

O-183-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2571211  
IN THE NAME OF STUDEX CORPORATION

AND

OPPOSITION THERETO UNDER NO 102227  
BY SURENDRA NARANDAS GADHIA

## Background

1. Application 2571211 stands in the name of Studex Corporation (“the applicant”), has a filing date of 4 February 2011 and seeks registration of the trade mark MEDISEPT in relation to the following goods:

*Pre-body piercing wipes, skin cleansing wipes; skin cleansing solution; skin cleansing gels*

2. Following publication of the application on 29 April 2011, notice of opposition was filed by Surendra Narandas Gadhia (“the opponent”). The opposition is brought on grounds under sections 5(1) and 5(2)(a) of the Act. In support of the opposition, the opponent relies on the following trade mark insofar as it is registered for the following goods:

Mark	Application/registration dates	Specification of goods
2400942 MEDISEPT	6 September 2005/ 10 March 2006	Pharmaceutical and veterinary preparations, sanitary preparations for medical purposes, dietetic substances adapted for medical use, food for babies, plasters, material for dressings, material for stopping teeth, dental wax, disinfectants, preparations for destroying vermin, fungicides, herbicides

3. The applicant filed a counterstatement in which it denies there is a valid ground of opposition. It puts the opponent to proof of use of the mark relied on.

4. Both parties filed evidence and the applicant also filed written submissions. Neither party requested to be heard. I give this decision following a careful review of all the papers.

5. Given the interplay between the publication date of the applied for mark and the earlier mark relied on by the opponent, section 6A of the Act is relevant. It reads:

“6A (1) This section applies where-

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

there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

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-

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, and

(b) 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.

(5) .....

(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.

(7)....”

6. Also of relevance is 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.”

7. The relevant period in which Mr Gadhia is required to prove use of his earlier mark is 30 April 2006 to 29 April 2011.

### **Proof of use**

8. The guiding principles to be applied in determining whether there has been genuine use of a mark are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

-genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the CJEU);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

## **The evidence**

9. The opponent's evidence in chief takes the form of a witness statement from George Myrants who is a registered trade mark attorney and principal of Trade Mark Consultants Co, the opponent's legal representatives in these proceedings. Mr Myrants's witness statement acts as a vehicle to introduce the following exhibits:

- GM1: six sample invoices dating between 8 June 2009 and 1 February 2011 which have been issued by Euro Gadhia (London) Ltd, a company which Mr Myrants says is the opponent's licensed company. They are:
  - 1: Dated 8 June 2009 and addressed to Bidiborough Stores in Kent. The invoice lists Medisept skin cream, skin lotion and lozonges (sic);

- 2: Dated 10 February 2010 and also addressed to Bidiborough Stores. The invoice is again for the supply of Medisept skin cream, skin lotion and lozonges (sic);
  - 3: Dated 15 June 2010 and addressed to Grove Hill Stores in Kent. The invoice relates to Medisept Milk Shakes in various flavours;
  - 4: Dated 9 November 2010 and addressed to Bidiborough Stores in Kent. The invoice relates to Medisept Milk Shakes in various flavours;
  - 5: Dated 12 December 2010 and addressed to Grove Hill Stores in Kent. The invoice is for the supply of Medisept skin cream, skin lotion and lozonges (sic);
  - 6: Dated 1 February 2011 and addressed to Garner Chemist in Harrow. The invoice is for the supply of Medisept lozonges (sic) in various flavours.
- GM2: 10 pages showing what appear to be design proofs for various packaging. Pages 1 to 4 are for various nasal creams, skin cream and skin lotion and each of them bears the word Medisept with a device of leaves followed by ®. Each also bears the name Medisept International Corporation. Pages 5 to 10 are for what appear to be packaging designs for “drops” in various flavours. Each shows the word Medisept followed by ®.

10. In its submissions, the applicant comments on Mr Myrants’s evidence. It submits that the invoices do not relate to the opponent and there is no evidence that he has licensed the trade mark. It submits that those invoices at pages 1, 2 and 5 to exhibit GM1 relate to the sales of cosmetics and that at page 6 relates to lozenges, none of which are goods included within the specification of the earlier mark relied upon. As to the packaging exhibited at GM2, it submits that those which are for creams relate to cosmetics rather than pharmaceutical products. Furthermore, the exhibits do not show actual packaging but drawings and, in any event, what has been shown would not comply with EC regulations relating to either cosmetics or pharmaceuticals because:

- There is no “e” placed after the weight indication;
- There is no indication of an expiry date, nor any indication of the shelf-life of the product once opened by the consumer.

11. In the light of this and the typographical errors in the invoices addressed to Bidiborough Stores, it submits that the material appears “to have been put together hastily and does not appear to constitute genuine examples of MEDISEPT in use”.

12. The opponent responded by way of a witness statement of Surendra Narandas Gadhia, the opponent. He states that he is the Director of Euro Gadhia (London) Ltd, a position he has held since it was incorporated in 1977. He states that the company is licensed to use the mark relied on in these proceedings. At SNG9 he exhibits what he says is a licence granted by him to the company authorising it to use the mark. The exhibit takes the form of a letter addressed to Euro Gadhia (London) Ltd. It

indicates it was sent from S N Gadhia of Medisept of International Corporation and it is written on Medisept International Corporation headed paper. The text indicates that “you can use **our** trade mark Medisept registered in March 2006” (my emphasis).

13. At SNG1-3 Mr Gadhia exhibits duplicates of some of the material already filed by Mr Myrants at GM2 along with what appears to be other similar design proofs and says that they are product packaging for goods of a pharmaceutical nature.

14. At SNG4-8 Mr Gadhia exhibits various invoices which he states relate to his company’s attendance at the same annual trade fair between 2006 and 2010.

15. At SNG11, Mr Gadhia exhibits a witness statement from Manjula Gadhia who he says is his company’s secretary. Ms Gadhia indicates that the reference to Bidiborough Stores in the invoices exhibited at GM1 of Mr Myrants’s witness statement contain a typing error in that references to Bidiborough should read Bidborough. She does not state that she is the person who made this error or how she knows this to be the case.

16. At SNG12, Mr Gadhia exhibits what he refers to as “trade references from all of the companies I have provided invoices for in support of use of the MEDISEPT mark”. The exhibit consists of 3 pages.

- Page 1 is a letter in the form of a computerised message from Bidborough Stores. It is not dated. Headed “To whom it may concern Re: Euro Gadhia Group” it indicates it “placed orders and received the products on 8<sup>th</sup> June 2009, 10<sup>th</sup> February 2010 and 9<sup>th</sup> November 2010” but does not indicate what products were ordered or received;
- Page 2 is in the form of an email dated 17 July 2012. It is from Sanjay Masrani and addressed to Euro Gadhia Group. Mr Masrani says he is the owner of Grovehill Stores. The email simply states “your products are popular and we will definitely support you in the future”. No indication is given that any specific goods have been supplied or under what trade mark and if supplied, what those products may have been;
- Page 3 is also in the form of an email. Addressed to S Gadhia it is from Kalpesh Patel of Garner Chemist and is dated 16 July 2011. The subject matter of the email is given as “Samples”. The email states “With reference to our conversation today and you (sic) invoice for goods supplied (Medisept Range) this is just to confirm that the goods are saleable in our Pharmacy”.

17. In reaching a determination, I keep in mind the comments of Jacob J in *Laboratoires Geomar SA’s Trade Mark* [2002] ETMR 32 where he said:

“9. 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.”

18. I also bear in mind the following comments of the General Court (“GC”) in *Anheuser-Busch Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-191/07*:

105. Moreover, the Court of First Instance has held that genuine use of a trade mark could not be proved by means of probabilities or suppositions, but had to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 *Kabushiki Kaisha Fernando v OHIM –Harrison (HIWATT)*[2002] ECR II-5233, paragraph 47”).

19. The opponent gives no evidence of the volume or value of any goods which may have been sold under the mark he relies upon in these proceedings. No evidence is given of any marketing or promotional expenditure under the earlier mark nor is there any evidence of any such activities having taken place. There is evidence that the company Euro Gadhia (London) Ltd, of which the opponent is a Director, has attended trade fairs within the relevant period. Mr Gadhia exhibits invoices relating to what he says is the same annual fair over a period of some years. The earliest of the invoices exhibited relate to a date before the relevant period. Some of the invoices are addressed to Mr Gadhia himself, some to Euro Gadhia (London) Ltd and others to Euro Gadhia India. No information is given about this latter company. I do not find this material is of assistance to Mr Gadhia, as the first of the invoices at SNG5 shows the fair is called the International Sweets & Biscuits Fair and all of the fairs took place in Cologne.

20. The material at GM2 and SNG1, showing the design of various packaging, is made up of what appears to be design proofs rather than actual packaging. The only company name shown on the designs is Medisept International Corporation who are not a party to these proceedings nor is any explanation given of any relationship this company might have with the opponent.

21. The invoices provided at GM1 relate to 1) skin creams, 2) lozenges and 3) milk shakes. Whilst I am prepared to accept that these are goods which could be included within the terms “pharmaceutical preparations” and “dietetic substances adapted for medical use” as are included within the specification of goods of the earlier mark, the invoices were issued in the name of Euro Gadhia (London) Ltd. Mr Gadhia states that Euro Gadhia (London) Ltd is licensed to use the trade mark relied upon. At SNG9 he exhibits what he says is a copy of that licence. It takes the form of a letter on the headed paper of Medisept International Corporation. It is not entirely clear to me exactly which trade mark is being referred to in that letter but in any event the use of the word “our” would indicate that it is a mark belonging not to Mr Gadhia but to Medisept International Corporation. No other details of the mark are set out in the letter and no explanation is given of any relationship of this company to the opponent.

22. In short, the evidence does not serve to show that genuine use of the earlier trade mark has been made and Mr Gadhia is not entitled to rely on it in these proceedings. That being the case, and as the only grounds he relies upon are those under Section 5(1) and 5(2) of the Act, Mr Gadhia’s opposition to the application fails.

## **Costs**

23. The opposition having failed, the applicant is entitled to an award of costs in its favour. In making the award, I bear in mind that the counterstatement was brief, the evidence filed by the opponent was not extensive with that filed by the applicant minimal and that no hearing took place. I make the award on the following basis:

For filing a counterstatement and reviewing the notice of opposition:	£300
For filing and reviewing the evidence:	£400
For the preparation of written submissions:	£300
<b>Total:</b>	<b>£1000</b>

24. I order Surendra Narandas Gadhia to pay Studex Corporation the sum of £1000 as a contribution towards its costs. 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 8th day of May 2013**

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