

O/588/17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 1 363 034:  
SPEEDBIRD IN THE NAME OF BRITISH AIRWAYS PLC

AND

IN THE MATTER OF AN APPLICATION FOR REVOCATION BY  
MICHAEL GLEISSNER

## Background and pleadings

1. British Airways Plc (BA) is the registered proprietor of trade mark registration No 1 363 034 consisting of SPEEDBIRD. The trade mark was filed on 8<sup>th</sup> November 1988 and completed its registration procedure on 20<sup>th</sup> July 1990. It is registered in respect of the following services in Class 39:

*Air travel services; airline services; aircraft chartering; transport of passengers and cargo by air; transportation and delivery of goods by air and by road; travel agency and booking services; organising and arranging holidays, tours, cruises and travel; car hire; tourist information services; all included in Class 39.*

2. Michael Gleissner seeks revocation of the trade mark registration on the grounds of non use based upon Section 46(1)(a) and (b) of the Trade Marks Act 1994. BA filed a counterstatement denying the claim.
3. Revocation is sought under Section 46(1)(a) in respect of the 5 year time period following the date of completion of the registration procedure, namely 21<sup>st</sup> July 1990 to 20<sup>th</sup> July 1995. Revocation is therefore sought from 21<sup>st</sup> July 1995. Revocation is also sought under Section 46(1)(b) in respect of the time period 5<sup>th</sup> September 2011 to 4<sup>th</sup> September 2016. Revocation is therefore sought from 5<sup>th</sup> September 2016.
4. Only the registered proprietor filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision.
5. A Hearing took place on 10<sup>th</sup> October 2017 with BA represented by Mr Pendered of Maucher Jenkins, the RP's trade mark attorney. The applicant for

revocation, Michael Gleissner represented himself alongside his colleague, Mr Afean Samad.

## Legislation

6. Section 46(1) of the Act states that:

“The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c).....  
.....

(d).....

(2) For the purpose of subsection (1) 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 use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

6. Section 100 is also relevant, which reads:

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

what use has been made of it.”

## **BA's evidence**

7. This is a witness statement, dated 25<sup>th</sup> January 2017, from Christopher Brown, a Brand Executive of BA. He explains that SPEEDBIRD has been BA's call sign for over 50 years. This is an identifying name that pilot crews and flight operators use in their communications with airport authorities, control towers and ground crews. Exhibit CB1 is an extract from an air industry website referencing airline call signs, including SPEEDBIRD for BA. Exhibit CB2 is an article from the national press (The Daily Mail), dated 2015 referencing call signs and confirming the call sign SPEEDBIRD of BA.
8. Mr Brown explains that SPEEDBIRD has been used in the UK between 2011 and 2016 in respect of all the services of the registration. According to Mr Brown, SPPEEDBIRD is used by BA as the name of its dedicated team and website for travel agents and other third party sellers of BA's flights and holiday products. The SPEEDBIRD CLUB has its own website at [www.speedbird.com](http://www.speedbird.com), which is accessible by members with an IATA number. The website contains information on travel, tours and flights and includes servicing for these bookings. Exhibit CB3 shows sample extracts from this website. It is noted that the extract provided is dated 2017, so after the relevant date in these proceedings, though previous years are listed on the left hand side of the page. The pages provided appear to be in respect of travel news. There are tabs at the top of the page: reservations and tracking, products and services, news and offers, airline alliances and partners and my sbc. A “Frequently asked questions” page is also exhibited.
9. Passenger numbers are provided for the years 2011-2016. These are around 36,000 – 39,000 per annum.

10. In assessing whether or not there has been genuine use in these proceedings, I bear in mind the following: *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, 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 Kameradschaft '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].”

## Conclusion – Non use

11. It is considered that the evidence of use filed by BA suffers from serious defects. There is, for example, no evidence of advertising and marketing activities. The evidence regarding the SPEEDBIRD call sign does not assist BA. This is clearly use as a nickname or moniker during the flight process and between airport professionals. It is not use 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 (see paragraph 3 of the guidance above).

12. In relation to the services for which SPEEDBIRD is registered, there is one extract from a website called the SPEEDBIRD CLUB. However, it is uncertain as to whether this evidence is from within the relevant period. Further, it is unclear as to the services being offered and precisely who they are being offered to. At its high point, it appears to be some kind of travel information, with a frequently asked question section, though this is far from clear. Passenger numbers are included in the witness statement of Mr Brown. However, these are not clearly linked to services provided under SPEEDBIRD and are not corroborated anywhere in the evidence. This is the sum of the evidence filed.

13. I also take into account the following:

*In Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use.....  
However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as



insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

14. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial*

*Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat);  
[2008] R.P.C. 35:

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

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

15. Bearing in mind all of the aforesaid, it is considered that the evidence filed raises more questions than answers due to the defects already outlined above. It is impossible to gauge from the information before the Tribunal the

nature and extent of use of SPEEDBIRD and it is clear that BA could easily have done more in its selection of evidence filed. As such, I conclude that the application for revocation succeeds in its entirety.

## **COSTS**

16. Though not consolidated due to the differing attacked trade marks, these proceedings have travelled with 7 other cases between the same parties. Further, they were all heard at a single oral Hearing. For ease of reference, the respective costs awards in respect of all 8 cases will be detailed under separate cover. It should be noted that the substantive appeal period for all 8 cases will run from the date of the subsequent costs decision.

**Dated this 22<sup>nd</sup> day of November 2017**

**Louise White**

**For the Registrar,  
The Comptroller-General**