

O/417/21

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION
NO. 2427251 BY
O2 WORLDWIDE LIMITED
IN RESPECT OF THE SERIES OF TWO TRADE MARKS:

O2 BLUE

O₂ BLUE

IN CLASSES 9, 35, 36, 37, 38, 39, 41, 42, 43, 44, & 45

AND

AN APPLICATION FOR REVOCATION
UNDER NO. 503269
BY
BACHMANN GMBH

Background & Pleadings

1. The (figurative and series of two) trade marks (“contested marks”) shown on the front page of this decision stand registered in the name of O2 Worldwide Limited (“the registered proprietor”). The marks were applied for on 14 July 2006 in the United Kingdom and completed their registration procedure on 19 November 2010 in respect of the following goods and services:

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; apparatus for the transmission of sound and image; telecommunications apparatus; mobile telecommunication apparatus; mobile telecommunications handsets; computer hardware; computer software; computer software downloadable from the Internet; PDAs (Personal Digital Assistants), pocket PC's, mobile telephones, laptop computers; telecommunications network apparatus; drivers software for telecommunications networks and for telecommunications apparatus; protective clothing; protective helmets; computer software onto CD Rom, SD-Card; glasses, spectacle glasses, sunglasses, protective glasses; contact lenses; parts and fittings for all the aforesaid goods.

Class 35: Advertising, business management; business administration; office functions; retail and wholesale services relating to scientific, nautical, surveying, photographic, cinematographic,

optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin operated apparatus, cash registers, calculating machines, data processing equipment and computers, fire-extinguishing apparatus, apparatus for the transmission of sound and image, telecommunications apparatus, mobile telecommunication apparatus, mobile telecommunications handsets, computer hardware, computer software, computer software downloadable from the internet, PDA's (Personal Digital Assistants), pocket PC's, mobile telephones, laptop computers, telecommunications network apparatus, drivers software for telecommunications networks and for telecommunications apparatus, protective clothing, protective helmets, computer software onto CD Rom, SD-Card, glasses, spectacle glasses, sunglasses, protective glasses, contact lenses, parts and fittings for all the aforesaid goods, business management relating to broadcasting stations, telecommunications installations; provision of information relating to the aforesaid; services of a database, namely computerised file management, statistical information, data search in computer files for others, commercial or industrial management assistance, compilation of information into computer databases, systemisation of information into computer databases.

Class 36: insurance; financial affairs; monetary affairs; real estate affairs; payment processing; online payment processing; information services relating to finance, monetary affairs and real estate affairs; information and advisory services relating to the aforesaid.

Class 37: Building construction; repair; installation services; installation and maintenance services relating to telecommunications hardware and networks; installation and maintenance services

concerning set top boxes for broadband connection; information and advisory services relating to the aforesaid.

Class 38: Telecommunications; telecommunications services; mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; fixed line telecommunication services, provision of broadband telecommunications access; broadband services; broadcasting services; television broadcasting services; broadcasting services relating to Internet protocol TV; provision of access to Internet protocol TV; Internet access services; email and text messaging service; monitoring services relating to telecommunications networks and apparatus; information and advisory services relating to the aforesaid; services of a network provider, information broker and provider, namely rental of access time to data networks and databases, in particular the Internet, provision of information relating to the aforesaid, provision of access time to data networks, data banks, providing access to the Internet.

Class 39: Transport; packaging and storage of goods; travel arrangement; information and advisory services relating to the aforesaid.

Class 41: Education; providing of training; entertainment; sporting and cultural activities; interactive entertainment services; electronic games services provided by means of any communications network; entertainment and information services provided by means of telecommunication networks; sporting and cultural activities; provision of news information; information services provided by means of telecommunication networks relating to telecommunications; television entertainment services; provision of entertainment services through the media of television; education services provided by television; service; Internet protocol television services; provision of entertainment by means of television and

Internet protocol television; information and advisory services relating to the aforesaid.

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; services of engineers; computer programming; programming services; expert advice and expert opinion relating to technology; technical and legal research services in relation to business legal protection; provision of technical advice; rental of data processing apparatus and computers; weather forecasting; research of field telecommunication technology.

Class 43: Services for providing food and drink; temporary accommodation; information and advisory services relating to the aforesaid.

Class 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; information and advisory services relating to the aforesaid.

Class 45: Dating services; online dating services; information and advisory services relating to the aforesaid; security services for the protection of property and individuals; information and advisory services relating to the aforesaid; information services relating to fashion and astrology; legal services; management and exploitation of copyright; providing of information with respect to business property rights; arbitration services.

2. On 7 August 2020, Bachmann GmbH (“the applicant”) sought revocation of the contested marks on the grounds of non-use. Under Section 46(1)(a), the applicant claims non-use in the five year period following the date on which the marks were registered, i.e. 20 November 2010 to 19 November 2015. The applicant requests an effective date of revocation of **20 November 2015**. Under Section 46(1)(b) the applicant claims non-use in

respect of the registered marks for the period between 7 August 2015 and 6 August 2020, claiming an effective date of revocation of **7 August 2020**.

3. The registered proprietor filed a counterstatement defending its registration for all goods and services for which the contested mark is registered, on the basis that it has been genuinely used during both relevant periods.
4. Only the registered proprietor filed evidence. 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. No hearing was requested and, thus, this decision has been taken following a careful consideration of the papers.
5. In these proceedings, the applicant is represented by Williams Powell and the registered proprietor by Stobbs.

Evidence

Proprietor's Evidence

6. The proprietor's evidence consists of a witness statement, dated 8 February 2021, in the name of Clare Coughlan, who is the Brand Lead of Telefónica UK Limited, one of the subsidiary companies which forms part of the Telefónica Group of Companies (hereinafter referred to as "the Group") includes the registered proprietor.
7. Ms Coughlan describes the establishment of the registered proprietor by illustrating some key events, which I will only summarise below. Ms Coughlan states that:

"6. O2 Limited was established in England and Wales in 2001 following the de-merger from British Telecom to become an independent company and the intellectual property holding company

for the O2 brand globally. [...] The goodwill passed from BT Cellnet to O2 Holdings Limited following the de-merger. The existing customer base of BT Cellnet of several million mobile customers in the United Kingdom as of November 2001 were informed in writing of the new company's re-branding exercise. O2 Worldwide was established as a corporation on 16 July 2015 in the United Kingdom. It is the successor of O2 Holdings Limited regarding the ownership of the O2 brand. [...]

7. [...] the company mmO₂ Plc was formed as a parent company in the de-merger from BT. [...]

9. [The Group] has traded under the trade mark O2 in the UK and Germany since the launch of this trade mark on 1 May 2002. [...] All goodwill accrued from [the Group's] use of the IP inures to the benefit of benefit of O2 Worldwide Limited. The ultimate parent company of [the Group] is Telefónica SA but the O2 brand is still a stand-alone brand in its own right.”

8. Ms Coughlan states that the Group's telecommunications businesses operate in various EU countries and the UK, using O2 as the main consumer brand. With her witness statement, Ms Coughlan provides the following breakdown of the active mobile customer base in the UK since 31 March 2002:

Date	Active customer numbers (millions)
31 March 2002	11.084
31 March 2003	12.050
31 March 2004	13.3
31 March 2005	14.4
December 2005	15.9
December 2006	17.65
December 2007	18.452
December 2008	19.81
December 2009	21.89
December 2010	22.883
December 2011	23.030
December 2012	23.842
December 2013	23.903
December 2014	24.726
December 2015	25.019
December 2016	25.463
December 2017	25.004
December 2018	25.044

By referring to the above figures, Ms Coughlan states that “[t]his huge customer base are [sic] made aware of the various O2 Blue offerings, through promotions, and customer specific offerings at the O2 venues.”

9. Further, the annual turnover between 2006 and 2018, which Ms Coughlan calls “Service Revenue”, is provided with her witness statement. This is reproduced as follows:

Date	Service Revenue
31 December 2011	€6,926 million
31 December 2012	€7,042 million
31 December 2013	€6,692 million
31 December 2014	€7,062 million
31 December 2015	€7,837 million
31 December 2016	€6,861 million
31 December 2017	€6,540 million
31 December 2018	€6,790 million

In addition to these figures, Ms Coughlan explains that:

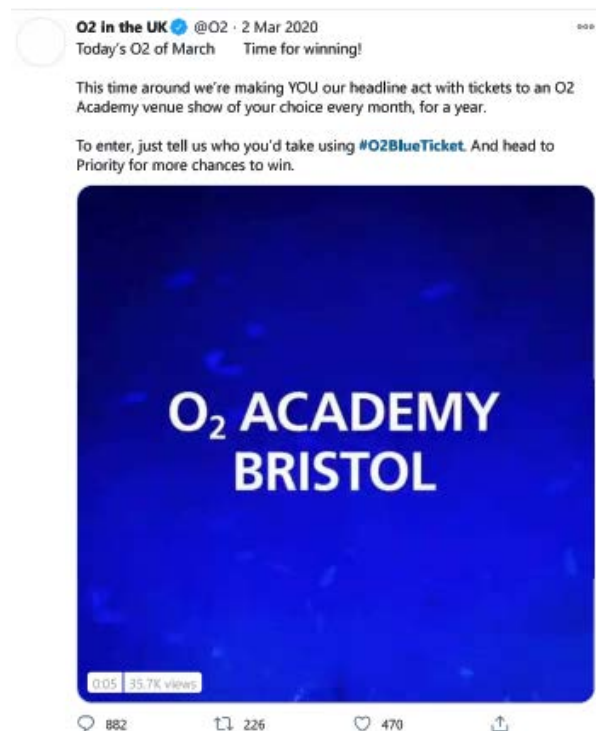
“My Company's Service Revenue in the UK has grown as a result of a combination of an increase in the subscriber base and an increase in Average Revenue Per User (ARPU). This term is the industry

recognised term to mean the revenue generated by a customer's phone, mobile device etc per month. In the mobile telephony field, ARPU includes not only the revenues billed to the customer each month for usage, but also the revenue generated from incoming calls, payable within the regulatory interconnection regime.”

It appears from the above statement of Ms Coughlan that the Service Revenue relates to all the purchases made by the phone/mobile customers without specifying to what extent the above figures concern the sales of goods or services under the registered mark (O2 BLUE) or whether the sales were made just in the UK or more widely.

10. Ms Coughlan then goes on to describe a number of high-profile events that took place in The O2 entertainment venue over the years, which I will not detail here. In this regard, Ms Coughlan provides Exhibit CC1, dated 22 August 2013, containing prints of “2011 YEAR END WORLDWIDE TICKET SALES TOP 200 ARENA VENUES”. It is clear from the Exhibit that The O2 – London dominated the top of the ranking for music arenas with 1,927,600 ticket sales for shows played between 1 January 2011 and 31 December 2011. In addition, a print of an article titled “The O2 arena Triumphs at Pollstar Awards” with a print date 22 August 2013 is provided with the same Exhibit. The article states that The O2 arena was voted as the Best International Arena of the Year at the Pollstar Concert Industry Awards between 2007 and 2011.
11. Figures between 2007 and 2011 concerning The O2 are also contained with Exhibit CC1 in relation to:
 - a. the location of the ticket buyers, 28% of which were based in Central and Greater London;
 - b. visitors/footfall at The O2, the total of which exceeded 34 million;

- c. the number of the events that took place over the given period, which reached the 196 in 2011;
 - d. the website and digital unique users per month (547,972) and email newsletter data base (1.5 million).
12. I note that even though Ms Coughlan, in her witness statement, states that Exhibit CC1 shows “the demographics of the visitors, and the nature of the visit, i.e. with friends/colleagues etc” and “[...] that 99% of people living in London have heard of The O2, which shows the nature and extent of its reputation”, there is no corroborating evidence that supports such a statement.
13. Exhibit CC2, dated 22 January 2021, contains prints of Twitter posts demonstrating a marketing promotion (as reproduced below) in the form of a contest, launched by the ‘O2 in the UK’ Twitter account, using the #O2BlueTicket; and prints that show the engagement it received by various Twitter users between 2 and 3 February 2020, and 2 March 2020.



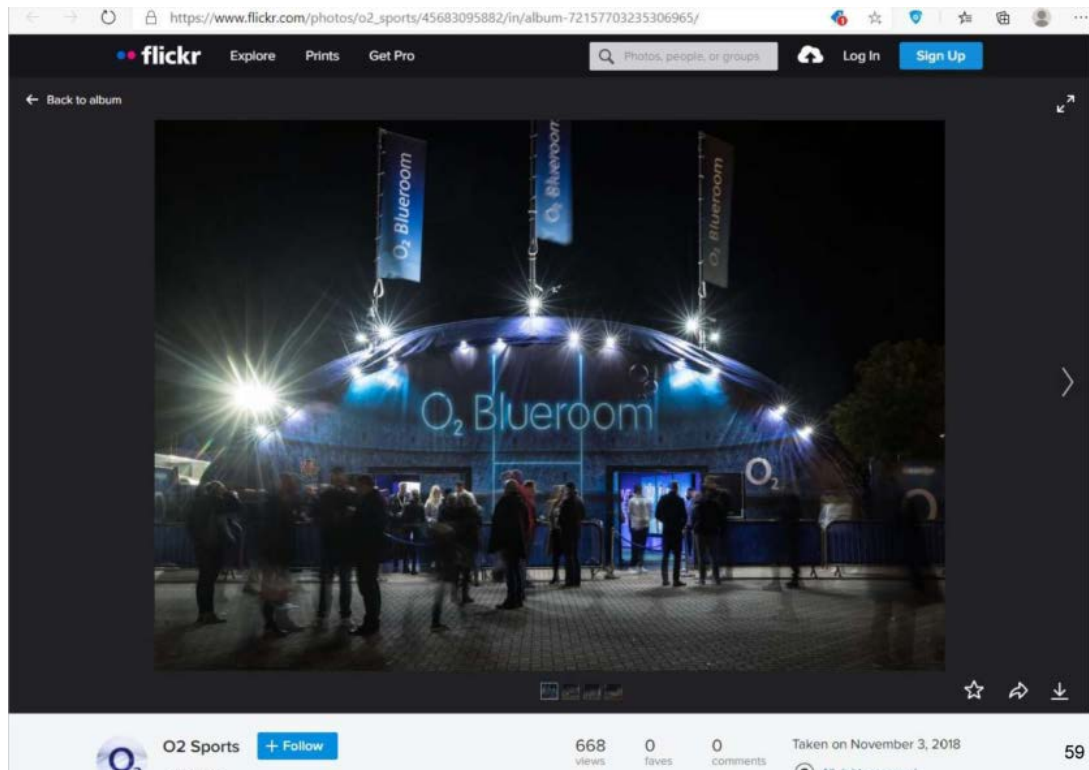
14. I note that Ms Coughlan explains the impact of the COVID-19 pandemic had on this promotion:

“O2 Blue Ticket was a promotion run by My Company during 2020. [...] As a result of the Covid pandemic, the event was not run for the whole year, only being run at the beginning of 2020. If the pandemic had not hit, and My Company’s venues did not have to close, then the intention was for this promotion to be run for the full calendar year.”

15. Exhibit CC3 consists of prints of online articles, dated 30 January 2020, from the *companynewshq.com* and *news.o2.co.uk* websites titled “O2 offering Blue Ticket for one lucky winner to see all events at The O2 for one year – O2 The Blue”. Both articles share the same content and provide details regarding the announcement and the participation process for the ticket contest. Similarly, prints, dated 31 January 2020, of another online article from the *telecompaper.com* website titled “O2 UK offers Blue Ticket for all events at The O2 for 12 months” are exhibited.
16. Exhibit CC4 consists of an undated print illustrating a map of The O2 that depicts the location of the O2 Blueroom. Ms Coughlan, in her witness statement, explains that “[t]he O2 Bluerooms “O2 Blueroom” are two customer venues within The O2 and Twickenham Rugby Stadium (used for England Six Nations Matches)”, operating since 2018 and since at least 2014, respectively. She also states that over 130 thousand customers visited Blueroom at The O2 from 2018-2020, with over 66 thousand transactions from 2018-2019; “1,200 customers (per event) pre and post match (around 2,400 customers per event)” visited O2 Blueroom at Twickenham in which five (three in 2019 and two in 2020) ‘England Six Nation’ matches were held; and that “[...] in 2018 there were 22,605 individual transactions at the O2 Blueroom, and 44,115 in 2019, these being just the O2 Blueroom located in The O2.”
17. Exhibit CC5 contains prints, dated with a print date of 22 January 2021, of an online article from the *restaurantandbardesignawards.com* website

titled “Award Entries 2019 – O2 Blueroom (London, United Kingdom) Platform Group” with a selection of photographs. These show the O2 Blueroom lounge and bar areas. There are also three prints from the *flickr.com* website, dated between November 2018 and March 2020, that show what appears to be the exterior of the O2 Blueroom.





18. Further, Exhibit CC6 consists of screenshots of Twitter user posts, dated between March 2017 and February 2020 but one undated. These show that the O2 Blueroom is mentioned in the captions of the Tweets, accompanied by photographs. I note that in one photograph, the O2 Blueroom can be seen written on the visitors' wristbands.
19. With Exhibit CC7, Ms Coughlan provides design briefings, dated 18 December 2019, for the O2 Blueroom - Six Nations 2020 layout featuring the O2 Blueroom branding.
20. Exhibit CC8 consists of undated prints showing: a mock-up of the drinks menu of the O2 Bluebar; and the relevant webpage of the O2 Bluebar found on the *theo2.co.uk website*. With this Exhibit, two Twitter user posts, dated 17 November 2019 and 9 February 2020, are included, mentioning the #O2Bluebar in the captions, while one of them depicts a wristband with the O2 Bluebar brand on it. In her witness statement, Ms Coughlan states that the O2 Bluebar has been operating since May 2007.

21. Exhibit CC9 consists of prints from the brochure of the business conference run by O2, dated 27 September 2018, containing: the conference agenda; day at a glance; chart with the number of registered guests (770) and attendees (624); a selection of photographs from the venue, speakers, and the audience; figures as to the social media engagement, including Twitter, Facebook, and LinkedIn; an article titled “O2 IS PREPARING THE UK FOR THE NEXT STAGE OF DIGITAL REVOLUTION” featuring at the *cityam.com*; the demonstration floorplan; and a demonstrations list. The ‘Blue Door Conference’ logo, as shown in the evidence, is demonstrated adjacent but separated from ‘O2 business’ with a horizontal/vertical line. Nonetheless, I note that there are various instances in Exhibit CC9 where ‘O2 Blue Door Conference’ appears in plain word format (mainly in the social media posts).
22. Exhibit CC10 comprises two Tweets, dated 10 October 2019, from Twitter users mentioning #O2BlueDoor in their posts alongside photographs from the event; and an undated print that shows the welcome page of the *bluedoorexpo2020.co.uk* website, including details in relation to registering for the Blue Door Expo. Also, part of the two-day programme appears in print.
23. Exhibit CC11 consists of prints of various articles from the *news.o2.co.uk* website, which I will not detail here. Ms Coughlan states that “O2 The Blue is a news service run by My Company. It started in August 2012 and has had 6.9 million page views since that date. Since the launch of this proposition, My Company has spent £328,800 on running this page.” As exhibited, the news articles mainly cover subjects such as news about the company’s products and services and more general business topics. The following number of news articles are shown: 5 from 2020, 7 from 2019, 5 from 2018, 7 from 2017, and 3 from 2016.
24. That concludes my summary of the evidence filed insofar as I consider it necessary.

Legislation

25. Section 46 of the Act states:

“(1) 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;

[...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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 in 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 either 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 existing at an earlier date, that date.”

26. Section 100 of the Act states:

“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.”

27. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Proof of Use

28. 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 Bunderversammlung 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 Marken 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].”

Form of the Marks

29. In Case C-12/12 *Colloseum Holdings AG v Levi Strauss & Co.*, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“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 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)”.

30. Where the issue is whether the use of a mark in a different form, rather than with, or as part of, another mark, constitutes genuine use of the mark as registered, the decision of Mr Richard Arnold QC (as he then was), sitting as the Appointed Person, in *Nirvana Trade Mark*, BL O/262/06, is relevant. He said:

"33. [...] The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period. [...]

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."


31. For convenience, I reproduce the registered as marks below:

O2 BLUE

O₂ BLUE

The (series of two) registered marks consist of the word elements "O2 BLUE" in block capitals and bold standard typeface. Also, the number 2 appears in a subscript form in the second mark. The word elements play the greatest part in the distinctive character while the stylisation is insignificant, and the relevant public is more likely to keep verbal elements in mind to identify the marks.

32. I note that there are examples throughout the registered proprietor's evidence (such as on its website and photographs) in the forms shown in the following table:

a. O2 Blue Ticket
b. O2 Blueroom /  / 
c. O2 Bluebar / 
d. O2 Blue Door Conference /  /  / 
e. O2 The Blue / 

33. The applicant submits that:

“The Proprietor has not shown any evidence of use of O2 BLUE in the form in which it is registered. The witness statement and accompanying exhibits refer variously to the trade marks The O2, O2 BLUE TICKET, O2 BLUEROOM, O2 BLUEBAR, O2 BLUE DOOR and O2 THE BLUE. The Applicant contends that use of these marks are not variant forms of the registration, but differ in elements which significantly impact the overall distinctive character of the mark.”

34. The registered proprietor in its submissions counterargues that:

“[...] the evidence provided shows use in relation to several propositions, namely, O2 BLUE TICKET, O2 BLUEROOM, O2 BLUEBAR, O2 BLUE DOOR, O2 THE BLUE. The Proprietor acknowledges the Applicant’s contentions that the use of these marks is not evidence of use of O2 BLUE alone, instead being used with (on the whole), another descriptive element. The Proprietor contends that the use shown is clearly indicative of various sub offerings using the

core O2 BLUE prefix. The O2 BLUE element of all of these marks is the core branding element, with the addition of descriptive terms such as TICKET, ROOM, BAR and DOOR distinguishing the different offerings related to this branding, that largely operate from The O2. The use of O2 BLUE for all of these offerings ties them together as part of the O2 BLUE brand at The O2. As such, it is clear that the use shown by Clare Coughlan is in fact genuine use of the O2 BLUE mark. [...] The Proprietor contends that the addition of the elements such as TICKET and ROOM do not call in to question the genuine use of the mark. This is because of their brevity, their weak distinctive character and their ancillary position, these additions do not alter the distinctive character of the mark in the form in which it was registered.”

35. As displayed above, the variants show use of the word elements (O2 BLUE) of the registered marks in either plain word form or figurative/stylised form (as shown in ‘b’–‘e’) in colours and script different from that of the registration. Also, in conjunction with the word elements of the registered marks, additional word elements, namely TICKET, -ROOM, -BAR, and DOOR, are presented.
36. By examining the above forms of use under the principles set out in *Colloseum*, I note that the second word element, BLUE, of the registered marks forms a single word unit, conjoined with the word elements -ROOM and -BAR, as seen in ‘b’ and ‘c’. In this regard, the marks lose their independent use as indicators of origin. Even when the word BLUE is separated and placed apart from the succeeding words, a conceptual relation is created between the word element BLUE and the words TICKET and DOOR, as seen in ‘a’ and ‘d’ above. As a result, such forms cannot be considered to retain their inherently distinctive character as per *Colloseum*.
37. I will now address whether the above forms would be considered acceptable variants, applying the approach set out in *Nirvana*. The registered proprietor submits that the addition of the elements TICKET, ROOM, BAR and DOOR does not alter the distinctive character of the mark

in the form in which it was registered. It adds that “This is because of their brevity, their weak distinctive character and their ancillary position” and refers me to the decision of the General Court (“GC”) in Case T-209/09, *Alder Capital Ltd v OHIM*, from which this wording is taken. The elements that were described in this way were Roman numerals. The registered proprietor also draws my attention to Case T-258/13, *Matratzen Concord v OHIM (ARKTIS)*, where the GC ruled that the word “LINE” was descriptive, designating the products are part of the ARKTIS range of goods without affecting the distinctive character of the registered mark (ARKTIS).

38. I am not persuaded that these cases are directly comparable. Although the verbal elements (O2 BLUE) that comprise the distinctive characteristics of the registered marks are present, the addition of the word element TICKET, -ROOM, -BAR, and DOOR (‘a’-‘d’) does alter the distinctive character of the marks. This is because, in my view, the general public will attribute the colour blue to the word that succeeds it in perceiving that, for example, the ticket is blue, or the room or bar is blue. In this way, the word element “BLUE” functions as a modifier of a noun and not merely as a prefix to a descriptive word, as the registered proprietor contends in its submissions¹. In addition, when considering the forms, O2 BLUEROOM and O2 BLUEBAR, part of the distinctiveness emanates from joining the two words BLUE and ROOM and BLUE and BAR to make another one. I also note that the word element DOOR could be descriptive in the context of those goods, but they are not included in the specification. The word TICKET might be allusive, but it is not descriptive of any of the goods and services registered. In that regard, I find that the use of O2 BLUE TICKET, O2 BLUEROOM, O2 BLUEBAR, and O2 BLUE DOOR CONFERENCE, shown above in ‘a’-‘d’, are not acceptable variants of the registered marks as per *Nirvana*.

¹ See paragraphs 9-10 of the proprietor’s written submissions of 10 May 2021.

39. For completeness, the stylised/figurative form of the O2 BLUE DOOR CONFERENCE, as demonstrated in 'd', show that the word elements O2 BUSINESS are evidently separated by a vertical/horizontal line or square box from the word elements BLUE DOOR CONFERENCE/EXPO. The differences noted between the registered marks and that form is the division of the word elements in two distinct groups (O2 BUSINESS and BLUE DOOR CONFERENCE/EXPO); and the addition of the word BUSINESS in between the words O2 and Blue. As for the figurative version of the O2 THE BLUE in 'e', the applicant contends in its submissions that:

“The branding is clearly O2 separated from a brand “THE BLUE”. The O2 logo is placed separately, in blue against a white background. Clearly marked apart from the branding for THE BLUE. THE BLUE is placed in “neon” effect writing, against a blue background, with the subtext “News and Views from O2”.”

I accept that the colour difference and the distance between the O2 and “THE BLUE” make the separation of those elements more acute, dividing the word elements into two groups, thereby altering the distinctive character of the mark. Nevertheless, the strapline “News and Views from O2” is descriptive and does not alter the distinctive character of the mark. For these reasons, I do not consider that any of the above is an acceptable variant of the registered marks.

40. In relation to the plain word form presented in 'e' above, it consists of the words O2 and BLUE, with the latter preceded by the definitive article “THE”. The mark is still essentially O2 BLUE, as little weight will be given to the article. In my view, such addition is an acceptable variant that does not alter the distinctive or dominant character of the marks as per *Nirvana* and, thus, they fall within the scope of genuine use. Therefore, I find that this is an acceptable variant of the marks and will proceed with the evaluation of genuine use in the following section.

Sufficient Use

41. 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.”

42. Although there is no evidence of use of the marks during the first five year period of alleged non-use, Section 46(3) provides that a trade mark shall not be revoked under sections 46(1)(a) or (b) where use of the mark is “commenced or resumed after the expiry of the five year period and before the application for revocation is made [...]”. Therefore, it suffices if the proprietor has shown genuine use of the marks during the second relevant period of alleged non-use.
43. As indicated in the case law cited above, use does not need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded 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.”

44. The responsibility is on the proprietor to provide sufficiently solid evidence to counter the application.² In this case, there is a number of deficiencies in the evidence provided. The thrust of the evidence demonstrating use of the mark O2 THE BLUE is online news articles, where the mark is mainly shown at the top left side of each page isolated from the text of the online news articles.³ There is one instance in Exhibit CC3 where the mark is part of the article title. As delineated earlier in this decision, Ms Coughlan stated that the O2 THE BLUE website has received 6.9 million page views since August 2012, and £328,800 was invested in the maintenance of this site. Although the number of page views is considered a substantial number, I do not overlook that there is no indication of whether these views originate solely from UK users. Neither the evidence nor the witness statement demonstrates any breakdown of the page views per year or investment figures. Notably, the registered proprietor has not provided any evidence that shows how the website looked throughout the relevant periods.
45. I have considered the evidence as a whole. While it is possible for an accumulation of evidence to show use, even if individual items of evidence would on their own be insufficient proof, in my view, the above figures provided with the witness statement in conjunction with the examples of news article content fall short of representing efforts to create and maintain a share of the UK market for the provision of news information. Consequently, they are not by themselves sufficient to establish genuine use.

² See *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14).

³ Exhibit CC11.

Outcome

46. The application for revocation on the grounds of non-use therefore succeeds under section 46(1)(a) and (b). Consequently, the trade marks are revoked for all the goods in Classes 9, 35, 36, 37, 38, 39, 41, 42, 43, 44, and 45.
47. The effective date of revocation is **20 November 2015**.

Costs

48. As the applicant for revocation has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. The sum is calculated as follows:

£200	Official application fees
£200	Preparing a statement and considering the counterstatement
£350	Filing written submissions
£500	Considering evidence
£1,250	Total

49. I, therefore, order O2 Worldwide Limited to pay Bachmann GmbH the sum of £1,250. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 3rd day of June 2021

**Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General**