

O-613-17

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**APPLICATION NO 501581 BY
BURN CABLE MANAGEMENT SYSTEMS LIMITED
TO REVOKE THE TRADE MARK REGISTRATION NO 2568553**

BURN

OWNED BY ROYAL STEEL INDUSTRY CO., LTD

AND

THE APPLICATION FOR TRADE MARK NOS 3183678, 3180091 AND 3180100

BURN,

ROTHLEY

BURN

AND

ROTHLEY BURN

ROTHLEY BURN

(A SERIES OF TWO MARKS)

IN THE NAME OF BURN CABLE MANAGEMENT SYSTEMS LIMITED

AND THE OPPOSITIONS THERETO UNDER NOS. 408112, 408113 AND 408114

Background and pleadings

1. Trade mark registration number 2568553, for the mark BURN, is owned by Royal Steel Industry Co., Ltd (“the registered proprietor”). The mark was applied for on 10 January 2011 and it completed the registration procedure on 10 June 2011. It is registered for the following goods:

Class 6: *Metallic conduits and fittings thereof; all included in Class 6*

Class 9: *Electrical conduits and fittings; all included in Class 9.*

2. Burn Cable Management Systems Limited (“the applicant”) owns the following three trade mark applications, all in classes 6 and 9, essentially for conduits, ducting, cables and metal building materials:

BURN: filed on 2 September 2016

ROTHLEY

BURN: filed on 12 August 2016

ROTHLEY BURN



(a series of two) filed on 12 August 2016

3. The registered proprietor opposed all three applications on the basis that there is a likelihood of confusion with its earlier mark, BURN, under section 5(2)(b) of the Trade Marks Act (“the Act”)¹. The applicant applied to revoke the earlier mark for non-use, in addition to filing defences against the oppositions in which it denies the section 5(2)(b) ground and puts the registered proprietor to proof of genuine use of its mark.

¹ Grounds under sections 5(3) and 5(4)(a) were dropped close to the hearing.

4. The applicant claims, under section 46(1)(a) of the Act, that the earlier mark was not put to genuine use in the UK in the five years after it completed the registration procedure. This period runs from 11 June 2011 to 10 June 2016 with an effective date of revocation of 11 June 2016. The registered proprietor denies the ground.

5. The proceedings were consolidated. The registered proprietor filed evidence. The matter came to be heard by video conference on 3 October 2016, at which Mr Andrew Norris, of Counsel, appeared for the registered proprietor, instructed by CSY London. The applicant was represented by Ms Amanda Michaels, of Counsel, instructed by Trade Mark Wizards Limited.

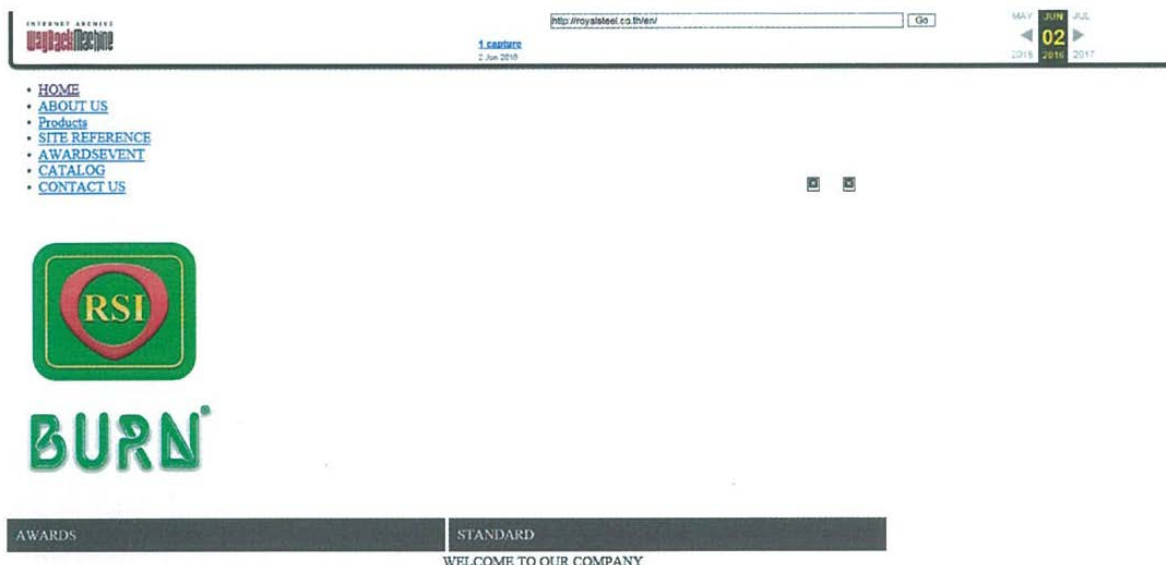
The registered proprietor's evidence

6. The evidence shows that the registered proprietor is a company based in Thailand. Its President, Mr Vitton Shevakittikul, has filed a witness statement, dated 15 June 2017, and exhibits.

7. Mr Shevakittikul states that the registered proprietor obtained its BURN brand and technological knowledge from a UK company called Rothley BURN, in 1996-7. The deal included the latter's BURN machinery which was shipped to the registered proprietor in 1997. From then on, the registered proprietor produced metallic and electrical conduits and their parts under the BURN mark. He states that the goods were distributed to Asia and to countries in the Middle East.

8. Mr Shevakittikul states that the BURN products have an annual turnover of £4,985,146.58 (this is a very precise figure, so I assume it was the current figure when Mr Shevakittikul made his statement). Exhibit VS2 comprises a single page which Mr Shevakittikul states is an extract from the registered proprietor's website royalsteel.co.th/en/, from the Internet Archive, the Wayback Machine. The extract shows a website page on 21 June 2016, with a stylised version of the word BURN and an RSI logo:

<https://web.archive.org/web/20160602113414/http://royalsteel.co.th/en/>



There are no product details or ordering details. Mr Shevakittikul states that the most recent edition of the website has operated since 2013. He provides a table showing the number of visits to the websites from the UK, but he does not state in which year. There were 127 visits from England, 9 from Scotland and 7 from Wales.

9. Mr Shevakittikul states that the registered proprietor first used BURN in relation to metallic and electrical conduits and fittings for such goods in the UK in 2016. Exhibit VS3 comprises a copy of a product catalogue which Mr Shevakittikul states has been available on the website since 2013. The pages show conduits and metal fittings, made to various ISO and BSI standards (certificates are shown on the first page). The penultimate page contains a summary of projects undertaken in United Arab Emirates, Singapore, Qatar, Lebanon, Oman and Iraq. Exhibit VS9 comprises further photographs of the products. Mr Shevakittikul states that these have been sold in the United Kingdom since 2016.

10. Mr Shevakittikul states that the registered proprietor's overall sales of BURN products in the UK for 2016 amounted to approximately US\$13,798.64. Exhibit VS10 contains three invoices and accompanying freight documents from the

registered proprietor to a London company, Tan Sales (London) Limited, dated 24 February 2016, 8 April 2016 and 14 October 2016. The amounts on the invoices are US\$7575.95, US\$5,501.50 and US\$721.19. The invoices state that the country of departure in all three cases is Thailand. The country of destination for the first two invoices is Hong Kong, whilst for the third it is the UK. Exhibit VS11 contains two emails dated 9 December and 30 December 2015. They are from 'Tan Sales':

exportsales@royalsteel.co.th

From: Jatin Asawla <Jatin.Asawla@tansales.co.uk>
Sent: Wednesday, December 09, 2015 9:07 PM
To: exportsales@royalsteel.co.th; info@royalsteel.co.th
Subject: Quotation request

Dear Sirs/Madam,

655 – 32 mm GI Galvanized Conduits.
280 – 32 mm GI Galvanized Couplers.
600 – 32 mm GI Galvanized Bends.
180 – 32mm 4 Way GI Galvanized Junction Box
1,965 – 32 mm GI Galvanized Sandal clips

Kind regards

Jatin Asawla

exportsales@royalsteel.co.th

From: Ramesh Shah <Ramesh.Shah@tansales.co.uk>
Sent: Wednesday, December 30, 2015 10:09 PM
To: exportsales@royalsteel.co.th
Cc: Jatin Asawla
Subject: burn conduit

Dear sir

We sent you an inquiry for export to Tanzania for the airport project but your dept has not come back with an offer nor a reply

Can you please advise by return if you will be quoting

Rgds

Ramesh shah

11. No response emails from the registered proprietor are exhibited.

12. Mr Shevakittikul states:

“My Company does not advertise its BURN products in the United Kingdom via traditional means, but the BURN trade mark is known to the industry in the United Kingdom as a result of my Company’s long standing presence and wide recognition in markets outside the United Kingdom, and in particular in Asia and in the Middle East.”

13. Mr Shevakittikul states that the registered proprietor takes part in industry events. He provides photographs of the registered proprietor’s exhibition stand at what he states to be the world’s largest electricity exhibition, Middle East Electricity in Dubai (Exhibit VS12). The photographs show a stylised version of the mark and date from 2010, which Mr Shevakittikul states was the first year of attendance. Exhibit VS14 comprises copies of cards left by visitors to the stand in 2011, three of which were from the UK.

14. Mr Shevakittikul refers to awards, giving examples in Exhibit VS15. It is not possible to read the writing on the trophies depicted, although Mr Shevakittikul states that one of them was an award from the Trade Leader’s Club in Paris, in 2008.

Revocation decision

15. If the applicant’s revocation action is successful, it will mean that the registered proprietor’s earlier mark cannot be relied upon to support its oppositions. I will, therefore, look firstly at the revocation action.

16. Section 46 of the Act states:

“(1) 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) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes 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 either 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.”

17. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 P *Sunrider Corp v Office for*

Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [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).

[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 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].”

18. The onus is on the proprietor to show use because Section 100 of the Act states:

“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.”

19. In *Plymouth Life Centre*, O/236/13 Mr Daniel Alexander QC, sitting as the appointed person, observed that:

“20. Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time to review the material that it has to prove use of it.

...

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.”

20. It is important to remember that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself². I also bear in mind that the genuine use provision is not there to assess economic success or large-scale commercial use³, and even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. An assessment as to whether there has been real commercial exploitation therefore includes consideration as to the nature of the goods or services and the characteristics of the market concerned.

21. The evidence is thin. The only direct evidence of sales is contained in the three invoices. The first two are dated in February and April of 2016, within four months and two months, respectively, of the end of the relevant period (which ended on 10 June 2016). The third invoice is dated in October 2016, after the relevant period. The first two invoices amount to approximately £13,000. All three invoices were raised in respect of a single customer in London; however, the goods shipped from Thailand in the case of the first two invoices were destined for Hong Kong. Indirect evidence of sales can be inferred from the product catalogue described in paragraph 9, specifically the page giving summaries of projects undertaken in various Asian and Middle Eastern countries, but not in the UK.

22. The majority of the proprietor’s evidence concerns its website. The only evidence showing that there may be an English language version of the website is a single page from the Wayback Machine. None of the links to the left of the page have been expanded or explained as to what the viewer would see if the links were clicked upon. The product catalogue has appeared on the website since 2013. This

² Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (“OHIM”) General Court (“GC”).

³ GC, Case T-334/01 *MFE Marienfelde GmbH v OHIM*.

is in English, but there is no evidence as to where on the website it was placed and, as English is the international language of trade, the catalogue does not prove genuine UK use without corroboration elsewhere of use in the UK.

23. *Starbucks (HK) & Anor v British Sky Broadcasting Group PLC & Ors* [2015] UKSC 31 and the decision of Professor Phillip Johnson, sitting as the Appointed Person, in *Johnny Rockets* (BL O/240/16) E.T.M.R. 37 both concerned territorial use of trade marks. The former case concerned goodwill and the latter case concerned genuine use. In *Starbucks*, the Supreme Court stated at paragraph 52:

“The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant. ..

24. In *Johnny Rockets*, Professor Johnson said:

“29. While the test for genuine use is different from that for establishing goodwill for the purposes of passing off, the central principle is the same. If customers buy services in the United Kingdom, which they enjoy outside the United Kingdom, such as hotel services, this might be use in the United Kingdom. This point seems to have been taken for granted by the Court of Appeal in *Thomson Holidays Ltd. v Norwegian Cruise Line Ltd* [2002] EWCA Civ 1828 (more recently, see the decision of the registrar in *Raffles*

(O/134/15) which is currently under appeal). Whether a dinner reservation made in the United Kingdom for a restaurant outside the United Kingdom is sufficient to be genuine use is more difficult. I am doubtful, for example, that a customer ringing from her home in London for a reservation at her favourite restaurant in New York would be sufficient in itself. What is clear is that however many thousands of British tourists visit a famous restaurant in New York, sales to those customers will never amount to use in the United Kingdom unless the particular commercial arrangement began in some way when the customer was in the United Kingdom.”

25. Mr Alexander QC, sitting as Deputy Judge in *Abanka DD v Abanca Corporacion Bancaria SA* [2017] EWHC 2428 (Ch) observed that “there is no fundamental problem in using these areas of law [passing-off and genuine use] to some degree as a cross-check on each other, given that they are serving broadly similar purposes” since, in *Starbucks*, Lord Neuberger had said:

"57. Indirect support for this approach is also to be found in decisions of the Court of Justice of the European Union, which has emphasised in a number of decisions the need for "genuine use" of a mark, namely "to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services", and that this means "real commercial exploitation of the mark in the course of trade, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating market share for the goods or services protected by the mark" – to quote from *Leno Marken BV v Hagelkruis Beheer BV* (Case C-149/11) [EU:C:2012:816](#), para 29. Further, it is relevant to note that the CJEU has also held that "the mere fact that a website [advertising or selling the product or service concerned] is accessible from the territory covered by the trade mark is not a sufficient basis for concluding that the offers for sale displayed there are targeted at consumers in that territory" – *L'Oreal SA v eBay International AG* (Case C-324/09) [EU:C:2011:474](#) [2011] [ECR I-6011](#), para 64."

26. I find that the business cards left at the registered proprietor's exhibition stall would not be sufficient to show goodwill because, as the Supreme Court said, "it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad". This is also not genuine use of the mark in the UK, simply because the visitors in Dubai were from the UK. Furthermore, there is no evidence that any purchase was made by the people who left their business cards at the Dubai exhibition.

27. I do not think it is necessarily fatal to the registered proprietor's case that the two invoices which fall within the relevant period related to goods which never entered the UK (they were shipped to Hong Kong from Thailand). It depends on whether the use was intended to create a market for the goods in the UK, in which case the relationship between Tan Sales (London) Limited and the destination, Hong Kong, is important to the assessment. Although the commercial papers (the invoices and freight details) were sent to a customer located in the United Kingdom (in London), there is no explanation about where the order was obtained. Were these sales to a UK business sourcing materials for overseas projects? Was the order obtained at a trade fair or exhibition outside of the UK? Why were the UK customer's goods sent to Hong Kong? There is no explanation given about the context. There is also the matter of substantiality of use; the fact that the sales took place right at the end of the relevant period; and that the sales were to a single customer.

28. Mr Shevakittikul states that the registered proprietor does not advertise its BURN products in the UK via traditional means, but that the mark is known to the UK industry because of its use outside the UK. He does not explain this further; but perhaps UK businesses working on overseas projects have come across the mark in the course of their work overseas. Again, the lack of advertising in the UK is not fatal to the registered proprietor's case but, viewed against the tiny website UK visitor numbers, the lack of UK-directed website content and that there has been only a single customer in the UK, it is suggestive of an overseas business which has not sought UK customers, but has nevertheless obtained one. In *Abanka*, Mr Alexander said this at [103]:

“Put colloquially, a proprietor should be treated as having used a mark in the UK if it has, itself "pushed" its business and mark into the UK, not if it has been "pulled" into the UK by (for example) its customers abroad, even though they may be based in the UK. That is the upshot of the case law on "direction" or "targeting" of a web-site to the UK cited above (see the summary of CJEU case-law in *Stichting DBO*). Quite what constitutes enough push of goods, services or advertising for them to the UK is not always easy to determine, especially in cases where a proprietor may be, in effect, a "pulled-pusher" in that, without having taken any active steps to develop the market in the UK, it nonetheless takes business from consumers based in the UK.”

29. The number of UK visitors to the website is stated to be 143 (England, Scotland and Wales). It is not clear whether this figure was from a particular year, or is a total figure for the years since 2013 (the most recent edition of the website dates from 2013). It is not specified whether the visits are from unique visitors, or whether they are the same visitors making several visits. Even if 143 people visited the website in a single year, the figure is tiny. The registered proprietor has taken business from a single customer based in the UK without evidence being shown that it had taken any active steps to develop the market in the UK. This, together with Mr Shevakittikul's statement that the mark is known to the UK industry because of its use outside the UK, supports the 'pull' theory.

30. In joined Cases C-585/08 and C-144/09, *Pammer v Reederei Karl Schlüter GmbH & Co. KG and Hotel Alpenhof GesmbH v Heller*, the CJEU interpreted the national court as asking, in essence, “*on the basis of what criteria a trader whose activity is presented on its website or on that of an intermediary can be considered to be 'directing' its activity to the Member State of the consumer's domicile ..., and second, whether the fact that those sites can be consulted on the internet is sufficient for that activity to be regarded as such*”. The court held that it was not sufficient for this purpose that a website was accessible from the consumer's Member State. Rather, “*the trader must have manifested its intention to establish commercial relations with consumers from one or more other Member States, including that of the consumer's domicile*”. In making this assessment national courts

had to evaluate “*all clear expressions of the intention to solicit the custom of that state's customers*”. Such a clear expression could include actual mention of the fact that it is offering its services or goods “*in one or more Member States designated by name*” or payments to “*the operator of a search engine in order to facilitate access to the trader's site by consumers domiciled in various member states*”. Finally, the court concluded:

“The following matters, the list of which is not exhaustive, are capable of constituting evidence from which it may be concluded that the trader's activity is directed to the Member State of the consumer's domicile, namely the international nature of the activity, mention of itineraries from other Member States for going to the place where the trader is established, use of a language or a currency other than the language or currency generally used in the Member State in which the trader is established with the possibility of making and confirming the reservation in that other language, mention of telephone numbers with an international code, outlay of expenditure on an internet referencing service in order to facilitate access to the trader's site or that of its intermediary by consumers domiciled in other Member States, use of a top-level domain name other than that of the Member State in which the trader is established, and mention of an international clientele composed of customers domiciled in various Member States. It is for the national courts to ascertain whether such evidence exists.”

31. English is the international commercial language of the West, and the first language of the UK, the USA and Australia (to name obvious examples). Therefore, the fact that a part, or parts, of the registered proprietor's website is in English is not enough to show, without more, that it is ‘pushing’ its mark into the UK or, in other words, directing the website to the UK in order to target customers in the UK. Nor is the fact that the website is accessible – and has been accessed – from the UK, particularly when the access figures are tiny, as they are in this case. In *Omnibill (Pty) Ltd v Egpsxxx Ltd & Anor* [2014] EWHC 3762 (IPEC), a copyright case, Birss J said, at [12]:

"It is clear that the question of whether a website is targeted to a particular country is a multi-factorial one which depends on all the circumstances. Those circumstances include things which can be inferred from looking at the content on the website itself and elements arising from the inherent nature of the services offered by the website. These are the kinds of factors listed by the CJEU in *Pammer* in the passage cited by Arnold J. However as can be seen from paragraph 51 of Arnold J's judgment he took other factors into account too, such as the number of visitors accessing the website from the UK. I agree with Arnold J that these further factors are relevant. Their relevance shows that the question of targeting is not necessarily simply decided by looking at the website itself. Evidence that a substantial proportion of visitors to a website are UK based may not be determinative but it will support a conclusion that the acts of communication to the public undertaken by that website are targeted at the public in the UK."

32. Although a single customer may be sufficient for genuine use and minimal use may qualify if it is deemed to be justified in the economic sector concerned (*La Mer*), relying on a couple of purchases by a single customer, at the end of the relevant period, means that the rest of the evidence needs to be more compelling than it is in demonstrating an active (i.e. 'pushing') approach to maintain or create a share in the UK market for the goods in question. In *Abanka*, a genuine use case in which the proprietor was a Slovenian bank, Mr Alexander observed, at [102]:

"The Act and the relevant EU legislation are designed to ensure that a mark only remains on the register if some serious effort have been made by the proprietor itself to develop the market in the particular territory in respect of which use is alleged (see case law cited above). Where the proprietor has not sought to do so and it is a matter of happenstance that its customers are doing business in the UK and contact the proprietor in its "home" country in order to do so or present its (e.g.) credit cards for payment, it is hard to see why such indirect and passive mere visibility of the mark in the UK should constitute use. Were it otherwise, the continued registration of a mark would depend on the, perhaps fortuitous, fact that, in the relevant years, customers

of the trade mark proprietor (rather than the proprietor itself) were doing business in the country in question, were living in the UK or the proprietor was in contact with the customer while in the UK.”

33. In all the circumstances of the present case, it seems to me that the sales to a single customer, only two of which were in the relevant period, were more as a result of happenstance than serious effort made by the proprietor to use, create or maintain a market for its goods under the BURN mark in the UK. The emails show that Tan Sales (London) Limited had to chase the registered proprietor for an answer to its request for a quotation. This is hardly commensurate with the registered proprietor’s claim that these were the first green shoots of the UK business, or its first tentative steps, as Mr Norris submitted. There are no steps in evidence at all. Mr Norris, whilst submitting that the invoices were the backbone of the registered proprietor’s case, importantly, said that, prior to the sales to Tan Sales (London) Limited, the website would not be seen as being targeted or directed to the UK.

34. Even if I were to accept that the invoices represent use in the UK, I bear in mind that not every proven commercial use of the mark may automatically be deemed to constitute genuine use (*Reber*). Standing back from the evidence and looking at it in the round, despite there being late and slight knowledge of the mark in the UK, the evidence does not show me that the mark has been used in the UK for creating or preserving a share in that market. It has been ‘pulled’, not ‘pushed’ into the UK. There is no evidence that the registered proprietor has taken any active steps or spent any effort, time or money to secure a UK market for its BURN goods; it has no website or advertising targeting the UK, and its single customer in the UK had to send a reminder to the registered proprietor in order to buy its goods. The proprietor has not shown that there was genuine use in the UK during the relevant period. The registration is revoked from 11 June 2016.

Outcome

35. The outcome is that registration number 2568553 is revoked in the UK with effect from 11 June 2016. As this is a date earlier than the dates on which the three

opposed applications were filed, 2568553 was not extant on the register on the three filing dates. The consequence of this is that the registration 2568553 was not an earlier mark on the dates on which the applicant filed its marks and it cannot be used as a basis for opposition to the applications. The oppositions, therefore, all fail.

36. At the date of writing this decision, there are outstanding third-party oppositions against two of the applications, 3180091 and 3180100. The outcome of these consolidated proceedings is therefore that application number 3183678 may proceed to registration, but applications 3180091 and 3180100 are suspended pending the resolution of the third-party oppositions against them.

Costs

37. The applicant has been successful. Bearing in mind the consolidation, which will have reduced costs⁴, I order Royal Steel Industry Co., Ltd to pay Burn Cable Management Systems Limited the sum of £1800 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period. This sum is calculated as follows:

Official fee for filing the TM26(N):	£200
Filing the revocation application and considering the counterstatement	£200
Considering the oppositions and filing the counterstatements	£200
Considering the evidence	£500

⁴ As per the scale set out in Tribunal Practice Notice 2/2016.
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Preparing for and attending the hearing £700

Total £1800

Dated this 1st day of December 2017

Judi Pike

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