



OPPOSITION No B 2 003 872

Barter Books, Alnwick Station, Alnwick NE66 2NP, United Kingdom (opponent), represented by **McDaniel & Co.**, 19 Portland Terrace, Jesmond, Newcastle upon Tyne NE2 1QQ, United Kingdom (professional representative)

a g a i n s t

Keep Calm and Carry On Ltd, 14–15 The Annexe, Investment House, 28 Queens Road, Weybridge, Surrey KT13 9UT, United Kingdom (applicant), represented by **M.J.P. Deans**, Lane End House, Hookley Lane, Elstead, Surrey GU8 6JE, United Kingdom (professional representative).

On 17/05/2013, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 003 872 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

REASONS:

The opponent filed an opposition against all the goods of Community trade mark application No 10 494 441 'KEEP CALM AND CARRY ON'. The opposition is based on the non-registered mark 'KEEP CALM AND CARRY ON', used in the course of trade in the United Kingdom. The opponent invoked Article 8(4) CTMR.

**NON-REGISTERED MARK USED IN THE COURSE OF TRADE –
ARTICLE 8(4) CTMR**

According to Article 8(4) CTMR, upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing that sign:

- (a) rights to that sign were acquired prior to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;
- (b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

The grounds of refusal of Article 8(4) CTMR are therefore subject to the following requirements:

- The earlier sign must have been used in the course of trade of more than local significance prior to the filing of the contested trade mark;
- Pursuant to the law governing it, prior to the filing of the contested trade mark, the opponent acquired rights to the sign on which the opposition is based, including the right to prohibit the use of a subsequent trade mark.
- The conditions under which the use of a subsequent trade mark may be prohibited are fulfilled in respect of the contested trade mark.

These conditions are cumulative. Thus, where a sign does not satisfy one of those conditions, the opposition based on the existence of a non-registered trade mark used in the course of trade within the meaning of Article 8(4) CTMR cannot succeed.

a) The right under national law – the law governing the sign

According to Article 76(1) CTMR, in proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

Therefore, the onus is on the opponent to submit all the information necessary for the decision, including identifying the applicable law and providing all the necessary information for its sound application. According to case-law, it is up to the opponent '... to provide OHIM not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application ... but also particulars establishing the content of that law' (judgment of 05/07/2011, C-263/09 P, 'Edwin', paragraph 50). The evidence to be submitted must allow the Opposition Division to safely determine that a particular right is provided for under the law in question, as well as the conditions for acquisition of that right. The evidence must further clarify whether the holder of the right is entitled to prohibit the use of a subsequent trade mark, as well as the conditions under which the right may prevail and be enforced vis-à-vis a subsequent trade mark.

In the present case, the opponent did not submit any information about where and to what extent the laws of the United Kingdom could grant the opponent any rights based on the claimed use of the word sign as a non-registered trade mark.

It was the applicant that suggested that the only non-registered trade mark rights recognised in the United Kingdom are those deriving from the Law on Passing-Off. The opponent reacted by arguing that since 'this is a Community trade mark, there is no action for passing-off initiated against the applicant, nor does there need to be.' The opponent erred in this conclusion. As stated above, it is the opponent's responsibility to identify the applicable law and to provide all the necessary information for its sound application, so that the Opposition Division can safely determine that a particular right is provided for under the law in question and that the conditions for acquisition of that right are met under that law.

Since the opponent did not submit any information in relation to the applicable national law and, indeed, objected even to the applicability of the Law on Passing-Off as suggested by the applicant, the Opposition Division is not in a position to determine the particularities in relation to the acquisition of said right, the scope of its

protection and the possible rights that it grants to the opponent vis-à-vis the contested trade mark. .

The opposition can be dismissed at this point of the examination as unfounded under Article 8(4) CTMR. For sake of completeness and in order to address the arguments of the parties, the Opposition Division will proceed with an overview and examination of the evidence submitted by the opponent.

b) Prior use in the course of trade of more than mere local significance

The condition requiring use in the course of trade is a fundamental requirement, without which the sign in question cannot enjoy any protection against the registration of a Community trade mark, irrespective of the requirements to be met under national law in order to acquire exclusive rights.

Furthermore, such use must indicate that the sign in question is of more than mere local significance. The rationale of that provision is to restrict the number of conflicts between signs, by preventing an earlier sign, which is not sufficiently important or significant, from making it possible to challenge either the registration or the validity of a Community trade mark.

The contested trade mark was filed on 14/12/2011. Therefore, the opponent was required to prove that the sign on which the opposition is based was used in the course of trade of more than local significance in the United Kingdom before 14/12/2011.

On 20/09/2012, the opponent submitted evidence to show use of the earlier sign in the course of trade. The evidence consists of the following documents:

- A witness statement signed by John Stuart Manley, director of Barter Books Ltd, containing information about the discovery of 'KEEP CALM AND CARRY ON' posters and the alleged use of the sign in the course of trade, dated 09/05/2012.
- An image of a poster on display in a premise that looks like a bookstore or a library showing the sign 'KEEP CALM AND CARRY ON', in which the verbal elements are placed in a vertical position beneath each other, and there is also a crown placed above them.
- An invoice, issued on 12/01/2006 by Barter Books, for the sale of 50 Keep Calm posters, for the total price of GBP 87.00.
- A copy of a feature article in 'The Guardian Weekend' magazine, dated December 2005, displaying the sign 'KEEP CALM AND CARRY ON', with a crown above, in the form of a poster. The article contains information regarding when and how this poster was discovered, and states that a copy can be purchased from Barter Books for the price of GBP 3.60.
- A screenshot from the Wayback machine internet archive evidencing that, as of 11/02/2006, on the website <http://barterbooks.co.uk>, reproductions of a 'KEEP CALM AND CARRY ON' poster were offered for sale for the price of GBP 3.60 each, and also the prices for multiple orders were provided.
- A document called 'The Keep Calm Timeline', with no reference to its origin, and bearing no date or signature.

When determining the significance of the use made of a trade sign according to Article 8(4) CTMR, one must consider the territory in which it is used, the length of time and economic dimension of such use, the group of addressees among which

the sign in question has become known as a distinctive element, namely consumers, competitors or even suppliers, or even of the exposure given to the sign, for example, through advertising or on the internet (see to this respect judgment of 24/03/2009, joined cases T-318/06 to T-321/06, 'GENERAL OPTICA').

The witness statement signed by John Stuart Manley does not emanate from an independent source. It is evident from the submissions of the opponent that Barter Books Ltd is the legal successor of the Barter Books (Partnership). It is also clear from the submissions of the opponent that the document called 'The Keep Calm Timeline' also originates from the opponent, although it bears no explicit reference to the source of origin. Statements drawn up by the interested parties themselves, or their employees, are generally given less weight than independent evidence. This is because the perception of the party involved in the dispute may be more or less affected by personal interests in the matter (decision of 11/01/2011, R 0490/2010-4, 'BOTODERM'). Therefore, in general, further evidence is necessary to establish use since such statements have to be considered as having less probative value than physical evidence (labels, packaging, etc.) or evidence originating from independent sources.

The submitted evidence does not meet the minimum threshold of 'more than local significance', set out in Article 8(4) CTMR. The rationale of that provision is to restrict the number of conflicts between signs by preventing an earlier sign, which is not sufficiently important or significant, from challenging a later right. This means that account must be taken, first, of the geographical dimensions of the sign's significance, that is to say of the territory in which it is used to identify its proprietor's economic activity, and, second, of the economic dimensions of the sign's significance. The latter is assessed in light of the length of time that the sign has fulfilled its function in the course of trade and the degree to which it has been used, the group of addressees among whom the sign in question has become known as a distinctive element, namely consumers, competitors or even suppliers, or even of the exposure given to the sign, for example, through advertising or on the internet.

When ascertaining the actual significance of the sign relied on in the relevant territory, the Opposition Division must not, therefore, confine itself to a purely formal assessment of the mere geographical extent of use, but must also examine the economic impact of the sign in the territory in question (judgment of 29/03/2011, C-96/09 P, 'Anheuser-Busch'). A trade sign is of more than mere local significance in the relevant territory when its impact is not confined to a small part of that territory, as is generally the case with a town or a province (judgment of 24/03/2009, joined cases T-318/06 to T-321/06, 'GENERAL OPTICA', paragraph 41).

Whether or not a non-registered trade mark is of more than mere local significance may be established by demonstrating the existence of a network of economically active branches throughout the relevant territory, but also, more simply, for example, by producing invoices issued outside the region in which the proprietor has its principal place of business, press cuttings showing the degree of recognition on the part of the public of the sign relied on or by establishing that there are references to the business establishment in travel guides (judgment of 24/03/2009, joined cases T-318/06 to T-321/06, 'GENERAL OPTICA', paragraph 43).

In the present case, the opponent failed to prove the significance of the economic impact of the sign in the United Kingdom. A single sale of 50 posters for the total amount of GBP 87.00 to a client based in London can hardly justify any economic impact, and certainly not a significant economic impact.

Considering all the above, and the lack of any other evidence capable of demonstrating use of more than mere local significance, the Opposition Division concludes that the evidence submitted by the opponent is insufficient to prove that the earlier sign was genuinely used in the course of trade of more than local significance before the filing date of the contested trade mark in relation to the goods for which protection of the earlier mark is claimed.

In its second round of observations, the opponent focused its argumentation on the fact that the applicant has no right to monopolise the expression 'KEEP CALM AND CARRY ON', since it is 'an image free to be used by everyone'. It must be noted, in this regard, that there is no legal ground provided for in the CTMR prohibiting a legal or natural person from registering a sign as a trade mark for which the term of protection under copyright has expired. Moreover, Article 8(4) CTMR restricts the scope of protection in opposition proceedings to earlier non-registered trade marks and other signs used in the course of trade of more than mere local significance. Therefore, any claim based on copyright or bad faith cannot be the subject of the current proceedings.

c) Conclusion

Bearing in mind the above considerations regarding the lack of information in relation to the applicable national law under which protection is sought, and the lack of use, of more than local significance, of the earlier non-registered trade mark in relation to the goods for which protection is claimed, the opposition must be rejected as unfounded under Article 8(4) CTMR.

The Opposition Division finds it appropriate to, explicitly, make it clear to the applicant that the OHIM has no sympathy whatsoever for the opponent, or any other representative acting before the Office. The Opposition Division is bound only by the provisions of Council Regulation No 207/2009 of 26/02/2009 on the Community trade mark, and renders its decisions based on the principles of legality and non-discrimination. Therefore, any suggestion that the Office may be influenced in its decisions by subjective factors, such as sympathy or partiality, is unfounded.

COSTS

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the opponent is the losing party, it must bear the costs incurred by the applicant in the course of these proceedings.

According to Rule 94(3) and (7)(d)(ii) of CTMIR, the costs to be paid to the applicant are the costs of representation which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

Catherine MEDINA

Plamen IVANOV

Juan Antonio MORALES
PAREDES

According to Article 59 CTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 CTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) CTMIR, such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2(30) CTMFR) has been paid.