

O-697-19

**TRADE MARKS ACT 1994
IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. WO0000001398752
DESIGNATING THE UNITED KINGDOM
BY WIN WIN PARENTING PTY LTD
TO REGISTER**




**IN CLASSES 9, 16, 41, 44 & 45
AND OPPOSITION THERETO (UNDER NO. 414356)
BY
WIN-WIN PARENTING INTERNATIONAL LIMITED**

Background & pleadings

1. Win Win Parenting Pty Ltd ('the holder') is the holder of International Registration ('IR') no. WO1398752 in respect of the trade mark set out on the title page of this decision. Protection in the UK was requested on 16 March 2017, with a priority date of 19 September 2016 from Australia, in respect of goods and services in classes 9, 16, 41, 44 & 45.

2. The IR was published in the UK, for opposition purposes, on 17 August 2018. Win-Win Parenting International Limited ('the opponent') opposes the designation for all the goods and services under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of its earlier UK trade mark set out below.

UK TM No. 2544718	Services relied on:
 Filing date: 12 April 2010 Registration date: 6 August 2010	Class 41: Parent training courses.

3. The opponent's above mentioned trade mark has a filing and priority date that is earlier than the date of the IR holder designating the UK and, therefore, it is an earlier mark, in accordance with Section 6 of the Act. As the registration procedure was completed more than 5 years prior to the publication date of the contested designation, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the services it relies on.

4. The holder filed a counterstatement in which it denied the ground of opposition and requested that the opponent produce proof of use evidence.

5. In these proceedings both parties are representing themselves and both have filed evidence. No hearing was requested on the substantive matter (see below) and I make this decision based on the material before me.

The holder's evidence

6. The holder provided a witness statement in the name of Rosina McAlpine, the Director of Win Win Parenting Pty Ltd. Ms McAlpine's witness statement did not contain evidence as such but rather contained submissions relating to the opponent's evidence. I do not intend to summarise these here but suffice to say that I have read them and bear them in mind, to the extent that they are relevant.

7. Ms McAlpine made a subsequent request to file further evidence on 9 October 2019. The preliminary view was to deny this request. Subsequently Ms McAlpine asked to be heard on the matter. A case management conference ('CMC') was held on 12 November 2019. The opponent did not attend. Ms McAlpine explained that she had compiled evidence to support a separate UK trade mark application for **Win Win Parenting** (word only) and believed that this same evidence would assist her case in these proceedings. I refused the request to file further evidence and in doing so, I explained that the UK trade mark application and the mark relied on in these proceedings are different and the evidence had been compiled for different reasons. The evidence prepared for the UK trade mark application is in support of demonstrating acquired distinctiveness through use under section 3 of the Act. These proceedings concern the similarity of marks and services under section 5(2)(b) of the Act and as such there is no requirement for the IR holder to provide any evidence. Whereas the opponent's mark is more than 5 years old, therefore there is an onus on that party to provide evidence of use.

The opponent's evidence

8. The opponent provided a witness statement in the name of its CEO, Alan Whitaker, and attached 7 exhibits which he referred to as annexures.

9.. Annexure A comprises background material to the 'Win-Win Parenting' Skills Training programme undertaken in South Africa since 2008. The document states that the words 'Win-Win Parenting' are used in books, training manuals, PowerPoint presentations and flash cards.

10. Annexure B consists of a photograph of undated training manuals. The trade mark is shown on the title pages.

11. Annexure C is a photocopy of the first and last pages of an apparently undated training manual. Attention is drawn to the copyright wording on the back page, which reads **Copyright © 2009 by Alan J Whitaker**. The trade mark is shown on the title page.

12. Annexure D consists of the first page of a letter dated 28 March 2017 addressed to the Saga Charitable Trust, whose address is given as just 'United Kingdom', from Mr Whitaker's charity, Billion Child Foundation. The letter sets out an executive summary of a proposal to establish the 'Win-Win Parenting' training programme in Cape Town, South Africa. The trade mark does not feature on this page.

13. Annexure E comprises three pages of an interim report provided by the opponent's charity Billion Child Foundation to the Saga Charitable Trust on the 'Win-Win Parenting' skills training programme in Cape Town South Africa. The trade mark features on the title and last pages, but the report itself appears undated. However the photograph on the title page is captioned as February 2019 which falls outside of the relevant period I must consider (see below).

14. Annexure F consists of a photocopied section from the 2017 Billion Child Foundation annual report. This section is titled 'Acknowledgments and Thanks' and contains repeated use of the words 'Win-Win Parenting' and also refers to board members and auditors in Southern Africa. The trade mark appears at the end of the section.

15. Annexure G consists of a photocopied page of a newsletter, dated February 2015. The newsletter contains the trade mark and a reference to the 'Win-Win Parenting' training programmes. The declarant states that newsletters of this type are sent quarterly by email. He also states that such newsletters are currently sent to 106 Friends of the Billion Child Foundation charity and to potential donors in the UK. However he does not state the number of recipients of the February 2015 newsletter referenced above.

16. Annexure H consists of the first page of a letter from the Billion Child Foundation to an individual, Sean D, whose surname details are redacted and which does not state any address details. The letter seeks to appoint a training partner to roll out the Win-Win Parenting course in Northern Ireland and the Republic of Ireland. The letter is dated 7 March 2018 and does not show the trade mark but does refer to the 'Win-Win Parenting Skills Programme'.

17. That concludes my summary of the opponent's evidence.

Proof of use

18. The first issue is to establish whether, or to what extent, the opponent has shown genuine use of the earlier mark within the 'relevant period'. The relevant period is defined as being a period of five years ending with the date of publication of the contested designation. In this case the relevant period would be **18 August 2013 to 17 August 2018**.

19. The relevant statutory provisions for proof of use 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 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 following case law is also applicable. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“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 Bunderversvereinigung 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 Beheer 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 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].”

22. I am also guided by the guidance given in *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. 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.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

23. In addition in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, where 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.”

24. In considering the evidence provided by the opponent, it is my view that it falls foul of section 6A(3). There is no use of the mark in relation to the services it is registered for, i.e. *Parent training courses* in the UK during the relevant period. The opponent states that “marketing programmes in the UK have yet to procure a donor to support the launch of Win-Win parenting programmes in the UK”¹. The evidence demonstrates that the delivery of the training courses took place in South Africa. I note that there are three annexures, namely those marked D, G and H, which appear to indicate that the opponent promoted the ‘Win-Win Parenting’ training course in the UK within the relevant period for the purposes of attracting funding. However only

¹ Paragraph 6 of the opponent’s witness statement

Annexure H relates to actually delivering the training courses in the UK but does not show the trade mark. Annexure D relates only to training provision in South Africa and does not show the trade mark. Finally Annexure G, shows the trade mark, but does not indicate where the services will be provided. I find this insufficient as Section 6A(3) clearly states that the evidence must show the mark being used in the UK in relation to the services for which the mark is registered.

25. Taking the above factors into account, the evidence provided falls short of the sufficiency and solidity needed to meet the standards of proof required. Accordingly, the earlier mark may not be relied on to support the opponent's claim under section 5(2)(b) of the Act and as this was the only ground of opposition relied upon, the opposition falls in its entirety.

Costs

26. The IR holder has been successful and is therefore, in principle, entitled to a contribution towards its costs. As the holder is unrepresented, at the conclusion of the evidence rounds the tribunal invited them, in the official letter dated 29 July 2019, to indicate whether they wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of their actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the opposition. It was made clear to the holder in that letter that if the pro-forma was not completed, costs may not be awarded. The holder did not respond to that invitation so consequently I make no award as to costs.

Dated this 15th day of November 2019

June Ralph

For the Registrar

The Comptroller-General