

O-024-19

TRADE MARKS ACT 1994

**IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. WO1078240
DESIGNATING THE UK
IN THE NAME OF WH SELFINVEST SA
FOR THE TRADE MARK**



**AND THE APPLICATION FOR CANCELLATION THEREOF
UNDER NO. CA501956
BY
BANQUE ET CAISSE D'EPARGNE DE L'ETAT, LUXEMBOURG**

Background & Pleadings

1. WH SELFINVEST SA (hereafter 'WHS') is the Registered Holder of the International Registration (hereafter 'IR') no. WO1078240 for the mark outlined on the title page. The mark was registered on 29 April 2011 and protected in the UK on 9 September 2011 in Class 36 for the following specification: *Securities brokerage; financial management of portfolios.*

2. Banque et Caisse D'Epargne de L'Etat, Luxembourg (hereafter 'Banque') seeks revocation of the registered mark, in full, on the grounds of non-use based on Section 46(1)(a) of the Trade Marks Act 1994 (hereafter 'the Act') in respect of the 5 year time period following the date of completion of the registration procedure, namely 10 September 2011 to 9 September 2016 (hereafter 'the relevant period'), with an effective revocation date of 10 September 2016.

3. WHS filed a counterstatement denying the claim and stating that the trade mark has been used since 2011 on the services as registered.

4. WHS are represented by Venner Shipley LLP in these proceedings and Banque by Office Freylinger SA. WHS filed evidence and both parties provided written submissions in lieu of a hearing. The evidence will be summarised to the extent that it is considered necessary and the submissions borne in mind. As no hearing was requested, this decision is taken following consideration of the papers before me.

WHS evidence

5. WHS filed a witness statement dated 31 May 2018 in the name of Pascal J. Hirtz, a director of WHS since 1998, and appended 25 exhibits. A particular point of information in the witness statement are the following turnover figures (in Euros) for services provided under the contested mark:

Period	Revenue (EUR)
Sept 10 2011 to 31 December 2011	3,362.18
Calendar year 2012	10,902.35
Calendar year 2013	10,930.27
Calendar year 2014	11,787.80
Calendar year 2015	14,168.89
Calendar year 2016	21,396.32
Calendar year 2017	40,363.59
1 to 4 January 2018	411.36

6. Exhibits PJH1 and 2 relate to press advertisements placed by WHS in the Financial Times newspaper in 2002 and an invoice dated February 2011 for an exhibition stand at a Traders Expo to be held in London in April 2011. However these exhibits are outside of the relevant period for these proceedings and as such are not relevant.

7. Exhibit PJH3 is a confirmation document showing that the domain name www.whselfinvest.co.uk is owned by WHS.

8. Exhibit PJH4 consists of screenshots of the WHS website www.whselfinvest.co.uk taken from the Wayback Machine Internet Archive. The screenshots are dated between October 2011 and March 2016 which is within the relevant period. The remaining screenshots dated 2017 are outside the relevant period. The IR is visible at the top of each screenshot and the website appears to be offering trading services.

9. Exhibit PHJ5 is a confirmation document showing that the domain name www.online-futures-trading.co.uk is owned by WHS. Exhibit PJH6 consists of screenshots of the website www.online-futures-trading.co.uk taken from the Wayback Machine Internet Archive. The screenshots are dated between November 2011 and May 2016. The remaining screenshots dated 2017 are outside the relevant period. The services offered by this website include futures trading under the mark **WHS FutureStation**. However, the contested IR is visible on this website, in a separate box graphic, and a word version of the mark **WH Selfinvest** appears as a hyperlink. Exhibit PJH7 consists of a Google analytics report regarding web traffic to

the website www.online-futures-trading.co.uk. The declarant states that there have been 11871 UK based unique visits to the website between September 2011-January 2018.

10. Exhibit PHJ8 is a confirmation document showing that the domain name www.whexpert.com is owned by WHS. Exhibit PJH9 consists of screenshots of the website www.whexpert.com taken from the Wayback Machine Internet Archive. The screenshots are dated between August 2012 – March 2016. The remaining screenshot dated 2017 is outside the relevant period. The contested IR is visible at the top of each screenshot and the website appears to be offering trading services for CDX (defined by the declarant as Contracts for Difference), Forex (defined by the declarant as Foreign Exchange) and futures. Exhibit PJH10 consists of a Google analytics report regarding web traffic to the website www.whexpert.com. The declarant states that there have been 14405 UK based unique visits to the website between September 2011-January 2018.

11. Exhibit PHJ11 is a confirmation document showing that the domain name www.best-trading-platforms.com is owned by WHS. Exhibit PJH12 consists of screenshots of this website taken from the Wayback Machine Internet Archive. The screenshots are all dated May 2017 which is outside the relevant period. The contested IR does not appear in the screenshots. Exhibit PJH13 consists of a Google analytics report regarding web traffic to the website www.best-trading-platforms.com. The declarant states that there have been 229 UK based unique visits to the website between December 2017-January 2018.

12. Exhibit PJH14 consists of screenshots from the WHS German and Dutch YouTube channels. The contested IR is not apparent although the word version of the mark is visible. Exhibit PJH15 consists of screenshots from the WHS English language YouTube channel which indicates that the content consists of many webinars/videos relating to WHS's trading platform. The contested IR appears in the top left of the screenshot. Exhibit PJH16 confirms that the WHS YouTube channel was established in April 2016, has 31 subscribers and has had 5032 views to date. From this I take to mean the date the screenshot was taken, presumably a

date at or around the date of the witness statement, ie May 2018. The contested IR appears on the top left of the screenshot.

13. Exhibit PJH17 consists of a Google analytics report regarding web traffic for the following 'AdWords', paid for by WHS at a total cost of €7000 between January 2010 and December 2017: '*future trading strategies*', '*futures trading signals*', '*trading the FTSE future*', '*no spread on Share CFDs*' and '*Online trading strategies*'. The declarant states that clicks on those AdWords directed browsers to WHS's website www.whexpert.com.

14. Exhibit PJH18 consists of a Google search, carried out on 9 March 2018, for the words **WH Selfinvest** which the declarant states will retrieve the first four hits which all relate to WHS.

15. Exhibit PJH19 consists of a screenshot from a UK based website, www.thearmchairtrader.com, announcing the results of a 2015 survey carried out by Investment Trends, who are stated to be an independent global financial services research company. WHS are named in the list for Germany's top CFD brokers in two categories. The word version of the mark is listed.

16. Exhibit PJH21 consists of a list of trading platforms which the declarant states is dated from 2014 although this date is not apparent to me from the exhibit. The word version of the mark is listed on page 5 as a provider of the **WHS ProStation** product.

17. Exhibit PJH22 consists of copies of a newsletter the declarant states were sent to 15 UK customers during the period September 2011 to January 2018. The contested mark appears in the newsletter masthead.

18. Exhibit PJH23 consists of approximately six redacted customer application forms for WHS services dated between 2016 and 2017. The available address details indicate a spread of locations throughout England. The contested mark appears at the top of each page.

19. Exhibit PJH24 consists of a customer account statement dated October 2017. The contested mark appears in the header of each page.

20. Exhibit PJH25 consists of WHS entries in various online brokerage directories. The screenshots are dated between January and March 2018. The contested IR is visible only in the Investmenttrends, Forexbrokerz and Forexbroker-check directories.

Legislation

21. 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.”

22. 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.”

The case law regarding genuine use

23. 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:

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].”

Decision

24. It is clear from the guidance given above that I must consider a number of factors when assessing whether genuine use of the mark has been shown from the evidence provided.

25. Banque has made a number of criticisms of the WHS evidence in its written submissions dated 1 October 2018. I will summarise the most salient points here. Firstly Banque has pointed out that it was not in receipt of the WHS evidence in a readable format until 27 July 2018 after the due date of 12 June 2018 owing to an administrative error in sending the evidence on the part of WHS's representatives Venner Shipley. It has therefore asked the Tribunal to reject the evidence. I note that the Tribunal wrote to Banque on 2 August confirming that the deadline for response to the evidence had been reset to 1 October 2018 to allow the fullest time period allowed for its consideration of the evidence. Banque accepted this deadline, did not raise any other concerns at that time and did not request to be heard on the matter. Taking this into account I do not see any reason to consider the matter further in this decision.

26. Secondly Banque has criticised the WHS evidence for failing to demonstrate use on the services for which the IR is registered in class 36. It claims that the exhibits relating to WHS's websites shows only use on navigating the trading platform (being software in classes 9 and 42) and demonstration/tutorial guides to trading (being class 41). Whilst I find there is some validity to this criticism on some of the exhibits such as PJH14, there is some evidence that WHS offers class 36 services to customers, notably in exhibits PJH4 and 9.

27. Thirdly, Banque have criticised the volume of unique visitors from the UK to the various WHS websites during the period 2011 to 2017 in relation to exhibits PJH 7 and 10. Banque submits that the numbers, namely 11871 and 14405 are very low over such a time period and when averaged out could mean less than 6 visitors per day. I agree with Banque that these visitor numbers are quantitatively low and moreover merely indicate that the websites www.online-futures-trading.co.uk

and www.whexpert.com were visited, not that the numbers of visitors set out above have purchased services under the IR.

28. Fourthly, Banque submits that WHS's use of Google AdWords (exhibit PJH17) does not show use of the mark but merely how the AdWords system is used to promote WHS's websites. In addition, Banque submits that the approximate cost of using Google AdWords, which WHS stated to be approximately €7000 between 2019 and 2017, works out at a very low figure per annum for advertising expenditure. WHS gave no other advertising expenditure figures other than that spent on the Google AdWords system. Absent any such information, I agree with Banque that it is a low sum to spend on advertising and promotion.

29. Lastly, Banque submits that the overall UK turnover figures provided by WHS in Mr Hirtz's witness statement are very low for the relevant time period. Turnover between 2012 – 2014 was stated as being between €10-12k per annum, rising to €14K in 2015 and €21K in 2016. I agree with Banque that in the context of the services *Securities brokerage; financial management of portfolios* (in a global financial market which must, by any reckoning, be vast) this turnover appears to be very low.

30. In drawing my conclusion in this decision I take into account the *London Taxi* criteria set out above, especially sub paragraph 6, and also the guidance set out in *Memory Opticians Ltd's Application*, BL O/528/15, where Professor Ruth Annand, as the Appointed Person, upheld the Hearing Officer's decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5 year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local from 3 branches of an optician. There was no advertising of goods under the mark, although the evidence indicated that they were only displayed in-store on occasions. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain market under the mark. Consequently, it was not genuine use.

31. Although there is some evidence of use of the IR for the registered services, I consider it to be insufficient. It demonstrates only very low levels of use of the contested mark in the UK, by having so few UK customers as evidenced by the 15 newsletters it sends out and the 7 customer applications in 2016-2017 for its services. There are no indications that the IR has been marketed in the UK other than tangentially by the use of the Google Adword system to promote the WHS websites. Moreover, the declared turnover generated by WHS under the contested mark is low for the market sector.

Outcome

32. The application for revocation on the grounds of non-use succeeds under sections 46(1)(a). Consequently, IR no. WO1078240 is revoked in its entirety under section 46(6)(b), the effective date of revocation being 10 September 2016.

Costs

33. As the applicant for cancellation has been successful, it is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs on the following basis:

£200 Application fee

£300 Preparing a statement and considering the counterstatement

£1000 Considering evidence and preparing submissions

£1500 Total

34. I order WH SELFINVEST SA to pay Banque et Caisse D'Epargne de L'Etat, Luxembourg the sum of £1500. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of January 2019

June Ralph

For the Registrar

The Comptroller-General