

**O-580-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF CONSOLIDATED PROCEEDINGS**

**APPLICATION NO 3044854**

**BY OPTIM MANAGEMENT LIMITED TO REGISTER THE TRADE MARK**

**Related**

**IN CLASS 25**

**AND IN THE MATTER OF OPPOSITION**

**THERE TO UNDER NO 402647**

**BY RELATE**

**AND**

**IN THE MATTER OF REGISTRATION NOS 2360664A AND 2483809 IN THE  
NAME OF RELATE IN RESPECT OF THE TRADE MARKS**

**RELATE AND Relate**

**IN CLASSES 14, 16, 18, 25, 26, 28, 35 AND 36, AND CLASS 9 RESPECTIVELY**

**AND APPLICATIONS FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO 500644 AND 500643 RESPECTIVELY BY OPTIM MANAGEMENT  
LIMITED**

## Background and pleadings

1) Optim Management Ltd (hereafter “Optim”) applied to register the mark 3044854 in the UK on 3 March 2014. It was accepted and published in the Trade Marks Journal on 16 May 2014 in respect of *Clothing* in Class 25.

2) Relate opposes the mark on the basis of Sections 5(1), 5(2)(a), 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The first three grounds are based upon conflict with the following earlier mark, the relevant details of which are shown below:

Mark and relevant dates	Goods relied upon
2360664A  RELATE  Filing date: 13 April 2004 Date of entry in register: 27 October 2006	<b>Class 25: <i>Clothing</i></b>

3) Relate claims that the marks are so similar as to be identical or nearly identical and that the goods are identical and the application should be refused given the identity between the goods and marks. Alternatively, it claims that the application should be refused due to the very strong similarity between the marks and the identity of the goods that will lead to the public being confused.

4) In respect of its grounds based upon Section 5(3), Relate relies upon the following earlier marks:

Mark and relevant dates	Services relied upon
1543543  RELATE  Filing date: 2 August 1993  Date of entry in register: 15 December 1995	<b>Class 41: <i>Educational and training services, all relating to advice and to counselling in the field of inter-personal relations; all included in Class 41.</i></b>
1543544  RELATE  Filing date: 2 August 1993  Date of entry in register: 19 January 1996	<b>Class 42: <i>Counselling services; provision of advice and guidance regarding inter-personal relationships; all included in Class 42.</i></b>

<p>2483809</p> <p>Relate</p> <p>Filing date: 2 April 2008</p> <p>Date of entry in register: 12 December 2008</p>	<p><b>Class 9:</b> <i>Magnetic data carriers; audio tapes; recording discs; digital and other electronic recordings; sound recordings; video recordings; computer discs; recording discs for visual images and sound; computers; downloadable electronic publications; downloadable website pages; all relating to the provision of advice and counselling services in the field of inter-personal relations and excluding telecommunication goods and telephone handsets.</i></p>
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5) Relate claims that it is a widely known charity providing relationship counselling and began using its earlier marks in 1988. It claims a substantial reputation as a result of this use. It claims that use of Optim's mark will result in:

- Unfair advantage because Optim's mark will call the earlier marks to mind and there is a likelihood that the public will believe that goods bearing the mark RELATED originated from Relate, or an undertaking economically linked to Relate and that the sales of such goods are supporting Relate's charitable purposes. This would amount to unfair advantage with Optim obtaining sales at the expense of Relate;
- Detriment to the distinctive character of its marks because its marks will be detrimentally impacted if the public believe they are supporting the activities of Relate by buying Optim's clothing. There is a risk that the economic behaviour of the average consumer would change as a result.

6) Optim filed a counterstatement denying the claims made and putting Relate to proof of use of its marks in respect of all the goods and services relied upon. The relevant period in which Relate must demonstrate use is the five years ending with the date of publication of the contested mark, i.e. 17 May 2009 to 16 May 2014 (see Section 6A of the Act).

7) On the 7 October 2014, Optima also filed applications to revoke Relate's UK registrations 2360664A and 2483809 on the basis on non-use of the following goods and services covered by these registrations, namely:

2360664A RELATE

**Class 14:** *Jewellery; lapel pins made from precious metals and/or their alloys or coated with precious metals and/or their alloys.*

**Class 16:** *Books; newsletters; printed matter; journals; business cards; stationery; diaries; printed website pages; instruction and teaching materials; Christmas cards; training materials including overhead projection transparencies.*

**Class 18:** *Leather goods.*

**Class 25:** *Clothing; footwear; and headgear.*

**Class 26:** *Lapel pins made from all materials excluding precious metals and their alloys.*

**Class 28:** *Games and playthings; and Christmas decorations.*

**Class 35:** *Advertising; and business administration.*

**Class 36:** *Financial affairs; ....*

2483809 Relate

**Class 9:** *Magnetic data carriers; audio tapes; recording discs; digital and other electronic recordings; sound recordings; video recordings; computer discs; recording discs for visual images and sound; computers; downloadable electronic publications; downloadable website pages; all relating to the provision of advice and counselling services in the field of inter-personal relations and excluding telecommunication goods and telephone handsets.*

8) The five year periods in which Optim puts Relate to proof of use in respect of both registrations are as follows:

Start date	End Date	Revocation to take effect
3 March 2009	2 March 2014	3 March 2014
16 May 2009	15 May 2014	16 May 2014
7 October 2009	6 October 2014	7 October 2014

9) Relate filed counterstatements claiming that it has used its mark and/or consented to the use by third parties of its marks or, alternatively, it commenced or resumed such use after the relevant five year period but before the applications for revocation were made and where commencement or resumption began before it became aware that the applications for revocation might be made. Such use is claimed in respect of all the goods and services listed in paragraph 7, above relating to registration 2360664A and in respect of the following goods (being narrower than the claim made in its pleadings; see paragraph 4, above) relating to registration 2483809:

Digital and other electronic recordings;  
Sound recordings;  
Video recordings;  
Recording discs for visual images and sound;  
Downloadable electronic publications;  
Downloadable website pages;

10) All three sets of proceedings were subsequently consolidated and both sides filed evidence. This will be summarised to the extent that it is considered necessary. No hearing was requested and so this decision is taken following careful consideration of the papers.

11) Relate is represented in the proceedings by Bircham Dyson Bell LLP and Optim is represented by Field Fisher.

### **Relate's Evidence**

12) This takes the form of a witness statement by Andrew Raymond Haxell, Federation Governance and Performance Manager at Relate. Mr Haxell states that he relies upon the following four categories of use:

- (i) Goods produced and/or offered for sale and services offered;
- (ii) Goods produced and/or offered for sale by third parties, and services offered by third parties, in collaboration with and/or under instruction from Relate;
- (iii) Goods and services offered by Relate to Relate Centres, and;
- (iv) Goods produced and/or offered for sale in, and services offered in, Relate Centres.

13) Mr Haxell wrongly identifies the period in which use should be shown as 7 October 2009 to 6 July 2014 and states that to the best of his knowledge, unless specifically identified as such, all the goods and services shown in the evidence were available during this period. Reliance upon this erroneous period has no material effect upon the proceedings because of the large overlap with all the correct relevant five year periods.

14) Exhibit AH1 consists of an extract from Relate's website providing a history of the organisation. It was originally known as the Marriage Guidance Council before changing its name to Relate in 1988. In 2006, it opened The Relate Institute, a training academy for counsellors. Under the heading "What we do", there is reference to a network of Relate Centres across the UK and counsellors providing relationship counselling and support. It champions the importance of relationships in society, works with government to ensure relationship support is at the heart of public policy, and conducts research on how relationships are changing and makes recommendations on how government policy should respond. Relate works in partnership with a number of third party organisations to raise awareness of relationship issues and to provide easy access to relationship education, training and coaching.

15) Mr Haxell explains that Relate is a federated organisation made up of a number of independent charities, known as Relate Centres that have agreed to act together for a mutual benefit. These Relate Centres have been recognised as members of Relate through a Federation Membership Agreement in 2012, with Relate being “the brand guardian”. They also signed a trade mark licence agreement. The Relate Centres provide a range of relationship support such as relationship counselling and sex therapy as well as workshops and training courses. Currently there are 59 Relate Centres across the UK. Relate charges an annual membership fee to be a member of the federation.

16) Until 2007, Relate’s training of its employees and licensed practitioners was provided from premises in Rugby. Since then it has taken place at Doncaster College where, in a joint venture with the college, the Relate Institute was set up. It has, at all times, operated under the Relate mark. The institute, in addition to providing training in the field of relationship advice, also undertakes academic research in the field.

17) The training services of the Relate Institute are open to individuals outside the federation’s network of Relate Centres and Mr Haxell identifies customers from the NHS, government agencies and private practice. Training is delivered through a number of locations in London as well as Doncaster and Tunbridge Wells.

18) Mr Haxell explains that a number of Relate Centres have a Relate branded charity shop within or near their premises selling a variety of second hand and new goods. The majority of these shops sell clothing. Mr Haxell explains the process for obtaining goods for resale at these shops. He states that turnover is not recorded by reference to type of goods but that annual income from these shops is in the region of £1 million to £1.1 million a year. In addition to sales through its charity shops, Relate also sells goods direct from its Relate Centres. Mr Haxell gives books and lapel pins as examples of the type of goods sold. Mr Haxell states that the turnover from such sales is £30,000 to £50,000 a year.

19) Undated photographs of some of Relate’s charity shops are provided at Exhibit AH7. The “relate” mark can be seen on the banner head of some of these shops. These photographs show shop displays of clothing, jewellery and bric-a-brac.

20) Mr Haxell makes statements and/or provides exhibits in support of use in respect of the following goods:

**Jewellery:** thirteen Relate Centres sell jewellery either through their charity shop or directly from the centres;

**Lapel pins:** Relate has produced and sold lapel pins through its centres. Exhibit AH8 consists of a photograph of such a pin. The word “Relate” appears on the face together with the words “The Relationship People” appearing in smaller text below. By way of example, Mr Haxell states that Relate produced a pin in 2008 to celebrate its 75<sup>th</sup> anniversary. Five thousand of these lapel pins were produced;

**Books:** Relate has authored a number of books over the years including during the relevant periods. These are published by third party publishers, but under the Relate mark. Mr Haxell gives six book titles as examples, the earliest being published in 2001. Others have publication dates of 5 November 2009 (“The Relate Guide to Finding Love”), 31 May 2012, 4 July 2013 and 6 February 2014. The latter three books have titles relating to personal relationships. Exhibits AH10 and AH11 consist of extracts from Relate’s website and the online market place, Amazon.co.uk showing its books for sale. All the book covers shown have the Relate mark appearing prominently.

**Newsletters, stationery:** Mr Haxell provides evidence of a newsletter targeted at Relate Centre employees, licensed counsellors, trustees, volunteers and supporters. These were produced fortnightly during the relevant period and three examples are provided at Exhibit AH11 and appear to be from November/December 2014, i.e. after the relevant periods. Mr Haxell states that the number of subscribers over the relevant period was consistently around 2000. They clearly display the mark “relate” in lower case appearing with the words “the relationship people” appearing underneath. In addition, a monthly newsletter is targeted at Relate Centres only. Fourteen centres also produce their own newsletter entitled RELATE that is sold directly to the public. He also states that Relate produce electronic templates and physical headed note paper for Relate Centres to use. Items such as paper, pens and pencils are sold directly to the public;

**Printed matter; business cards:** Relate produces business cards to Relate Centre staff. Many of the Relate Centres also derive income from the sale of posters, photographs, leaflets and stickers;

**Journals, diaries:** Branded diaries, calendars and pens have been provided to staff and Relate Centres and a number of these and its charity shops also sell these to external customers. The collective arrangement for the sourcing of these goods ended in late 2012/early 2013 and since then Relate Centres have made local arrangements for these items to be supplied locally;

**Printed website pages, downloadable website pages, downloadable electronic publications:** Relate’s mark appears on all pages of its website. Its website has numerous tools and downloadable web pages offering the general public guidance and assistance with their personal relationships, including two named personality profile tools, quizzes relating to personal relationships and short articles to assist parents with separation. At least 17 Relate Centres also have their own Relate branded website where some pages are designed to be downloadable (see the example from the Cambridge Relate Centre at Exhibits AH21 and 22). Examples of branded downloadable publications are provided at Exhibit AH24. These include:

- Two policy statements dated June and July 2014, respectively;
- An undated document entitled "The Relationships Alliance Priorities for Policy". This is co-branded with the trade marks of a number of

organisations shown at the bottom of the last page, including the Relate mark;

- A printed manifesto of The Relationship Alliance, dated October 2014, once again co-branded which includes the Relate trade mark;
- An extract of a Relate branded paper entitled "Relationships, Recession and Recovery - The role of relationships in generating social recovery";
- A consultation document co-branded "College of St George" and "Relate", dated January 2014;

**Instruction and teaching materials; training materials including overhead projection transparencies:** Mr Haxell states that the Relate Centres produce teaching materials as does Relate itself to assist the Relate Centres to deliver training locally. Examples of these teaching materials are provided at Exhibit AH25 in the form of course specifications dated March 2011 and October 2010 and trainer notes, dated February 2013. Mr Haxell states these courses are delivered to employers as "continuing professional development". Course materials, co-branded with the Stroke Association are also provided at Exhibit AH27 and dated August 2013.

Mr Haxell also explains that Relate creates materials for the Relate Institute and authorises use of the Relate mark on materials used by Doncaster College. By way of example, pages from the programme handbook, 2014 – 2015 for the MA course on Relationship Therapy is provided at Exhibit AH27. The mark that appears on the front page of this handbook consists of a device followed by the words "relate institute". Mr Haxell explains that he has been unable to locate earlier versions because of the practice of "writing over" earlier electronic versions when producing the handbook each year.

Mr Haxell states that course material is also provided on DVD to students and that a large volume of instructional material is provided during counselling sessions to customers for self-study/self-help. The costs of counselling sessions and training sessions include the cost of the course or other materials provided;

**Christmas cards:** Mr Haxell states that Relate produce own-branded Christmas cards and an example order form from 2012 is provided at Exhibit AH28 and an example of a Relate branded e-Christmas card is provided at Exhibit AH29. In the region of 5000 cards were sold in the period 2012 to 2014;

**Digital and other sound recordings; Sound recordings; Video recordings; Recording discs for visual images and sound:** Mr Haxell states that Relate has produced a "significant number" of videos, short films and sound bites, many of which are available for download from its website. Some are intended for the general public and some also for use by the Relate Centres in the provision of their services. Internet information and links to



various videos are shown at Exhibit AH30 and are all dated from 2014. Relate's videos are also made available on YouTube. A screenshot demonstrating this is shown at Exhibit AH31. Relate Centres also produce their own videos. An example of this is shown at Exhibit AH32. This consists of a screen print from March 2015 of the "Welcome" page of Relate Cambridge. There is a link to a video entitled "this is what we do". Mr Haxell states that at least 19 Relate Centres have Relate branded videos available on their website. Video titles include "introduction to self-help exercises, "what people need" and "balancing family couple and personal time". Finally, Mr Haxell states that eleven Relate Centres informed him that they sell DVDs and CDs, mostly as part of education and learning courses;

**Leather goods; clothing footwear, headgear; games and playthings, Christmas decorations:** Mr Haxell states that a number of "Relate" charity shops sell clothing, footwear, headgear, leather goods and games. These goods are obtained through collections made by "Relate" or donations. Relate branding is heavily relied upon by these stores. He also states that staff also wear "Relate" branded fleeces and t-shirts.

**Business administration services; financial affairs services:** Mr Haxell relies upon services provided by Relate to the Relate Centres, such as:

- a quality assurance framework it operates to ensure Relate Centres deliver high quality services;
- Relate Centres operating to external ethical standards and that all Relate practitioners must meet minimum standards set by Relate;
- promoting continuous improvement in Relate Centres and it monitors this through reviews and initiating programmes of works;
- encouraging innovation in service delivery at the Relate Centres and developing innovative projects that it encourages its centres to adopt;
- providing a complete administration system for Relate Centres. It consists of three parts, the first of which is included in the membership fee with the second and third parts being charged-for options;
- offering an "intervention" process to its members where a centre is not operating to the required level or is in financial difficulty;
- providing assistance with appraisals, due diligence, benchmarking, financial modelling (as well as other areas of assistance) and also offering a financial performance management system to its Relate Centres;
- producing benchmarking reports to assess the performance of centres against the performance of other centres;
- providing legal and HR advice to Relate Centres;

- Defined services provided under the federation agreement (as per schedule 4 of agreement).

**Advertising services:** Mr Haxell refers to Relate's service, to the Relate Centres, of providing business cards etc. It also provides templates of advertising flyers for Relate Centres to access on its website. Further, Relate manages the brand portfolio working to promote the brand for the benefit of the Relate Centres and conducts national advertising that the Relate Centres can "top-up" locally such as placing advertisements in Yellow Pages, national press campaigns etc..

**Charitable fund raising:** Mr Haxell explains that Relate is funded by a variety of grants, fundraising, donations and membership fees and charges for advice and counselling. Revenue generated since 2008 has been between £25 million to £29 million a year (and includes income from the Relate Centres). Spend on promotional activities has varied between £700,000 and £1.2 million a year. This spend includes the maintenance of its website and advertising and at Exhibit AH43, Mr Haxell provides copies of advertisements placed in the BT Phone Book and Yell.

**Educational and training services, all relating to advice and to counselling in the field of inter-personal relations:** Mr Haxell states that a significant part of the work of the Relate Centres is the running of educational workshops and training sessions and is aimed at either individuals or couples and also to relationship counsellors and counselling skills for non-counsellors. About 8500 users received training in the year 2012-2013.

The majority of Relate's training is carried out through the Relate Institute. For the 6 years from 2008, the number of people who have received such training is over 11,000. Mr Haxell states that the Relate Institute attracts world-renowned speakers to give lectures, such as Nick Clegg (in 2009) and David Cameron (in 2008). Flyers advertising the Relate Institute are provided at Exhibit AH44 and are dated October 2013. Mr Haxell provides information on the many courses provided but, suffice to say, these all relate to relationship advice and counselling. In 2011, the BBC commissioned a documentary into the work of counsellors trained at the Relate Institute and this was aired on 11 May 2011. At Exhibit AH46 is a BBC News article discussing the documentary.

**Counselling services, provision of advice and guidance regarding inter-personal relationships:** Mr Haxell states that these services have been provided under the mark RELATE for 26 years and that there are around 400 "access points" around the country, including the 59 "Relate Centres", where these services are provided. Clients locate licensed counsellors on the RELATE website. A screenshot from the website Yell, is provided at Exhibit AH47 and shows a RELATE licensed counsellor based in Cumbria.

Mr Haxell also states that RELATE offers around 350,000 hours of counselling to around 150,000 people each year. Mr Haxell provides an

annual breakdown for the years 2008 to 2014 showing counselling in respect of the following categories: adult relationships, sex therapy, children and young people, family services and education and learning. These figures are reasonably consistent year-on-year and confirm the figure stated by Mr Haxell.

It is stated that RELATE has 1900 employed advisors, is the largest employer of counsellors in the UK and is recognised by the UK government as being the market leader in the field of relationship counselling and advice.

Mr Haxell states that RELATE is widely recognised by the public and in the media and he refers to “extensive coverage in national newspapers, magazines, on radio and on television. Exhibit AH49 consists of a document listing key media coverage between 2009 and 2012. Examples include RELATE counsellors featuring in articles in newspapers such as the *Guardian*, *The Daily Mail* and *The Sun* and others, on *BBC Radio 1* and *BBC Radio 4* programmes or articles and also on television such as the Alan Titchmarsh Show on *ITV1*.

### **Optim’s Evidence**

21) This takes the form of two witness statements, the first of which is by Amy Denise Reynolds, Senior Associate with Field Fisher Waterhouse, the applicant’s representative in these proceedings. Ms Reynolds’ evidence consists of information she has obtained from the website of the Charity Retail Association that is self-proclaimed as “the only body in the UK that represents the interests of charity retailers”.

22) The main thrust of this evidence is that most charity shops acquire their stock from donations.

23) The second witness statement is by Helen Nicola, sole director and shareholder of Optim. Ms Nicola states that Optim was incorporated in 1994 and specialises in the retail and wholesale of women’s fashion clothing.

24) Ms Nicola states that, together with her daughter, Ms Joanna Nicola, she runs The Oxygen Boutique in London. As well as selling designer label clothing, this shop also sells its own brand clothing. The mark RELATED was chosen for the brand because of the mother and daughter team running the shop. Clothing sold under the mark was promoted from February 2013.

### **Relate’s Evidence in reply**

25) This takes the form of a witness statement by Clara Bakosi, an IP and Trade Mark Paralegal with Bircham Dyson Bell LLP. At Exhibits 1 – 6, Ms Bakosi provides extracts from a number of charities’ websites to support the proposition that multiple charities do sell own branded clothing. It is not necessary for me to detail this evidence further.

## Proof of use

26) Optim has filed non-use revocation actions, in respect of the list of goods and services shown in paragraph 7, against the earlier marks 2360664A RELATE and 2483809 Relate, relied upon by Relate in its opposition. Further, in its counterstatement filed in the opposition proceedings, it has also put Relate to proof of use in respect of ALL goods and services listed in all four of its earlier marks.

27) The relevant part of the Act, Section 6A, reads as follows:

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

6A. - (1) This section applies where -

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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.”

28) In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

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

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]–[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

29) Although minimal use may qualify as genuine use, the Court of Justice of the European Union (“the CJEU”) stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

30) Section 100 of the Act states that:

“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.”

31) Before looking more closely at the range of goods and services where Relate has claimed use, I should comment that what use is shown, consistently shows the mark RELATE in word form (usually in the lower case form “relate”) and therefore, where I find genuine use, it is respect of the marks as registered.

32) Before considering what use has been shown in respect of each of the earlier marks, I believe it is appropriate to make some general observations regarding the evidence provided by Mr Haxell and the overall impression it creates regarding the activities of Relate. Mr Haxell has produced a detailed witness statement and has attempted to address the issue of use in respect of most of the goods and services listed in Relate’s earlier marks. When considering this evidence in respect of certain goods and services, his evidence is not above some criticism. For example, Mr Haxell states that Relate has sold lapel pins during the relevant periods, but the photograph provided to support this contention is undated and further, the only information he provides regarding the scale of business in lapel pins relates to 2008, the year BEFORE the commencement of the relevant periods. That said, the evidence, when considered as a whole creates the impression of a large charitable organisation operating independently and through its federated Relate Centres to provide its core activities in the field of relationship management/advice/counselling

and educations and training in the same field. What is equally clear is that Relate raised funds for its activities through the operation of numerous charity shops, that it does produce certain items for sale (such as the lapel pins I referred to) and this model appears to have been reasonably consistent over time. In light of this, despite the evidence in respect of certain goods and services having some flaws, I keep in mind the broader impression created when reaching a conclusion on whether there has been genuine use.

33) In addition, the existence of a federation agreement between Relate and the individual Relate Centres points towards the Relate Centres being different entities to Relate itself and consequently, goods or services provided by Relate to the Relate Centres is not internal use but rather use that can be taken into account for the purposes of demonstrating genuine use.

34) I keep all of the above comments in mind, and I will now consider whether genuine use has been shown in respect of each of Relate's earlier marks, beginning with the two marks subject to the revocation actions:

***Earlier Mark 2360664A***

35) Optim has applied for revocation of this earlier mark in respect of the list of goods and services in paragraph 7, above. I will consider each class of goods or services in turn:

**Class 14: Jewellery; lapel pins made from precious metals and/or their alloys or coated with precious metals and/or their alloys**

36) Mr Haxell states that 13 Relate Centres sell *jewellery* either through their charity shops or directly from the centres. He provides no evidence as to whether this jewellery is sold under the mark RELATE. What the evidence does show, is that third party branded goods are sold through Relate's network of charity shops. This activity is the service of retailing (and proper to Class 35) and it is not evidence of the mark RELATE being used in respect of the goods themselves. In considering this point, I take into account the following comments of Mr Daniel Alexander Q.C. sitting as the Appointed Person in *Aegon UK Property Fund Limited v The Light Aparthotel LLP*, BL O/472/11:

“17. .... unless it is obvious, the proprietor must prove that the use was in relation to the particular goods or services for which the registration is sought to be maintained.

18. In *Céline SARL v. Céline SA*, Case C-17/06 (*Céline*), the Court of Justice gave guidance as to the meaning of “use in relation to” goods for the purpose of the infringement provisions in Article 5(1) of the Directive. Considering a situation where the mark is not physically affixed to the goods, the court said at [23]:

“...even where the sign is not affixed, there is use “in relation to goods or services” within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign

which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party.”

19. The General Court (“the GC”) has, on more than one occasion, proceeded on the basis that a similar approach applies to the non-use provisions in Article 43 of the Community Trade Mark Regulation. For example, in *Strategi Group*, Case T-92/091, it said:

“23. In that regard, the Court of Justice has stated, with regard to Article 5(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989, L 40, p. 1), that the purpose of a company, trade or shop name is not, of itself, to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being ‘in relation to goods or services’ (*Céline*, paragraph 21).

24. Conversely, there is use ‘in relation to goods’ where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets. In addition, even where the sign is not affixed, there is use ‘in relation to goods or services’ within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party (see *Céline*, paragraphs 22 and 23).

20. Those passages must be read together with the general requirements of proof of use in *Ansul* at [43] that there is genuine use of a trade mark where the mark is used in accordance with its essential function namely to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services.

37) In the current case, there is no evidence to show that the Relate uses its mark in a way that most of the goods sold in its charity shops are linked to it such that the consumer will perceive that it is responsible for the goods. Certainly, this is the case in respect of jewellery and I conclude that there is no evidence of use in respect of *jewellery*.

38) In respect of *lapel pins*, Mr Haxell states that Relate has produced and sold lapel pins and these have been available through its Relate Centres. An example is shown at Exhibit AH8 where the words “relate, the relationship people” appear thereon. As an illustrative example, Mr Haxell states that five thousand of these lapel pins were produced in 2008 to celebrate Relate’s 75<sup>th</sup> anniversary. Whilst there is a lack of corroboratory evidence illustrating the mark was used in respect of *lapel pins* during any of the relevant periods, I infer that sales of the 2008 production of lapel pins spilled over into the relevant period and, further, that Mr Haxell stresses that this is



an illustrative example. What I cannot accept however, is that such lapel pins are made from precious metals etc. There is no evidence of this and neither do I consider it normal for charitable organisations to produce and sell such goods as part of their normal activities. Therefore, I conclude that there has been genuine use in respect of lapel pins, but only of the type covered by Class 26 (see paragraph 51, below).

**Class 16: Books; newsletters; printed matter; journals; business cards; stationery; diaries; printed website pages; instruction and teaching materials; Christmas cards; training materials including overhead projection transparencies**

39) Mr Haxell states that over the years, third party publishers have published a number of books under the RELATE mark and he refers to five books published within the relevant periods. Exhibit AH11 consists of pages from the Relate website and the online retailer, *Amazon*. These show the RELATE mark appearing on the front cover of the books. I conclude use has been shown in respect of *books*.

40) Mr Haxell provides evidence of a newsletter targeted at readers that include Relate Centre employees and licensed counsellors. The subscription level during the relevant periods was consistently around 2000. He also explains that other newsletters are provided including newsletters produced by at least fourteen Relate Centres and these are also provided under the RELATE mark and sold to their customers. I conclude that genuine use has been demonstrated during the relevant periods.

41) Mr Haxell has also states that at least twenty three Relate Centres sell RELATE branded items of stationery such as pens. Other stationery items are sold, but the evidence lacks the detail in order to be able to state categorically that there has been genuine use in respect of such goods, namely paper, pencils. Nevertheless, it is normal for charities to provide own-branded items such as these and in light of the evidence that RELATE does produce self-branded pens, diaries and calendars, I also conclude that use extends to pencils and paper also. Taking all of this into account, I find that Relate has demonstrated use sufficient to retain the term *stationery* as well as *diaries*.

42) Mr Haxell also states that Relate provides business cards to the Relate Centres. Taking account of my comments in paragraph 33, above, I conclude that use is shown in respect of *business cards*.

43) Mr Haxell does not provide evidence of any use in respect of printed website pages, but rather relies upon the fact that numerous pages on the Relate website and the web sites of the Relate Centres include pages that are downloadable. Use in respect of one, cannot be taken as use of the other, despite their similarity and I conclude there is no use shown in respect of *printed website pages*.

44) There is no evidence in respect of *journals*. Further, whilst use in respect of some *printed matter* has been shown (resulting in the retention of narrower terms), the use shown does not justify retention for such a wide term. I conclude that the use shown does not permit me to accept use in respect of *printed matter per se*.

45) Mr Haxell provides a number of examples at Exhibit AH25 illustrating use of the RELATE mark in respect of course specifications, trainer notes and a course programme handbook from within the relevant periods. He further states that course materials are provided to students and a large volume of instructional materials are provided to customers for the purposes of self-help or self study. Taking all of this together, I conclude that genuine use has been shown in respect of *instruction and teaching materials* and *training materials including overhead projection transparencies*.

46) Finally, Mr Haxell states that Relate produces its own-branded Christmas cards and he provides an example order form from 2012 at Exhibit AH28. He states that around 5000 Christmas cards were sold between 2012 and 2014. I conclude this demonstrates genuine use in respect of *Christmas cards*.

**Class 18: Leather goods**

47) Mr Haxell provides no specific evidence in respect of these goods and I conclude that no genuine use has been shown.

**Class 25: Clothing; footwear; and headgear**

48) Mr Haxell provides no evidence of RELATE branded clothing, footwear or headgear being offered for sale. He relies upon sales of donated clothing from RELATE branded charity shops and also the fact that staff are issued with RELATE branded fleeces. Neither of these uses constitute genuine use of the RELATE mark in respect of clothing. The sale of such goods from RELATE branded shops is the service of retailing of clothing. As I have already stated, this is a service proper to Class 35 and not covered by the earlier mark (or any of the other earlier marks). It is the shop that is branded as RELATE and not the goods (also see my comments at paragraph 36, above).

49) The use by staff of clothing featuring the RELATE mark, is not evidence of trading in RELATE branded clothing. Rather this is an example of internal use where Relate provides clothing to its staff. There is no evidence that it conducts any trade under the mark RELATE in respect of clothing (or footwear or headgear).

50) In summary, I conclude that there is no evidence to support the claim that genuine use of the mark has been made in respect of *clothing, footwear or headgear*.

**Class 26: Lapel pins made from all materials excluding precious metals and their alloys**

51) As I have already found in paragraph 37 above, there has been genuine use in respect of *lapel pins* in this class.

**Class 28: Games and playthings; and Christmas decorations.**

52) As with Mr Haxell's claim to use in respect of clothing, he relies upon the sale of these goods from Relate's charity shops. As I have already concluded, this is use in

respect of a retail service and not use in respect of the goods themselves. Further there is no evidence that these goods are provided under the RELATE mark. I find that there is no genuine use in respect of these goods.

**Class 35:** *Advertising; and business administration.*

53) Mr Haxell relies upon Relate's promotional activities that it undertakes to promote its own mark and also the provision of business cards and templates for advertising flyers to the Relate Centres. This is not use in respect of *advertising*. Such a service would involve undertaking to advertise goods or services on behalf of a third party. Promotion of its own mark does not qualify as such an advertising service. I conclude that no genuine use has been shown.

54) In respect of *business administration*, Mr Haxell has provided comprehensive information regarding how Relate Centres work within a quality assurance framework designed by Relate. Relate provides, under the federation agreement, a complete administration system for which it charges. I conclude that genuine use has been made in respect of *business administration*.

**Class 36:** *Financial affairs; ....*

55) Mr Haxell describes an intervention process that is available to the Relate Centres. This is triggered when a Relate Centre is not performing to a satisfactory level such as when it is in financial difficulty. He states that this intervention procedure has only been triggered once, at the end of November 2014 when a centre had insufficient funds to meet its payroll commitments. In this instance, Relate provided draw-down funding to ensure the pay-roll commitments were met, undertook an inspection of the accounts and created a recovery plan. Certainly the provision of draw-down funding is a service covered by the very broad term *financial affairs*, but the other services described would more accurately fall under the headings of business support and accountancy-type services, proper to Class 35 and not Class 36.

56) Despite draw-down funding only being provided on one occasion (and the month after the latest of the relevant five year periods ended), I do not find this to be critical. This is because it is indicative that the service was on offer as part of the federation agreement, and the access to such a service was paid for by the Relate Centres through their fees associated with the federation agreement. Therefore, I conclude that the evidence demonstrates that genuine use has been shown in respect of draw-down funding. This is a service covered by the term *financial affairs* and it is necessary for me to consider whether such use is sufficient to warrant the broad term remaining in the specification. In considering this point, I keep in mind the guidance in a number of cases. Firstly, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person summed up the law as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

57) Secondly, in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed

independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

58) Therefore, I must consider how the consumer would fairly describe the services and what would be a fair description of the category of the services. However, it is not clear to me what sub-category, if any would be appropriate. What is clear to me, is that the term *financial affairs* is very broad and the use shown does not justify retention of such a broad term. In the absence of an obvious sub-category, I find that the term financial affairs should be replaced by the term *draw-down funding*.

59) Mr Haxell also makes reference to a “financial performance management system”. Once again, this appears to be a term that relates to an accountancy-type service rather than a financial service. However, no further information is provided and I cannot conclude that genuine use has been shown.

60) In summary, earlier mark 2360664A survives the application for revocation only in respect of:

**Class 16:** *Books; newsletters; [...]; [...]; business cards; stationery; diaries; [...]; instruction and teaching materials; Christmas cards; training materials including overhead projection transparencies*

**Class 26:** *Lapel pins made from all materials excluding precious metals and their alloys*

**Class 35:** *[...] business administration*

**Class 36:** *Draw-down funding*

61) In respect of all other goods and services, it is revoked from the earliest date claimed, namely 2 March 2009.

**Earlier Mark 2483809**

62) This earlier mark is registered in respect of the following list of goods in Class 9:

*Magnetic data carriers; audio tapes; recording discs; digital and other electronic recordings; sound recordings; video recordings; computer discs; recording discs for visual images and sound; computers; downloadable electronic publications; downloadable website pages; all relating to the provision of advice and counselling services in the field of inter-personal relations and excluding telecommunication goods and telephone handsets.*

63) Mr Haxell claims use in respect of two contradictory lists of goods, so I will consider the broader of the two claims, namely the claim made when bringing the opposition proceedings, that Relate has a reputation (and therefore it must have also genuinely used its mark) in respect of all the Class 9 goods listed in the earlier mark.

*Downloadable electronic publications; downloadable website pages; all relating to the provision of advice and counselling services in the field of inter-personal relations and excluding telecommunication goods and telephone handsets.*

64) Mr Haxell states that the RELATE mark appears on all pages of its website and this is borne out in the evidence. Further, he states that a number of these pages are downloadable offering guidance and assistance in respect of personal relationships. He further states that 17 Relate Centres have their own RELATE branded websites where some pages are designed to be downloadable. Examples of these are provided at Exhibit AH21 and AH22. These all appear to be policy documents rather than advice or counselling and therefore do not demonstrate use of the goods listed in the specification (which are limited to being in the field of advice and counselling). Consequently, I conclude there is no genuine use shown in respect of these goods.

*Magnetic data carriers; audio tapes; recording discs; digital and other electronic recordings; sound recordings; video recordings; computer discs; recording discs for visual images and sound; computers.*

65) Mr Haxell states that Relate has produced a “significant number“ of videos, short films and sound bites. Examples of these are provided at Exhibit AH30. These examples consist of videos accessible through Relate’s website or the websites of some Relate Centres. The RELATE mark appears prominently at the top of each web page. The following videos are shown:

- What Makes a Relationship Work, dated 7 January 2014;
- Talking to Children About Separation and Divorce, dated 7 January 2014;
- Why Do Relationships Matter, dated 3 January 2014;
- Tricia’s Story – How Mediation Saved My Family, dated 18 July 2014;
- Is Technology Another Member of the Family, dated 8 December 2014;

66) At Exhibit AH31 is a screen print from *YouTube*. The RELATE mark appears at the top and links are provided to 9 different videos. The screen print was obtained on 9 March 2015, but there is no indication of when these videos were first made available on the website.

67) In addition, Mr Haxell states that 19 Relate Centres produce their own videos under the mark RELATE and he refers to a number of titles (see paragraph 20 at the top of page 9). Exhibit AH32 shows a video accessed through the Relate Cambridge website, provided by Mr Haxell as evidence that Relate centres also produce their own videos. It is a video, entitled "This is what we do". This last example appears to be more by way of promotional material for Relate's own services rather than the provision of video recordings per se. Nevertheless, taking Mr Haxell's evidence as a whole in respect of these goods, there is clear use under the mark from at least the whole of 2014. Further, when taken in context with the rest of the evidence regarding the long standing history of activity under the RELATE mark, it is not likely that the video recordings were only produced in 2014. Taking all of this into account, I conclude that use has been shown in respect of *video recordings, all relating to the provision of advice and counselling services in the field of inter-personal relations and excluding telecommunication goods and telephone handsets*.

68) Mr Haxell also states that eleven Relate Centres informed him that they sell DVDs and CDs, mostly as part of education and learning courses. The fact that Mr Haxell has no direct knowledge of these activities but has relied upon what he has been told means that his evidence amounts to "hearsay". When this is taken into account together with the fact that there is no corroboratory evidence to support the statement, I must conclude that the statement is insufficient to demonstrate use in respect of such goods. Mr Haxell also states that educational course material is provided to students on DVD, but there is no indication of whether this was done during the relevant periods, what the scale of this activity was and whether the mark RELATE was used in respect of such DVDs. In the absence of any corroboratory evidence, I am unable to reach the conclusion that there has been genuine use in respect of these goods during the relevant periods.

69) Mr Haxell makes no comment in respect of *magnetic data carriers; audio tapes; recording discs; digital and other electronic recordings; sound recordings; computer discs; recording discs for visual images and sound; computers*. Consequently, other than where I have already found use (namely, *video recordings* that would be covered by the broader term *digital and other electronic recordings*), I conclude that there is no use shown.

70) In summary, the registration survives in respect of:

[...] *Video recordings; [...]; all relating to the provision of advice and counselling services in the field of inter-personal relations and excluding telecommunication goods and telephone handsets*.

71) The registration is revoked from the earliest date claimed, namely 2 March 2009, in respect of all the other Class 9 goods.

### **Earlier Marks 1543543 and 1543544**

72) The respective specifications of these registrations are as follows:

**Class 41:** *Educational and training services, all relating to advice and to counselling in the field of inter-personal relations; all included in Class 41.*

**Class 42:** *Counselling services; provision of advice and guidance regarding inter-personal relationships; all included in Class 42.*

73) It is self-evident from the evidence provided by Mr Haxell that Relate has used its mark RELATE in respect of all these services. These are the core services provided by Relate and its federated members and it has clear that it has provided these services, uninterrupted, for many years.

74) In summary, I find that Relate has used its mark in respect of all of these services.

### **Opposition to application 3044854**

#### **The objections under sections 5(1), 5(2)(a) and (2)(b)**

75) In respect of these grounds, Relate only relies upon its earlier mark 2360664A RELATE, insofar as it covers *clothing*. Following my conclusions regarding genuine use, this earlier mark is revoked in respect of these goods (See paragraph 48 – 50 and 60, above). As a consequence, Relate can no longer rely upon this earlier mark for the purposes of its case based upon Sections 5(1), 5(2)(a) and Section 5(2)(b).

76) In conclusion, Relate's opposition to 3044854 based upon Sections 5(1), 5(2)(a) and 5(2)(b) fails in its entirety.

#### **The objection under Section 5(3)**

77) Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

78) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.



- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.
- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.
- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or

similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

### Reputation

79) 'Reputation' for the purposes of Section 5(3) means that the earlier mark is known by a significant part of the public concerned with the products or services covered by that mark (paragraph 26 of the CJEU's judgment in *General Motors Corp v Yplon SA (CHEVY)* [1999] ETMR 122 and [2000] RPC 572).

80) Relate's evidence demonstrates that it has a strong and long standing presence in the UK in the field of counselling, advice and guidance relating to personal relationships. Optim have not expressly conceded this point, but it is clear from Relate's evidence that it enjoys a substantial reputation in this field as well as education and training services in the same field. In light of this evidence, I find that, for the purposes of its case based upon Section 5(3), it may rely upon the earlier marks 1543543 RELATE and 1543544 RELATE respectively, in respect of the following lists of services:

**Class 41:** *Educational and training services, all relating to advice and to counselling in the field of inter-personal relations; all included in Class 41.*

**Class 42:** *Counselling services; provision of advice and guidance regarding inter-personal relationships*

81) Relate also relies upon its earlier mark 2483809 "Relate" which, following my consideration of genuine use, is restricted to the following goods:

**Class 9:** *Video recordings; all relating to the provision of advice and counselling services in the field of inter-personal relations and excluding telecommunication goods and telephone handsets.*

82) Such goods are provided as part of the delivery of its core services listed in paragraph 80, though the level of reputation in respect of such goods is not shown as being as great as that for its core services. However, even if the level of reputation in respect of these goods was on a par with that attached to its core services, it is my view that this would not materially improve Relate's case. Therefore, for the purposes of these grounds, I will consider the issues from the perspective that Relate has a reputation in respect of its core services listed in paragraph 80, above.

### Link

83) Having established the existence and scope of a reputation, I need to go on to consider the existence of the necessary link. I am mindful of the comments of the CJEU in *Intel* that it is sufficient for the later trade mark to bring the earlier trade mark with a reputation to mind for the link, within the meaning of *Adidas-Salomon and Adidas Benelux*, to be established. The CJEU also set out the factors to take into account when considering if the necessary link exists:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42. Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.”

84) In Case C-408/01, *Adidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

85) The respective marks are shown below:

<b>Relate’s earier marks</b>	<b>Optim’s mark</b>
RELATE	RELATED
and	
Relate	

86) Both parties’ marks consist of single words and it, therefore, follows that it is those single words that are the dominant and distinctive component of the respective marks. One of Relate’s marks is in uppercase and the other in lower case with a capital first letter. These differences are not relevant because a word only mark is

considered to cover representations of the word in any common typeface and in both lower and uppercase.

87) Visually, the respective marks are similar because they differ only by one letter being the letter “D” at the end of Optim’s mark. There is a good deal of visual similarity. Aurally, they are also similar, one expressed as the two syllables RE-LATE, the other as the three syllables RE-LATE-ED. There is also a good deal of aural similarity. Relate’s marks consist of the verb meaning “to make or show a connection between”<sup>1</sup> whereas Optim’s mark consists of the adjective that has its root in the same verb. Consequently, the marks also share a good deal of conceptual similarity.

88) The respective goods and services are as follows:

<b>Services relied upon by Relate</b>	<b>Optim’s goods</b>
<p><b>Class 41:</b> <i>Educational and training services, all relating to advice and to counselling in the field of inter-personal relations; all included in Class 41.</i></p> <p><b>Class 42:</b> <i>Counselling services; provision of advice and guidance regarding inter-personal relationships</i></p>	<p><b>Class 25:</b> <i>Clothing</i></p>

89) When considering the respective natures, intended purpose, methods of use, trade channels and whether the respective goods and services are in competition or are complementary (in the sense that one is essential or important for the other), there is no obvious similarity. I find that the respective goods and services are dissimilar. Such a finding is not fatal to a case based upon Section 5(3), but it is a factor that I must keep in mind.

90) Relate has a strong reputation in its field, namely, the field of providing advice, counselling, education and training relating to personal relationships. The degree of inherent distinctive character of Relate's mark is no more than reasonable because it is an ordinary dictionary word that is readily understood by its consumers and, further, it is a word that has some allusion towards the services that it provides. However, this inherent level of distinctive character is enhanced because of the use made of it and the strong reputation enjoyed by Relate.

91) Factoring all of these findings together, whilst accepting that there is a good deal of similarity between the marks there is, nevertheless, a difference. This difference, combined with the fact that the parties are in unrelated areas (with the respective goods and services being dissimilar) counteracts the similarity in the marks to the extent that the requisite link does not exist. The relevant consumer of Relate's services, upon seeing Optim's Mark used in respect of clothing will not make any connection, or even bring to mind Relate's mark.

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<sup>1</sup> Oxford Reference at <http://www.oxfordreference.com/search?q=relate&searchBtn=Search&isQuickSearch=true>

92) As the requisite link does not exist, use of Optim's mark cannot result in any detriment to, or unfair advantage of Relate's mark and Relate's case based upon Section 5(3) of the Act fails in its entirety.

## **Summary**

### ***Application 500644 for revocation of Relate's mark 2360664A RELATE***

93) This mark survives the application for revocation only in respect of:

**Class 16:** *Books; newsletters; [...]; [...]; business cards; stationery; diaries; [...]; instruction and teaching materials; Christmas cards; training materials including overhead projection transparencies*

**Class 26:** *Lapel pins made from all materials excluding precious metals and their alloys*

**Class 35:** *[...] business administration*

**Class 36:** *Draw-down funding; and charitable fundraising*

94) The term *charitable fundraising* in Class 36 is also retained because it was not subject to any challenge.

95) In respect of all goods and services not listed in the preceding paragraph, it is revoked from the earliest date claimed, namely 2 March 2009.

### ***Application 500643 for revocation of Relate's mark 2483809 Relate***

96) This mark survives the application for revocation only in respect of:

*[...] Video recordings; [...]; all relating to the provision of advice and counselling services in the field of inter-personal relations and excluding telecommunication goods and telephone handsets.*

97) The registration is revoked from the earliest date claimed, namely 2 March 2009, in respect of all the other Class 9 goods.

### ***Opposition 402647 against application 3044854 Related***

98) The opposition fails in its entirety.

## **COSTS**

99) Both parties have achieved a measure of success in the two revocation actions and consequently, I find that the parties should bear their own costs in respect of these proceedings.

100) Relate has been unsuccessful in its opposition and Optim is therefore entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. Therefore, I make an award of costs only in respect of the opposition proceedings. I take account that both sides filed evidence but that no hearing took place. I award costs as follows:

Preparing a statement and considering the counterstatement	£300
Application fee	£200
Preparing evidence and considering other side's evidence	£500
<b>Total:</b>	<b>£1000</b>

101) I order Relate to pay Optim Management Limited the sum of £1000 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

**Dated this 8th day of December 2015**

**Mark Bryant  
For the Registrar,**