

O-043-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2515426
BY BISON RIVER LIMITED TO REGISTER A SERIES OF NINE TRADE
MARKS**

**GEE GEE
Gee Gee
gee gee
GEE-GEE
Gee-Gee
gee-gee
GEEGEE
GeeGee
geegee**

IN CLASSES 3, 9, 14, 16, 18, 25, 28 AND 35

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 99892
BY GLORIA GUGGENHEIM**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No. 2515426
by Bison River Limited to register a series of nine trade marks
in Classes 3, 9, 14, 16, 18, 25, 28 and 35**

and

**IN THE MATTER OF Opposition thereto under No. 99892
by Gloria Guggenheim**

BACKGROUND

1) On 8 May 2009, Bison River Limited ("Bison"), of 47 High Street, Bassingbourn, Royston, Herts, SG9 5LD applied under the Trade Marks Act 1994 for registration of the following series of nine marks:

**GEE GEE
Gee Gee
gee gee
GEE-GEE
Gee-Gee
gee-gee
GEEGEE
GeeGee
geegee**

2) The application was in respect of a wide range of goods and services that it is not necessary to detail here. On 11 December 2009, Gloria Guggenheim of 10 Walpole Street, London, SW3 4QP filed notice of opposition to the application. The opposition is partial and only in respect to the following goods and services of Bison's application:

Class 3

Cosmetics, perfumes and toiletries; soaps; essential oils, dentifrices, mouthwashes, hair care products; personal grooming products; ...; parts and fittings for the aforesaid goods.

Class 35

Retail services connected with ..., cosmetics, perfumes and toiletries, soaps, essential oils, dentifrices, mouthwashes, hair care products, personal grooming products, ..., parts and fittings for ... the aforesaid goods; ...

3) The first ground of opposition is that the application is in respect of marks that are similar to two of Ms Guggenheim's earlier marks. Both marks are subject to the proof of use provisions by virtue of being registered more than five years before the publication of Bison's marks. In this context, Ms Guggenheim has claimed use in respect of *perfumes* only. The other relevant details of these marks are:

Relevant Details
Application No. 1334639 GIGI Filing date: 8 February 1988 Registration date: 6 March 1992
Application No. 2283062 GIGI Filing date: 12 October 2001 Registration date: 3 May 2002

4) The second ground of opposition is that Ms Guggenheim is entitled to protection in respect of the mark GIGI by virtue of the law of passing off and use of the contested mark by Bison would lead to misrepresentation. This mark was first used in the UK in 1993 in respect of *perfumes* and it is claimed that the mark has been used in respect of perfumes for many years and is well known as a mark used in respect of *perfumes*.

5) Bison subsequently filed a counterstatement denying Ms Guggenheim's claims and putting her to proof of use.

6) Only Ms Guggenheim filed evidence in these proceedings. Both sides included submissions in their statements and I will keep these in mind and both sides ask for an award of costs. Neither side wish to be heard and I therefore take the following decision based upon the papers before me.

Opponent's Evidence

7) This is in the form of a witness statement, dated 21 May 2010, by Nicholas Francis Preedy, Registered Trade Mark Attorney with Ms Guggenheim's representatives, HallMark IP Limited. At Exhibit NFP1 is a copy of a photograph of GIGI goods sold in the UK together with a series of photocopies. The photograph shows three containers coloured red and decorated with gold hearts. One of these containers contains GIGI perfume as is evidenced by a photocopy of its base where the words "GIGI PARFUM" are legible together with other illegible text. The next photocopy is of the outer packaging that is mainly plain,

but contains a barcode, a dark circle and the text “28/7854 GOLD HEARTS GIGI”.

8) At Exhibit NFP2, Mr Preedy produces a letter from “The May Fair”, dated 27 August 2009. It contains a list of products previously available for sale from August 2008 until July 2009 by Partridge Fine Art Limited. The products were transferred to “The May Fair” for safe keeping after Partridge Fine Art Limited went into administration. The list contains the following eight items:

“AN ENAMAL ‘VICTORAIN FLOWERS’ PERFUME ATOMISER” (two entries)

“AN ENAMAL ‘SILVER STARS’ PERFUME ATOMISER” (two entries)

“AN ENAMAL “SILVER STARS’ PERFUME” (one entry)

“AN ENAMAL ‘GOLD HEARTS’ PERFUME ATOMISER” (three entries)

9) In support that the earlier marks have been used in the UK, in respect of perfumes, since at least the 1960s, Mr Preedy provides Exhibit NFP4. This includes a copy of an advertisement dating back to the 1960s incorporating a stylised form of the GIGI mark. It also includes a copy of the details of a UK trade mark registration of this stylised version of the mark bearing a registration date of 7 July 1964.

10) Mr Preedy states that sales of GIGI perfume have taken place in “upper market” outlets and it is clientele from these outlets that are aware and recognise the quality of perfumes sold under the GIGI mark.

11) At Exhibit NFP5, Mr Preedy provides a copy of an extract from www.babynamespedia.com, identifying the word Gigi as a girls’ name and provides the following information regarding its pronunciation:

[2 syll. Gi-gi, gig-i] The girl Gigi is pronounced as JH/YJHiy

12) Mr Preedy also makes a number of submissions that I will not detail here, but I will keep in mind.

DECISION

Proof of use

13) Ms Guggenheim’s marks were registered more than five years before the publication of the contested mark and, therefore, The Trade Marks (Proof of Use, etc) Regulations 2004 apply. Ms Guggenheim claims use in respect of *perfumes* only and Bison has required proof of use of this.

14) The relevant provision reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

...

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services...”

15) The contested mark was published on 27 November 2009 and it is necessary for Ms Guggenheim to demonstrate that genuine use has been made of her marks during the five years directly preceding this date, namely between the 28 November 2004 and 27 November 2009. The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed Person in O-371-09 SANT AMBROEUS:

42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *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]; *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].

(6) 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].

16) Taking account of this guidance from the courts it is clear that genuine use does not need to be quantitatively significant and that, when asking if the use is genuine, it is necessary to assess all surrounding circumstances.

17) The evidence provided in support of use of the mark in respect of *perfumes* can be summarized as follows:

- Undated photographs of a decorated perfume container with the words GIGI PERFUM appearing on the underside and of its outer-packaging bearing the text “28/7854 GOLD HEARTS GIGI”.
- A letter dated 27 August 2009 illustrating the transfer of eight perfume items from a retailer, that entered into administration, to another party for safe keeping. These items had been available for sale between August 2008 and July 2009.
- There is contradictory information provided in the statement of case and in Mr Preedy’s witness statement. In the former, it is claimed that the mark has been used in the UK since 1993. In the latter, Mr Preedy states that the perfume has been available in the UK since at least the 1960s. He exhibits an advert from that decade.

18) There appears to only be one outlet for the perfume in the UK, there is no evidence of any sales during the relevant period only an uncollaborated

statement that it was available to purchase from this outlet for a period of eleven months up to July 2009. There are no receipts or invoices relating to any sales of the perfume. The evidence does show that eight items of perfume were held in the retailer's stock at the time the company running the outlet went into administration.

19) When considering the impact of this evidence, I am mindful of the comments of the GC in Case T-334/01, *MFE Marienfelde GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (HIPOVITON)* when it stated:

“37. However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness.”

20) In this case, there is no such evidence and I retain serious doubts regarding the scale of any trade or if there has been any trade at all. The best possible interpretation of the evidence before me is that a very small number of sales may have been made by a single retailer during a period of eleven months that fell within the relevant five year period. To my mind, such evidence is insufficient to demonstrate that there has been use at all, let alone on a scale to maintain or create an outlet for the goods. There are a number of uncertainties that the evidence fails to address. For example, just because the retailer held a small amount of stock, this in itself is not evidence that it actually sold any of the goods. Secondly, there is no evidence that the retailer ever purchased the goods from Ms Guggenheim and it is possible that they may have been provided on a sale or return basis. Taking these issues into account, the evidence provides for a scenario where Ms Guggenheim made no sales either directly to the retailer or indirectly to consumers via that retailer. As such, the evidence falls short of demonstrating that any use was made of the mark in respect of *perfumes* during the relevant five year period. The evidence does no more than demonstrate a possible attempt to create a market, but no more.

21) When considering this evidence, I also remain mindful of the GC's comments in *HIPOVITON*. I do not believe that Ms Guggenheim has dispelled the doubts raised by the evidence provided in support of her case. Mr Preedy has also put forward evidence, by way of a 1960s advert, that the mark has been used for many years. Elsewhere, use in the UK is claimed only from 1993. However, either way, I do not find this persuasive as any use outside the relevant five year period does not assist Ms Guggenheim's claim to genuine use of the mark during this period.

22) Taking all of the above into account, I conclude that the evidence fails to demonstrate that the mark has been genuine use during the relevant five year period.

Section 5(2)(b) and Section 5(4)(a)

23) The consequences of my finding in respect of proof of use, is that the earlier registrations of Ms Guggenheim cannot be relied upon as earlier marks as defined by Section 6 of the act. It follows that the grounds of opposition based upon Section 5(2)(b) of the Act must fail.

24) As I have found no genuine use, during the relevant period, of Ms Guggenheim's mark in respect of *perfumes*. In addition, the evidence fails to demonstrate any use of the mark in the UK at any other time. It must follow from this that no goodwill, as identified by the mark GIGI, has been demonstrated. The requirement of goodwill is a prerequisite for a finding of passing off. As such, it follows that the opposition based upon these grounds must also fail.

COSTS

25) The opposition having failed, Bison is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place. I award costs on the following basis:

Preparing statement & considering other side's statement	£400
Considering evidence	£350
TOTAL	£750

26) I order Gloria Guggenheim to pay Bison River Limited the sum of £750. 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 09 day of February 2011

**Mark Bryant
For the Registrar,
the Comptroller-General**