

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 1 341 349:

**B.A.**  
**BA**

**BA** 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

B.A.  
BA

No 1 341 349 consisting of a series of three marks: **BA** The trade mark was filed on 14<sup>th</sup> April 1988 and completed its registration procedure on 22<sup>nd</sup> May 1992. It is registered in respect of the following services:

Class 39:

*Air travel services; aircraft chartering; passenger transport and air cargo transport services; travel agency and booking services; sightseeing, tour and cruise arranging services; package holiday services; car hire services; tourist information services; all included in Class 39.*

Class 42:

*Booking and reservation services, all for hotels, guesthouses and accommodation; hotel and restaurant services; all included in Class 42.*

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 23<sup>rd</sup> May 1992 to 22<sup>nd</sup> May 1997. Revocation is therefore sought from 23<sup>rd</sup> May 1997. Revocation is also sought under Section 46(1)(b) in respect of the time period 5<sup>th</sup> September 2011 to 4<sup>th</sup> September 2016. Revocation is therefore sought from 5<sup>th</sup> 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 10<sup>th</sup> October 2017 with the RP represented by Mr Pendered of Maucher Jenkins, the RP'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 24<sup>th</sup> January 2017, from Christopher Brown, a Brand Executive of BA. He explains that the mark BA has been used by BA for more than 20 years and is still in use to this day in respect of all the services covered by the registration. According to Mr Brown, BA is the abbreviated name by which British Airways is known both within the airline industry and amongst the general public. Further, it is used in its communication materials to passengers, such as ticketing, where its flights are identified by the mark BA as a prefix to the flight number. Exhibit CB2 contains sample ticketing materials, a sample website extract and a picture of a typical departure board. It is noted that the website extract is dated October 2013 and BA is clearly visible throughout.

9. Mr Brown goes on to explain:

- BA appears in the company name of BA CityFlyer Limited, one of BA's wholly owned subsidiaries. This company offers domestic and European flights operating out of London City, Edinburgh and Manchester. These services are marketed under the mark BA CITY FLYER. Exhibit CB3 is a bundle of marketing materials used by this company, together with sample press articles. The following is noted from this exhibit: the entries are all dated within the final relevant period (2011 to 2016); refer to BA CITY FLYER and is in respect of flights.

- BA is used by a company called British Airways Holidays Limited, another wholly owned subsidiary. The company is a tour operator, offering services such as hotel bookings, package holidays and car hire. Exhibit CB4 is a bundle of sample webpages through which it advertises its services. It is noted that these are dated within the final relevant period (September 2011 to September 2016) and that the relevant section of the website is titled “Holidays by BA” together with all of the necessary options to build a holiday (examples include flight + hotel, hotel + car).
- BA is used extensively in marketing communications, in electronic and printed media, and also orally. The mark forms the name of BA’s website for example and also used to identify BA in commercial documents, such as Annual reports and Accounts. Exhibit CB5 is a bundle of samples of such materials. It is noted that the materials are dated within the final relevant period and that BA is regularly used and mentioned throughout the materials.
- BA is often referred to solely as BA in the media, both trade press and national and local press. Exhibit CB6 is a bundle of sample press articles. It is noted that these are dated within the (final) relevant period and are in respect of news regarding BA generally, rather than focussed upon the services covered by the attacked registration.
- Exhibit CB7 is a Wikipedia extract and a google search extract. Mr Brown considers these to support his claim that BA is the name by which his company is commonly known. Again, these are dated within the final relevant period and in respect of Wikipedia provide background/historical information on BA together with notable news stories (in particular accidents and/or incidents). The result of the google search is undated and (unsurprisingly) brings back the BA website following a search for BA in the search bar.
- BA flight passenger numbers and sales turnover figures are provided. These are as follows: 2011: 34.2 million passengers (£9.987 million turnover); 2012: 37.6 million passengers (£10,827 million turnover); 2013: 39.9 million passengers (£11,421 million turnover); 2014: 41.5 million passengers (£11,719 million turnover); 2015: 43.3 million passengers (£11,333 million turnover).

10. Mr Brown concludes his witness statement by advising that the amount spent by BA in the last few years in promoting and advertising their service has been approximately £37m per annum in purchasing advertising space alone.

11. 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 Bunderversammlung 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].”

12. The majority of the evidence filed is appropriately dated and so the scale, duration and frequency of use is clear. Sales turnover figures and passenger numbers are also provided. National newspaper articles are in evidence, as well as details in annual accounts, all of which are dated within the final relevant period. It is clear that BA has established genuine use in the use of the mark BA in these proceedings. However, there has not been use shown across all of the services covered by the registration. In this regard, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

13. Further, in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

14. Bearing in mind all of the aforesaid guidance, it is considered that the evidence filed demonstrates use of all of the services in Class 39. In respect of Class 42, use on the following services is considered to be established: *Booking and reservation services, all for hotels, guesthouses and accommodation; all included in Class 42.*

15. In respect of the remaining services in Class 42, namely hotel and restaurant services, it is noted that while the BA mark is clearly used as a booking service for hotels as part of, for example, a package holiday, these are booking services rather than hotel services per se. Further, such a hotel service are normally provided by third parties under their own marks. In respect of restaurant services, there is no evidence at all that these have been provided under the BA mark. As such, the following services will be revoked:

Class 42:

*Hotel and restaurant services.*

16. These services will be revoked, from 23<sup>rd</sup> May 1997.

## 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 22<sup>nd</sup> day of November 2017**

**Louise White**

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