

O-574-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3224537
BY DISCOVER THE BLUEDOT LIMITED TO REGISTER:**

BLUEDOT

AS A TRADE MARK IN CLASSES 9, 16, 25, 35 AND 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 409829 BY DOUGLAS & GRAHAME LIMITED**

Background & Pleadings

1. On 12 April 2017, Discover The Bluedot Limited (“the applicant”) applied to register the above trade mark in classes 9, 16, 25, 35 and 41. The application was published for opposition purposes on 21 April 2017.

2. On 20 July 2017, the application was opposed by Douglas & Grahame Limited (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“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.”

3. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

4. The opposition is directed against all goods in class 25, namely:

Articles of outerwear, ski wear, ski jackets, jackets, waterproof and weatherproof jackets, waterproof clothing, coats, waterproof and weatherproof coats; clothing namely, shirts, T-shirts, shirts, polo shirts, rugby shirts, sports shirts, shorts, sports shorts, leisurewear, sweatshirts, sweatpants, sweat shorts, sweat suits, jogging suits, hoodies, tracksuits, jerseys, jumpers, sweaters, smocks, cardigans, pullovers, waistcoats, wraps, shawls, sleepwear nightwear, pyjamas, pyjama sets, nightdresses, bathrobes, socks and hosiery, stockings, tights, swimwear, beach cover-ups, towelling dress, beachwear, bikinis, swimming costumes; bathing caps; scarves, belts (being articles of clothing), gloves, mittens, aprons, footwear, namely, boots, shoes, slippers, sandals, trainers, running shoes, beach shoes; headgear, namely, hats, caps, baseball caps, berets, earmuffs, visors, bandanas, beanies.

5. The opponent relies upon the following trade marks and all goods for which they are registered:

	Filing date:	Registration date:	Goods relied on:
United Kingdom Trade Mark ("UKTM") 224555B: BLUE DOT	4 September 2000	6 April 2001	Class 25: Articles of outerclothing, headgear and footwear.
UKTM 2244555A: 	4 September 2000	6 April 2001	Class 25: Articles of outerclothing, headgear and footwear.
European Trade Mark ("EUTM") 2090611: BLUE DOT	16 February 2001	17 January 2002	Class 25: Articles of outerclothing, headgear and footwear.

6. Each of the opponent's trade marks qualifies as an earlier trade mark under the provisions outlined above. In accordance with section 6A of the Act, each is subject to the proof of use provisions, having completed its registration procedure more than five years prior to the publication date of the applicant's mark. In its Notice of Opposition, the opponent indicated that it had used each of its earlier trade marks in respect of all goods relied upon.

7. In its Notice of Opposition, the opponent states:

“The subject application is for an aurally and conceptually identical mark and a visually similar mark. The subject application covers some identical goods and some very similar goods in Class 25. The Opponent contends that there is therefore likelihood that relevant confusion will be caused.”

8. The applicant defended its application by filing a counterstatement. While it did not comment specifically on the pleadings within its counterstatement, it did request that the opponent provide proof of use of the earlier marks.

9. The applicant in these proceedings is represented by Lewis Silkin LLP and the opponent is represented by Ansons. Both parties filed evidence during the evidence rounds; only the applicant filed written submissions in lieu of attendance at a hearing. This decision is taken following a careful reading of all the papers which I will refer to, as necessary.

Proof of use

10. The first issue is to establish whether, or to what extent, the opponent has shown genuine use of the earlier marks. 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”.

11. Section 100 of the Act also applies, 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”.

12. 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:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch); [2013] F.S.R. 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G&D Restaurant Associates Ltd (SANT AMBROEUS Trade Mark)* [2010] R.P.C. 28 at [42] of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV (C-40/01)* [EU:C:2003:145]; [2003] E.T.M.R. 85 , *La Mer Technology Inc v Laboratories Goemar SA (C-259/02)* [EU:C:2004:50]; [2004] E.T.M.R. 47 and *Silberquelle GmbH v Maselli-Strickmode GmbH (C495/07)*[EU:C:2009:10]; [2009] E.T.M.R.28 (to which I added references to *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-416/04 P)* [EU:C:2006:310]). I also referred at [52] to the judgment of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV(C149/11)* EU:C:2012:816; [2013] E.T.M.R. 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-141/13 P)* EU:C:2014:2089 and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd (O/528/15)* [2016] E.T.M.R. 8.

218. [...]

219. 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].”

13. 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.”

14. 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.”

15. As one of the opponent’s earlier marks is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are also relevant. The court noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

and

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

and

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to

establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

16. In *London Taxi*, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use

required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself

express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

17. The General Court restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

18. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods at issue in the Union during the relevant five year period.

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods for which use has been shown
- iv) The nature of those goods and the market(s) for them
- iv) The geographical extent of the use shown

19. For the purpose of these proceedings, the relevant period for the proof of use assessment is from 22 April 2012 until 21 April 2017.

Opponent's evidence

20. The opponent's evidence comprises two witness statements and supporting exhibits DF1 to DF3. The first witness statement is provided by Mr Donald Finlay, who is the opponent's managing director, and the second is from Mr Alan Jackson, a brand

consultant and graphic designer at Alan Jackson Designs. Both witness statements were filed on 4 December 2017, though I note that neither is dated; an irregularity which was not identified during the evidence rounds and, consequently, has not been properly rectified.

21. In opposition proceedings before the Tribunal, the evidential requirements follow those stipulated in Part 32 of the Civil Procedure Rules (“CPR”). I refer to the Practice Direction for guidance on what constitutes a valid witness statement. It states, *inter alia*, that witness statements must include the date the statement was made¹. It goes on to explain that where a witness statement does not comply with the direction in relation to its form, the court *may* refuse to admit it as evidence². In this case, I am not of the view that the irregularity affects the outcome of the decision and will therefore proceed on the basis that the evidence was filed correctly.

22. In his witness statement, Mr Finlay gives a brief overview of the use made of the opponent’s trade marks, explaining that they were used as part of the promotion of other brands within its portfolio. The opponent’s headquarters are located in Carrickfergus, Northern Ireland, and its premium showrooms are based in London and Manchester. Its retail outlets are under the name of REMUS UOMO, another of the opponent’s brands, and are located in Belfast, Glasgow, Galway and Ballymena. Mr Finlay provides annual sales figures from 2003 to 2008 (reproduced below), representative of “when the mark BLUEDOT was in use”³.

2003	£43,692.32
2004	£70,465.90
2005	£70,572.99
2006	£41,821.45
2007	£26,691.85
2008	£11,265.97

¹ Para. 17.2 (5)

² Para. 25.1

³ Para. 4 of Mr Finlay’s witness statement

23. Mr Finlay admits that use of the opponent's earlier marks ceased in 2008, stating specifically:

"5. While use of the BLUEDOT trade marks was not used for a number of years, a decision was made in January 2017 to put the mark back onto use.

In March 2017 Alan Jackson Design began working on artwork incorporating the BLUEDOT trade mark alongside other Douglas & Grahame Limited trade marks with the aim of commencing use in 2018 to use the BLUEDOT trade marks to promote certain items and ranges of clothing...

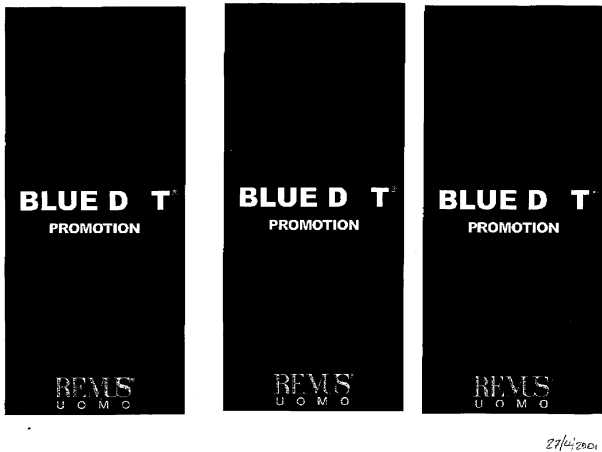
6. The reason we have not used 'Blue Dot' since 2008 is due to the economic recession when from 2008 until 2015 it was necessary to reduce certain resources of product and marketing ventures."

24. When reflecting on the above, I bear in mind that Form TM7 provides the opposing party, where applicable, an opportunity to state any proper reasons for non-use in respect of its earlier mark(s)⁴. The opponent did not provide any such reasons, having opted instead to provide a statement of use for each. As proper reasons for non-use must be specifically pleaded, any allusion to them made by the opponent cannot be formally considered within these proceedings. Nevertheless, in the interest of completeness, parties are advised that the economic recession alone would not constitute proper reasons in accordance with the relevant case law⁵.

25. Exhibit DF1 consists solely of what Mr Finlay refers to as sample labels of the BLUE DOT mark in use, of which there are three in total. The images are annotated '27/4/2001' and show UKTM 2244555A displayed in what appears to be a promotional capacity alongside REMUS UOMO, as shown below:

⁴ Question 3b, Section A, Form TM7 (Notice of opposition and statement of grounds)

⁵ Armin Häupl v Lidl Stiftung & Co. KG, Case C-246/05



26. Exhibit DF2 consists of 12 invoices; the earliest dated 10 November 2003 and the latest dated 27 August 2008. All appear to relate to deliveries made within Northern Ireland, though the addresses are largely redacted. The invoiced amounts range from £94.76 to £1770.00. On each of the invoices, at least one of the listed items is annotated “Blue Dot Promotion Line”. Examples of this are provided below:

Puccini Suit
Blue Dot Promotion Line

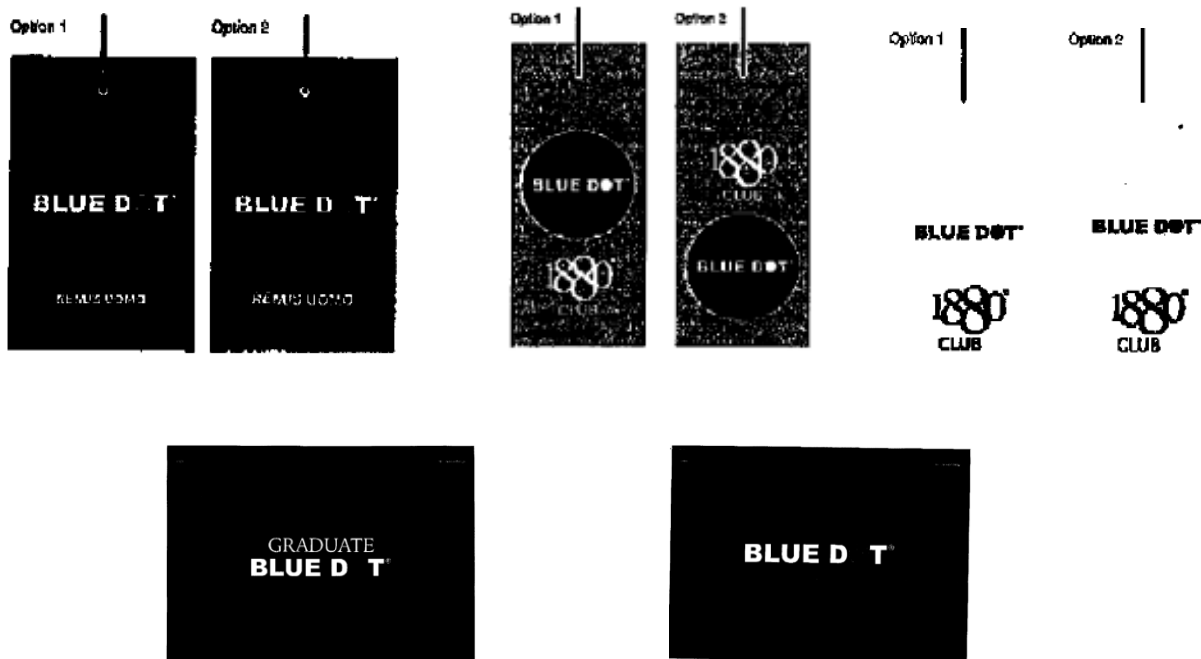
Roberto Suit
Blue Dot Promotion Line

27. In his witness statement, Mr Jackson states the following:

“2. Douglas & Grahame Limited contacted me in March 2017 to commission us to prepare artwork incorporating their BLUE DOT trade mark.

3. My understanding was that the mark BLUEDOT was to form a supporting role in the future marketing campaign for certain ranges of clothing.”

28. Exhibit DF3 comprises copies of the artwork produced by Alan Jackson Design on behalf of the opponent for the reasons explained above. Several examples are provided in which UKTM 2244555A (or a variation of) is displayed, both in combination with other trade marks belonging to the opponent, specifically REMUS UOMO, 1880 CLUB and GRADUATE, and in isolation. A sample is provided below:



29. Although Mr Finlay and Mr Jackson agree that the opponent contacted Alan Jackson Designs in March 2017, the samples provided at DF3 are not dated.

Applicant’s evidence and written submissions

30. The applicant filed a witness statement from Mr Ben David Robinson, a director of Discover the Bluedot Limited, which is dated 24 April 2018. The supporting evidence (“Exhibit BDR1”) comprises an assortment of archived websites bearing various dates ranging from 2014 to 2018. The websites concern the opponent’s company and associated brands and were seemingly filed for the purpose of establishing an absence of use during the relevant period. I have reviewed the applicant’s evidence and its written submissions in their entirety but do not find it necessary to summarise them here for reasons that will soon become apparent.

Decision

31. In reaching a decision, I find the following details to be of most significance:

- Mr Finlay admitted that use of the opponent's 'BLUE DOT' trade marks ceased in 2008 because of the economic recession.
- Consequently, none of the opponent's evidence of use is taken (or at least can be seen to have been taken) from within the relevant period.
- The opponent intended to relaunch its earlier marks in 2018. Even if I were to take the view that it is likely that the samples were produced as a result of the opponent's contact with Alan Jackson Designs in March 2017, this contact was made only a month prior to the relevant date, at the furthest extreme of the five year period in question.

32. Even if I was satisfied that this constituted preparations for recommencement of use, that use was not due to start until the year after the end of the relevant period. There has to be a balance between the proprietor's interest and the public interest in the register not being clogged with unused marks, which hinders other traders who are in a position to commercialise goods and services using the same or a similar mark, thereby harming commerce and innovation. If marks which their owners are not using because of unfavourable economic conditions were allowed to remain registered indefinitely, UK and international trade would be stifled by such register cluttering. Explaining the public interest behind the use provisions, Justice Jacob (as he then was) stated, in *La Mer* [2002] E.T.M.R. 34 (paragraph 19):

“There is an obvious strong public interest in unused trade marks not being retained on the registers of national trade mark offices. They simply clog up the register and constitute a pointless hazard or obstacle for later traders who are trying actually to trade with the same or similar marks. They are abandoned vessels in the shipping lanes of trade.”

33. Taking all findings into account, I conclude that the opponent has not properly discharged the onus upon it to demonstrate use of its earlier trade marks. In fact, it has acknowledged the cessation of their use. Consequently, it cannot rely upon its earlier trade marks in support of its claim under section 5(2)(b) of the Act. As this was the only ground of opposition, the opposition fails.

Outcome

34. The opposition has failed and, subject to any successful appeal, the application will proceed to registration in respect of all goods and services for which registration is sought.

Costs

35. As the applicant has been successful, it is entitled to a contribution toward its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the applicant on the following basis:

Preparing a counterstatement:	£200
Considering the other side’s evidence and preparing evidence:	£500
Written submissions:	£300
Total:	£1000

36. I order Douglas & Grahame Limited to pay Discover The Bluedot Limited the sum of £1000. 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 13th day of September 2018

**Laura Stephens
For the Registrar**