

**O-632-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3248505**

**BY BRENDAN FRANCIS CARNE**

**TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS**

**IN CLASS 12:**

**(i) SILVER SPECTRE**

**(ii) Silver Spectre**

**AND**

**OPPOSITION THERETO UNDER NO. 410692**

**BY PETER OLA BLOMQUIST**

## **Background and pleadings**

1. On 06 August 2017, Brendan Francis Carne (“the applicant”) filed trade mark application number UK00003248505, for the marks above, for the following goods:

Class 12: *Motor Cars.*

2. The application was accepted and published for opposition purposes on 18 August 2017. Peter Ola Blomqvist (“the opponent”) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon the UK Trade mark (“UKTM”) registration 2167102, the pertinent details of which are as follows:

**Mark:** SPECTRE

**Filing date:** 19 May 1998

**Date of registration:** 30 July 1999

**Expiration date:** 19 May 2018

**Goods (as relied upon):**

*Class 12: Motor land vehicles and parts and fittings therefor; but not including motor land vehicles being rocket propelled, bicycles, wheelchairs and parts and fittings thereof.*

3. The opponent claims that the marks are similar and that the class 12 goods of the application are identical or similar to the class 12 goods covered by the earlier mark, leading to a likelihood of confusion under section 5(2)(b) of the Act.

4. The applicant filed a counterstatement in which it denies a likelihood of confusion.

5. Section 6 of the Act relates to the meaning of “earlier trade mark” and reads:

“6. Meaning of “earlier trade mark”.

(1) In this Act an “earlier trade mark” means-

(a) a registered trade mark, international trade mark (UK), European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b) a European Union trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK),

(ba) a registered trade mark or international trade mark (UK) which-

(i) has been converted from a European Union trade mark or international trade mark (EC) which itself has a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.

6. The opponent's trade mark, despite having expired on 19 May 2018, is an earlier mark, in accordance with section 6(3) of the Act; it was in any event extant at the time when the application was made. As it completed its registration procedure more than five years prior to the publication date of the applicant's mark, it is subject to the proof of use conditions, as per section 6A of the Act. To this extent, and in its statement of case, the opponent made a statement of use in relation to "motor land vehicles". Consequently, this is the only term that now forms the basis of this opposition as no use is even claimed in relation to the other term (parts and fittings) which were relied upon. The applicant, in its counterstatement, requested the opponent provide proof of use of the earlier registered mark, in relation to motor land vehicles.

7. The opponent is represented by Eagle IP International, whilst the applicant represents itself. Only the opponent filed written submissions and evidence. Neither party chose to be heard, nor did they file written submissions in lieu of a hearing.

### **Evidence summary**

8. The opponent's evidence takes the form of a witness statement and eight corresponding exhibits from Peter Ola Blomqvist, the opponent.

### Witness statement

9. Mr Blomqvist's witness statement is dated 02 May 2018, in which he gives the following evidence:

- Spectre cars are niche sports cars, of which there is currently a 2015 model and a 2018 model;
- The 2018 model will carry the Spectre trade mark and will be registered for sale this year;
- Spectre cars are in use today in the United Kingdom and will continue to be built and sold for the foreseeable future;
- The vehicles have built up a reputation and brand identity with devoted enthusiasts;

- The exhibits enclosed with the witness statement include documents of certification, approval and sale of one Spectre vehicle.

## Exhibits

10. Exhibit POB1 is labelled "The 2015 Spectre Sports Car and YouTube video". It consists of three photographs of an unbranded car, all from different angles, one of which displays the vehicle registration number HX65 LLO. None of the photographs show a make or model displayed on the vehicle, nor are they dated. Page two of the exhibit provides a link to a YouTube video, described as "showing [the] newly road registered Spectre prototype on 5<sup>th</sup> October 2015". As the video has been referred to by way of a link rather than being submitted into evidence in media format, I must disregard it. Nowhere in the exhibit, except in the opponent's own words, is the earlier mark visible.

11. Exhibit POB2 is labelled "The 2018 Spectre Sports Car". It consists of three computer-aided design ("CAD") images, in black and white, of a car, described by the opponent as the 2018 Spectre model. The images are undated, and the car shown in them is unbranded, except a number plate which reads "C2P AUTOMOTIVE". Again, nowhere in the exhibit is the earlier mark visible.

12. Exhibit POB3 is labelled "Individual Approval Certificate (IVC) for Spectre Angel P107". Its content is indistinct but I am able to make out the make and model as "SPECTRE ANGEL (P107)", the year of manufacture as 2013, and a date of 23 June 2015 (although I cannot tell what this date specifically relates to).

13. Exhibit POB4 is labelled "Engine Certificate of Newness, Spectre P107". The 'certificate' is dated 09 March 2010 and relates to a Ford Mustang SVT Engine, its condition and the specification details. Reference is made to a Spectre P107.

14. Exhibit POB5 is labelled "Receipt of Sale, Spectre P107". It appears to be a receipt for the sale of used car parts (to make up a Spectre P107) at a cost of £19,000. The receipt is dated 23 March 2010 and names Mr Mark Roonan as the buyer.

15. Exhibit POB6 is labelled “UK Registration Certificate, Spectre Angel P107, 01/09/2015”. It is a photograph of a small section of a UK Registration Certificate which identifies the registration number HX65 LLO, the make and model as SPECTRE ANGEL P107 and the date of registration as 01 September 2015.

16. Exhibit POB7 is labelled “Spectre Car Badge”. What is actually contained within this exhibit (which is undated) is shown below.



17. Exhibit POB8 is labelled “Spectre 8 page Brochure”. It is an undated brochure containing: CAD images of a car, almost identical to those within exhibit POB2; design details; dynamics details; aesthetics & functionality details; and specifications & equipment details. The word SPECTRE is used on pages 1-5 and 7.

18. That concludes my summary of the evidence, insofar as I consider it necessary.

### **Proof of use**

19. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where-

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

(b) there is an earlier trade mark 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 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 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 European Union 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 Union.

(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.”

20. 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.”

21. The relevant period in the current case, in which the opponent must prove use of its mark (no claim for proper reasons for non-use having been made), in accordance with section 6A(3) of the Act, is 19 August 2012 to 18 August 2017.

22. 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. In *Walton International Ltd & Anot v Verweij Fashion BV*<sup>1</sup>, Arnold J. summarised the case law on genuine use of trade marks:

“114. The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Behher BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 *P Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal*

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<sup>1</sup> [2018] EWCH 1608 (Ch) (28 June 2018)



Market (Trade Marks and Designs) [EU:C:2014:2089] and Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

23. Before assessing the opponent's evidence of use, I remind myself of the comments of Mr Daniel Alexander, Q.C., sitting as the Appointed Person in *Awareness Limited v Plymouth City Council*<sup>2</sup>, where he stated that:

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<sup>2</sup> Case BL O/230/13

“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.”

24. I also note Mr Alexander’s comments in *Guccio Gucci SPA v Gerry Weber International AG*<sup>3</sup>. Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition actions. 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””.

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<sup>3</sup> O/424/14

25. The comments of Mr Geoffrey Hobbs Q.C. in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*<sup>4</sup>, where he sat as the Appointed Person, are also relevant. He 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

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<sup>4</sup> Case BL O/404/13

for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use”.

26. One difficulty for the opponent is that a significant amount of its evidence is either undated or dated outside the relevant period. In particular, the only exhibit which actually confirms that a vehicle relating to the Spectre mark has been sold in the UK, the Receipt of Sale at exhibit POB5, is dated 2010 and so is not sufficient for showing genuine use within the relevant period.

27. Another issue is that some of its evidence focuses on a 2018 model of a vehicle that is yet to be manufactured, which must therefore relate to a prospective launch after the relevant period that ended in August 2017. For this to qualify as genuine, I would need to be persuaded that the goods are about to be marketed and that preparations are under way to secure customers. In *Healey Sports Cars Switzerland Limited v Jensen Cars Limited*<sup>5</sup>, Mr Henry Carr Q.C., sitting as a Deputy Judge of the High Court, stated that:

“12. Healey submitted [from a summary of the case law of the CJEU] that genuine use was to be contrasted with token use. Use which was not token, in the sense that it was not done merely to preserve the rights conferred by the registration was genuine and satisfied the statutory test.

13. In my judgment, acts which were not done merely to preserve the rights conferred by the registration may nonetheless be insufficient to constitute use within the meaning of section 46(1)(a). This is clear from the requirement to take all relevant facts and circumstances into account. It is also clear from [37] of *Ansul*, which the Hearing Officer cited at [31] of his Decision:

“Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns.”

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<sup>5</sup> [2014] EWHC 24 (Pat)

And:

“25. The Hearing Officer also referred to the press reports which picked up the press release at paragraph 20. He was clearly aware of the press interest in the development of the new Jensen Interceptor. However, these press reports were not use of the mark by Healey, and could not be relied on as such.

26. I agree with the Hearing Officer that the question of whether goods are “about to be marketed” is to be decided in the context of the economic sector concerned, and that some goods will take longer to develop than others. I also agree that the press release and website, which were published a few days before expiry of the five year period and enabled no more than initial interest in a future development to be registered, did not show that the goods were about to be marketed.”

28. In the present case, there are not even any press releases, advertisements or websites in operation to show that the 2018 Spectre model is about to be marketed. It is not apparent where the three images at exhibit POB2 are taken from (be it a website or a brochure, for example), or whether the public has seen them. Similarly, the brochure at exhibit POB8 does not evidence where it was made available (if at all), or how many were produced, issued or requested. These exhibits are wholly unconvincing and call into question whether they were in fact intended to create a market for the goods amongst potential customers for motor vehicles. To me, they do not build a picture of goods that are about to be marketed, not just because the evidence is minimal, but because in the context of new or upcoming motor vehicles, marketing material would exist and little is provided. In any event, the relevant period ended in August 2017, I am unaware of when in 2018 the car was to be launched, and neither of the exhibits are dated. Consequently, they do not show genuine use of the mark.

29. The only exhibits that are dated within the relevant period are the YouTube video at page 2 of exhibit POB1 (which I have already disregarded), the Individual Approval Certificate and the UK Registration Certificate. The certificates are internal documents

that would not be available to the public and, as such, do not show use by way of real commercial exploitation of the mark on the market for the relevant goods.

30. Contrary to the witness statement, there is no evidence of any other vehicles registered in the UK, any other sales, or a community of “devoted enthusiasts”. I would expect there to be, for example, invoices for previous sales, a website or some form of advertising platform, discussion groups for those interested in the cars. None of this has been evidenced. As far as the evidence shows, one vehicle (as a ‘kit car’) has been sold to one purchaser outside the relevant period. I am not satisfied that this maintains or creates a share in the market of the goods.

31. Taking into account all the circumstances of the case, the evidence filed is insufficiently solid to show that there has been genuine use of the mark on or in relation to the goods upon which the opponent relies.

## **Conclusion**

32. The opponent has failed to establish genuine use of its earlier mark within the relevant period. The opposition fails at the first hurdle and is dismissed accordingly. Subject to appeal, the application will proceed to registration.

## **Costs**

33. As the applicant has been successful, it would, ordinarily, be entitled to an award of costs in its favour. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of its actual costs. It was made clear to the opponent that if the pro-forma was not completed “no costs, other than official fees arising from the action and paid by the successful party...will be awarded”. Since the applicant did not respond to that invitation, each party will bear its own costs. As no official fee has been paid by the applicant, I make no award of costs in its favour.

**Dated this 8<sup>th</sup> day of October 2018**

**Emily Venables**

**For the Registrar,**

**The Comptroller-General**