

**O-401-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO 3171548  
BY SAINT-GOBAIN BUILDING DISTRIBUTION LIMITED  
TO REGISTER THE TRADE MARK:**

**GEMINI**

**IN CLASSES 19 AND 35**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 600000493  
BY GUSTAFS SCANDINAVIA AB**

## **Background and pleadings**

1. On 27 June 2016, Saint-Gobain Building Distribution Limited (“the applicant”) applied to register the trade mark **GEMINI** for goods and services in classes 19 and 35. The application was published for opposition purposes on 16 September 2016.

2. The application is opposed by Gustafs Scandinavia AB (“the opponent”) under the fast-track opposition procedure. The opposition is based upon section 5(2)(a) of the Trade Marks Act 1994 (“the Act”) and is directed against only the goods in class 19 of the application, namely:

Class 19 Wall tiles; floor tiles; bathroom tiles; kitchen tiles; ceramic tiles; earthenware tiles; stone tiles; porcelain tiles; wood effect tiles; brick effect tiles; quarry tiles; glass tiles; mosaic tiles; border tiles; natural stones.

3. The opponent relies upon its International trade mark registration no. 926543 for the following trade mark:

**Gemini**

4. The international registration date of the opponent’s mark is 18 April 2007. The UK was designated on the same date and protection in the UK was granted on 26 April 2008. The opponent relies upon all of the goods for which the mark is registered, namely “wood veneer” in class 19.

5. Given the date of designating the UK which, in accordance with Regulation 2 of the Trade Marks (International Registrations) Order 2008, is the filing date of the opponent’s trade mark it qualifies as an earlier mark in accordance with s. 6 of the Act. The opponent states in its Notice of Opposition that it has used its trade marks in relation to all of the goods relied upon. This statement is made because the earlier mark is subject to the proof of use provisions contained in s. 6A of the Act.

6. The applicant filed a counterstatement in which it denies the grounds of opposition. It claims that the contested goods in the application are not similar to those of the earlier mark. Although the applicant's counterstatement made no concessions regarding the similarity of the marks, it later accepted in submissions that the marks are identical.<sup>1</sup> In addition to its comments on the goods and marks at issue, the applicant also made a number of criticisms of the opponent's evidence of use. I bear these in mind.

7. Rules 20(1)-(3) of the Trade Marks Rules ("TMR") (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

8. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. In these proceedings, the applicant sought, and was granted, leave to file evidence of honest concurrent use. It also filed written submissions with its evidence, which I will bear in mind.

9. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Neither party filed written submissions in lieu of a hearing. This decision is taken following a careful reading of the papers.

10. The opponent is not professionally represented. The applicant has been represented throughout by Potter Clarkson LLP.

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<sup>1</sup> Written submissions dated 2 May 2017, p. 2.

## **Evidence**

### **Opponent's evidence**

11. This being a fast track opposition, the opponent's evidence of use has been filed as a series of responses to questions on the form TM7F, verified by a statement of truth. There is also one exhibit. The evidence has been given by Ruben Krouwel, the product manager for the opponent.

12. Mr Krouwel states that the number of sales achieved under the mark in the UK during the relevant period is "2 million GBP annually" (question 8). He also states that £50,000 was spent promoting the mark in the UK in the relevant period (question 9).

13. Exhibit 1 consists of a product brochure entitled "GUSTAFS PANEL SYSTEM: Standard veneer collection". There is use throughout of "Gemini", both with and without the symbol "®", to describe a particular type of veneer. The exhibit is not paginated but there are seven pages of images of different "GEMINI®" veneers. The last page features a description of the "Gemini®" veneer and how it differs from the natural veneers also offered by the company. On the inner cover page, the brochure records two examples of work in the UK, at Hertford College (Essex) and at UCL. However, unlike some of the other images, these potential examples of use in the UK are not identified as using "Gemini" veneers. Nowhere is the exhibit dated.

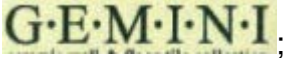
### **Applicant's evidence**

14. The applicant's evidence consists of the witness statement of Nicholas Holland, with six exhibits. Mr Holland states that he is the Managing Director of Ceramic Tile Distributors ("CTD"), a trading arm of the opponent company. Mr Holland states that he has held his position for the last ten years, previous to which he held other roles in the company. He states that he launched the "GEMINI" brand in the 1980s and that the

trade mark has been in use in relation to the goods covered by the application for over 26 years.

15. For reasons which will become apparent, I do not intend to describe the applicant's evidence in detail. Much of the evidence is not dated or is dated after the relevant date.

The key points are as follows:

- The applicant's sales "under and by reference to the GEMINI brand" have totalled at least £32 million per annum since 2006;<sup>2</sup>
- Advertising figures since 2012 have ranged between £50,000 (2011-2012) and £90,000 (2014);<sup>3</sup>
- CTD was listed as the supplier of "Gemini" tiles in the National Association of Tile Distributors Directory in 1994 and in the National Tile Association Directory in 1997;<sup>4</sup>
- Tiles described as the "Gemini range" or the "Gemini collection" were advertised on the applicant's website between 2002 and 2008;<sup>5</sup>
- The applicant's website shows tiles offered for sale under the mark "GEMINI" in May 2017;<sup>6</sup>
- Not all of the applicant's use of "GEMINI" is word-only. The mark also appears in the form ;<sup>7</sup>
- "Gemini" tiles were available from a number of distributors throughout the UK (the evidence is not dated).<sup>8</sup>

### **Proof of use**

16. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

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<sup>2</sup> Paragraph 8.

<sup>3</sup> Paragraph 9.

<sup>4</sup> Exhibit 1, pp. 9-12

<sup>5</sup> Exhibit 3

<sup>6</sup> Exhibit 4

<sup>7</sup> Ibid.

<sup>8</sup> Exhibit 5

“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”.

17. Section 100 of the Act is also relevant. It 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”.

18. 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 (C-495/07) [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 (C-149/11) 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 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]”.

19. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is not, therefore, genuine use.

20. According to section 6A(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied-for mark. Consequently, the relevant period is 17 September 2011 to 16 September 2016.

21. Before assessing the opponent’s evidence of use, I remind myself of the comments of Mr Daniel Alexander, Q.C., sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*, Case BL O/230/13, where he 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”.

22. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition actions. He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round- or lose it”” [original emphasis].

23. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/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”.

24. It is clear from the case law above that the onus is on the opponent to show that it has used its trade mark in the relevant period. It is also clear that no particular documents are required for that purpose. The difficulty for the opponent is that it has filed almost no documents at all, and nothing which is clearly in the relevant period. I accept that Mr Krouwel has given evidence that sales under the mark in the UK totalled £2 million annually and that there has been no challenge to that statement in evidence. However, not a single piece of documentary evidence has been provided to support the claimed turnover figures. While I have no reason to question whether Mr Krouwel is telling the truth, the authorities cited above tell me that I must nevertheless consider whether the evidence filed by the opponent is sufficient to show that the trade mark at issue has been put to genuine use in the relevant period. In my view, evidence that sales consistently worth £2 million were made every year during a five-year period requires some kind of documentation to support the claim. Given the size of the figures and the likely sums involved in each transaction, it ought not to have been difficult for the opponent to provide evidence to show that it had made sales under the mark, in the form of, for example, invoices. The same applies to the statement that £50k was spent on advertising. It is not clear whether this is a total or annual amount, the figure not being broken down in any way. The only documentary evidence which has been provided is one undated brochure. The mark appears in that brochure but there is no indication of when or where it was distributed. Two addresses in the UK are given alongside images of the opponent's products. However, there is nothing to show that the goods sold in the UK were sold under the mark at issue.

25. The relevant period ended a little over two months before the evidence was filed. It is reasonable to assume that fairly recent documents would have been available to support the opponent's assertions regarding turnover and advertising but none has been provided. I have no evidence which can be said with any certainty to show the mark in use in the relevant period. Nor is the opponent assisted by the applicant's evidence of concurrent use, since it contains no evidence in relation to the opponent's mark or goods.

26. In addition, I bear in mind that the applicant made a number of criticisms of the opponent's evidence of use, both in their counterstatement and in their submissions of 2 May 2017. The opponent has not responded to these criticisms, either by asking for leave to file further evidence or by way of submissions in lieu. On the basis of the evidence before me, I am not satisfied that genuine use has been made on or in relation to the goods upon which the opponent relies.

## **Conclusion**

27. The opponent has failed to establish genuine use of its earlier mark within the relevant period. The opposition fails at the first hurdle and is dismissed accordingly. Subject to appeal, the application will proceed to registration.

## **Costs**

28. As the applicant has been successful it is entitled to a contribution towards its costs. Although it filed evidence intended to show concurrent use, the evidence was solely focused on the applicant's use of the mark and, had I needed to decide the point, would not have assisted in establishing that there had been parallel trade. Accordingly, I make no award in respect of the applicant's evidence. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. This being a fast-track opposition, TPN 2/2015 also applies. I award costs to the applicant on the following basis:

Preparing a statement and considering the other side's statement:	£200
Considering the evidence and preparing submissions:	£300
Total:	£500

29. I order Gustafs Scandinavia AB to pay Saint-Gobain Building Distribution Limited the sum of **£500**. 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 24<sup>th</sup> day of August 2017**

**Heather Harrison**

**For the Registrar**

**The Comptroller-General**