportation services in Class 39. The more challenging aspect of this decision is in respect of the remaining services: package tour and package holiday services. It appears from the evidence provided that CLUB WORLD is used in respect of the “class” of seat for a flight. This often has particular added features such as quicker check in, airport lounges, flight menus, spacious, comfortable environment etc. There is little in the evidence to suggest that a complete package tour or holiday is also offered under the CLUB WORLD trade mark. Even where a destination is mentioned, the information advises that you can choose CLUB WORLD seats on the flight, but not that the entire package, including accommodation, transfers etc is CLUB WORLD. The trade mark used in respect of packages is British Airways or BA, whereas CLUB WORLD refers to just one of the flight seat options that can be chosen as part of the overall package. As such, it is considered that no genuine use has been shown in respect of package tour and package holiday services. The registration should therefore be revoked in this regard.

Conclusion – Non use

16. The application for revocation succeeds in respect of package tour and package holiday services and fails in respect of airline, air transportation services. The following services will therefore be revoked from 11th April 1995:

Class 39:

Package tour and package holiday services, all included in Class 39.

COSTS

17. Though not consolidated due to the differing attacked trade marks, these proceedings have travelled with 7 other cases between the same parties. Further, they were all heard at a single oral Hearing. For ease of reference, the respective costs awards in respect of all 8 cases will be detailed under separate cover. It should be noted that the substantive appeal period for all 8 cases will run from the date of the subsequent costs decision.

Dated this 22nd day of November 2017

Louise White

**For the Registrar,
The Comptroller-General**