

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF Trade Mark Registration Nº: 1338514 in the name of Laboratoires Goemar**

**and**

### **An Application under Nº: 10073 for Revocation by La Mer Technology Incorporated.**

#### **BACKGROUND**

1. The mark LABORATOIRE DE LA MER, was applied for on 15<sup>th</sup> March 1988 for:  
  
    ‘Pharmaceutical, veterinary and sanitary products, dietetic products for medical use; all included in Class 5 and all containing marine products’.  
  
It now stands on the register in the name of Laboratoires Goemar, ZAC. de la Madeleine, St. Malo, 35403, France.
2. In an application dated 27<sup>th</sup> March 1998 La Mer Technology Incorporated applied for revocation of the mark. Their Statement of Grounds said:  
  
    ‘Inquiries have revealed that trade mark Registration No. 1338514 LABORATOIRE DE LA MER has not been used by the registered proprietor or with its consent on any of the goods for which it is registered during the past five years.  
  
    It is contended that there are no proper reasons for the non-use.  
  
    It is therefore contended by the applicant that the registration be revoked under the power which is contained in Section 46(1) of the Act and removed from the Register for all of the goods for which it is registered.’
3. The registered proprietors (RPs) deny the ground.
4. Both sides filed evidence in these proceedings and a hearing took place on 23<sup>rd</sup> February 2001. The RPs were represented by Mr Mellor of Counsel, instructed by Lane and Partners, and the applicants by Mr Tritton, also of Counsel, instructed by Gill Jennings & Every.
5. The applicants in this matter are also involved in parallel proceedings for revocation (Nº 10074) of the same mark, registered under Nº 1402537 for ‘Perfumes and cosmetics containing marine products; all included in Class 3’. There also appears to have been an earlier revocation action for the mark in suite under revocation Nº 9638 (the fate of that is unclear; it is not now extant). The evidence presented is common to the two subsisting cases as the parties have adopted that from both into each. Not all of this is relevant, of course. This matter is concerned with the goods listed at paragraph 1 above.
6. The relevant sections of s. 46 of the Act state:

‘46.-(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;

.... ,

(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.

.... ,

(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.’

7. S. 100 of the Act places the onus of proof on the registered proprietor:

‘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.’

8. In the light of this I want to consider the applicants use of their mark on the goods at issue, as given in their evidence, during the relevant period, which is the five years before the application date of 27<sup>th</sup> March 1998, i.e. the years preceding that date back to 27<sup>th</sup> March 1993. No proper reasons for non-use were presented in evidence or at the hearing; thus the RPs case stands or falls on this evidence.

9. In a Statutory Declaration dated 19<sup>th</sup> January 1999 (adopted into these proceedings from N<sup>o</sup>-10074 opposition, which I will call this the ‘main declaration’) Mr Simon Bertaud, the Managing Director of Laboratoires Goemar (the RPs), describes the RPs’ business:

‘My company’s products are mainly used for cleansing and moisturising the skin, although my company also manufactures liquid dietary supplements. Details of these products, as shown by a copy of Health Scope Direct’s “Special Needs Collection” magazine are now produced and shown to me marked Exhibit 1. Products marketed under the brands IODUS, GOEFORM and THALASSO BAIN are featured in the magazine, together with brief descriptions of the use of the products. All of these products are derived from marine products, in particular seaweed/algae..’.

10. Mr Bertaud describes his relationship with UK distributors:

‘My company has been selling products bearing the trade mark LABORATOIRE DE LA MER in the United Kingdom since November 1996. Initially, the products were supplied to a company called Meadow Breeze Limited who distributed them in the United Kingdom.

Meadow Breeze subsequently changed its name to Health Scope Direct which continues to market my company's products'.

11. Against this background, after careful study of the evidence, the RPs use of their mark can be itemised as follows:

(1) In a Statutory Declaration dated 1<sup>st</sup> October 1997 produced by Mr Alasdair Lennie MacQuarrie, a registered trade mark attorney employed by Gill, Jennings and Every (which is Exhibit 1 of his Statutory Declaration to these proceedings, dated 16<sup>th</sup> July 1998) are copies of, what I take to be, two invoices, listing products supplied by the RPs to Meadow Breeze Limited. One of these documents is one dated 29/10/96; the other 14/04/97. This puts them within the relevant period. There is no use of the mark on either. In his other declaration dated 19<sup>th</sup> January 1999 (his main declaration also carries this date) Mr Bertaud refers to the invoices and says 'GOEFORM Magnesium' and 'GOEFORM Circulation', shown on the invoices, both carried the trade mark. There is no direct evidence of this. Mr Bertaud cites the document 'The Health Scope Direct Special Needs Collection' (Exhibit 1 to this declaration, and Exhibit 1 to his main declaration), which was produced in 1997, and depicts an example of the type of packaging then used (it refers Goeform 'Circulation', but not 'Magnesium'). I cannot discern from the copy provided - as Mr Bertaud himself points out (paragraph 4, main declaration) - the trade mark. However, examples of the packaging and products ('GOEFORM Magnesium' and 'GOEFORM Circulation') are given in Exhibit 1 to the other 19<sup>th</sup> January 1999 declaration). The mark is clearly visible. Of course, these are products of younger origin, but the packaging appears to be the same as that depicted in 'The Health Scope Direct Special Needs Collection' document.

The invoices refer to the following quantities:

Product	29/10/96	14/04/97
GEOPHARM Magnesium bte 20x10ml	32 items at F560	
GEOPHARM Magnesium bte 15x10ml		20 items at F340
GEOPHARM Circulation bte 15x10ml		20 items at F340

That is approximately £120 worth of business.

(2) In a declaration dated 18<sup>th</sup> February 1999, and introduced into this evidence from the parallel opposition N<sup>o</sup>: 10074, Mr Bertaud responds to a criticism directed at these invoices by Mr Per Ake Neuman, the Managing Director of Estee Lauder Cosmetics Limited (declaration dated 14<sup>th</sup> October 1998 and, again, introduced into these proceedings from opposition N<sup>o</sup>: 10074) that '...there is no evidence here that any goods were ever delivered to the United Kingdom.' In Exhibit 1 to his declaration, Mr Bertaud alludes to a number of 'deliver sheets'. These coincide with the two invoices and also refer to other material as

well. Deliveries of ‘dietary supplements’, made before the relevant date are summarised below. I have included all the products I have been able to identify from ‘The Healthscope Direct Special Needs Collection’ document as dietary supplements, and also from Exhibit 1 to the other Declaration of M. Bertaud dated 19<sup>th</sup> January 1999, which encloses various examples.

Product			
	14/04/97	14/04/97	2/06/97
GEOPHARM Magnesium bte 15x10ml	20	525	
GEOPHARM Circulation bte 15x10ml	20	525	504
GEOPHARM Digestion bte 15x10ml			504
GEOPHARM Tonus bte 15x10ml			504

There is only a price per unit for the products listed at point 1 above for the ‘Magnesium’ and ‘Circulation’ products. If I assume a similar price for these products, their total value is around £400-£500.

(3) In his main declaration Mr Bertaud gives the following sales figures ‘to Meadow Breeze/Health Scope Direct in the UK’:

Year	£
1996	220
1997	5,399
1998	2,661

He says: ‘These figures are not particularly high since the products are relatively new to the United Kingdom and the market is still being established’. The relevant period ended on 27<sup>th</sup> March 1998. There is no indication of the proportion of this attributable to dietary supplements or to other products.

(3) Exhibit 4 of Mr Bertaud’s January 1999 declaration encloses a letter, dated 15<sup>th</sup> December 1998, from Fraser J Hays, Managing Director of Health Scope Direct. It contains the following passage:

‘I, the undersigned, hereby certify that the following documents:

- i) Your Business Bible
- ii) Start Your Own Health Business
- iii) Wholesale Order Form.

were made in the year 1996, whilst the following documents:

- i) The Healthscope Direct Special Needs Collection
- ii) Health Bites

were made in 1997.

All of the above documents were for the marketing and selling of Goemar Le Laboratoire De La Mer in the United Kingdom as agent for the manufacturers’.

A copy of ‘Your Business Bible’ is included in Exhibit 4; the RPs main name ‘Goemar’ is featured on every page. I can find no reference to a date, while there is a reference to the trade mark in suite on the ‘Wholesale Order Form’ at the back of the document.

‘The Healthscope Direct Special Needs Collection’ document (featured in Exhibit 1 of Mr Bertaud’s declaration) is obviously produced by or for the RP’s UK distributor but, again, there is no date and no mention of the mark in suite.

12. At the start of the hearing, Mr Tritton, appearing for the RPs, said that he had to concede that there had been no use on pharmaceutical, veterinary and sanitary products. Following s. 46(5), this is effectively an admission to revocation of the mark to the extent the specification applies to these products. The rest of this decision is concerned with ‘..dietetic products for medical use; all included in Class 5 and all containing marine products’.
13. Mr Tritton then referred me to s. 46(2) and said:

‘ “ .... use in the Unit Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.” I place emphasis on that aspect. It is quite clear therefore that if one was merely affixing the mark to the goods, but not selling the goods in the country, but exporting them abroad, that would constitute use, even though there are no sales in the United Kingdom whatsoever’.

I was also referred to s. 10(4) of the Act, which defines use of a mark, for the purposes of infringement, as affixing it to the goods or packaging thereof; offering or exposing for sale; *importing* or exporting goods under the sign. Mr Tritton made a connection between this section and s. 46(2) in that both include export in ‘use’. He said; ‘..if one is using the mark in exporting...one is clearly using it when importing into the UK..’

14. Mr Tritton also explained his view on the meaning of ‘genuine use.’ I was referred to *DDM Italia SpA v Zippo Manufacturing Co* [1999] RPC 173 and *Euromarket Designs Inc. v Peters* [2000] ETMR 1025. *Zippo* states (page 185):

‘I conclude that the substantial (or degree) of use is one factor that must be considered in deciding whether use of a mark is genuine. But where, as in this case, it is established that a mark has been used, and the genuineness of such use is not in question, detailed consideration of the substantiality of that use serves no purpose.’

15. Mr Tritton noted the background to the *Euromarket* case in that Jacob J was presented with evidence of use abroad that had expressed itself in this country. Jacob J states:

‘It seems to me that genuine use must involve that which a trader or consumer would regard as a real or genuine trade in this country. This involves quantity as well as the nature of the use. In part, it is a question of degree and there may be cases on the borderline. If that were not so, if Miss Vitoria were right, a single advertisement intended for local consumption in just one United States city, in a journal which happens to have a tiny UK distribution, would be enough to save trade mark monopoly in this country and yet the advertisement would not be a sham. This to my mind shows that Miss Vitoria’s gloss on the meaning of genuine use is not enough. The only stopping place after that is real trade in this country. I think all the examples relied upon are examples of trade just in the United States.’

Mr Tritton’s commented that the distinction Mr Justice Jacob made was between a mere physical presence of the mark in the UK as opposed to genuine use. The Claimant in *Euromarket*, was relying upon the former. Thus ‘Mr Justice Jacob is quite right to say it is not sufficient to show it was not a sham. You must show that there has been a real trade in the country’. Against this background, Mr Tritton remained of the view espoused in *Zippo*, that once genuine use had been established, the extent of it was irrelevant.

16. Mr Mellor, of course, rejected this. He said that *Euromarket* overrules *Zippo* - in establishing genuine use in this country, one must look at what ‘..a trader or consumer..’ would consider genuine use, and this includes quantity and nature of the use. He added:

‘Mr Justice Jacob is ... saying you have got to look at everything in the round. The substantiality of use is one of the factors you are going to have to take into account. You do not decide first whether it is genuine and then examine the substance of the use. You have got to do them together.’

17. I think Mr Mellor must be right. It seems to me that a trader or consumer, in assessing whether actual trade has taken place, would approach the matter in this way - the manner and extent of use will determine his view on the authenticity of the trade at issue. It is also approach now adopted by the Registry - for example, in the *Roy of the Rovers* Decision (SIRIS 0/212/01), the Hearings Officer (Mr Salthouse) referred to the *Bon Martin* [1989] RPC 537 case, where Whitford J commented:

‘To my mind what plainly emerges from the authorities is this ... the substantiality of the use is undoubtedly a relevant factor to be considered and at the end of the day one has got to consider every relevant factor. It must always be remembered that what one is directed to by Section 26 of the Act is the question as to whether there has been any *bona fide* use. Although the extent of the use is a factor which may be of significance, some of those factors may lead to the conclusion that although the use could not in the commercial sense be described as anything other than slight, nonetheless it may be appropriate to reach a conclusion, in the light of the circumstances as a whole, that the use ought to be regarded as *bona fide*.’

Mr Salthouse then commented:

‘I accept that the *Bon Martin* case was concerned with the Trade Marks Act 1938 where the statutory language in Section 26 focussed on whether or not the use had been “*bona fide*”, whereas under the new law the reference in Section 46 of the 1994 Act is to “genuine use”. However, in my view no substantial change in the law has been brought about by the different use of language and the above remarks are still apt in relation to the new law. Therefore, substantiality is a factor to be considered within the overall test of genuineness and not a separate hurdle that a registered proprietor must overcome’.

18. Later, in *Euromaket*, Jacob J makes a comment that is relevant to Mr Tritton’s submission on s. 10:

‘In this connection it should be borne in mind that the Directive does not include an all-bracing definition of “use”, still less of “use in relation to goods”. There is a list of what may *inter alia* be specified as infringement (Art. 5(3), corresponding to s. 10(4)) and a different list of what may, *inter alia*, constitute use of a trade mark for the purpose of defeating a non-use attack (Art. 10(2), equivalent to s.46(2)). It may well be that the concept of “use in relation to goods” is different for different purposes. Much may turn on the public conception of the use.’

19. These remarks are *obiter* and there is not much guidance in them; however, there is enough for me to be uncomfortable about connecting ‘use’ for the purposes of s. 10 with its appearance in s. 46. It seems clear that if the definitions were the same, there would be no need to specifically mention export in the latter part of s. 46(2), as it is already listed in s. 10(4). In my view, the mention of export in s. 46(2) is a specific inclusion present in the Act for its own sake, in all probability to provide clarity. I would not argue that because export signifies use, and is not trade to consumers, import signifies use for the same reason.
20. Rather, following Jacobs J’s test for genuine use, I think most traders (if not consumers) would regard, *prima facie*, import from a French Company to a UK company as an in the nature of genuine use, whether or not this trade has continued further along the supply chain to consumers. On this point Mr Tritton stated:

‘We submit that there is plainly genuine use. The fact that it is relatively slight is reflected in the fact that it is a start-up market for these people. It has taken a bit of time, but it is genuine use. It is a trade in the country. It is importation. It is something which is deemed, in our submission, to be an act of use of a sign in the UK’.

While I do not think I can argue with the principle here, following *Euromaket*, I must consider a number of other factors before I can come to a final conclusion. Mr Mellor conceded at the hearing that their had been use. He said that it could not be regarded as genuine. Various points arise.

21. First, Mr Tritton challenged those present at the hearing to give an instance where the mark was not use on the examples of the RPs’ products shown in the evidence. Mr Mellor’s response was that we are shown no actual examples of the products imported - they are ‘..similar to..’ or we are assured that they did (e.g. paragraph 4 of M. Bertaud’s other declaration dated 19<sup>th</sup> January 1999). Further, the invoices and delivery notes list other products for which there is no evidence of use of the mark at all. Of course there is no evidence they did not, but it is for the RPs to provide this material.

22. Next, there was a submission based on the ‘illegality’ of the imported goods under the Medicines Act 1968 (MCA) and the Food Safety Act (FSA) 1990. (This was first explained in evidence of Mr Neuman (paragraph 2 of his declaration dated 14<sup>th</sup> October 1998)). Mr Mellor pointed out that the RPs’ products were placed in Class 5, and both sides agreed this was a more likely classification than Classes 29 or 30 (i.e. as a food). The FSA states that food does not include ‘medicinal products within the meaning of the Medicines Act 1968 in respect of which product licences within the meaning of that Act are for the time being in force’ (s. 1(2)(d)(i)). The following passage is from Mr Mellor’s skeleton argument:

‘M Bertaud uses the example of ginseng to claim that class 5 products do not necessarily require licences. This is wrong. The MCA takes account of the claims made for the product as well as the pharmacological effects of the product in deciding if products are medicines. Some ginseng products will therefore be medicines requiring licences in class 5, depending on the claim made for them, and the others will be classified as foods, outside class 5. The wording of the FSA makes this irrelevant in any case, as the exception extends only to “medicinal products in respect of which product licences are in force”. Anything which falls into an exception to the Medicines Act licensing regulations (such as certain herbal remedies in specific circumstances), will automatically become classified as a food since it does not require a licence.’

Mr Tritton agreed with this interpretation, though not with the conclusion that Mr Mellor drew subsequently, where he stated:

‘Goemar is ... on the horns of a dilemma, from which there is no escape. Either the products are dietary supplements and no more, in which case they do not fall within the class, or they are medicines, in which case their sale has been illegal and cannot constitute genuine use.’

I feel there is a misunderstanding here. The system for classification of goods under the Act is an administrative mechanism solely for the objective of trade mark registration. It simply an organisational tool. The implication of this is that something can be a medicine for the purposes of the Act and yet not be so regarded for other purposes. This is implicit in the submissions made by Mr Tritton at the Hearing. He said that the Food Safety Act 1990 and the Medicines Act contained deeming provisions defining foods and medicines for the purposes of those Acts, and I agree.

23. More to the point is whether a product which cannot be sold in the UK, because it is illegal, can generate trade mark use. Mr Tritton was of the following view:

‘If, say, for instance, as some of my learned friends argument, I sold £10 million worth of GOEMAR Fitness in this country, but under a technicality that proves to be contravening some provision, does that mean I have not used it in this country? Of course, I have used it in this country. Does that suddenly mean my mark can be revoked? It is genuine use. It is not genuine by reference to the Medicines Act. Genuine is by reference to whether or not there has been actual use of the mark in this country and it is important to keep the various and wholly unrelated disciplines distinct. If someone under the Medicines Act wants to bring a prosecution against my client, Mr Hay or Eastern Pharmaceuticals, fine. Let them do it. That does not mean I have not used the mark in this country.’

Mr Mellor responded to this by stating:

‘The issue that arises under Class 5 is whether in all the circumstances that could possibly be genuine trade. I am saying in Class 5 the application of the Medicines Act indicates very clearly that it was not because it is a very stringent set of regulations. To the extent that you accept there was any trade and therefore supplements in the UK, it was a trade that was liable to be stopped and, shut down at any time. That is the main factor why there has been no genuine use in Class 5.’

Mr Mellor did not appear to be going so far as to say that import of an illegal product never amount to evidence of genuine use. Rather it is a factor I should take into account in determining whether genuine use had occurred. He said:

‘You do have to ask the general overall question would any trader or consumer looking at this think that a genuine trade has been established in this country? They would say no because if you were established in a genuine trade, you would go and clear the regulatory requirements and get a product licence?’

24. This may be going to far. If a car dealer imports vehicles from Japan, and then discovers he cannot sell them on because they do not conform to European emission regulations, I think it is possible that other car dealers might regard him as careless, but engaged in genuine trade, albeit somewhat unprofitable. Rather it is a factor that should be taken into account in determining whether genuine use had occurred or not. It is something I have to consider as part of an overall test of genuineness. I note the following.
25. First, the extent of the trade is small, but not trivial. It represents about £600 worth business conducted over the course of just over a year (October 1996 to June 1997).
26. Next, the relationship between the RPs and their agent in the UK is questioned by Mr Neuman in his evidence (see paragraphs 13 - 16 of his declaration dated 14<sup>th</sup> October 1998, adopted into these proceedings), who suggests that the UK ‘agent’ - Meadow Breeze/Healthscope Direct - is merely an extension of the RPs, and the supply was thus ‘in-house’. Mr Neuman points out that Mr Hay is also a Director of a UK company called ‘Goemar (UK) Limited’, which (PAN1) was incorporated in 1996. Mr Bertaud responds (main Declaration paragraph 16) by stating that this company is not a subsidiary of the RPs and that Mr Hay had no authority to register a company using the Goemar name. In response, Mr Neuman refers to a copy of the ‘Wholesale Order Form’ in Exhibit 4 to Mr Bertaud’s main declaration and notes that ‘Goemar Le Laboratoire de La Mer’ is actually trading from the premises of Health & Beauty Direct in Banff.
27. I have studied this evidence closely. Certainly the RPs are very much in the forefront of the ‘Business Bible’ document, with the putative agent only mentioned in the address for supply. The Healthscope Direct Special Needs Collection (see Exhibit 4, but irrelevant to this case as it does not include any of the dietary supplements) features references to the RPs only in the body of the text of that document. However, even there the introduction to the products on offer seems to make no distinction between the agent and RPs: ‘The seaweed we use is the purest, highest quality..’. All this might invite a conclusion that the transaction between the RPs and Health & Beauty Direct/Meadow Breeze was, if not an ‘in-house’ activity as suggested by Mr Neuman, a transaction appertaining to a business entity in the UK whose only

purpose was to establish a 'bridgehead' for the RPs' trade in the UK. It might invite it, but I cannot come to any such a conclusion without further evidence. There is not enough in the material before me to come to the result suggested by Mr Neuman. His views, based on the evidence, are conjectural - they may not contradict it, but that does not amount to proof.

28. In passing, I note that the RPs were supplying products in to the into the UK via a different agent (see Exhibit 5 of Mr Bertaud's main declaration) in 1998. This does not lend support to the interpretation given to the evidence above, that Healthscope Direct/Health & Beauty Direct/Meadow Breeze were the RPs' 'arm' in the UK. It suggests that the RPs had no particular commercial commitment to these other concerns, and that they were distinct entities.
29. Third, document 'Your Business Bible' appears to contain instructions on how to set up a business for the RPs products (see page 9ff); in particular, a mail order business (certainly the name of the distributor 'Health & Beauty *Direct*' would tend to support this conclusion as to the nature of the business). This suggests that the document was a 'pre-sale' document; it is certainly no evidence that sales to the public actually took place, despite overtly confident claims to this by M. Bertaud. In fact, there is no indication that the products listed were ever marketed in the UK.
30. Mr Hays letter of 15<sup>th</sup> December 1998 is informative for what it does not say rather than for what it does. Nowhere is there a statement to the effect that the documents listed were in fact *used* in marketing the RPs products - there were made in 1996 and 1997 (in the UK or outside it?); they were 'for the marketing and selling' of the RPs' products. Mr Bertaud, in his main Declaration, says 'All these documents show that the products bearing the trade mark LABORATOIRE DE LA MER were available for purchase in the years 1996-1997'. Mr Bertaud, in his main Declaration, says 'All these documents show that the products bearing the trade mark LABORATOIRE DE LA MER were available for purchase in the years 1996-1997'. This is rather equivocal to say the least. Having products *available* for sale is not same as actual sales.
31. Before completing my assessment of the evidence and submissions, there is one other point with which I must deal, which was not subject to much argument at the hearing, but was raised by Mr Neuman in paragraphs 9 and 10 of his first declaration:

'Because of the manner in which the phrase is used, I am in no doubt that any businessman, or member of the public, who was to scrutinise this packaging and see on it the phrase LABORATOIRE DE LA MER, would consider that phrase to be a description of GOEMAR, being the name of the manufacturer which appears immediately before it. As such, the phrase in small print LABORATOIRE DE LA MER - whatever its legal significance may be - does not appear to have been intended by the registered proprietor to function as a conventional trademark ...The phrase LABORATOIRE DE LA MER never appears on its own. It is not the means employed by Goemar to identify their goods. It does not appear anywhere in the invoices which were produced by Mr MacQuarrie. Apparently it is not trusted by its registered proprietor as the means of identification of the goods. Moreover, so small and insignificant does the phrase appear on the packaging that, as a practical matter, in the form as used by Laboratoires Goemar SA on this packaging, it is incapable of distinguishing the goods of the registered proprietor from the goods of other manufacturers. Plainly these goods can be distinguished from those of other manufacturers, but this distinctiveness derives from the highly distinctive Marks IODUS or THALASSO

BAIN and/or GOEMAR and does not in practice stem from the use of the phrase LABORATOIRE DE LA MER.’

32. I don't accept that the RPs' use of their mark cannot be trade mark use. 'Goemar' is the RPs' name, and it is hardly surprising that should be present. Further, it is not unusual for traders to use more than one trade mark on their products. Also, even if consumers in the UK came across the mark in this form, those that are able to translate the phrase (many, I would suggest, but not all by any means) into 'laboratory of the sea' would not consider this as is not so meaningful as to be overtly descriptive. There is enough that is ambiguous about the phrase to, in my view, obviate such a response. Certainly, the applicants believe that DE LA MER can inherently function as a trade mark, as they wish to make use of it themselves (see paragraph 1 of Mr Neuman's first declaration), and that is - following Mr Neuman's contention - arguably more descriptive of products containing marine-sourced ingredients (and misleading if they do not).

33. Considering all the arguments and submissions I have come to the conclusion that the RPs have done enough to meet the onus placed on them and have demonstrated genuine use of the mark within the relevant period. Though I have not found this an easy decision to make, it seems to me that the applicants do not disturb the substance of the following submission from Mr Tritton:

‘..that unless there has been doubt cast upon the act of importation itself, that somehow or other the act of importation was not genuine .... [t]he fact that you do not have evidence of where those goods are going to go afterwards is irrelevant. All I say is, in this case, as I said in opening, if goods are imported over a period of 18 months is one to really infer there was not genuine importation occurring here? Why else would he be importing unless he was concerned with trading in the products in the UK?’

34. Whatever the requirements of UK legislation, on the basis of the evidence, the RPs have simply responded to an order from a business in the UK. Viewed from this perspective, trade occurred using the mark in 1997 and 1998. The products might have been strictly illegal in the UK market. But I do not think this makes the trade, in this case, any less real. If the RPs' agents in the UK were unable to sell the products on because of this, the fact they were on the receiving end of bad bargain does not mean the purchase from Goemar was 'sham'. Further, if one alleges that the extent of the trade was small viewed against the background of the dietary supplements industry as a whole (though it may be significant in terms of such products based on marine extracts), £600 pounds worth of business is not trivial and, considering this matter in the round, amounts to genuine use.

35. As a result, registration N<sup>o</sup>- 1338514 is revoked, in as far as it applies to pharmaceutical, veterinary and sanitary products, from the date of the application for revocation. The specification of the product now stands as:

‘Dietetic products for medical use; all included in Class 5 and all containing marine products’

36. Neither side has been wholly successful in this case. I therefore decline to make any order as to costs.

**Dated this 19 Day of June 2001.**

**Dr W J Trott  
Principal Hearing Officer  
For the Registrar, the Comptroller General.**