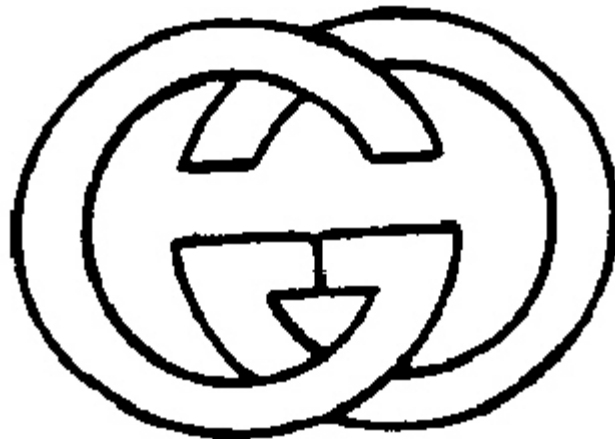


O-441-13

TRADE MARKS ACT 1994

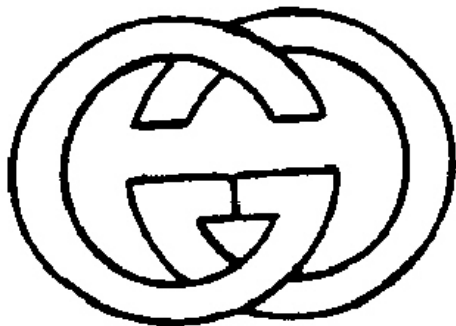
IN THE MATTER OF REGISTRATION NO. 1082541
IN THE NAME OF GUCCIO GUCCI S.P.A.
OF THE TRADE MARK



AND THE APPLICATION FOR REVOCATION THERETO
UNDER NO. 84452
BY GERRY WEBER INTERNATIONAL AG

Background and pleadings

1. On 23 April 2008, trade mark registration number 1082541 was merged with three other registrations (1082538, 1082539 and 1082540). Under rule 20(6) of the Trade Marks Rules 2000 (as amended), which were in force at the time of the merger, the date of registration of the final merged registration is the latest of the registration dates of the merged registrations. The date on which the registration procedure was completed for 1082541 was the latest of these: 11 July 1984. The date of completion of the registration procedure for merged trade mark registration 1082541 is therefore 11 July 1984¹. Nothing in this decision turns upon this date². The trade mark, shown below, is registered for the following goods:



Class 3: *Non-medicated toilet preparations, cosmetic preparations, perfumes, soaps, dentifrices, preparations for the hair; anti-perspirants, depilatory preparations.*

Class 14: *Bracelets included in Class 14, watches, necklaces, earrings; tableware and keyrings, all of precious metals or coated therewith.*

Class 18: *Handbags, pocket wallets, shoulder bags, holdalls, travelling bags, toilet bags, brief cases, umbrellas, attache cases, document cases, whips, walking sticks; pouches, cases all included in Class 18; purses (not of precious metal or coated therewith); key fobs, card cases, holders for paper tissues, passport cases, all made of leather.*

Class 25: *Scarves, blouses, trousers, T-shirts, cardigans, jumpers, skirts, coats; socks and belts, all being articles of clothing; all made from textile materials or from knitted materials; shoes and boots.*

2. On 15 June 2012, Gerry Weber International AG (“the applicant”) filed an application for the revocation of registration number 1082541, owned by Guccio Gucci S.p.A. (“the registered proprietor”), on the grounds of non-use.

¹ As per the notice in *Trade Marks Journal* 5725, which confirmed that, prior to June 1986, the date of the *Journal* in which the fact of registration was recorded in the list of trade marks registered was the actual date of registration; see the decision of Geoffrey Hobbs Q.C., as the appointed person, in *WIS/ [2006] RPC* 17. UK trade mark number 1082541 was recorded as registered in *Journal* 5522, published on 11 July 1984.

² Section 46(1)(a) of the Trade Marks Act 1994 was not pleaded.

3. The applicant seeks revocation of the registration in full under section 46(1)(b) of the Trade Marks Act 1994 (“the Act”). It claims that no use was made of the mark for the goods as registered in the five year period 1 February 2003 to 31 January 2008; alternatively, no use was made of the mark for the goods as registered in the five year period 15 June 2007 to 14 June 2012. The applicant claims effective dates of revocation of either 1 February 2008 or 15 June 2012. There is some confusion over the dates pleaded. The dates given above were entered into an amended version of the statutory form TM26(N), but an additional page attached to that form matches that attached to the earlier, erroneous TM26(N). The attached page refers to non-use “during an earlier five year period expiring on 1st February 2003” and a request for revocation “from either 15th June 2012, or 1st February 2003” or a date in between, if grounds existed at another date. An earlier period expiring on 1 February 2003 would not have a revocation date of 1 February 2008. This is repeated in paragraph 3 of the registered proprietor’s evidence. I note that the dates in boxes 6 and 7 of the amended TM26(N) clearly set out the five year date periods and the dates of revocation which correspond to those periods. These are 1 February 2003 to 31 January 2008 (effective date 1 February 2008) and 15 June 2007 to 14 June 2012 (effective date 15 June 2012).

4. The registered proprietor filed a counterstatement in which it opposed the application for revocation.

5. The registered proprietor filed evidence, but the applicant did not. The registered proprietor sought to file further evidence, a request which I refused at a case management conference held on 17 July 2013, giving my reasons in a letter of the same date (on file). I refused the registered proprietor’s request, made under rule 70(2) of the Trade Mark Rules 2008, for leave to appeal in a letter dated 11 September 2013 (also on file). The parties chose to have a decision on the substantive merits of the case made from the papers, rather than after a hearing. Both sides filed written submissions in lieu of a hearing. I have considered all the evidence and submissions made by both parties.

Evidence

6. The registered proprietor has filed a witness statement made by Vanni Volpi, who is Intellectual Property Counsel for the registered proprietor. Mr Volpi states that all the facts in his statement are from his own knowledge, unless obtained from the records of the proprietor, to which he has full access.

7. Mr Volpi states that the registered proprietor’s goods, which he refers to as “ready to wear and couture clothing, handbags, wallets, sunglasses, watches, shoes, jewellery, and associated accessories”, are marketed in the UK and around the world “under a variety of brands including the iconic GG logo which is the mark the subject of Registration No. 1082541”. Mr Volpi refers to the proprietor as being amongst the 50 most valuable brands in the world³, but does not explain the relevance of this claim in relation to the trade mark which is the subject of the non-use attack. He gives evidence about the company’s history and 2008 worldwide revenue, but does not explain how this affects the non-use claim. Exhibit 1, from Wikipedia, gives a

³ Exhibit 1.

history of the registered proprietor and refers to the adoption in the 1960s of the famous GG logo, but the relevance to this in the periods of non-use claimed is not explained. Similarly, Mr Volpi refers to the proprietor's website gucci.com as having, e.g. 1,442,697 'hits' in the UK in 2008, but not whether the mark in suit was involved.

8. By way of Exhibit 2, Mr Volpi refers to the proprietor's stores in the UK (in London, Glasgow, Manchester and Birmingham). He states that the mark

"is used prominently throughout the stores, not only on the goods covered by the Registration, but also at point-of-sale advertising, on receipts, swing tags and bags."

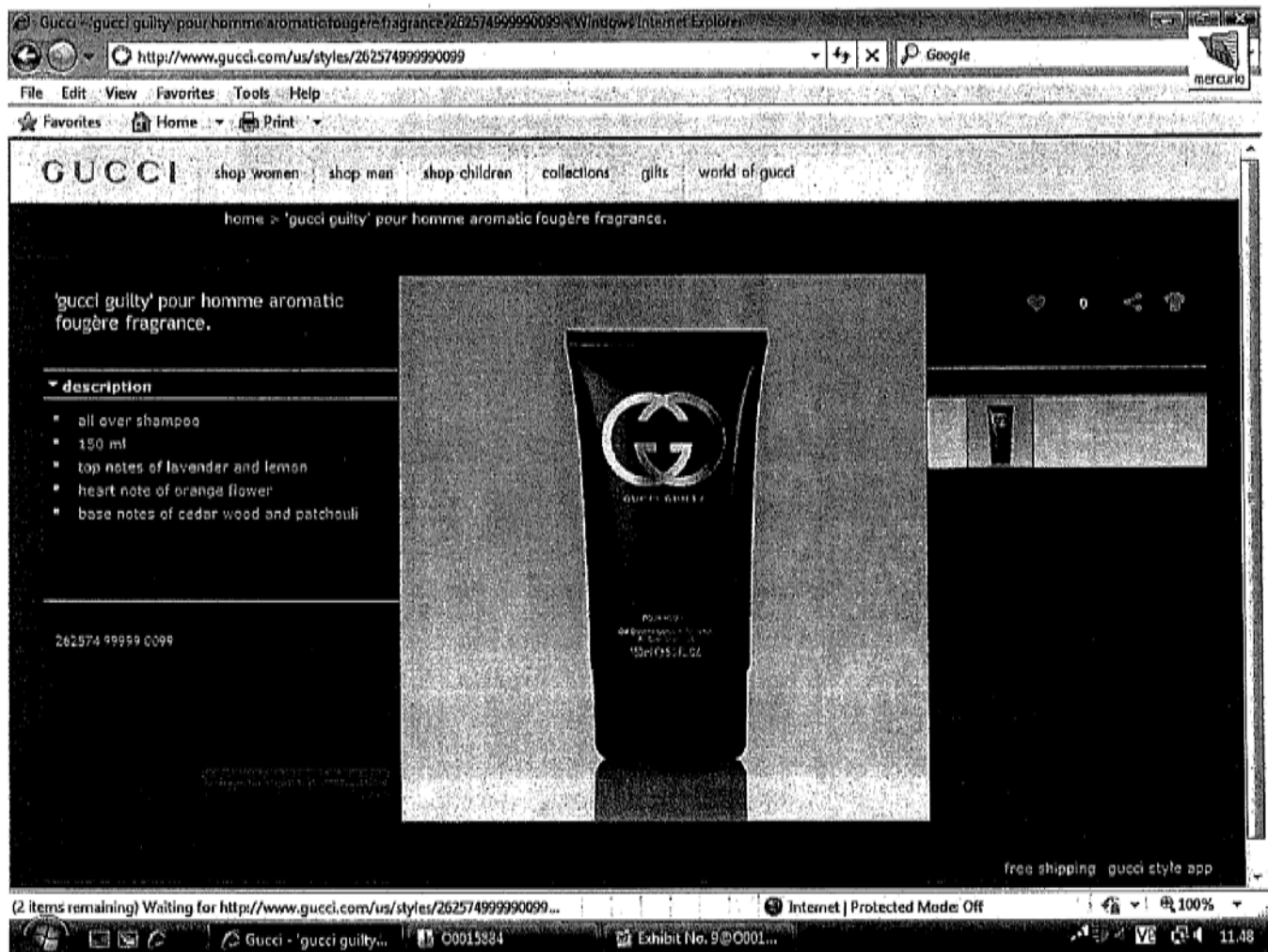
Further, Mr Volpi states that the mark is used in catalogues, referred to as 'look books', produced annually as Autumn-Winter, Spring-Summer and Cruise. Mr Volpi states that the items shown in the look books are also available in store.

9. In relation to class 3 goods, Mr Volpi states that the mark has been used on the products EAU DE GUCCI, GUCCI NO 1, GUCCI NO 3 and GUCCI POUR HOMME in the UK since 1985. He exhibits a photograph⁴ which he submits shows the mark used as a distinctive element of the packaging:

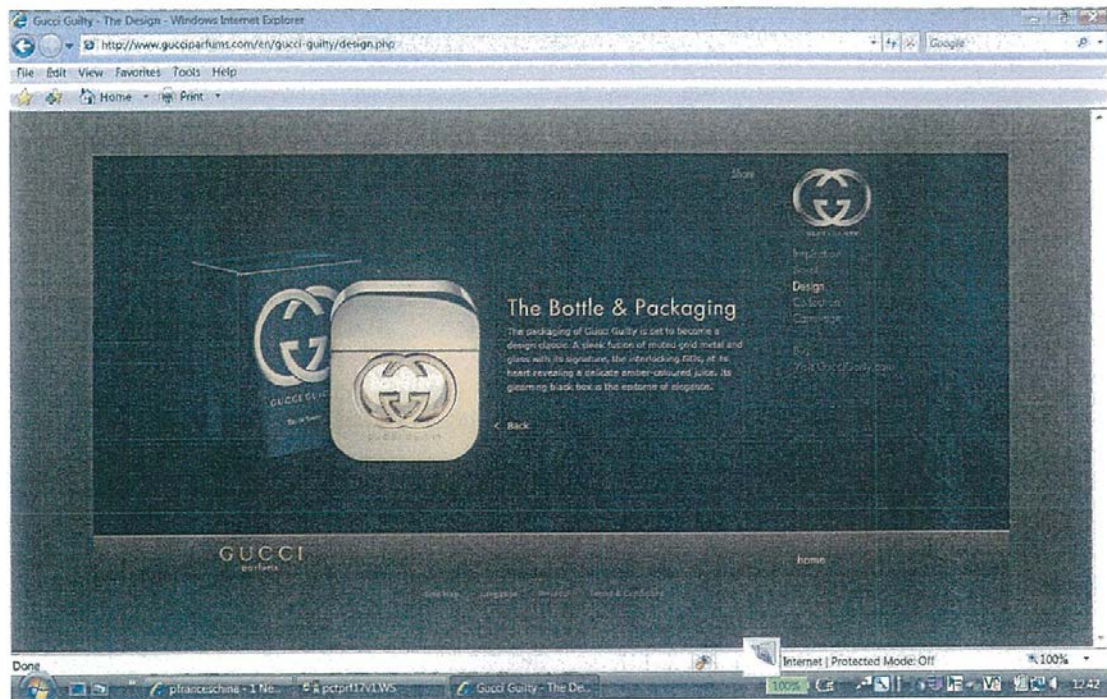
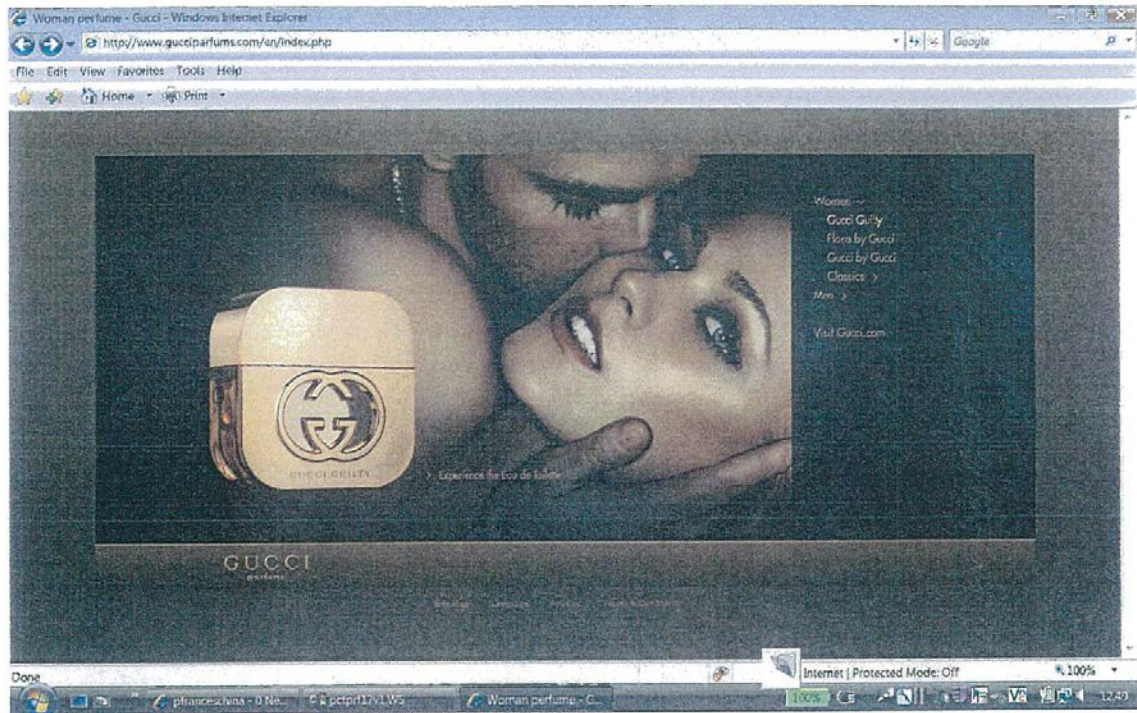


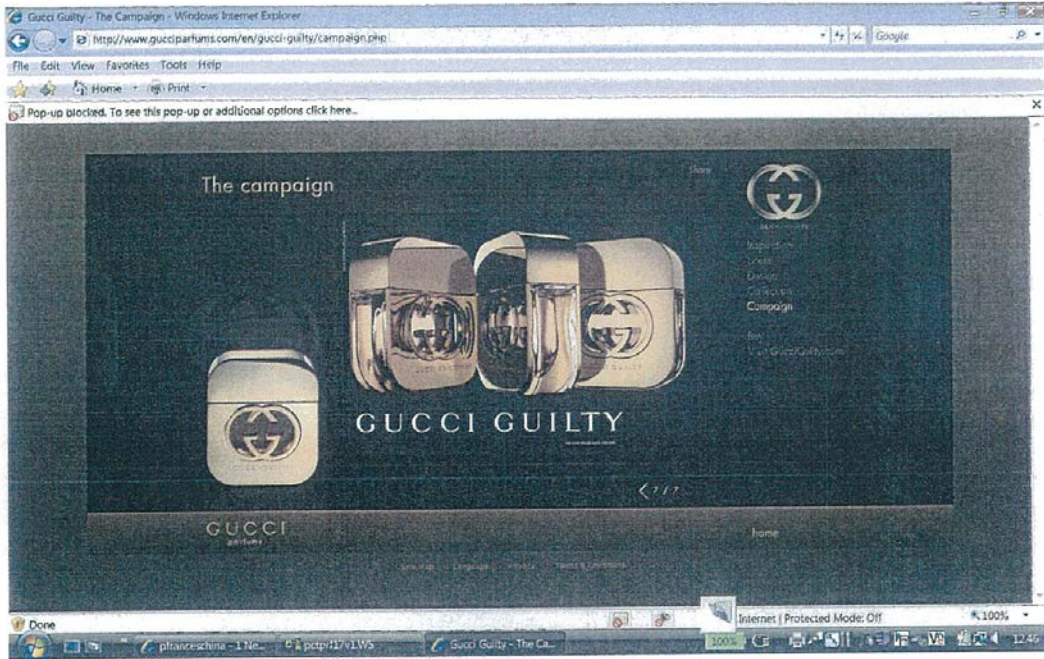
⁴ Exhibit 3.

10. Mr Volpi states that the mark was also used from October 2010 for the fragrance GUCCI GUILTY, as per Exhibit 4:



The domain name for this page is www.gucci.com/us/styles. Similar pages, for the domain name www.gucci.com/it/styles, show a solid version of the mark (as above) on boxes, tubes and bottles, but the product descriptions are in Italian. Pages 24 to 27 of the exhibit are headed with a domain name of www.gucciparfums.com/en:





Pages 28 and 29 look like a press release for Gucci Guilty but it is undated and there is no explanation as to what it represents, where it appeared, or when it appeared. However, there is a reference within the text on page 29 which says that “Gucci Guilty for Women will launch globally in mid-September 2010”, as an eau de toilette, body massage oil, body powder and body soufflé. The contact details given at the bottom of page 29 include telephone numbers which do not appear to be UK numbers.

11. Mr Volpi exhibits invoices from 2010, 2011 and 2012 in Exhibit 5. He states that sales of class 3 goods featuring the mark amounted to €11,281,133 in 2010; €21,851,449 in 2011; and €1,768,068 until March in 2012. Mr Volpi does not state that these are UK figures (and they are shown in euros). He does not differentiate between the various goods in class 3 for which the mark is registered. The invoices are from P&G Prestige Products (which appears, although it is not stated, to be the ultimate parent company of the registered proprietor: the press release in Exhibit 4 is headed "P&G".) There are two invoices from 2010. The first is to House of Fraser, Glasgow, for 3 bottles of Gucci Guilty eau de toilette and 3 sprays, at a total cost of £171.12, on 10 December 2010. The second invoice is to Debenhams, Southampton. It is hard to read the quantities, but the items ordered are Gucci Guilty eau de toilette and body lotion, at a total cost of £2619.51, on 10 December 2010. There are three invoices from 2011. The first is to Brook House Pharmacy, in Essex, on 7 October 2011. The order was for Gucci Guilty sprays (3 bottles) and eau de toilette (3 bottles), at a cost of £114.80. The second invoice from 2011 is to Gill Chemist, in Middlesex, on 22 November 2011. The order was for a mixture of Gucci Guilty sprays and perfumes of various sizes, totalling 27 items at a cost of £527.47. The third invoice is dated 7 October 2011, to Debenhams in Stratford-upon-Avon. The order came to £214.54, for a mixture of Gucci Guilty sprays and eau de toilette bottles. There are three invoices for 2012, dating from 13 March 2012, 10 February 2012 and 29 June 2012, the last of these being after the relevant period (ending on 15 June 2012). The 13 March 2012 invoice is to Debenhams in Ipswich, for 6 bottles of Gucci Guilty eau de toilette, at a cost of £129.20. The 10 February 2012 invoice is to Debenhams in Swansea, for 6 bottles of Gucci Guilty eau de toilette at a cost of £103.34. The invoice after the relevant date is to Debenhams in Sutton for 3 bottles of Gucci Guilty eau de toilette, at a cost of £56.25.

12. The next part of Mr Volpi's statement addresses goods in class 14. Mr Volpi states that sales of class 14 goods featuring the mark are as follows:

2011	£ -
2010	£1,808
2009	£17,337
2008	£4,770
2007	£3,063
2006	£2,730

Mr Volpi does not state that these are UK figures but the amounts are in sterling. He does not differentiate between the various goods in class 14 for which the mark is registered.

13. Mr Volpi refers to Exhibit 6 in relation to class 14 goods but does not explain what the exhibit contains. It appears to comprise copies of front pages of catalogues (e.g. 'Jewellery collection Fall/Winter 2005/2006'). The front pages of the catalogues only show the mark GUCCI. There are catalogues for the years 2004, 2005 and 2006 showing various items of jewellery. Later in the exhibit, pages showing watches are exhibited, but there are no dates other than a copyright date: "©1988 GUCCI TIMEPIECES". It is also not possible to see the registered mark on or next to the watches; there is a device on the watch faces which looks like two interlocking circles, but the representations are unclear. In Exhibit 7, page 89 says

“Spring/Summer 2006” and page 90 shows a watch. The only trade mark visible on the watch is GUCCI.

14. I give below a breakdown of the types of items appearing in Exhibit 6, together with some representations. The representations I have included are those which I consider to be relevant to these proceedings; some of the items in the catalogues bear no trade marks, and some bear the mark GUCCI (but no other marks).

(i) Fall/winter 2005/2006: bracelets and necklaces



(ii) Spring/summer 2006: bracelet and necklace as shown above.

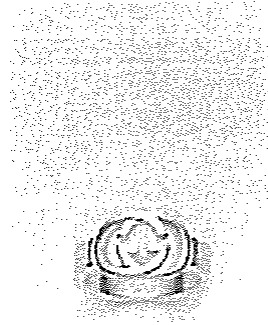
(iii) Fall/winter 2004/5: key chains, money clips, a mixer spoon, olive picks, rings and necklaces



134927 GG MONEY CLIP



134925 GG KEY CHAIN



132801 GG MIXER SPOON



132798 GG OLIVE PICKS (6 PC SET)



15. Some of the catalogues do not bear any dates; instead, for example, page 53 of the evidence is a front page saying “GUCCI cruise collection/season 21”. I do not know which year included “cruise collection/ season 21”, so I have not included references to the items which follow the page. There are no invoices shown for goods in class 14.

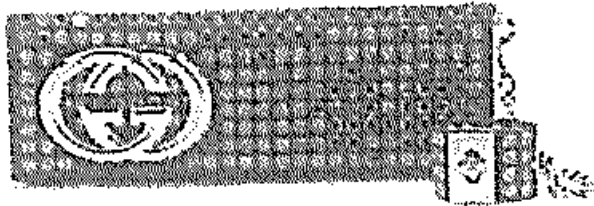
16. Mr Volpi states that sales of class 18 goods featuring the mark are as follows:

2011	£1,914,418
2010	£4,327,719
2009	£2,694,908
2008	£215,309
2007	£172,231,
2006	£53,862 ⁵

Mr Volpi does not state that these are UK figures but the amounts are in sterling. He does not differentiate between the various goods in class 18 for which the mark is registered. Mr Volpi refers to Exhibit 7 as comprising copies of various look books, said to show use of the mark in relation to bags and other class 18 goods.

17. The front pages of the look books date from the years 2004, 2005, 2006 and 2007. Pages 113 to 118 of the evidence in this exhibit are pages from the website www.gucci.com/it, showing wallets. The information provided on the pages is in Italian. The front pages show only the mark GUCCI.

18. The Spring/Summer 2006 look book shows handbags and clutch bags/evening bags, for example:



⁵ It is assumed that the figure Mr Volpi gives of £5,3862 is a typographical error.



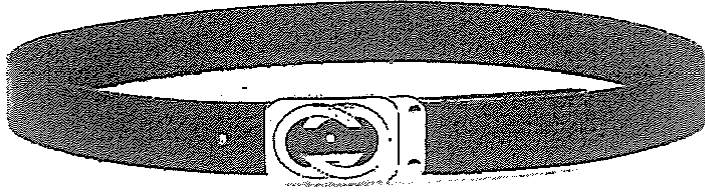
There are no other class 18 goods shown in the look books (the other goods are belts, and ladies' shoes and boots). There are no invoices shown for goods in class 18.

19. Mr Volpi states that sales of class 25 goods featuring the mark are as follows:

2011	£1,762
2010	£34,818
2009	£88,317
2008	£52,301
2007	£8,378
2006	£ -

Mr Volpi does not state that these are UK figures but the amounts are in sterling. He does not differentiate between the various goods in class 25 for which the mark is registered. Mr Volpi refers to Exhibit 7 as comprising copies of various look books, said to show use of the mark in relation to shoes, belts and "other goods in class 25". The front pages of the books show only the mark GUCCI.

20. The Fall/Winter look book from 2006/2007 shows the following belt:



138610 MEN'S BELT (4 CM WIDTH)

Similar men's and women's belts are shown in the Fall/Winter 2004/2005, Spring/Summer 2005, and Fall/Winter 2005/2006 look books. Page number 104 of the evidence is annotated "Fall Winter 2006-2007 (WShoes)". This page and those which immediately follow it show boots and shoes, such as:





21. Mr Volpi states that the registered proprietor advertises in national and international business magazines and newspapers, and assists its licensees in producing marketing materials. He does not refer to the registered mark other than to state that "Gucci public relations efforts target the fashion press, including national fashion magazines and create publications, offering products bearing the mark for

photographic shoots and providing up-to-date product information.” Mr Volpi states that public relations staff are based in major cities throughout the world, including London. Mr Volpi gives figures spent on advertising the registered proprietor’s brands in the UK, “including the mark”. These figures are €35,487 in 2008; €82,671 in 2009; €73,338 in 2010; and €46,594 in 2011, in publications such as *Vogue*, *GQ*, *Sunday Times Style*, *Vanity Fair* and *Esquire*. As an example, he refers to Exhibit 8 which is an extract from the UK edition of *Vogue* from April 1981, over 20 years prior to the relevant dates for these proceedings.

Decision

22. Section 46 of the Act reads as follows:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

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

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

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

23. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is

aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(4) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]"

24. Use which amounts to real commercial exploitation of the mark on the market for the goods means that there must have been exploitation that is aimed at maintaining or creating an outlet for the services, or a share in that market. The assessment can only be made on the basis of the evidence filed by the registered proprietor, because Section 100 of the Act states:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

25. The Trade Marks Rules 2008 apply to these proceedings, which were commenced in June 2012. Rule 38 of the 2008 rules states:

"38. (1) An application to the registrar for revocation of a trade mark under section 46, on the grounds set out in section 46(1)(a) or (b), shall be made on Form TM26(N).

(2) The registrar shall send a copy of Form TM26(N) to the proprietor.

(3) The proprietor shall, within two months of the date on which he was sent a copy of Form TM26(N) by the registrar, file a Form TM8(N), which shall include a counter-statement.

(4) Where the proprietor fails to file evidence of use of the mark or evidence supporting the reasons for non-use of the mark within the period specified in paragraph (3) above the registrar shall specify a further period of not less than two months within which the evidence shall be filed.

(5) The registrar shall send a copy of Form TM8(N) and any evidence of use, or evidence supporting reasons for non-use, filed by the proprietor to the applicant.

(6) Where the proprietor fails to file a Form TM8(N) within the period specified in paragraph (3) the registration of the mark shall, unless the registrar directs otherwise, be revoked.

(7) Where the proprietor fails to file evidence within the period specified under paragraph (3) or any further period specified under paragraph (4), the registrar may treat the proprietor as not opposing the application and the registration of the mark shall, unless the registrar directs otherwise, be revoked.

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

26. Under the previous set of rules (The Trade Marks Rules 2000), the registered proprietor had two bites of the evidence cherry. An arguable defence had to be mounted under rule 31(3) and a further opportunity was provided under rule 31(6) for the registered proprietor to supplement that evidence, having first seen the applicant’s evidence (filed under rule 31(5)):

“31. (1) An application to the registrar for revocation under section 46(1)(a) or (b) of the registration of a trade mark shall be made on Form TM26(N) together with a statement of the grounds on which the application is made; the registrar shall send a copy of the application and the statement to the proprietor.

(2) Within three months of the date on which a copy of the notice and statement is sent by the registrar to the proprietor, the proprietor may file a counter-statement, in conjunction with notice of the same on Form TM8 and either:

(a) two copies of evidence of use made of the mark; or

(b) reasons for non-use of the mark.

Where such a notice and counter-statement, and evidence of use of the mark or reasons for non-use of the mark, are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement, and

the evidence of use of the mark or the reasons for non-use of the mark, to the applicant.

(3) Where a counter-statement, in conjunction with a notice of the same, on Form TM8, and evidence of use of the mark or reasons for non-use of the mark, are not filed by the proprietor within the period prescribed by paragraph (2), the registrar may treat his opposition to the application as having been withdrawn.

(4) Within three months of the date upon which a copy of the Form TM8 and counter-statement is sent by the registrar to the applicant, the applicant may file such evidence as he may consider necessary to adduce in support of the grounds stated in his application and shall send a copy thereof to the proprietor.

(5) If the applicant files no evidence under paragraph (4) above in support of his application, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his application.

(6) If the applicant files evidence under paragraph (4) above or the registrar otherwise directs under paragraph (5) above, the proprietor who has filed a notice and counter-statement under paragraph (2) above may, within three months of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such further evidence as he may consider necessary in support of the reasons stated in the counter-statement and shall send a copy thereof to the applicant.

(7) Within three months of the date upon which a copy of the proprietor's evidence is sent to him under paragraph (6) above, the applicant may file evidence in reply which shall be confined to matters strictly in reply to the proprietor's evidence, and shall send a copy thereof to the proprietor.

(8) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.

(9) ...

(10) ...”

27. The registered proprietor did not file evidence within the rule 38(3)⁶ period, but did file evidence within the further period specified by the registrar under rule 38(4), after which the applicant was given a period of time to file evidence. The applicant chose not to file evidence. It is not unusual for applicants in non-use proceedings to choose not to file evidence, the burden of proof being upon the registered proprietor. Tribunal Practice Notice 2/2010 sets out the sequence for the evidence rounds (my italics):

⁶ Trade Marks Rules 2008

“Rule 38 Application for revocation (on the grounds of non-use)

The registered proprietor

8. Having been served with the applicant’s form TM26(N), the registered proprietor will be allowed two months to file form TM8(N) ‘Notice of defence and counterstatement’ together with the evidence of use (or proper reasons for non-use) it intends to rely upon in order to defend the registration. If a counterstatement is filed without evidence (as the rules permit), the registrar will specify a further period, normally of two months, within which any evidence in support of the trade mark registration may be filed.

The applicant for revocation

9. Following the serving of the counterstatement, the applicant will normally be permitted two months to file any evidence or written submissions in response to the registered proprietor’s counterstatement and evidence of use of the trade mark (or proper reasons for non-use).

The registered proprietor

10. If the applicant files evidence of fact, the registered proprietor will be given one month from receipt of the applicant’s evidence, in which to notify the Registry of their intention to file evidence of fact in reply. The period for filing evidence in reply will then be set; normally to one month (i.e. one further month will be allowed).

11. The evidence rounds will be regarded as complete when:

a) The period for the applicant to file evidence of fact/submissions has passed and the applicant has filed no evidence of fact; or

b) The applicant has filed evidence of fact and the period has passed for the registered proprietor to file evidence in reply.”

28. The 2008 rules, complemented by the guidance in the Practice Notice, are constructed in such a way as to provide a framework for achieving finality to the evidence rounds, and, an expectation of finality. Despite the evidence rounds having finished, because the applicant had not filed any evidence, the registered proprietor sought to file a second set of evidence (as if the 2000 rules applied). The evidence could not be considered to be evidence in reply because the applicant had not filed evidence; there was nothing to reply to. Such a request properly fell under rule 38(8) of the 2008 rules; a request that the registrar exercise discretion to allow further evidence to be filed. Of substantial significance in deciding upon such a request is the materiality of the evidence in relation to the issues to be decided. No copy of the evidence was provided, in which case it was incumbent upon the registered proprietor to give a clear explanation of the materiality of the evidence; i.e. what difference it might make to the substantive decision. However, the registered proprietor declined to give any such explanation for fear of exposing the gaps in the

evidence which I have summarised earlier in this decision. At a case management conference held on 17 July 2013, I refused to admit the second set of evidence⁷. Without information enabling me to decide the materiality of the evidence, there was no basis to exercise discretion.

29. It was for the registered proprietor to put forward its best evidence when it was given the opportunity to do so under rule 38(4), not to wait for the applicant to criticise that evidence, and therefore expose gaps, which the registered proprietor might then seek to fill with another set of evidence⁸. In *Plymouth Life Centre, O/236/13* Mr Daniel Alexander QC, sitting as the appointed person, observed that:

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

The evidence which was filed came from the registered proprietor’s in-house intellectual property counsel, Mr Volpi. In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd* (‘CATWALK’), BL O/404/13, Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“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.

⁷ For the record, the applicant opposed the request.

⁸ In *Laboratoire De La Mer Trade Marks* [2002] FSR 51, Jacob J said: “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.”

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."

30. The applicant submits that Mr Volpi's evidence falls far short of the mark for showing genuine use. It points out that genuine use cannot be proven by probabilities or suppositions but must be demonstrated by solid and objective evidence. However, I also bear in mind that, although criticisms can be made of individual items of evidence, the registrar must stand back and take a view of the evidence in its entirety. It is a matter of viewing the picture as a whole. I also bear in mind that the genuine use provision is not there to assess economic success or large-scale commercial use, and even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. An assessment as to whether there has been real commercial exploitation therefore includes consideration as to the nature of the goods and the characteristics of the market concerned.

31. The applicant criticises the evidence for the general, non-specific claims made across classes of goods without clear indication as to the specific goods which have been sold. That is not to say that determining a fair specification should be done by listing only the specific goods which appear in the evidence. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, Mr Geoffrey Hobbs QC, sitting as the appointed person said:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

32. Mr Volpi makes broad claims without also referring to specifics. His evidence about 'Gucci', its reputation, and the company's length of trading are of no assistance. I agree with the applicant's submission that "Evidence of the fame of the proprietor of a mark is not evidence of use of a mark owned by that party". The advertising figures are for the registered proprietor's brands "including the mark". Mr Volpi states that the registered proprietor advertises in national magazines and the press, but does not show any such advertisements. It is impossible to extract anything from this statement. The only advertisement which is shown dates from 1981, over two decades before the relevant dates.

33. Mr Volpi states that he has full access to the records of the proprietor, as its intellectual property counsel. With full access to records, it should have been possible to have filed examples of the advertisements to which he refers. There is

also an absence of proof of sales. Apart from the invoices in relation to goods in class 3, there are no other invoices in the evidence. Turnover figures are given for goods in classes 14, 18 and 25, but there are no invoices. This is important because for all of the classes Mr Volpi states that the figures represent sales, but does not say in which country the sales took place. Class 3 figures are given in Euros, but for the other goods the figures are in sterling. No explanation is given for the different currency. If sufficient and specific invoices had been exhibited, they would have assisted in corroborating the turnover figures.

34. Mr Volpi has provided invoices in respect of some goods in class 3, for 2010, 2011 and 2012 (to March of that year). The two invoices for 2010 were both dated 10 December 2010, for Gucci Guilty goods. The sales amounted to £2790.63. Even allowing for the mark-up to the end-consumer, and the difference in currency, this represents a tiny fraction of the sales figure which Mr Volpi gives for 2010 for class 3 goods: €11,281,133. Two of the invoices for 2011 were dated 7 October 2011 and the third 22 November 2011. They amount to £856.81 for Gucci Guilty. The turnover figure for 2011 for class 3 goods is stated to be €21,851,449. The two invoices for 2012 which are within the relevant periods are dated 10 February 2012 and 13 March 2012 and amount to £232.54 for Gucci Guilty. The turnover figure for Class 3 goods in 2012 was €1,768,068.

35. Mr Volpi does not provide a narrative in relation to the registered mark except to state that, for all the goods, the mark appears not only on the goods, but also on point-of-sale advertising, receipts, swing tags and bags. None of these are shown in the evidence. Other than this, where there is a narrative, it is in relation to 'Gucci' (the registered proprietor). There is no explanation or elaboration in relation to turnover or the copies of pages in the look books. For example, there is no explanation as to when "Cruise Collection/Season 21" was published. The witness statement, in relation to class 14, simply says "I refer to exhibit 6" (pages from the look book, summarised in paragraphs 1 to 15 of this decision) and gives a table of turnover figures for the class, without confirming that the figures relate to the UK. A similar format is used for the evidence in classes 18 and 25.

36. For class 3, Mr Volpi refers to the use of the mark on various Gucci perfume products and substantiates his statement with exhibit 3, shown in paragraph 9 of this decision; but the mark is not visible. There is a single sentence to explain the connection between the registered mark and the Gucci Guilty perfumes appearing on the invoices: "The mark was used again, starting on October 2010, for the fragrance GUCCI GUILTY and I refer to photographs of the same marked Exhibit 4". This exhibit is summarised in paragraph 10 of this decision, consisting of web pages, not photographs of the goods. Some of the web pages are in Italian with an Italian domain name. Another has a US domain name. Pages from a website called www.gucciparfums.com/en could be from the UK, owing to the use of 'en' in the URL; however it is more usual to use the designation 'uk'. The applicant submits that these 'en' pages could simply signify an English language version, without the pages being necessarily from a UK website.

37. A feature of the content of these pages is that they have the flavour of a press release prior to the goods being released for sale, rather than pages from which goods can be purchased. It will be seen in the images reproduced in paragraph 10

that one of the pages refers to “The Bottle & Packaging” and another to “The campaign”. Preparations to put goods or services on the market, such as advertising campaigns, are an example of real commercial exploitation of the mark which is aimed at maintaining or creating an outlet for the goods or services. Mr Volpi has made a statement to the effect that the ‘photographs’ in this exhibit, which look as though they are publicity pages, represent the mark used in relation to the Gucci Guilty perfume products. The P&G press release refers to the launch of the perfume in October 2010. The first invoice is from December 2010. All the invoices show sales of the perfume and although the amounts are small, they are nevertheless consistent over time, going through to March 2012. I think it likely that the turnover figures are not confined to the UK and therefore are not of much assistance. However, standing back from the various pieces of class 3 evidence, and viewing the whole, they do combine to provide a picture of sales of a fragrance product which carried the registered mark, or a form of it, within the second period claimed, throughout the UK, and in well-known department stores. The picture which emerges is sale of fragrance, not all the other goods for which the mark is registered in class 3. Some of the registered goods are very closely allied to eau de toilette; I note that one of the invoices includes Gucci Guilty body lotion, a type of item often sold with sprays of the same fragrance. I consider that a fair specification is *non-medicated toilet preparations; perfumes*. There has been no use shown on dentifrices and depilatory preparations, both of which are quite specific, discrete types of goods.

38. The applicant submits that the mark which appears on the web-page pictures is different to the registered mark. The bottom part of the registered mark is more ‘closed’ than that shown on the web pages and in the P&G press release. To my mind, there is not much difference. The distinctive character of the mark resides in the arrangement of the interlocking circular devices. The straight part at the bottom of the device is retained in use and although slightly further apart than in the registration, does not increase or lessen the level of distinctive character of the mark or alter its impression⁹. The difference is not great enough to fall foul of section 46(2) of the Act; i.e. the mark in use has not differed in elements which alter the distinctive character of the mark in the form in which it was registered.

39. The applicant also submits that the mark appears to be used as decoration rather than as a trade mark. This submission is chiefly levelled at the goods in classes 14, 18 and 25. In relation to class 3, I consider that for those goods, marks are commonly used dually as both trade marks and decoration (e.g. on perfume bottles). The use of the device on the packaging (in the web pages) is trade mark use.

40. In relation to all the goods in classes 14, 18 and 25, I reach the conclusion that the registered proprietor’s evidence is not sufficient to show “actuality of use” of the registered mark on the goods for which it is registered in these classes. I do not

⁹ In *Bud/Budweiser Budbrau* [2003] RPC 25, Lord Walker of Gestingthorpe stated: “43. ...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

need, therefore, to consider the decoration versus trade mark issue in relation to the goods in classes 14, 18 and 25. The factors which I have considered are:

- The only documentary evidence of goods showing the mark is a collection of pages from look books, some of which are undated and some of which are in Italian. Those which are dated (none are dated after 2006) are scant and show a very limited selection of goods. The mark GUCCI appears on the front pages.
- Leather belts appear in the exhibits, but the specification in Class 25 expressly limits belts to textile belts.
- The evidence in relation to watches relates to 1988 and it is not possible to see the registered mark.
- The turnover figures are in sterling but are not stated to be UK figures. This would not be fatal if corroborative evidence supported the turnover figures.
- There are no invoices. Invoices are provided in relation to some class 3 goods, but are conspicuous in their absence for goods in classes 14, 18 and 25.
- There is no evidence of point-of-sale advertising, receipts, swing tags and bags, and no evidence of advertisements for any of the goods other than an extract from the April 1981 edition of *Vogue*. There is no evidence of the up-to-date product information to which Mr Volpi refers.

41. In criticising the individual pieces of evidence, I have not lost sight of the potential for a picture to emerge which shows genuine use when they are all viewed together. Although they are individually less than compelling, the various parts might corroborate each other. However,

- (i) a combination of turnover figures about which there is no statement that they relate to UK sales, and
- (ii) no breakdown at all as to types of goods, and
- (iii) no invoices at all, and
- (iv) no indication as to number of goods (of any type) sold, and
- (v) no packaging and no advertisements other than one from 1981, and
- (vi) a loose collection of pages, many undated, showing a very scant range of goods,

does not present me with a picture of genuine use when I put the pieces together. The registered proprietor has not shown genuine use of the mark for any of the goods for which the mark is registered in classes 14, 18 and 25.

Outcome

42. The mark may remain registered for *non-medicated toilet preparations; perfumes* in class 3. It is revoked from 1 February 2008 for all other goods for which it is registered.

Costs

43. The applicant has been largely successful and is entitled to an award of costs, offset by the degree of success on the part of the registered proprietor. The registered proprietor had requested off scale costs on account of the delays caused by the applicant, which it submitted were the amendments necessary to the TM26(N); the directions to the applicant to paginate its evidence; a one month extension of time for the applicant to file evidence, which was subsequently not filed; a request for an extension to the time allowed for choosing whether to be heard, and another for filing written submissions in lieu of a hearing. I do not consider this to be behaviour that is so unreasonable that an award off the scale would have been appropriate. I add to this that the delays caused by the need to deal with the registered proprietor's request to file further evidence, after the evidence rounds had closed, neutralise the delays caused by the applicant. Applying a broad brush in relation to the offset, I award costs from the published scale¹⁰ as follows:

Preparing a statement and considering the counterstatement	£200
Application fee	£200
Considering the registered proprietor's evidence	£500
Written submissions	£300
Offset	-£200
Total:	£1000

¹⁰ Tribunal Practice Notice 4/2007.

44. I order Guccio Gucci S.p.A. to pay Gerry Weber International AG the sum of £1000. This 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 5th day of November 2013

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