

**O-607-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3115866 BY  
MOHAMMAD NILFOROUSHAN**

**TO REGISTER THE TRADE MARK:**

**5 OCEANS**

**IN CLASS 29**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 405415  
BY THREE OCEANS FISH COMPANY LTD**

## **Background and pleadings**

1. On 1 July 2015, Mohammad Nilforoushan (“the applicant”) applied to register the trade mark **5 OCEANS** for the following goods:

Class 29     Tuna; canned tuna; pouched tuna.

2. The application was published for opposition purposes on 7 August 2015. It is opposed by Three Oceans Fish Company Ltd (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application.

3. The opponent relies upon its UK trade mark registration no. 2539201 for the trade mark shown below:



The mark was applied for on 15 February 2010 and its registration procedure was completed on 16 July 2010.

4. Given its date of filing, the opponent’s mark qualifies as an earlier mark in accordance with section 6 of the Act. The mark is registered for a range of goods in classes 29 and 30. For the purposes of this opposition, the opponent relies upon the following goods:

Class 29     Fish; frozen fish.

5. The opponent states in its Notice of Opposition that it has used its mark in relation to all of the goods relied upon. This statement is made because the earlier mark is subject to the proof of use provisions contained in section 6A of the Act. The opponent claims that there is a likelihood of confusion because:

“The word element of the opponent’s earlier mark relied upon is THREE OCEANS. This is visually, aurally and conceptually very similar to the mark applied for; 5 OCEANS. Given that the goods of the respective marks are identical or at least near identical, there exists a likelihood of confusion in the mind of the average consumer”.

6. The applicant filed a counterstatement in which he denies the basis of the opposition and puts the opponent to proof of the use of the earlier mark. The applicant claims that:

“6. [...] based on a visual, conceptual, and phonetic comparison of the marks at issue, taking into account all relevant factors, and particularly when bearing in mind their distinctive and dominant elements, the Applicant’s Mark and the Opponent’s Mark are not similar, such that there is no likelihood of confusion between the two in the marketplace” (paragraph 6).

7. Both parties have been professionally represented throughout the proceedings, the applicant by Withers & Rogers LLP and the opponent by Bailey Walsh & Co LLP. Both parties filed evidence and submissions during the evidence rounds. Neither party asked to be heard. Only the opponent filed submissions in lieu of attendance at a hearing. Both parties seek an award of costs. I do not intend to summarise the parties’ submissions but will refer to them as appropriate. This decision is taken following a careful reading of the papers.

## Evidence

### *Opponent's evidence*

8. This consists of the witness statement of Philip Stephenson, with one exhibit, and the witness statement of Geoffrey Druce, accompanied by two exhibits.

### Mr Stephenson's evidence

9. Mr Stephenson is a trade mark attorney at Bailey Walsh & Co. LLP, the opponent's representatives.

10. Exhibit PS1 consists of archive web pages of the opponent's website, [www.3oceans.co.uk](http://www.3oceans.co.uk), taken from the internet archive WayBackMachine. The images show the website between 3 and 5 September 2013. A range of fish products are detailed in the images, from breaded fillets (p. 5) to "healthy nuggets" (p. 14). Some of the products are described as "freshly frozen" (p. 7) or there is a recommendation to "fry from partially defrosted" (p. 8). The earlier mark is shown at the top of each page in the following form:



11. Mr Stephenson states that each page shows an image of "shipping boxes bearing the opponent's earlier mark".<sup>1</sup> He also indicates that "Unfortunately the all the [sic] images on each page have not reproduced in their entirety, however on visiting the web archive all images are readily apparent". I have no reason to doubt the truth of what Mr Stephenson says. I note that packaging on which at least the device element of the mark is visible is shown at p. 4 and that what appears to be the same packaging is shown on each of the other web pages.

---

<sup>1</sup> Paragraph 3.

## Mr Druce's evidence

12. Mr Druce is the director of the opponent. He states that the opponent has been using its trade mark since “around late 2002”.

13. Exhibit GD1 are pages from a catalogue entitled “HOPWELLS: The Caterer's Choice for frozen foods”. At the bottom of the cover page, the document is described as the “Spring & Summer 2014 Frozen Food Catalogue” (p. 4). Mr Druce explains that Hopwells is “one of our national UK distributors”. At p. 6, minimum order values are given in pounds sterling and, at pp. 11 and 19, details of offices in six UK cities. There is a map at p. 19 which shows the areas in England covered by each office. The opponent's mark is visible in an advertisement for fish fillets at p. 11, in the form shown below:



14. There is another image of the mark, also repeated at p. 13, where the fish device and “THREE OCEANS” are shown in white on a dark background, surrounded by a rectangular black border. The reproduction is poor but it is shown below:



Underneath the opponent's mark, a variety of fish fillets are offered for sale.

15. Exhibit GD2 shows pages from the “Autumn & Winter 2014-2015 Frozen Food Catalogue” (p. 21) of the same distributor. It shows the same minimum order values and UK distribution as exhibit GD1 (p. 23 and pp. 28 and 37, respectively). At p. 28 the same advertisement is shown, where the mark is visible as at paragraph 13, above. At pp. 30 and 32, the mark shown at paragraph 14, above, can be seen, with various fish fillets listed underneath.

### *Applicant's evidence*

16. This consists of the witness statement of Tania Clark. Ms Clark is a trade mark attorney at Withers & Rogers LLP, the applicant's representatives.

17. At exhibit TC1, Ms Clark exhibits web prints from [www.amazon.co.uk](http://www.amazon.co.uk). It shows a range of emergency food and water products on sale under the mark "Seven Oceans". The stated purpose of the exhibit is to show that "an entity is trading in the food sector under the name SEVEN OCEANS". Ms Clark does not say why she thinks this is relevant to the present proceedings and it is not clear how this evidence assists the applicant.

### **Decision**

18. The opposition is based upon Section 5(2)(b) of the Act, which reads as follows:

"5 (2) A trade mark shall not be registered if because -

(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".

### *Proof of use*

19. The relevant statutory provisions are as follows:

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

6A- (1) This section applies where -

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes -

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

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

(5) In relation to a 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”.

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

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

21. According to section 6A of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the mark applied for. The relevant period is, therefore, 8 August 2010 to 7 August 2015.

22. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. What constitutes genuine use has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (“*London Taxi*”), Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the



Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(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]; *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]”.

23. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed 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” is, therefore, not genuine use.

### Form of the mark

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

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)" [my emphasis].

25. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under s.46(2) of the Act as follows:

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

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

26. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

27. The mark as appears in three different forms in the opponent's evidence. The first is:



28. The only difference between this form of the mark and the mark as registered is that the device and word elements are arranged side by side rather than one above the other. There are no other differences in presentation and no additions or omissions which might have an effect on the distinctive character of the mark. I consider that the use shown above is acceptable in terms of fair and notional use of the mark. If that is not right, I consider that it is use of the mark in a form which does not alter the distinctive character of the mark, as outlined in *Nirvana*.

29. There is also use in the following form:



30. It is clear from the case law in *Colloseum*, cited above, that use in conjunction with other matter falls within the ambit of genuine use. That applies here. The words “always exceptional” are likely to be seen as descriptive of the quality of the goods and would be given no trade mark significance. I consider that the use shown is use of the mark as registered, upon which the holder may rely.

31. Finally, the mark is also used as shown below (the reproduction is poor but the words and device appear in white on a dark background):



32. The arrangement of the elements is the same as in the registered mark. It is not clear whether the shading of the fish in the mark as registered is reproduced in the variant form. For reasons which will become apparent, I intend to assume, without deciding, that this is also use of the mark in a form which does not alter the distinctive character of the registered mark.

#### Sufficient use?

33. The applicant has made a number of criticisms of the opponent's evidence, including: that the evidence is restricted to short periods in 2013 and 2014; that there is no evidence of web traffic or advertising regarding the opponent's website; and that there are no invoices or other evidence of actual sales under the mark.<sup>2</sup>

34. In respect of its evidence of use, the opponent submits that:

“4. [...] use on a website in relation to the goods in question is clearly commercial use and not token use. Although web traffic data is not available concerning the relevant period, a professionally produced website showing the mark concerned and the goods concerned demonstrates exploitation of the mark for commercial purposes.

5. In addition, the Applicant has challenged the evidence of use shown in the distributor's catalogues, submitting that the evidence does not amount to “continuous use in the relevant period”, however this is not the requirement for demonstrating earlier use. As acknowledged in the Applicant's

---

<sup>2</sup> Submissions, paragraphs 10 and 14.

submissions, there is no de minimis principle concerning trade mark use. The Opponent has merely been efficient and economical in selecting the evidence which clearly demonstrates commercial use in the fewest pages.

6. It is submitted that whilst the evidence of use is not voluminous, it is sufficient to show commercial trade mark use [...]”.<sup>3</sup>

35. In *Awareness Limited v Plymouth City Council*, Case BL O/230/13, Mr Daniel Alexander, Q.C., sitting as the Appointed Person, stated that:

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public”.

36. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition actions. He stated:

---

<sup>3</sup> Submissions dated 21 November 2016.

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round- or lose it”” [original emphasis].

37. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of



evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use”.

38. 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”.

39. The opponent’s evidence consists of 11 web pages from the opponent’s website in September 2013 and two catalogues from a distributor of the opponent’s goods in 2014. I do not overlook that each page from the opponent’s website bears a copyright date of 2012, which suggests that the mark was in use on the website from 2012, or that pack prices in the catalogues suggest that the goods were genuinely offered for sale. As no particular documents are required in order to establish genuine use, the lack of invoices is not fatal to the opponent’s case. Mr Druce, as Director of the opponent, ought to be in a position to give reasonably detailed information regarding matters such as turnover and advertising spend. However, he has not provided any information about, for example, the volume of sales under the mark, the size of the opponent’s business or its share of the market. Nowhere in the opponent’s evidence are there details of any actual sales, whether to a distributor, other intermediary or end consumers.

40. I acknowledge that preparations to secure customers can constitute genuine use and that an advertisement appears in the catalogues covering 2014 exhibited at GD1 and GD2. There is evidence in the same catalogues that fish was available from the distributor under the opponent's mark (or an acceptable variant of it). However, there is no evidence of any other marketing exercises, such as advertising campaigns in other publications, meetings with potential customers (or distributors), or attendance at trade events. Mr Druce's evidence shows that the distributor covers a substantial area of the UK but there is no evidence of the method or scale of distribution of its catalogues.

41. I have no information regarding the size of the relevant market but it is reasonable to assume that the market for fish and frozen fish in the UK is substantial. There is no evidence at all of any sales made by the opponent under the mark. Even though the opponent has used the mark on its website, there is, as the applicant points out, nothing to indicate whether or how potential customers were encouraged to visit that website and there is no evidence showing web traffic data relating to the site. I acknowledge the opponent's submission that web traffic data is not available for the relevant period. However, there is no other information in the opponent's evidence to explain, for example, whether any sales were made through the website or whether any enquiries from potential customers were generated through the site. I take the view that the evidence, considered as a whole, is insufficient to establish that there has been real commercial exploitation of the mark which is warranted in the sector concerned. I find that the use as shown cannot be considered genuine use in relation to the goods upon which the opponent relies.

## **Conclusion**

42. The opponent has failed to establish genuine use of its earlier mark within the relevant period. The opposition falls at the first hurdle and is dismissed accordingly.


## Costs

43. As the applicant has been successful it is entitled to a contribution towards its costs. Both parties filed evidence. The applicant's evidence was, however, of no assistance and I make no award in respect of it. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 4 of 2007. Using that TPN as a guide but bearing in mind my comments, above, I award costs to the applicant on the following basis:

Considering the notice of opposition and filing a counterstatement:	£200
Considering the other side's evidence:	£250
Written submissions:	£300
Total:	£750

44. I order Three Oceans Fish Company Ltd to pay Mohammad Nilforoushan the sum of **£750**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 20<sup>th</sup> day of December 2016**



**Heather Harrison  
For the Registrar  
The Comptroller-General**