

O/592/17

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 2 047 538:
BUSINESS LIFE 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 (RP) of trade mark registration No 2 047 538 consisting of BUSINESS LIFE. The trade mark was filed on 5th December 1995 and completed its registration procedure on 28th November 1997. It is registered in respect of the following goods in Class 16:

In-flight magazines, all relating to business and financial affairs.

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 29th November 1997 to 28th November 2002. Revocation is therefore sought from 29th November 2002. Revocation is also sought under Section 46(1)(b) in respect of the time period 5th September 2011 to 4th September 2016. Revocation is therefore sought from 5th 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 10th October 2017 with the RP 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.”

7. 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

8. This is a witness statement, dated 25th January 2017, from Christopher Brown, a Brand Executive of BA. Mr Brown explains that the mark BUSINESS LIFE has been in continuous use in the UK from the period 5th September 2011 to 4th September 2016 in relation to the goods covered by the registration. He goes on to explain the following:

- The BUSINESS LIFE publication is the title of one of BA's in-flight magazines and is available to passengers on board all BA's flights into and out of the UK from Europe and in BA's airport lounges. Exhibit CB1 is a media sales pack with details of the BUSINESS LIFE magazine.
- The magazine is produced in 10 issues per year and had a print circulation of over 1,000,000 for each of the years 2012 to 2016 inclusive. Exhibit CB2 is a bundle of sample front covers of the magazine, all of which appear to date between 2012-2016.
- The magazine is provided free of charge to passengers. However, it generates significant income for BA through sales of advertising space. These are as follows: 2012 - £850,000; 2013 - £750,000; 2014 - £900,000 and 2015 - £870,000.
- The magazine has been recognised in the media sector. Exhibit CB3 is a profile of the magazine by the Content Marketing Association.

9. In considering whether or not there has been genuine use, I take into account the following guidance:

In *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 Bunderversvereinigung 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].”

10. The evidence is clear as to scale, duration and frequency of use. Revenue figures (from advertising sales) are provided. Numerous sample covers of the magazines (all of which are dated within the later relevant period) are provided. The magazine has also been profiled by a third party publication. It is considered that BA has clearly made genuine use of its mark BUSINESS LIFE and in respect of the Class 16 goods for which it is registered.

Conclusion – Non use

11. In conclusion, the application for revocation fails in its entirety. As such, BA is successful.

COSTS

12. 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 22nd day of November 2017

Louise White

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