

**BL O/0559/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001637020**

**DESIGNATING THE UK**

**BY TOSUNĖLU TEKSTİL SANAYİ VE TİCARET ANONİM ŐİRKETİ:**

**OKRA HOME**

**IN CLASS 24**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 434665**

**BY OKA DIRECT LIMITED**

## BACKGROUND AND PLEADINGS

1. International trade mark 1637020 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is TOSUNĞLU TEKSTİL SANAYİ VE TİCARET ANONİM ŞİRKETİ. The IR is registered with effect from 2 June 2021.

2. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The mark also claims priority from 17 May 2021. The holder seeks protection for the IR in relation to the following goods:

Class 24 Woven or non-woven textile fabrics; textile goods for household use, not included in other classes; curtains, bed covers, sheets (textile), pillowcases, blankets, quilts, towels; flags, pennants, labels of textile, swaddling blankets; sleeping bags for camping.

3. The request to protect the IR was published on 1 April 2022. On 30 June 2022, OKA Direct Limited (“the opponent”) opposed the protection of the IR in the UK based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

4. The opponent relies upon the following trade mark:

# OKA HOME

## Oka Home

(“Series of 2”)

UK registration no. UK00003009929

Filing date 13 June 2013; Registration date 21 February 2014.

Relying upon some of the goods for which the mark is registered, namely:

Class 22 Ropes, strings, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of

rubber or plastics); raw fibrous textile materials; feathers for stuffing upholstery; silk flock; hammocks; raw linen; raffia; raw cotton; raw silk; textile fibers; sacks of textile; bags of textile; fabric in the form of a canopy cover.

Class 24 Textile and textile goods, not included in other classes; bed and table covers; banners; bath linen; bed blankets; bed linen; bed clothes; bed covers; bedspreads; brocades; buckram; bunting; calico; canvas for tapestry or embroidery; table linen; table linen coasters; furniture coverings of textile; covers for cushions; loose covers for furniture; curtains of textile or plastic; damask; eiderdowns; fabric of imitation animal skins; fabrics for textile use; flags; household linens; mattress covers; mosquito nets; net curtains; pillow shams; pillow cases; place mats; table runners; table cloths; wall hangings of textile; tapestry wall hangings; towels; upholstery fabrics; piece goods; fabric; canopy covers; flags; banners; tapestries; duvets.

Class 26 Lace and embroidery, ribbon and braid; buttons, hooks and eyes, pins and needles; artificial flowers; hair bands; hair slides; belt clasps; bows for the hair; sewing boxes; brooches; buckles; needle cushions; pin cushions; fancy goods; wreaths of artificial flowers; hair ornaments; hat ornaments; lace trimmings; ornamental novelty badges; ribbons; lapel and tie pins; emblems.

5. The opponent claims that there is a likelihood of confusion because the majority of the goods are identical, the marks are visually and aurally similar, and conceptually both marks are “non-sensical words”.

6. The holder filed a counterstatement denying the claims made and putting the opponent to proof of use.

7. The opponent is represented by Briffa and the holder is represented by Forrester's IP LLP. Neither party requested a hearing, however, the opponent filed evidence in

chief. I have taken all of the evidence and submissions into account in reaching this decision.

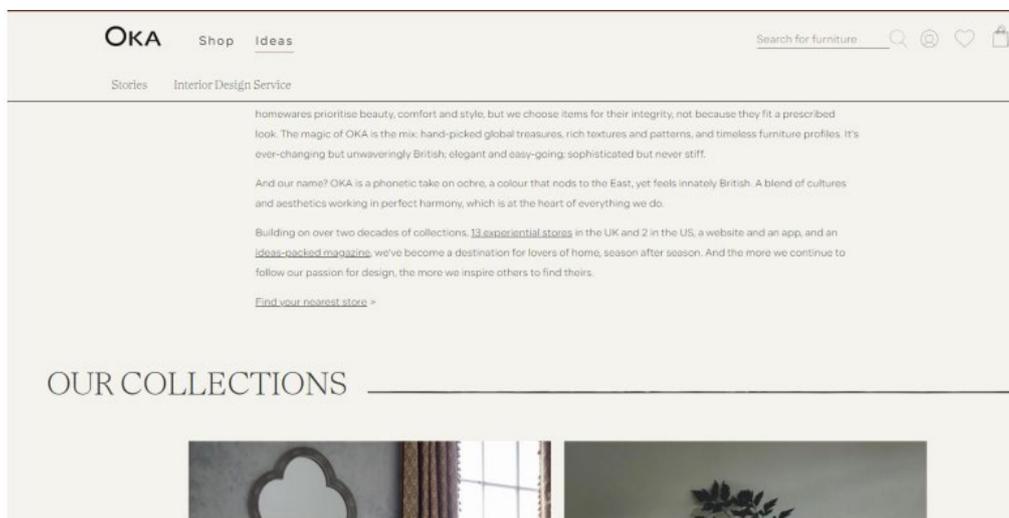
8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU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

## EVIDENCE

9. The opponent's evidence consists of the witness statement of Leila Bailey dated 28 November 2022. Ms Bailey is the Director of the opponent, and her statement was accompanied by 3 exhibits (LB1- LB3). I note the following from the opponent's evidence:

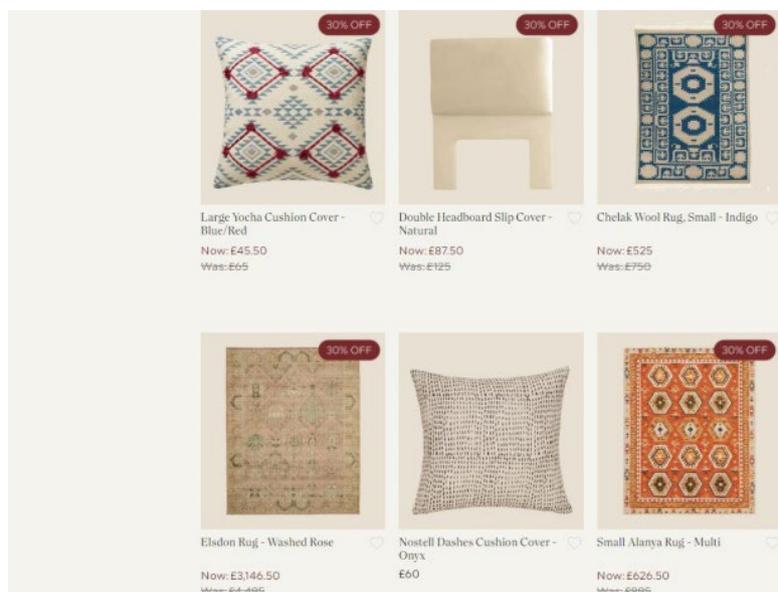
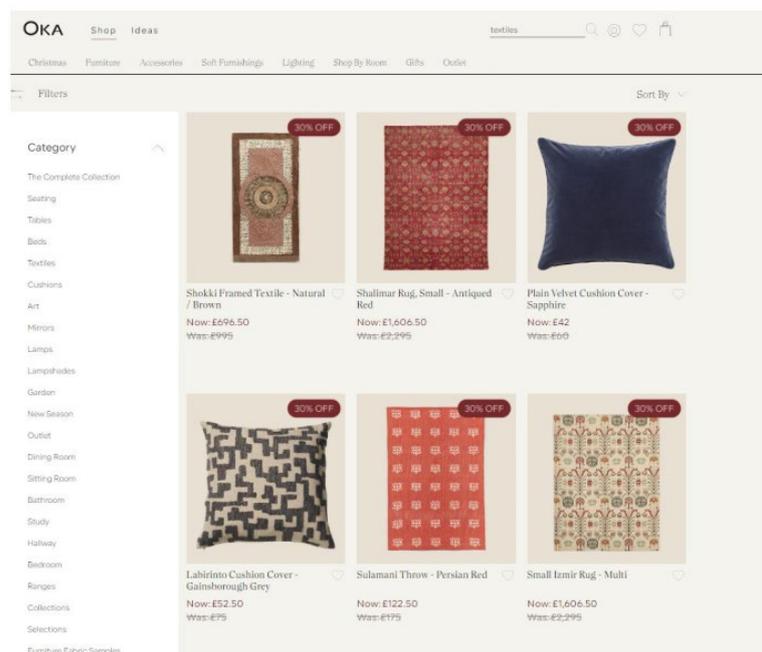
10. Ms Bailey states that "the opponent is a highly successful furniture and furnishing brand with a widely recognised profile in the furniture and interior design industry. The Opponent was incorporated in 1999 and has used the Registration consistently in relation to retailing furniture and furnishings".

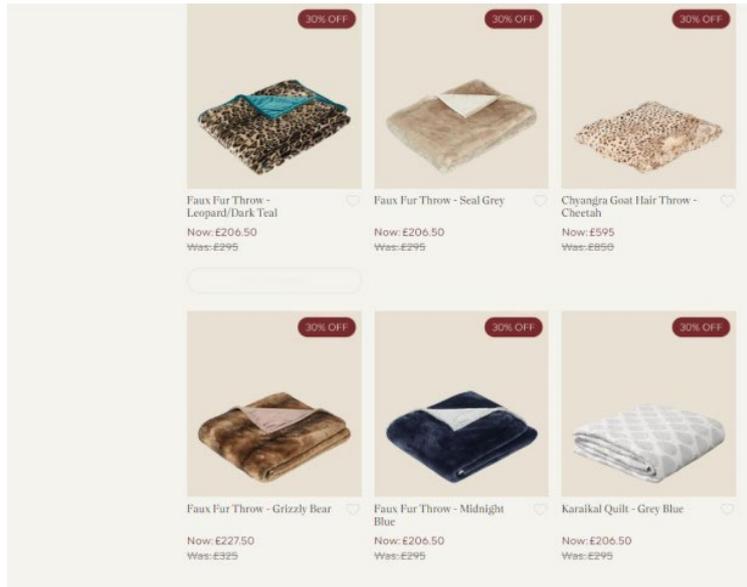
11. **Exhibit LB1** contains the following screenshot of the opponent's website dated 28 November 2022:



12. It states that they have “two decades of collections, 13 experimental stores in the UK and 2 in the US, a website and an app, and an ideas-packed magazine, we’ve become a destination for lovers of home, season after season”.

13. **Exhibit LB2** contains 12 screenshots from the opponent’s website, dated 28 November 2022, showing cushion covers, rugs, headboard covers, throws, sofa covers and quilts for sale. These goods are priced between £45.50 to £2,796.50, and the opponent’s mark is clearly used on the top left hand corner of its website page. For reference, this exhibit includes the following screenshots:





14. **Exhibit LB3** contains a screenshot, from a google search, dated 28 November 2022. The screenshot shows that the search was for “okra home”, however, the first website suggestion was the opponent’s website ([www.oka.com](http://www.oka.com)), with the holder’s website suggested second ([www.okrahome.com](http://www.okrahome.com)).

## **DECISION**

### **Section 5(2)(b)**

15. Section 5(2)(b) reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

16. The opponent's mark qualifies as an earlier mark in accordance with section 6(1)(a) and 6(1)(ab) as its filing date is an earlier date than the priority date of the holder's mark. As the opponent's mark had completed its registration process more than five years before the priority date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

### **Proof of use**

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

18. Section 6A of the Act states:

“(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), (aa) 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.”

19. 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.”

20. 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 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 Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, 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].”

21. 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.<sup>1</sup>

22. As indicated in the case law cited above, use does not need to be quantitatively significant in order 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”.

23. 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)

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<sup>1</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

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. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. 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.”

25. I must assess whether, and to what extent, the above evidence supports the opponent’s statement that it has made genuine use of its mark in relation to the class 22, 24 and 26 goods it relies upon. The relevant period for this purpose is the five years ending on the priority date of the holder’s mark, i.e. 18 May 2016 to 17 May 2021.

### **Conclusions from the evidence on genuine use**

26. The mark upon which the opponent is relying is the mark OKA HOME/Oka Home. I consider that the word “HOME” is descriptive of the nature of the goods; that they are homeware. Therefore, the distinctive character of the opponent’s mark lies in the word OKA. I note that this word is presented in the top left hand corner of the opponent’s website. I also note that it is presented in a slightly stylised typeface, but this does not alter the distinctive character of the mark. Consequently, as far as the form of the mark is concerned, I am satisfied that the mark has been used as registered.

27. The case law summarised in the passage from *Walton* quoted above makes it clear that real commercial exploitation of the trade mark must be shown. Even in a case where the use is not sham, i.e. it is not use engineered solely to preserve the trade mark registration, the use must be more than trivial if it is to be considered genuine. An example of this can be seen in *Memory Opticians Ltd’s Application*, BL O/528/15, where the Appointed Person, Professor Ruth Annand, upheld the decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local, from 3 branches of an optician. There was no advertising of the goods under the mark, and the evidence indicated that they were only displayed in-store on occasion. The mark was said to have been applied to the

goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain a market under the mark. Consequently, it was not genuine use.

28. Where proof of use is required, it is typical to see evidence such as turnover figures, numbers of units sold and invoices showing the sale of goods to customers, whether retail or wholesale. I have not been provided with any of this evidence, which is plainly information which should have been available and relatively easy to provide.

29. It is not necessarily fatal to the assertion of genuine use that there is no such evidence, if other material filed by the opponent is sufficient to show that there has been a real attempt to exploit the mark in the sector. However, there is very little evidence of other activity in this case.

30. **Exhibit LB1** contains a screenshot of the opponent's website which mentions that it has 13 stores located in the UK, an app and magazine. However, no further evidence has been provided in regard to any of these. **Exhibit LB2** shows that the goods the opponent sells are cushion covers, rugs, headboard covers, throws, sofa covers and quilts. However, I note that the name of the goods are not specified as "OKA" goods, they are simply listed as, for example, "Labirinto Cushion Cover" or "Colworth Rug Small". Beyond the website screenshots in **LB1** and **LB2**, there is no evidence of any advertising or promotional activity, whether in terms of traditional print advertising, web advertising or via social media.

31. **Exhibit LB3** shows that when google searching the term "okra home", the first website suggestion is the opponent's, and the second is the holder's. Lastly, I note that all of the exhibits are dated after the end of the relevant period.

32. Therefore, taking the evidence as a whole, my view is that it does not establish that there has been genuine use of the opponent's mark for any goods.

33. The consequence of my finding on use is that UK00003009929 may not be relied upon in these proceedings. As there is no other basis for the opposition, the action must fail.

## CONCLUSION

34. The opposition is unsuccessful, and the application may proceed to registration.

## COSTS

35. The holder has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the holder the sum of **£200** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
<b>Total</b>	<b>£200</b>

36. I therefore order OKA Direct Limited to pay TOSUNĞLU TEKSTİL SANAYİ VE TİCARET ANONİM ŞİRKETİ the sum of £200. This sum is to 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 15<sup>th</sup> day of June 2023**

**L FAYTER**

**For the Registrar**