

O-262-07

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 1569531 IN THE NAME OF
DARASHAN SANDHU T/A TOP MARKS (LONDON)**

AND

**APPLICATION FOR REVOCATION UNDER NO 82479 BY JAYNE
GOODMAN**

TRADE MARKS ACT 1994

**IN THE MATTER of registration
No. 1569531 in the name of
Darashan Sandhu t/a Top Marks (London)
and application for revocation under No.
82479 by Jayne Goodman**

Background

1. Registration No. 1569531 is for the trade mark MATERIAL GIRL and the registration procedure was completed on 31 March 1995. It stands in the name of Darashan Sandhu t/a Top Marks (London) and is registered in respect of:

Articles of clothing for women and girls; all included in Class 25; but not including footwear.

2. By an application dated 19 April 2006, Jayne Goodman applied for the registration to be revoked under the provisions of Sections 46(1)(a) and (b) of the Act on the basis that the mark has not been used at any time since it was registered.

3. In a counter-statement filed on 23 August 2006, the registered proprietor claims the mark was first used in 1993 and has been in continuous use since that date on the goods for which it is registered.

4. Both sides filed evidence in these proceedings. In accordance with usual practice, the parties were advised of their right to a hearing and were informed that if neither requested to be heard, a decision would be made from the papers and any written submissions that were received. Neither party requested to be heard and no written submissions were received.

Registered proprietor's evidence under rule 31(3)

5. This consists of a witness statement of Darashan Sandhu dated 18 August 2006. Mr Sandhu is the proprietor of Top Marks, a manufacturer and wholesaler of clothing for women and girls. Mr Sandhu states that his company first used the mark in 1993 and has used it continuously since then on clothing for women and girls.

6. Attached to Mr Sandhu's witness statement are two exhibits. The first, DS1, consists of labels said to be used on garments made by the registered proprietor along with copies of three purchase invoices for labels and copies of photographs showing garments bearing such labels. The labels consist of a cloth label and a card swing label. Both bear the words MATERIAL, in cursive script above the word GIRL in block capitals and larger font size. The copy invoices are dated 3 June 2005, 21 March 2006 and 7 April 2006 and refer to MATERIAL GIRL labels. The photocopies of photographs of garments show sew-in labels and swing labels as detailed above.

7. Exhibit DS2 consists of two open letters headed "To whom it may concern". I presume that these letters have been solicited for the purpose of these proceedings.

Rule 55 of the Trade Marks Rules 2000 (as amended) provides that evidence be in the form of a statutory declaration, affidavit or witness statement. Accordingly, as these letters have not been put into proper evidential form, I can give no weight to them.

Applicant's evidence under rule 31A(1)

8. This consists of a witness statement of Anthony Gregory Burrows and is dated 17 November 2006. Mr Burrows confirms he is a registered trade mark agent acting for the applicant in these proceedings. He confirms he is representing the applicant in respect of a Community Trade Mark application for the mark MATERIAL GIRL. Mr Burrows explains that prior to filing the application for the Community Trade Mark, he carried out a search and found the registration now under attack. He goes on to say that he carried out an internet search but was unable to trace any use of the mark by the registered proprietor either under his own name or his trading name. No details are provided of when or how the search was carried out.

Registered proprietor's evidence under rule 31A(4)

9. This consists of a further witness statement of Darashan Sandhu and is dated 22 February 2007.

10. Mr Sandhu confirms that his company has been trading from its current premises since 1986. The trade mark MATERIAL GIRL was first used on clothing for women and girls in 1993 and that since that time, sales of garments under the mark have steadily grown.

11. Mr Sandhu gives the following details of sales of clothing under the trade mark as follows:

2000	£463,204
2001	£316,805
2002	£570,850
2003	£606,294
2004	£385,123
2005	£384,123
2006	£430,517

12. Mr Sandu confirms that his company does not advertise MATERIAL GIRL clothing in any journals or magazines but says that sales are made to regular customers with new customers being recommended by word of mouth. He confirms that his company is listed in the telephone directory and on yell.com.

13. Mr Sandhu says that his customers are shop owners in Berkshire, Essex, Herts, Hants, London, Middlesex, Surrey and Scotland. He gives no details of these customers other than to say that many of them own chains of shops.

14. At DS3 and DS4, Mr Sandhu exhibits copies of exhibits DS1 And DS2 as previously filed. I can see no purpose in filing these documents a second time in these proceedings, indeed it seems to me to be superfluous to do so.

15. At DS5, Mr Sandhu exhibits copies of some 42 invoices which are said to be a selection from his records. The invoices range in date from 11 December 2002 to 9 April 2006. None of the invoices show or bear any reference to the mark. Only one invoice shows full name and address details of the customer.

16. No further evidence was filed in these proceedings.

Decision

17. The relevant statutory provision in relation to an application for revocation of a registered trade mark can be found in Section 46. This states:

“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;
- (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.

(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 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 exist at an earlier date, that date.”

18. Form TM26(N) is the form by which an application for revocation is made. The applicant, through its trade mark agent Anthony Burrows, completed the form and in doing so, indicated that it sought revocation under section 46(1)(a) from 1 April 2000. It also indicated that in respect of the objection under section 46(1)(b), the 5 year period where use was alleged not to have been made was 18 April 2001 to 17 April 2006; thus the applicant sought revocation under this ground from 18 April 2006.

19. For reasons unknown to me, on receipt of the application, the Trade Marks Registry wrote to the applicant informing her that the dates from which she sought revocation under both section 46(1)(a) and (b) were incorrect and requiring them to be changed to show the effective dates of revocation requested to be 31 March 2000 (section 46(1)(a)) and 17 April 2006 (section 46(1)(b)). The form was subsequently altered.

20. The registration procedure for this mark was completed on 31 March 1995. Under section 46(1)(a), the relevant five year period therefore runs from 1 April 1995 until 31 March 2000. The applicant was therefore correct to seek revocation from 1 April 2000. Similarly, under section 46(1)(b), the applicant gave the relevant period as 18 April 2001 until 17 April 2006. The earliest date of revocation under this section of the Act is therefore 18 April 2006. In light of this, the Trade Marks Registry was, I believe wrong to require the applicant to change the dates on the form. I therefore intend to consider the application for revocation in respect of the original dates requested. I do not consider the registered proprietor will be disadvantaged by this as he has claimed to have used the mark continuously since it was first used in 1993 and has not addressed the issue in terms of any specific dates.

21. The onus of showing that the trade mark in question has been used within the relevant period or that proper reasons exist for its non-use, rests with the proprietor. This is set out in Section 100 of the Act which states:

“**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.”

22. The Act refers to “genuine use” having been made of the trade mark though it does not set out what constitutes such use. The basis of what constitutes genuine use

was decided by the European Court of Justice (ECJ) in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 [2003] ETMR 85:

“1. Article 12(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is 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; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is 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, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark that is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”

23. In *La Mer Technology Inc v Laboratoires Goemar SA* Case C-259/02 the ECJ considered the extent of use, the amount of use and the types of use that can be considered when deciding whether there has been genuine use of a trade mark:

“20. It follows from those considerations that the preservation by a trade mark proprietor of his rights is predicated on the mark being put to genuine use in the course of trade, on the market for the goods or services for which it was registered in the Member State concerned.

21. Moreover, it is clear from paragraph 39 of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive, even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed to be justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case-by-case assessment which is for the national court to carry out. The characteristics of those products and services, the frequency or regularity of the use of the mark, whether the mark is used for the purpose of marketing all the identical products or services of the proprietor or merely some of them, or evidence which the proprietor is able to provide, are among the factors which may be taken into account.

23. Similarly, as emerges from paragraphs 35 to 39 of *Ansul* set out above, the characteristics of the market concerned, which directly affect the marketing strategy of the proprietor of the mark, may also be taken into account in assessing genuine use of the mark.

24. In addition, use of the mark by a single client which imports the products for which the mark is registered 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 of the mark.”

24. In *Laboratoires Goemar v La Mer Technology Inc* [2005] ETMR 114 Mummery LJ held that a quantitative and qualitative test for market use and market share could not be erected when considering genuine use:

“32 Blackburne J. interpreted and applied the rulings of the Court of Justice as placing considerably more importance on the market in which the mark comes to the attention of consumers and end-users of the goods than I think they in fact do. I agree with Mr Tritton that the effect of Blackburne J.'s judgment was to erect a quantitative and qualitative test for market use and market share which was not set by the Court of Justice in its rulings. The Court of Justice did not rule that the retail or end-user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine.”

25. Neuberger LJ in the same judgment held the following:

“45 The notion that the use of the trade mark must be substantial or significant before it qualifies as "genuine" seems to me to run into two difficulties in any event. The first is that it does not involve attributing the word "genuine" its natural meaning, although this point of course potentially substantially weakened by the fact that the equivalent word used in the text in Art.10 in other languages may carry with it a slightly different meaning.

46 Secondly, once one imposes a requirement of significance or substantiality, it becomes potentially difficult, time-consuming, and expensive to decide whether, in any particular case, that requirement is satisfied. In this connection, Mr Tritton made a fair point when he suggested that the introduction of a test of significant use could lead to detailed arguments about the precise nature and extent of the market in which a particular trade mark is to be used, as well as a detailed enquiry in many cases as to the precise nature and extent of the use of the particular mark over the relevant five-year period. I do not regard that as a particularly desirable outcome.

47 Although the use of the instant mark within the jurisdiction can be said to be close to exiguous, I do not think it could be characterised as *de minimis*. Even if it could be so characterised, I do not consider that that concept would be a useful or helpful one to invoke or apply, even if it had not been effectively ruled out by the European Court.”

26. In *The Sunrider Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-416/04 P the ECJ stated:

“72 It follows that it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A de minimis rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order in *La Mer Technology*, paragraph 25). Thus, when it serves a real commercial purpose, in the circumstances referred to in paragraph 70 of this judgment, even minimal use of the trade mark can be sufficient to establish genuine use (order in *La Mer Technology*, paragraph 27).”

27. The applicant has claimed continuous use of the trade mark since an unspecified date in 1993. Annual sales figures for the years 2000 to 2006 are given which, whilst likely to be small in terms of the relevant clothing market are not insignificant of themselves. But there is no explanation of whether all or any, and if so what proportion of those figures relate to sales within the UK. No advertising is made of the mark. Labels said to be used on garments have been provided but they are not dated in any way. Photocopied photographs of a number of garments have been provided, though the photocopies are not clear enough to enable me to say what type of garments they show nor are they dated. There is no evidence as to whether and if so when, any garments may have been sold under the mark. Invoices have been provided and they date from December 2002 to April 2006. Mr Sandhu says these invoices show “the type of clothing that my Company sells under the mark MATERIAL GIRL”. Whilst they may show the type of clothing sold under the mark, he does not say that the invoices themselves actually relate to clothing sold under the mark. Certainly none of them bear any reference whatsoever to the mark.

28. In *Laboratoire De La Mer Trade Marks* [2002] FSR 51 Jacob J held:

“9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye -- to ensure that use is actually proved -- and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted...”

29. Furthermore, in *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-39/01 [2003] ETMR 98 the Court of First Instance stated:

“47 In that regard it must be held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned.”

30. The limited evidence before me is insufficient, in my view, to satisfy me that the registered proprietor has made any use of the mark in relation to any of the goods for which the mark is registered. Whilst labels and copy receipts for labels have been exhibited as evidence, there is no evidence to show if, and if so when, where and on

what goods, they were used. The registered proprietor might well be involved in the manufacture and sale of clothing but despite the sales figures provided, there is no evidence to support his claim to have used the mark in relation to those sales whether or not within the relevant periods.

31. Accordingly, the application for revocation of the registration succeeds in relation to all the goods for which it is registered. The application for revocation has succeeded under both sections 46(1)(a) and (b). In accordance with section 46(6)(b), the rights of the proprietor will be deemed to have ceased from the earlier date, that is with effect from 1 April 2000.

Costs

32. The application for revocation having succeeded, the applicant is entitled to an award of costs. I take into account that the evidence filed was minimal and in some instances duplicated and that the decision was reached without a hearing having taken place and without any written submissions being filed. In all the circumstances, I order the registered proprietor to pay the applicant the sum of £850 as a contribution towards her costs. That sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of September 2007

**Ann Corbett
For the Registrar
The Comptroller-General**