

BL O/0471/23

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL REGISTRATION NO. 1505983

IN THE NAME OF SHANGHAI SHIMU IMPORT & EXPORT CO., LTD

IN RESPECT OF THE TRADE MARK:

OPTY

IN CLASS 9

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 432209

BY OPTIMA SRL

BACKGROUND AND PLEADINGS

1. Shanghai Shimu Import & Export Co., Ltd (“the holder”) applied to protect International Trade Mark no. 1505983 designating the UK, for the mark shown on the cover page of this decision, on 26 November 2019. The International Registration (“IR”) was accepted and published in the Trade Marks Journal on 21 January 2022, in respect of the following goods:

Class 9 Protection devices for personal use against accidents; clothing for protection against accidents, irradiation and fire; asbestos gloves for protection against accidents; gloves for protection against accidents; protective masks; gloves for divers; gloves for protection against x-rays for industrial purposes; acid-proof gloves; goggles; fire resistant gloves.

2. On 24 March 2022, Optima srl (“the opponent”) filed a notice of opposition, opposing the application in full under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon its comparable United Kingdom Trade Mark (“UKTM”) number 912096293,¹ ‘OPTY-WAY’ (“the earlier mark”). The earlier mark was filed on 28 August 2013 and became registered on 21 January 2014, in respect of goods and services in Classes 9, 38 and 42. For the purpose of these proceedings, the opponent relies upon the following goods:

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments.

3. The opponent claims that the trade marks at issue are similar on the basis that they have identical beginnings and therefore a likelihood of confusion exists. In accordance with section 6A of the Act, the earlier mark is subject to proof of use; the opponent made a statement of use in relation to all the goods relied upon.

¹ On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number 012096293 being registered at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and the original EUTM filing dates remain.

4. The holder filed a defence and counterstatement denying the grounds of opposition and requesting that the opponent provide proof of use of the earlier mark in respect of all the goods relied upon.

5. The opponent is represented by Mentor Legal LLP; the holder is represented by Leo Wang. Only the opponent filed evidence and written submissions. Neither party requested a hearing, nor did they file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers before me.

EVIDENCE AND SUBMISSIONS

6. The opponent filed evidence in the form of the witness statement of Antonio de Capoa, dated 9 November 2022, and his corresponding three exhibits (AdC1-AdC3). Mr de Capoa, a legal representative at de Capoa & Partners Law Firm, is the Italian legal representative for the opponent, and is duly authorised to speak on the opponent's behalf in these proceedings. The opponent also filed written submissions, dated 9 November 2022.

7. I have considered the opponent's evidence and submissions and will refer to them, where necessary, during this decision.

PRELIMINARY ISSUES

8. The holder has raised a point in their counterstatement that I intend to address as a preliminary issue. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, this point will have no bearing on the outcome of this opposition.

Goods comparison and the target market

- In its counterstatement, the holder states that its products in Class 9 are different to the opponent's products and that they target a different type of consumer market.

9. Differences between the goods currently provided by the parties, such as particular characteristics of the goods, including whether they are intended for the field of information technology applied to flat glass processing, etc., are irrelevant, except to the extent that those differences are apparent from each party's specification. It is the goods relied upon by the opponent and the goods applied for by the holder that will be compared. The assessment I must make between the goods is a notional and objective assessment, rather than a subjective one.

10. Furthermore, marketing strategies, including the targeting of specific consumers, are temporary and may change over time. As such, it is not appropriate to take that factor into account in my assessment. However, if applicable, I will make an assessment in this decision, as to who the average consumer could be for the goods at issue.

DECISION

Relevance of EU law

11. 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 Act relied upon 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

12. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

“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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (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

(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)-(5A) [Repealed]

(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.”

13. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

14. Accordingly, for the purposes of assessing proof of use, the earlier mark will be treated as an EUTM for the part of the relevant period before IP completion day (being 31 December 2020) and, as such, use in the EU may be sufficient.

15. Section 100 of the Act is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade mark was made within the relevant territory in the relevant period, and in respect of the Class 9 goods as registered.

Relevant case law

17. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114. The Court of Justice of the European Union (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*, 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 Marken 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 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].”

18. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the date the holder applied to protect its International Registration in the UK, namely, 27 November 2014 to 26 November 2019.

19. Before assessing the opponent’s evidence of use, I remind myself of the comments of Mr Daniel Alexander QC, sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*, where he stated that:²

² 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.”

20. I also note Mr Alexander’s comments in *Guccio Gucci SPA v Gerry Weber International AG*.³ 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”.”

21. The comments of Mr Geoffrey Hobbs QC in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, where he sat as the Appointed Person, are also relevant.⁴ He stated that:

³ Case BL O/424/14

⁴ Case BL O/404/13

“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.”

22. Accordingly, whilst there is no requirement to produce any specific form of evidence, I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied that there has been genuine use of the mark.

Genuine use

23. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the earlier mark, in the course of trade, sufficient to create or maintain a market for the goods at issue during the relevant five-year period. Given that the earlier mark is a comparable mark, the relevant territory during the five-year period is the UK, though use in the EU before IP completion day may be sufficient. In making the assessment, I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown;
- ii) The nature of the use shown;
- iii) The goods for which use has been shown;
- iv) The nature of those goods and the market(s) for them; and
- v) The geographical extent of the use shown.

24. I remind myself that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁵

25. The opponent claims to have used its earlier mark 'OPTY-WAY' in relation to the following goods:

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments.

26. In his witness statement, Mr Antonio de Capoa states that the trade mark 'OPTY-WAY' was registered by the opponent over nine years ago in both Europe and the UK, as shown in Exhibit AdC1. This exhibit contains a printout from the trade mark application and registration database, 'TMview', showing the registration details of

⁵ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

the earlier mark. The printout shows that the trade mark details were exported from the database on 28/09/2022.

27. In his statement, Mr de Capoa states that the earlier mark is currently in use in connection with a range of goods and services such as 'optimization', 'single-user solutions' and 'erp systems' which he adds is shown in Exhibits AdC2 and AdC3. These exhibits comprise of the following two screenshots taken from the opponent's website 'optima.it':

Exhibits AdC2

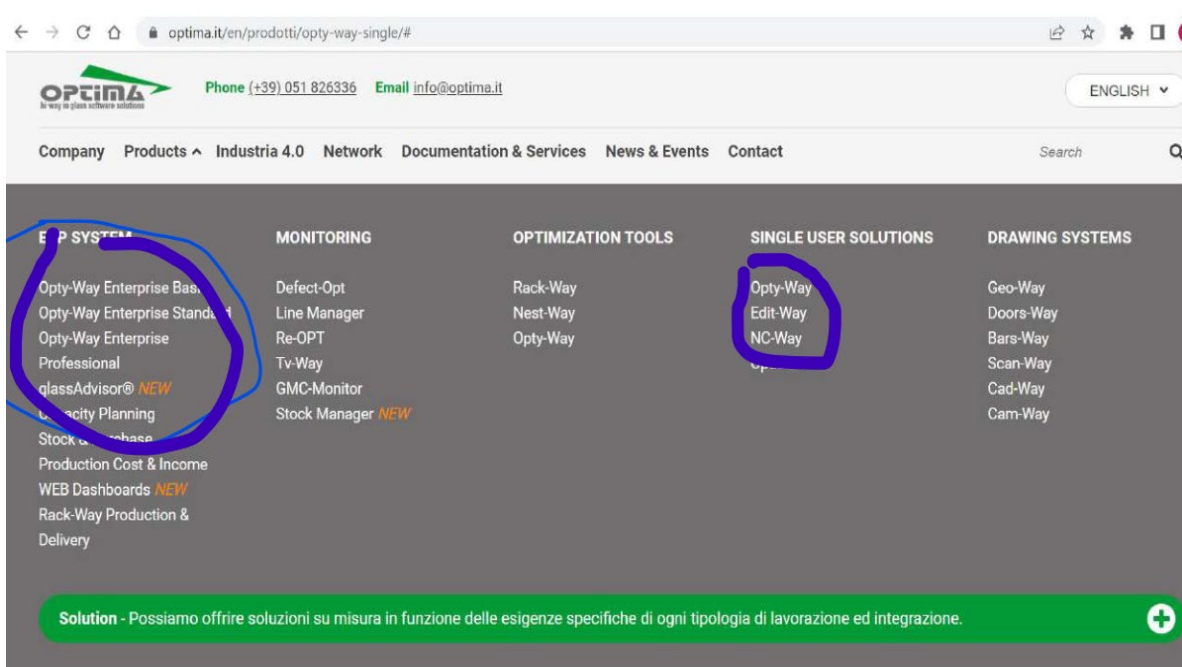


Exhibit AdC3



28. It is clear from the case law above that the onus is on the opponent to show that it has used its trade mark in the relevant period. It is also clear that no particular documents are required for that purpose. However, in the present case, the difficulty for the opponent is that it has filed very few documents, only three exhibits in total, one of which merely shows the registration details of the mark, and the remaining two exhibits, containing screenshots from the opponent's website, are undated. Furthermore, whilst it is acknowledged that the screenshots show use of the mark on the opponent's website, it cannot be established from these screenshots what actual goods the mark at issue is being used in connection with. Moreover, no evidence has been provided relating to sales or turnover. It should not have been difficult for the opponent to provide evidence to show that it had made sales under the mark in the form of, for example, invoices. In addition, no information has been provided by the opponent regarding any advertising or promotional activity undertaken in relation to the mark. Furthermore, figures have not been provided to show how many people have viewed its website or indeed the geographical location of such viewers.

29. Accordingly, I find that the opponent's evidence is insufficiently solid to adequately demonstrate that there has been genuine use of the mark in relation to the goods upon which the opponent relies. If the mark had been put to genuine use on the goods relied, within the relevant period, then it should not have been a difficult matter for the opponent to show it. However, it did not.

CONCLUSION

30. The opponent has failed to establish genuine use of its earlier mark within the relevant period. Where the proof of use provisions apply, an opponent cannot rely on its earlier mark unless those provisions are satisfied. Consequently, as the opponent has not proved use of its mark, it cannot rely on its earlier mark for the purposes of this opposition and the opposition fails at the first hurdle and is dismissed accordingly. Subject to appeal, the application will proceed to registration.

COSTS

31. As the holder has been successful it is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. I award the holder the sum of £400, as a contribution towards the cost of proceedings, calculated as follows:

Considering the Notice of Opposition and preparing a counterstatement	£200
Considering the other side's evidence and submissions	£200
Total	£400

32. I therefore order Optima srl to pay Shanghai Shimu Import & Export Co., Ltd, the sum of £400. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 22nd day of May 2023

**Sam Congreve
For the Registrar**