

O-138-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2515426
BY BISON RIVER LTD TO REGISTER THE TRADE MARK**

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AS A SERIES OF NINE, IN CLASSES 3, 9, 14, 16, 18, 25, 28 and 35.

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 100066
BY GG.COM LTD**

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IN THE MATTER OF Opposition thereto under No. 100066 by GG.COM LTD

BACKGROUND AND PLEADINGS

1. On 8th May 2009 , Bison River Ltd of Unit 8, Valley Court Offices, Lower Road, Croydon, Nr Royston, Hertfordshire SC8 OHF (hereafter "Bison") applied to register the mark as above in Classes 3, 9, 14, 16, 18, 25, 28 and 35. The goods and services the subject of this opposition are as follows:

Class 9:

Protective clothing including body armour; protective helmets; riding helmets including for equestrian sports; sporting articles for equestrian use [for protective purposes]; protective footwear; protective gloves; sunglasses, eyewear, optics, eyeglass frames, contact lenses and contact lens cases; reading glasses; eyewear cases; optical apparatus and instruments; computer software; CD-ROMs; computers; videos; disks and tapes; telephone apparatus and instruments; mobile phones; telecommunications apparatus and instruments; publications downloadable from the Internet; parts and fittings for the aforesaid goods.

Class 14:

Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery and imitation jewellery, precious stones; horological and chronometric instruments; watches, clocks; cufflinks; tie clips; collar and shirt studs; belt buckles; key rings of precious metal or coated therewith; parts and fittings for all the aforesaid goods.

Class 16:

Catalogues, newsletters, periodicals, brochures, inserts, magazines, circulars, books, photographs, stationery and gift stationery including cards and paper; diaries, yearbooks and calendars, pens and pen holders, office requisites (except furniture), passport holders, writing instruments; parts and fittings for the aforesaid goods.

Class 18:

Equestrian articles; articles for equestrian use; halters; bridles; reins; bits for use with animals; head bands; horse collars; saddles; stirrups; cloths for saddles; covers for saddles; pads for saddles; articles of clothing for horses; blankets, cloths, sheets and covers, all for horses; horse protectors (strapping and bandaging); horse riding apparatus; boots (hoof coverings) for horses; knee pads for horses; leads; lead ropes; tethers; articles made of leather or of imitation leather; bags, handbags, backpacks, satchels, haversacks, knapsacks, rucksacks, valises, holdalls, cases, suitcases, trunks, articles of luggage, briefcases, key cases, travelling bags, suit carriers, purses, pocket wallets and pouches; umbrellas, parasols and walking sticks; whips, harness and saddlery; shooting sticks; leather or leather board boxes; card cases; clothing for pets; parts and fittings for all the aforesaid goods.

Class 25:

Clothing, footwear, headgear; trousers; jackets; outer wear; blouses; T-shirts; suits; braces; lingerie; underwear; leisure wear; casual wear; sports clothing, footwear and headgear; equestrian clothing; equestrian footwear; equestrian headgear; articles of underclothing for equestrian use; sporting articles for equestrian use [other than for protective purposes]; articles of clothing for horse-riding (other than protective clothing); articles of footwear for horse-riding (other than for protective purposes); articles of headgear for horse riding (other than for protective purposes); jodhpurs; riding trousers; leggings; stocks; gloves; scarves; neck covers; gilets; beanie hats; baseball caps; fleeces; snoods; wellington boots; polo boots; tabards; belts for wear; shirts; socks; ties; parts and fittings for all the aforesaid goods.

Class 28:

Sporting articles for equestrian sports [other than clothing or articles for protective purposes]; sporting articles for equestrian use [other than clothing or articles for protective purposes]; rocking horses; exercise boots; toys, games and playthings; gymnastic and sporting articles and apparatus; sports bags; bags specifically designed for sports and equestrian equipment; playing cards; parts and fittings for the aforesaid goods.

Class 35:

Retail services connected with equestrian goods, cosmetics, perfumes and toiletries, soaps, essential oils, dentifrices, mouthwashes, hair care products, personal grooming products, sun screen, shampoo containing insecticide, insect repellent, protective clothing including body armour, protective helmets, riding helmets including for equestrian sports, sporting articles for equestrian use [for protective purposes], protective footwear, protective gloves, sunglasses, eyewear, optics, eyeglass frames, contact lenses and contact lens cases, reading glasses, eyewear cases, optical apparatus and instruments, computer software, CD-ROMs, computers, videos, disks and tapes, telephone apparatus and instruments, mobile phones, telecommunications apparatus and instruments, publications downloadable from the Internet, precious metals and their alloys and goods in precious metals or coated therewith, jewellery and imitation jewellery, precious stones, horological and chronometric instruments, watches, clocks, cufflinks, tie clips, collar and shirt studs, belt buckles, key rings of precious metal or coated therewith, catalogues, newsletters, periodicals, brochures, inserts, magazines, circulars, books, photographs, stationery and gift stationery including cards and paper, diaries, yearbooks and calendars, pens and pen holders, office requisites, passport holders, writing instruments, equestrian articles, articles for equestrian use, halters, bridles, reins, bits for use with animals, head bands, horse collars, saddles, stirrups, cloths for saddles, covers for saddles, pads for saddles, articles of clothing for horses, blankets, cloths, sheets and covers, all for horses, horse protectors (strapping and bandaging), horse riding apparatus, boots (hoof coverings) for horses, knee pads for horses, leads, lead ropes, tethers, articles made of leather or of imitation leather, bags, handbags, backpacks, satchels, haversacks, knapsacks, rucksacks, valises, holdalls, cases, suitcases, trunks, articles of luggage, briefcases, key cases, travelling bags, suit carriers, purses, pocket wallets and pouches, umbrellas, parasols and walking sticks, whips, harness and saddlery, shooting sticks, leather or leather board boxes, card cases, clothing for pets, furniture, mirrors, picture frames, goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, picture frames, curtains, curtain poles, runners, hooks, curtain fixtures and fittings, cushions, textiles and textile goods, bed and table covers, fabrics, linen, sheets, towels, bedspreads, duvets, shams, dust ruffles, blankets, pillow cases, comforters, throws, travel rugs, cushion covers, drapes and window coverings, furnishings, handkerchiefs, clothing, footwear, headgear, trousers, jackets, outer wear, blouses, T-shirts, suits, braces, lingerie, underwear, leisure wear, casual wear, sports clothing, footwear and headgear,

equestrian clothing, equestrian footwear, equestrian headgear, articles of underclothing for equestrian use, sporting articles for equestrian use [other than for protective purposes], articles of clothing for horse-riding (other than for protective purposes), articles of footwear for horse-riding (other than for protective purposes), articles of headgear for horse-riding (other than for protective purposes), jodhpurs, riding trousers, leggings, stocks, gloves, scarves, neck covers, gilets, beanie hats, baseball caps, fleeces, snoods, wellington boots, polo boots, tabards, footwear, headgear, belts for wear, shirts, socks, ties, lace and embroidery, ribbons and braid, buttons, hooks and eyes, pins and needles, artificial flowers, hair accessories and ornaments, belt clasps, ornaments for clothing, footwear and headgear, clips and fasteners for braces, carpets, rugs, mats and matting, linoleum and other materials for covering existing floors, wall hangings, floor coverings, wall coverings, sporting articles for equestrian sports [other than clothing or articles for protective purposes], sporting articles for equestrian use [other than clothing or articles for protective purposes], rocking horses, exercise boots, toys, games and playthings, gymnastic and sporting articles and apparatus, sporting and leisure goods, sports bags, bags specifically designed for sports equipment, playing cards, parts and fittings for all the aforesaid goods; provision of advice and assistance in the selection of goods brought together as above; consultancy, information and advisory services relating to all the aforesaid services.

2. The application was published in the Trade Marks Journal on 27th November 2009 and on 27th January 2010 GG.Com Ltd of Low Rigg, Lower Farm Road, Effingham, Surrey KT24 JL (hereafter "Com") lodged an opposition against the goods and services specified above.
3. The opposition is made solely under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), in respect of which Com has two earlier marks, the details of which are as follows:

Mark. Filing and registration dates	Goods and services relied upon under section 5(2)(b) (In respect of '079, those for which use is claimed as per attorney's letter dated 19 th March 2010)
UK 2306079 ("079") GG 4 th July 2002 11 th June 2004	<p>Class 14 Badges</p> <p>Class 16 Booklets; brochures; printed matter; photographs; stationery; postcards; greetings cards; posters; calendars; prints; pictures.</p> <p>Class 25 Clothing</p> <p>Class 28 Games; sporting articles</p> <p>Class 35 Data search for the benefit of others; news clipping services; conducting opinion polls; rental of advertising time on communication media.</p>

<p>UK 2265007 ("007")</p>  <p>21st March 2001 2nd November 2001</p>	<p>Class 35: Advertising services; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from an Internet website specialising in the marketing of goods relating to horse racing.</p> <p>Class 41: Betting services; information relating to horse racing provided on-line from a computer database or the Internet; racing information services; news services relating to racing; ticket information and booking services for sporting events.</p>
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4. It is worthwhile recording that Com do not claim that the services of their '007 are identical or similar to *all* those goods and services listed in para 1 above, which reflects the goods and services under attack by their '079 mark. This is something I shall have to bear in mind in due course.
5. In their statement of case, Com say, as regards the pronunciation of their '079 mark, that it is identical to Bison's marks and this gives rise to a likelihood of confusion. As regards their '007 mark they say the suffix ".com" is known as a common reference to a domain name such that the distinctive aspects of their '007 mark are the letters GG and the device of the head of an equestrian jockey. Thus, the pronunciation of the '007 mark is also identical to Bison's mark and this also gives rise to a likelihood of confusion under section 5(2)(b).
6. Bison filed a counterstatement denying the ground of the opposition and putting Com to proof of use of their marks. They say, as regards the '079 mark, the scope of protection of a mark consisting of two letters only is extremely narrow and that it requires very little to render such marks sufficiently different from other marks to allow for co-existence. The repeated letters G and G would not be confuse or associated with GEE GEE which has a specific meaning, that of an informal or pet name which is often used by young children to refer to a horse and which is the connotation most likely to be evoked by their marks. Visually, the only commonality between the respective marks is the letter 'G'.

7. Likewise, as regards the '007 mark given the differences between the respective marks there is no likelihood of confusion as this contains additional visual differences.
8. As regards the respective goods and services, they admit some are identical or similar to those covered by '079, but that this is not the situation with all goods and services, specifically eyewear and telecommunications apparatus and instruments are not identical or similar to anything in Coms specifications.
9. Bison has also, through its attorneys, conducted a search on the register of trade marks to show examples of marks with the letters 'GG' and 'Gee Gee' to show 'co-existence'.
10. Evidence has been filed by Com only, which, insofar as it is relevant, I shall summarise below. Neither party has filed submissions and nor has either party requested a hearing. Both parties are content for a decision to be issued based on the papers and both parties request costs.

Opponent's evidence

11. This takes the form of a witness statement dated 27th August 2010 by Nicholas Francis Preedy, a trade mark attorney at HallMark IP, acting for the opponents. By way of submission, Mr Preedy says the respective marks are aurally identical and that the overall impression given by the respective marks will be the same, as the words 'gee gee' will be recognised in the UK by the average consumer as slang for a horse and so will the letters, 'GG', as in the '079 mark. The extra matter in the '007 mark will not change the overall impression, but rather, reinforce the underlying horse connotation. To support these submissions, evidence is adduced from dictionaries and internet searches on the words "horse gg" and "horse gee gee", the results being shown as an exhibit to illustrate that the term 'gee gee' would be recognised by the average consumer as being an informal colloquialism for a horse.
12. On the question of proof of use, Mr Preedy (who has previously said that the information contained in the witness statement is either within his personal knowledge, obtained from the internet or derived from records supplied by the opponent) says the following:

"Substantial use has been made of both the trade mark GG and GG.COM (and device) with the owner of UK Trade Mark Registration Nos 2306079 and 2265007 being the proprietor of domain name GG.COM. There is now produced and shown to me marked NFP5 evidence of use which has been made of GG.COM (and device) on the gg.com website from which it can be clearly noted that everything is connected with horses as can be expected by the letter combination, and that the overall impression of the

respective mark GG.COM (and device) is the same as that created by the combination GEE GEE.”

13. Exhibit NFP5 comprises firstly, a slightly indistinct screen shot of the webpage www.gg.com. The webpage is dated either 26th or 28th January 2010. At the bottom is a copyright notice “Copyright GG Com Ltd 2001-2010”. The page shows the ‘007 device mark at the top and the content of the website is plainly that of a horse racing news, tips and results service, together with, eg the facility to place bets.
14. There is also an undated ‘map’ of the website, showing that it hosts also messageboards and a shop with merchandising, books, annuals, racecards and clothing available. A further shot of the page, hosting the shop is supplied showing, for sale, a “GG –WORLD” baseball cap and a “WWWEARGG” T –shirt. There is then an undated photograph of a single umbrella with the ‘007 mark present. The last page comprises also an undated photograph of four umbrellas, with the ‘007 mark present together with the name “GARY WILTSHIRE” and the domain name www.gg.com.

DECISION

Proof of use

15. The Trade Marks (Proof of Use, etc) Regulations 2004 apply in respect to the Section 5(2) (b) grounds of this case. The 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, ...

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

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

16. With registration dates of 11th June 2004 and 2nd November 2001, it is clear that under Section 6(1) of the Act, both Com’s mark are earlier trade marks. Further, as they completed their registration procedure more than five years before the publication of the contested mark (being 27th November 2009), they are subject to the proof of use requirement set out in section 6A of the Act. The relevant 5 year period ends on 27th November 2009 and starts on 26th November 2004.

17. Consideration has to be taken, also, of 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.”

Consequent upon section 100, the onus is upon the registered proprietor to prove that it has made use of the trade mark in suit, or that there are proper reasons for non-use.

18. The leading cases on genuine use are well known: *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] ETMR 85 (“*Ansul*”), *La Mer*

Technology Inc v Laboratoires Goemar SA [2004] FSR 38 and [2005] ETMR 114 (“*La Mer*”), *The Sunrider Corp v OHIM*, Case C-416/04P (“*Sunrider*”). A helpful synthesis of the ‘legal learning’ from these cases and several more recent ones has been provided in the appointed person case, *Sant Ambroeus* (BL O-371-09), as follows:

“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 GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR 28 (*Silberquelle*) where relevant:

(1) Genuine use means actual use of the mark by the proprietor or 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].”

What the evidence shows

19. Section 100 places a clear onus upon the opponent to show what use is made of the earlier mark. The opponent’s evidence has been filed by its attorney who says he has had access to material from the opponent.
20. Whilst saying that ‘substantial use’ has been made by the opponent of its marks, he does not say when that use commenced, whether it is within the relevant period or what the turnover of the opponent is under its marks. There are no, eg invoices, third party statements or other corroborative evidence. Usage of the marks is apparently equated to ownership of the website www.qg.com, of which I simply have a screen print taken outside the relevant period, several undated photographs of umbrellas and a ‘map’ of the website, also without any dates or provenance.
21. The European Courts have held in, eg, Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM* (para 47) 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.” Despite the fact that such a statement is made against the backdrop of a specific European provision (rule 22(2) of the Community Trade Mark Regulation, requiring that indications and evidence for furnishing proof of use are to consist of indications concerning the place, time, extent and nature of use), I do not understand the burden of proof under UK law to be necessarily lower than that applied under Community legislature.

22. In the UK case, *Laboratoire De La Mer Trade Mark* [2002] FSR 51, Jacob J said:

“In the present case, 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 all the goods and services of the mark in question. All the ‘t’s should be crossed and the i’s dotted.”

23. This is not advocating a counsel of perfection, but a simple recognition of the legal and evidential burden faced by the opponent who has been put to proof of use.

24. In this case, the opponent has singularly not discharged the burden to show *any* use during the relevant period, and accordingly I do not propose to continue with my analysis as to whether any use is ‘genuine’, what goods and services the opponent may be entitled to and any resultant likelihood of confusion as between the respective marks.

25. The opposition therefore fails in relation to all the goods opposed.

Costs

26. Bison River Ltd has been totally successful in defending against the opposition. Accordingly, it is entitled to a contribution towards its costs. I take account of the fact that that the decision has been reached without a hearing. In the circumstances I award Bison River Ltd the sum of £750 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

1. Preparing a counterstatement and considering statement - £400
2. Considering evidence - £350

Total £700

27. I order GG.Com Ltd to pay Bison River Ltd the sum of £750. The sum should 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 26 day of April 2011

**Edward Smith
For the Registrar,
the Comptroller-General**