

**TRADE MARKS ACT 1938 (as amended)  
TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 1540670  
BY GEMINI SHOES LIMITED  
TO REGISTER A TRADE MARK IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION NO. 42186 THERETO  
BY MOHINDER SINGH DHALIWAL, JAGIT KAUR DHALIWAL  
AND PAUL RAGBHIR SINGH DHALIWAL  
TRADING AS GEMINI FASHIONS**

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15 **TRADING AS GEMINI FASHIONS**

**BACKGROUND**

20 On 5 July 1993 Gemini Shoes Limited applied to register the trade mark GEMINI in respect of "Boots, shoes and sandals; all included in Class 25".

On 14 March 1995 Mohinder Singh Dhaliwal, Jagit Kaur Dhaliwal and Paul Ragbhir Dhaliwal trading as Gemini Fashions, filed Notice of Opposition to the application. The grounds of  
25 opposition are in summary:

- (i) under Section 11, by reason of their use of, and reputation in, the trade mark GEMINI in respect of clothing and footwear;
- 30 (ii) under Section 12(3) by reason of the fact that the trade mark the subject of this application, is identical to the trade mark GEMINI applied for by the opponents under no. 1588341 in respect of the same goods, such that if the former was registered confusion and deception is likely to occur
- 35 (iii) under Section 17(1) because at the date of application the applicant could not claim to be the proprietor of the trade mark GEMINI

Details of the opponents' trade mark and the subject of the application referred to above are as follows:

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<b>No.</b>	<b>Mark</b>	<b>Class</b>	<b>Specification</b>
1588341	GEMINI FASHIONS	25	Articles of clothing for women and girls; shoes all included in Class 25

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The opponents ask the Registrar in the exercise of his discretion to refuse the application in suit or to order the specification of goods in the application to be appropriately restricted.

5 The applicants, in their counterstatement, deny all of the grounds of opposition. The applicants state that their use of the trade mark GEMINI pre-dates that of the opponent; that the opponent purchased significant numbers of shoes from the applicant bearing the applicants' GEMINI trade mark some years prior to either of the parties application for the registration of a trade mark; any use by the opponent of the term GEMINI has been in conjunction with the term FASHIONS which has been the opponents' trading style and not their trade mark.

10 Both sides seek an award of costs in their favour.

15 Both sides filed evidence in these proceedings but neither side sought to be heard in the matter. Therefore, having read the Notice of Opposition, counterstatement and the evidence filed by both sides, I give my decision below.

### **OPPONENTS' EVIDENCE**

20 This consists of a Statutory Declaration dated 2 December 1996 by Paul Ragbhir Singh Dhaliwal. He states that he is one of the opponents in these proceedings, the other two being his parents and that he is duly authorised by them to make this declaration on their behalf as well as himself. Mr Dhaliwal says that he is now the sole proprietor of the opponents' business, GEMINI FASHIONS. The other named opponents who until recently operated as a trading partnership with him, under the same name, have retired.

25 Mr Dhaliwal goes on to state that this family business was founded under the name GEMINI FASHIONS in 1981. In confirmation of that there is exhibited at Exhibit PRSD1 the following documents:

- 30
1. a certificate of registration of a business name dated 27 October 1981 which states that "A statement of change of registered particulars in respect of GEMINI FASHIONS was this day registered in London"

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  2. a letter to Mr and Mrs Dhaliwal from Mr A C Wilkins, the Manager of the Upton Park Branch of the Midland Bank, and dated 1 July 1994. In his letter Mr Wilkins states that from a brief examination of the bank's records, references to the use of the business name GEMINI goes back to 1983

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  3. a certificate of registration for Value Added Tax in respect of Gemini Fashions at the opponents address

45 Mr Dhaliwal goes on to state that the words GEMINI FASHIONS have always appeared prominently on the opponents printed letter heads and invoices and exhibited at PRSD2 are samples of these which show use of the term GEMINI FASHIONS as "manufacturers, wholesaler and exporters of ladies and children's clothing, footwear and handbags". Insofar as shoes are concerned, Mr Dhaliwal states that these have always been sold with the words

GEMINI FASHIONS prominently displayed on the insole and at PRSD3 he Exhibits a typical insole currently used. This shows the term GEMINI FASHIONS with the legend “Made in England”.

5 Mr Dhaliwal further states that the opponents make a substantial proportion of the garments they sell (blouses and sun dresses, for example) but others are bought in from specialist suppliers. All of the shoes sold are obtained from specialist suppliers and come with the GEMINI FASHIONS insole already fitted. They have been doing business with some suppliers in this way for a very long time. For example, Firona Shoes (Hockley, Birmingham) 10 have supplied the business since 1981, while Elite Footwear Limited (also in Hockley) have been doing so since 1983. Copies of invoices from these and other suppliers are Exhibited at PRSD4. All of these invoices indicate that shoes were supplied by them to GEMINI FASHIONS, the earliest dated 11 November 1985 and is in respect of 245 pairs of shoes, 15 supplied by R & R Shoes Limited of Manchester to Gemini Fashions in London.

Mr Dhaliwal is not able to supply sales figures in respect of the opponents for the period 1981 to 1984 because records are no longer available. However, figures for 1985 to 1994 are given. These are:

	Total sales (wholesale) £K
	1985 390
	1986 453
	1987 421
25	1988 352
	1989 309
	1990 254
	1991 189
	1992 147
30	1993 219
	1994 316

It is emphasised that these figures are calculated at wholesale rates; the retail figure would be substantially higher since the opponents’ customers mark up prices by anything between 50 35 and 100 per cent before selling on to the final purchaser.

Mr Dhaliwal states that a high proportion of the sales represented by these figures are sent by way of export to countries overseas. Insofar as shoes are concerned, virtually all of these are exported to Africa. As for articles of clothing, 10% are sold to customers in the United 40 Kingdom and the remainder to customers in the other member states of the European Union.

No advertising figures are produced. Mr Dhaliwal explains that his company is located in the Whitechapel area of London, one of only two areas in London renowned for clothing and footwear businesses; the Finsbury Park area being the other. In view of this, potential 45 customers simply visit premises in these areas. If the need to advertise arose the opponents

would rely upon individuals to distribute handbills in the street containing the company's address and telephone details. However, in recent years it has not been necessary to do so, the business has an established reputation and new customers come by way of recommendation.

## 5 APPLICANTS' EVIDENCE

10 This consists of a Statutory Declaration dated 12 December 1997 by Mrs Hiroo Parmar, Managing Director of Gemini Shoes Limited. She states that she is duly authorised to make the declaration on behalf of the applicants and the facts declared are either within her personal knowledge or have been obtained as necessary from the records of the company to which she has access.

15 Mrs Parmar, first of all, provides some background to the opponents which started trading in 1979 and started use the trade mark GEMINI the following year in relation to footwear, and in particular to shoes. She Exhibits at HP1, a copy of a Certificate of Registration under the Registration of Business Names Act 1916, showing that with effect from 11 December 1991 the name "Gemini Shoes" was used as a business name by the applicants.

20 Mrs Parmar goes on to state that the applicants commissioned shoes from leading United Kingdom manufacturers under the trade mark GEMINI and almost all of these shoes were exported, under the trade mark, to Africa. At Exhibit HP2 Mrs Parmar lists British manufacturers who made shoes for her company. Unfortunately, she says, because of competition from the Far East, many of these manufacturers have ceased to trade and are not therefore able to support this declaration. However, at Exhibit HP3 she produces the following:

- 25 1. a copy of a letter from P Corner, Senior Sales Executive of Newmans Footwear Limited which states that whilst he was working for the Lambert Howarth Group during the late seventies, who were producing ladies shoes with the Gemini sock brand
- 30 2. a copy of a letter from Mr Christodoulou, a Director of Cheho Limited (manufacturers and wholesalers of ladies footwear), stating that while he was trading as Peters Shoe Limited he was producing ladies shoes for Mr and Mrs Parmar who were trading as Gemini Shoes. As far as he remembers, they were using labels to brand these shoes with the name "GEMINI"
- 35 3. a copy of a letter from Mr B H Corn, Managing Director, Eastfield Footwear Limited, who states that his company has been manufacturing ladies shoes for Gemini Shoes Limited since 1983/84 at the rate of 35/40,000 pairs per year. All of the shoes have been goal stamped on the sock with the brand name GEMINI
- 40 4. a copy of a letter from a Mr R M Green, Managing Director of Haddon Costello Limited, stating that they supplied Eastfield Footwear with approximately 40,000 pairs per year of socks stamped with the Gemini logo from the early 1980's.
- 45

Because of the lapse in time Mrs Parmar states that it has not been possible to obtain turnover figures from the start of the company's operations but the following are turnover figures from 1988 to 1993.

5

<u>Year</u>	<u>Turnover (£K)</u>
1988	1,857
1989	1,613
1990	1,862
1991	2,409
1992	2,099
1993	2,350

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15

Prior to the formation of the limited company, Mr and Mrs Parmar, trading as Gemini Shoes, had turnover of over £½ million in 1986 and £2½ million in 1987.

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Mrs Parmar goes on to produce at HP4 copies of monthly returns for Value Added Tax to HM Customs & Excise from June 1982 to May 1988. She states that although these do not show use of her company's trade mark they do show use of the term GEMINI as a trade name in relation to shoes.

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She also produces at HP5, various copies and original documents relating to the shipment of shoes to Ghana and enquiries from Kenya and Ghana. Although these documents are all dated 1994 (i.e. after the date of application in this case) she states that her company received such enquiries and was engaged in the business of exporting shoes to various African countries from the start of the business using the term GEMINI.

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At Exhibit HP6 Mrs Parmar produces an original Certificate of Shipment received by her company in 1993. She notes that this was addressed to the opponents but was sent to her company. She believes that this is proof of confusion arising on the part of the authors of the certificate as between the applicants and opponents. Indeed, she believes that this confusion was deliberately engineered by the opponents with the aim of encroaching upon the goodwill of her company. She goes on to state that she believes that she can establish that the opponent has passed off their goods as those of the applicants and that therefore the tort of passing off can be established.

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Finally, in commenting upon the opponents' evidence, Mrs Parmar makes the following points:

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1. the opponents have shown use of the term GEMINI FASHIONS as a business name, but no use of the term as a trade mark in relation to shoes
2. the opponents are unable to show any sales of shoes prior to November 1985
3. the opponents sales figures do not show what proportion, if any, cover sales of footwear (but are in any event likely to be so small as to be negligible).

45

That concludes my review of the evidence as far as I consider it is relevant.

## DECISION

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I deal first of all with the Ground of Opposition based upon Section 17(1) of the Act. I have to determine therefore, whether the applicants for registration are the proprietors of the trade mark in suit. In that connection I take particular note of the following passage from AL BASSAM trade mark [1995] RPC 511 at page 522, line 14 et seq:

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“The case to which I have referred (and there are others to the like effect) show that it is firmly established at the time when the Act of 1875 was passed that a trader acquired a right of property in a distinctive mark merely by using it upon, or in connection, with his goods irrespective of the length of such user and or the extent of his trade and that such right of property would be protected by injunction restraining any other person from using the mark.”

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No evidence has been submitted by the opponents in support of this Ground of Opposition. However, it seems to me from the evidence filed that the applicants for registration have established, at least to my satisfaction, that they have use of the term GEMINI solus as a trade mark from the start of their trading activities in 1980. The opponents use of their trade mark GEMINI FASHIONS in relation to shoes is from 1983. In the circumstances I have no hesitation in stating that, in my view, the applicants have established their claim to the proprietorship of the trade mark GEMINI and therefore the ground of opposition based upon Section 17(1) of the Act is dismissed.

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I turn to consider the Ground of Opposition based upon Section 11 of the Act which states:

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“11. - It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”

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The established test in respect of opposition based upon this section of the Act is that set down in Smith-Haydn and Co Limited's application as adapted by Lord Upjohn in the BALI trade mark case [1969] RPC 496. Adapted to the matter in hand the test may be expressed as follows:

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“Having regard to the user of the opponents' mark GEMINI FASHIONS, is the tribunal satisfied that the mark applied for GEMINI, if used in the normal and fair manner, in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?”

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First of all, I consider the respective trade marks. The applicants' trade mark is the word GEMINI solus, the opponents' trade mark consists of the words GEMINI FASHIONS. However, the word FASHION in relation to the goods supplied under the trade mark,

whether they be ladies or children's clothing or footwear, is not distinctive. Therefore, for all intents and purposes these two marks are substantially the same and normal and fair use by either party of their trade mark would result in it being known as a GEMINI trade mark.

5 As indicated earlier in this decision, I am satisfied that the applicants have established use of  
the trade mark GEMINI in relation to shoes from 1981. The opponents have also established  
10 use of the trade mark GEMINI FASHIONS but from a later date. I am aware that the  
opponents' business commenced somewhat earlier than that of the applicants, but I am not  
satisfied, from the evidence, that they supplied footwear, in particular shoes, under the trade  
15 mark GEMINI FASHIONS (as opposed to women and children's clothing) from a date which  
preceded that of the applicants. I should add that I take note of the applicants submission in  
their pleadings that the opponents use of the term GEMINI FASHIONS was as of a business  
name and not as a trade mark, but I am satisfied that as well as use as a business name the  
term GEMINI FASHIONS has been used as a trade mark denoting a badge of origin of the  
opponents' goods.

From the above, it is apparent that I consider that the applicant was the first to use the trade  
mark GEMINI in relation to shoes. Therefore it is use by the opponents of their trade mark  
20 GEMINI FASHION in relation to shoes which is likely to result in the confusion and  
deception of a substantial number of people, in line with the test laid down in the Smith-Haydn  
case. That being so, the opposition based upon Section 11 must be dismissed.

The opponent also asked the Registrar to exercise his discretion under the provisions of  
Section 12(3). However, as I have established to my satisfaction that the applicants have  
25 established earlier use of the trade mark in relation to the goods covered by their application  
for registration, I do not consider that I need to refer the matter to the Court (and matters  
have certainly not been settled between the parties such that I can endorse in the agreement  
between them). There is therefore no action to be taken in relation to Section 12(3). I would  
30 add that from the evidence before me it may well be that in respect of the goods at issue in this  
case that both sides have established a concurrent position in the export market they supply  
such that both the applicants and the opponents trade marks could be registered under the  
provisions of Section 12(2) of the Act. However, the opponents application for registration is  
not before me in that respect and matters in that regard will have to be settled at the  
appropriate time and on the basis of any evidence filed.

35 In view of my findings above in relation to the Ground of Opposition based upon Section 11,  
which is mandatory, it is not appropriate to consider the exercise of the Registrar's discretion.

40 As the applicants have been successful I order the opponent to pay to them the sum of £400 as  
a contribution towards their costs.

Dated this 30 day of June 1999.

45 **M KNIGHT**  
**For the Registrar**  
**the Comptroller General**