

O-300-08

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2257307
IN THE NAME OF ISHTIAQ HUSSAIN ESQ.
OF THE TRADE MARK:**

DUCCIO

**AND THE APPLICATION FOR REVOCATION THERETO
UNDER NO. 82750
BY GUCCIO GUCCI S.P.A**

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In the name of Ishtiaq Hussain Esq.

Of the trade mark:

DUCCIO

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by Guccio Gucci S.p.A

BACKGROUND

1) On 17 January 2007, Guccio Gucci S.p.A , which I will refer to as “Gucci”, filed an application for the revocation of registration number 2257307. The registration is for the word DUCCIO and is registered for “[a]rticles of clothing” in Class 25:

2) Completion of the registration procedure for 2257307 took place on 22 June 2001. On 30 April 2001, the registration was assigned from Cape Design Limited to Ishtiaq Hussain Esq.

3) Gucci seeks revocation of the registration either in full or in part under Sections 46(1) (a) and (b) of the Trade Marks Act 1994 (the Act). It claims that the mark has not been put to genuine use in the United Kingdom by the proprietor or with its consent between 23 June 2001 and 22 June 2006, and between 16 January 2002 and 15 January 2007. Success for Gucci would mean revocation taking effect on either 23 June 2006 or 16 January 2007. There is an overlap between both periods of non-use pleaded, when the registration was owned by Cape Design Limited. This overlap is between 16 January 2002 and 22 June 2006.

4) Mr Hussain filed a counterstatement, claiming the trade mark had been used in the UK since 2001 and used on all goods registered for during the relevant time period.

5) In its application, Gucci pleaded Section 46(1) (a) and, in the alternative, Section 46(1) (b). I have based my decision on the requirement to prove genuine use of the trade mark during both periods of time. It also requests that, where the grounds for revocation exist only in relation to certain goods, it requests revocation in relation to those goods only, pursuant with Section 46(5).

6) Only Mr Hussain filed evidence and both parties seek an award of costs. Gucci requested a hearing. The matter came to be heard on 7 August 2008 when Gucci was represented by Simon Malynicz of Counsel instructed by Msrs Addleshaw Gogard. Mr Hussain was represented by Ms Camila Rahman for J R Jones Solicitors.

EVIDENCE

7) Mr Hussain filed evidence in the form of a witness statement dated 7 April 2008 together with supporting exhibits. He explains that he is the registered owner of the trade mark registration at issue and that he has responsibility for the trade mark portfolio of Duccio Ltd.. The information provided is from his own knowledge or from the records of Duccio Ltd. to which he has access.

8) Mr Hussain states that there is a seven year reputation in the trade mark DUCCIO and that it is a nationally recognised brand. This has led him to apply for a further trade mark and he provides a wide ranging list of Class 25 goods that are the subject of the application, but no further details are provided.

9) I do not intend to summarise Mr Hussain's witness statement or itemise each exhibit here, but I will refer to them in detail later in my decision.

The Hearing

10) At the hearing, the submissions presented in favour of Mr Hussain contained a mixture of arguments in support of his case and evidence of fact being introduced into the proceedings. In accordance with the comments of Simon Thorley sitting as the Appointed Person in ACADEMY (O/169/00), I intend to draw a line between the submissions and the evidence of fact and to disregard the latter. Opportunity is provided for the filing of such evidence during the evidence rounds that precede a hearing and it is not appropriate for such evidence to be introduced at this late stage.

11) At the end of the hearing, Ms Rahman also sought leave to introduce further exhibits into the proceedings. She explained these were in the form of items of clothing in the form of jeans, Asian dresses and T-shirts. I refused this request, explaining that such exhibits would not prove decisive in deciding the case because, at best, they can only demonstrate use of the contested trade mark on certain items of clothing at this time, some eighteen months after the end of the latest relevant period ending on 15 January 2007.

DECISION

12) 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.”

13) 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.

14) The application for revocation is based on Sections 46(1)(a) and 46(1)(b). In *Philosophy di Alberta Ferretti Trade Mark* [2003] R.P.C. 15, the Court of Appeal held that an application for revocation on the grounds of non-use may be made only after the five years following completion of the registration procedure has ended. The date for revocation is the date that the application for revocation was made, and cannot be less than five years from the date the registration procedure was completed. In *WISI Trade Mark* [2006] RPC 22, Geoffrey Hobbs QC, sitting as the Appointed Person said:

“...This permits revocation with effect from the day following the fifth anniversary of completion of the registration procedure in the case of an application which succeeds under s.46(1)(a) and with effect from any subsequent date at which there has been suspension of use for an uninterrupted period of five years in the case of an application which succeeds under s.46(1)(b).”

15) The subject trade mark achieved registration on 22 June 2001, so the five year period for the purposes of Section 46(1)(a) runs from 23 June 2001 to 22 June 2006. The application for revocation was made on 17 January 2007 requesting a date of revocation under Section 46(1)(b) of 16 January 2007 which makes the five year period from 16 January 2002 to 15 January 2007. The proviso to Section 46(3) means that whether or not the registered proprietors have used the mark within the five years following registration, if there is genuine use within the 46(1)(b) periods this will be sufficient to overcome the ground under Section 46(1)(a). However, if there is no use during either period, the registration will stand to be revoked at the earlier of the two possible dates, 23 June 2006.

16) Therefore, I have to consider whether there was genuine use in the UK of DUCCIO, for all or any of the goods for which it is registered, by Mr Hussain between 23 June 2001 and 22 June 2006 and between 16 January 2002 and 15 January 2007.

17) The basis of what constitutes genuine use was decided by the European Court of Justice (ECJ) in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] ETMR 85 at paragraph 47:

“1. Article 12(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that there is “genuine use” of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark that is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”

18) In *La Mer Technology Inc v Laboratoires Goemar SA* [2004] FSR 38, the ECJ considered the extent of use, the amount of use and the types of use that can be considered when deciding whether there has been genuine use of a trade mark:

“20. It follows from those considerations that the preservation by a trade mark proprietor of his rights is predicated on the mark being put to genuine use in the course of trade, on the market for the goods or services for which it was registered in the Member State concerned.

21. Moreover, it is clear from paragraph 39 of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive, even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed to be justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case-by-case assessment which is for the national court to carry out. The characteristics of those products and services, the frequency or regularity of the use of the mark, whether the mark is used for the purpose of marketing all the identical products or services of the proprietor or merely some of them, or evidence which the proprietor is able to provide, are among the factors which may be taken into account.

23. Similarly, as emerges from paragraphs 35 to 39 of *Ansul* set out above, the characteristics of the market concerned, which directly affect the marketing strategy of the proprietor of the mark, may also be taken into account in assessing genuine use of the mark.

24. In addition, use of the mark by a single client which imports the products for which the mark is registered 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 of the mark.”

19) In *Laboratoires Goemar S.A. v La Mer Technology Inc* [2005] ETMR 114, Neuberger LJ held that:

“45 The notion that the use of the trade mark must be substantial or significant before it qualifies as "genuine" seems to me to run into two difficulties in any event. The first is that it does not involve attributing the word "genuine" its natural meaning, although this point of course potentially substantially weakened by the fact that the equivalent word used in the text in Art.10 in other languages may carry with it a slightly different meaning.

46 Secondly, once one imposes a requirement of significance or substantiality, it becomes potentially difficult, time-consuming, and expensive to decide whether, in any particular case, that requirement is satisfied. In this connection, Mr Tritton made a fair point when he suggested that the introduction of a test of significant use could lead to detailed arguments about the precise nature and extent of the market in which a particular trade mark is to be used, as well as a detailed enquiry in many cases as to the precise nature and extent of the use of the particular mark over the relevant five-year period. I do not regard that as a particularly desirable outcome.

47 Although the use of the instant mark within the jurisdiction can be said to be close to exiguous, I do not think it could be characterised as *de minimis*. Even if it could be so characterised, I do not consider that that concept would be a useful or helpful one to invoke or apply, even if it had not been effectively ruled out by the European Court.”

20) In *The Sunrider Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-416/04 P the ECJ stated:

“72 It follows that it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order in *La Mer Technology*, paragraph 25). Thus, when it serves a real commercial purpose, in the circumstances referred to in paragraph 70 of this judgment, even minimal use of

the trade mark can be sufficient to establish genuine use (order in *La Mer Technology*, paragraph 27).”

21) 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 sufficient it is necessary to assess all surrounding circumstances. At the hearing, Mr Malynicz attacked each exhibit of Mr Hussain’s evidence in turn concluding that all of them fail to demonstrate use of the trade mark DUCCIO on any of the goods covered by the registration. Mr Malynicz drew my attention to Section 100 of the Act and how it places an onus upon the registered proprietor to prove that it has made use of the trade mark. He submits that there is insufficient material in the proprietor’s exhibits for the Registrar to apply the *Ansul/Le Mer* principles. In order to test his submission, I will consider each exhibit in turn.

22) Mr Hussain states that between 2000 – 2001 he purchased a range of industrial sewing machines with a view of launching the DUCCIO brand of clothing. At Exhibit IH-1, he provides support for this statement in the form of an undated letter from Kamal (Sewing Machines) Ltd. addressed “[t]o whom this may concern” and attesting that Mr Hussain did buy such machines but, as it does not retain records more than five years old, it is unable to supply a copy of the invoice relating to the transaction. This exhibit also includes what Mr Hussain describes as an invoice. It takes the form of a page from a lined paper pad and includes a hand written list of items with prices attributed to each. The total amount of these items is six thousand pounds. There is a possible reference to the date in that it includes the numerals and letters “2001 Sep” under Mr Hussain’s address that appears near the bottom of the page. If this a reference to the date then it relates to the Section 46(1) (a) period. This exhibit has no reference to DUCCIO.

23) The letter does not comply with the requirements of Rule 55(1) or (3) of the Trade Marks Rules (2000) (as amended). These rules set out a requirement for evidence to be filed in the form of a statutory declaration, affidavit or witness statement. Whilst the exhibit concerned is admissible as an exhibit to Mr Hussain’s witness statement, it is nevertheless a letter solicited for the purposes of these proceedings and without knowing the full facts behind its commissioning, I am unable to accord the exhibit much weight. Nevertheless, it does carry some weight and therefore I need to go on and assess the value of its content. There is nothing to indicate that the sewing machines referred to were used to manufacture products bearing the DUCCIO brand. Therefore, the letter fails to support the claim of genuine use of the DUCCIO trade mark in respect of articles of clothing. The hand written list of goods provided with this letter also fails to support such use as the only reference to DUCCIO is in the address details that appear at the bottom of the page. The top line of this address records the company name as “Cape design T/A Duccio Limited”.

24) In his witness statement, Mr Hussain identifies four retail outlets, namely Nicholls, Premier Leathers, Space Birmingham and Shafran where DUCCIO clothing is marketed and states that there are others, but these are unspecified. To support this statement,

exhibits IH-2 to IH-7 are presented. These consist of a series of invoices, delivery notes and order forms. In more detail, these exhibits consist of:

IH-2 An invoice dated 19 July 2002 from a company called Baltex Clothing relating to eighty pairs of jeans. There is no indication that such jeans feature the Duccio trade mark. The customer is indicated as “Cape Design Duccio”.

IH-3 An invoice dated 28 November 2003 from a wholesale fabric and textile trader named Image House Ltd. for two items identified in hand written script only as “11 oz R/R 9139” and “12 oz R/R Lewis” and totalling £347.21. Mr Hussain states that this relates to the purchase of denim fabric for the manufacture of jeans. The customer is recorded as “Cape Designs T/A Duccio”. There is no further reference to DUCCIO.

IH-4 A document from Ikon Marketing Solutions headed “delivery note” and dated 29 September 2006 detailing in handwritten script that £293.75 was paid for “Duccio design – B/C, C/H, C/S, web page, logo”. The invoice address box is completed with the Duccio Ltd. company name and address. Mr Hussain claims this relates to the creation of a web page for Duccio limited. It does not assist in demonstrating use of DUCCIO in relation to clothing and no collaborative evidence of the existence or content of this website is provided.

IH-5 Two invoices, the first dated 2 April 2002 detailing a quantity of twenty “Duccio brass antique brass” and twenty “aluminium rivet pin” invoiced to “Cape Design Limited”. The total value of this invoice is £215.97. The second, dated 22 November 2006, is invoiced to “Duccio Co. Ltd.” and details “custom item – “Duccio” Logo” and an indication that these items are made of brass. Brass studs and posts are also listed. The quantity of each item is recorded as ten and the total value of the invoice is £910.04. Mr Hussain states that these invoices relate to the “final design on DUCCIO buttons”. In support of this, the exhibit also includes a copy of an e-mail dated 27 October 2001. The senders name is not visible but it was received by V. M. Mason, the distributor of fasteners who issued the two invoices. The subject of the e-mail is “(DUCCI) artwork” and contains a representation of the word DUCCIO appearing twice within the curves of an inner and outer circle. This artwork could be described as a button bearing the DUCCIO trade mark. A photograph of such is also provided, but no reference is made to this and it is undated. No further information has been provided, but as Mr Malynicz pointed out at the hearing, the mere existence of these DUCCIO buttons is not evidence of use of DUCCIO in respect to clothing. Such buttons could equally be used in the manufacture of shoes or bags.

IH-6 Two invoices that, Mr Hussain states, show the manufacture of labels carrying the DUCCIO name. Both are issued by “PP Pre Print Limited” to “Cape Design”. The first, dated 28 February 2002 lists thirty “Duccio real leather patches” and the total value is £881.25. The second, dated 11 April 2002 lists “Duccio 12mm woven labels” with a total value of £235. At the hearing, Ms Rahman explained that

second invoice relates to the purchase of a single pack containing 12800 labels. The product descriptions on both these invoices make reference to DUCCIO but it requires a further step, which is not supported, to accept that these patches and labels were used in the manufacture of DUCCIO branded clothing.

IH-7 An order form and despatch note from John Smedley Limited that Mr Hussain, in his witness statement claimed illustrates the manufacture of T-shirts bearing the DUCCIO trade mark. The order form is dated 7 November 2006 and is completed in hand written script and records a number of different “styles” of product. Under the heading “Labels” the word “Duccio” has been entered. The nature of the products is not explained, but they are split into mens and womens. Each of the six styles listed is attributed a price which varies between £29.20 and £59.20. It is unclear if these prices relate to the total for each style or to individual unit prices. Written across the page is “order form 3 part NCR 500 sets”. The despatch note, dated 29 November 2006, records that “Casper T-shirt CNSS” was despatched to Duccio Limited. The quantity is recorded as three and under the heading of “Labelling” the words “John Smedley Label” appear. At the hearing it became clear that, contrary to Mr Hussain’s contention in his witness statement, these exhibits do not illustrate the manufacture of T-shirts. Mr Hussain was in negotiations with John Smedley and the invoice was actually a quotation from John Smedley that was not taken up by Mr Hussain because he found it “quite expensive”. Once again, the exhibit fails to demonstrate any use of DUCCIO in relation to clothing. At best, it can be interpreted that Mr Hussain was preparing to launch a range of clothing, possible branded as DUCCIO.

25) Mr Hussain states that the DUCCIO trade mark has been used since 2001 on a variety of goods and sold through his retail outlet under the name “Shafran”. In support of this, he provides the following exhibits:

IH-8 A copy of a “Shafran” business card that carries a list of six brand names including Armani and Hugo Boss. DUCCIO is also contained in this list. The very nature of business cards means that it is not dated and it is not therefore possible to ascertain if it is a business card in use during the relevant periods. Further, the reference to DUCCIO could relate to goods other than articles of clothing such as shoes or bags. As such, this exhibit falls short of demonstrating use of DUCCIO in relation to clothing during either of the relevant periods.

IH-9 A letter from Adam Kirby, Local Business Manager for Barclays Bank plc dated 23 April 2007. He is Mr Hussain’s business manager and states that he has “witnessed him (Mr Hussain) selling and manufacturing products in the name of Duccio since 2002 at which time he used a trading name of Shafran and has more recently changed to using the trading name of Duccio”. My comments relating to IH1 are relevant here also. This exhibit takes the form of a “whom it may concern” letter and is considered as hearsay evidence. Mr Malynicz invited me to interpret Mr Kirby’s comments as meaning only that Mr Hussain has traded from time to time as both DUCCIO and “Shafran”, but that it is not possible to

ascertain what goods Mr Kirby had seen being manufactured and sold. Certainly in isolation this potentially important exhibit does fail to enlighten the reader as to what products Mr Kirby has seen being manufactured. This leads me to conclude that it adds little to Mr Hussain's assertions.

IH-10 Mr Hussain explains that this is a "job lot invoice" showing retail products sold to a Birmingham based company called Pathfinder Technologies UK Ltd.. The invoice is dated 24 August 2006 and headed up with both the Shafran and Duccio names. It records "sales job lot £150.00 paid with thanks" and then goes on to list over a hundred clothing items, the first of which is listed as "Duccio jeans". At the hearing, Ms Rahman clarified that this related to the sale of stock when the Shafran shop was closed. I have concerns regarding this exhibit as the list of products consists predominantly of trade mark classification terms that appear to have been extracted from the list of goods in Mr Hussain's later trade mark application detailed in his witness statement. For example, the invoice includes in its list of goods, the terms "wet suits, wet suits for surface water sports, wet suits for surfing, wet suits for water skiing, wet suits for wind surfing" and also the phrase "parts and fittings for all the aforesaid goods". The document is self-evidently incredulous. In light of my doubts over the providence of the document, I am minded to give this document no weight.

IH-11 Mr Hussain explains that this consists of two invoices, but actually appear to be hand written delivery notes generated by Mr Hussain's company. Both are dated 21 November 2003 and are headed with the words "Cape Design (Capo Disegno)" and "Duccio Limited Company 4008284". The first contains a list of clothing products all covered by the heading "Ladies smart casual jean collection Duccio", the second with a list of clothing products all covered by the heading "Gents smart casual jean Duccio". A total of ninety nine items are recorded but there are no prices and the customer is only identified by a customer number and branch number. As such, it is not possible to verify the providence of these documents and no supporting evidence is provided to enlighten this point. As regards the other details in this invoice, Mr Malynicz suggested that the reference to DUCCIO in the list heading could relate to the company rather than the branding of the products. An equally valid interpretation is that the reference to DUCCIO does relate to the branding of the products, but once again, in the absence of any corroborative evidence to clarify this, I am unable to conclude that this exhibit is evidence of DUCCIO in relation to clothing.

IH-12 An acknowledgement of order, dated 19 December 2001, for 5000 carrier bags to be provided by Severn Valley Packaging Ltd. to Cape Design. The form includes a heading "description" and under this section, a subsection for "name". Here "Duccio 12" is recorded. Also, there is an invoice for 3950 bags and totalling £512.30 and a delivery note relating to 5200 bags. Both are dated 18 February 2002. The latter appears to relate to unprinted bags as evidenced with the bag design being recorded as "Cape Design 12" unprntd". The design of the bags covered by the other two documents may include the word DUCCIO but as

Mr Malynicz observed, these exhibits fail to demonstrate external use of the trade mark in relation to clothing. This design may relate either to Mr Hussain's retail activities or to goods that fall outside the scope of the registration at issue.

26) Mr Hussain also states that he has allowed other companies to use the trade mark DUCCIO under licence and in support of this he submits at Exhibit IH-13 copies of two licence agreements. The first is dated 19 July 2001 and permits a company named Premier Leathers International Limited to market the DUCCIO trademark in all its retail outlets and to provide Duccio Limited with the manufacturing facilities to produce clothing bearing the trade mark. The second agreement is dated 3 January 2003 and permits Eric Marsh (trading as Solo Footwear UK) to manufacture and retail shoes and bags bearing the trade mark. The second of these is of no relevance as it only relates to shoes and bags, neither of which are covered by the scope of the registration at issue. The first, relates to clothing, but in the absence of further corroborative evidence it, at best, demonstrates an intention to trade in DUCCIO in relation to clothing, but falls short of demonstrating actual trade.

27) In this case the proprietor of the registration, Mr Hussain, must demonstrate that there has been genuine use of the trade mark DUCCIO in respect to articles of clothing during either the period of 23 June 2001 to 22 June 2006 or the period 16 January 2002 and 15 January 2007. In assessing this point, it is relevant that I look at the frequency as well as the scale of any use shown. Certainly there is no evidence of the DUCCIO brand enjoying a national reputation as contended by Mr Hussain in his witness statement. However, the evidence does create a suggestion that some use has occurred but it fails to define either the volume or frequency of use, or for that matter, what goods it has been used on. In fact, I am left to guess at the significance of many of the exhibits.

28) I am mindful of the comments of the CFI in Case T-334/01, *MFE Marienfelde GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (HIPOVITON)*:

“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.”

29) There is a vagueness to the evidence that may be either intentional or because of Mr Hussain's lack of records. Either way, it is not for me to surmise as to the probability that there has been some relevant use. I must find on the basis of the facts before me. These facts fail to demonstrate that there has been any use of DUCCIO in relation to clothing of any kind.

30) What can be extracted from the evidence is that Mr Hussain, trading as “Duccio Ltd”, has been trading in jeans (Exhibits IH2 & IH11), has considered trading in T-shirts (Exhibit IH7) and has used brass buttons (Exhibit IH5), leather patches and woven labels (IH6) in some undeterminable way through his Shafran retail outlet and, later, his Duccio

retail outlet. It is not clear whether DUCCIO has been used in respect of anything other than the brass buttons.

31) Mr Hussain has been able to provide evidence going back to 2002 relating to activities that collectively can be described as making preparations for sale, but has been unable to provide any concrete evidence of actual sales in respect of DUCCIO clothing during the relevant periods. I have to agree with Mr Malynicz that there is insufficient information in Mr Hussain's evidence for me to assess if there has been even minimal use, the frequency of any use and also whether the trade mark has been used to market some or all of the goods at issue. I must therefore conclude that there has been no genuine use of the trade mark DUCCIO in relation to "articles of clothing" within either of the periods pleaded under Sections 46(1) (a) and (b) of the Act.

Application to admit further evidence

32) On 12 September 2008, the proprietor filed further evidence, urging that I admit it into the proceedings as it "is crucial to our client's case and shows use of the mark in the relevant period". In the accompanying witness statement, Mr Hussain explained that the evidence "was not in [his] possession and [he] was not able to obtain the items prior to the hearing date". He goes on to say that "at the time [of the hearing] the evidence was not available nor was [he] aware that it existed". The Registrar invited the applicant to comment on the admissibility of this evidence and on any cost implications and I take its response into account in making my decision on whether to admit the further evidence.

33) I considering whether to admit the evidence, I also bear in mind the guidance of Mr Geoffrey Hobbs QC sitting as the Appointed Person in *Lappet Manufacturing Co. Ltd. v Yosif Abdulrahman Al-Bassam Trading (AL-BASSAM)* O-467/02:

"38. The filing of additional evidence requires leave so that the Registrar can be satisfied that an extension to the expired timetable for the filing of evidence in the prescribed sequence should be granted in the particular circumstances of the case in hand. The Rule [Rule 31A(6) is the relevant rule under the Trade Marks Rules 2000 (as amended)] specifically envisages that leave may be given "*at any time*". The burden of persuasion is clearly upon the party asking for the indulgence. The position adopted by the opposite party may well have a bearing on the answer to be arrived at. In a case such as the present, where rectification of a procedural irregularity is required, I think it is necessary to consider: (1) the materiality of the evidence in question to the issues that the Registrar has to determine; (2) the seriousness of the irregularity which the Registrar is being asked to rectify; and (3) the justice and fairness of subjecting the opposite party to the burden of the evidence in question at that stage of the Registry proceedings. These are matters of degree. Over and above that, a judgment must be made as to their relative weight in the context of the given case."

34) Firstly, I must consider if the new evidence is material to the proceedings. I do not believe this to be the case here. The four exhibits accompanying Mr Hussain's witness

statement provide a further illustration of activity that can be described as preparations to begin trading. But once again, these exhibits fall short of demonstrating use of DUCCIO in relation to clothing. The first two exhibits relate to a fashion show that took place at a night club called Liberty's on 30 October 2002. The showing of DUCCIO branded clothing at this event is not evidence of any trade in such goods, only that there was an intention to trade. Similarly, the third and fourth exhibits relate to studio photographs showing DUCCIO branded clothing. It is not known if the photographs have ever been used for any marketing activity let alone if that then resulted in any trade in DUCCIO branded clothing. As such, they are of little persuasive value.

35) With regard to the second point, I recognise that the registration of the proprietor's trade mark is at issue, but as I have already commented above, this evidence is of little persuasive value and despite the serious consequences of the proprietor failing to demonstrate genuine use of his trade mark, my conclusions above mean that the seriousness of the issue will not be determinative in my decision to grant leave to admit this evidence.

36) Thirdly, taking account of my considerations on the first point, I do not believe it is just or fair to subject the applicant for revocation to the additional burden that would result from admitting the evidence.

37) Taking these factors into account, I do not consider it appropriate that I exercise my discretion and admit the evidence.

38) On the 27 October 2008, Mr Hussain filed further evidence together with a form TM54 Notice of Further Evidence. This evidence takes the form of another "to whom it may concern" letter, this time from Mr Bob Manning, Course Director, ND Fashion & Clothing at Birmingham City University. My comments regarding the earlier "to whom it may concern" letter are equally applicable and I will not repeat my comments here other than to say that such exhibits carry little weight. As to the content of the letter, Mr Manning states that Mr Hussain, whilst a student attending his course (which he completed in June 2005), included garments incorporating the logo "Duccio" in his "final catwalk collection". He also states that, during this time, Mr Hussain had his own fashion retail outlet called "Shafran" which sold his design work using his logo "Duccio". Without supporting evidence that such use was for goods relevant to these proceedings and was more than mere token use, I find that this evidence is not material to the proceedings. I have not asked the applicant to comment on the admissibility of this latest exhibit as, to do so, would introduce further delay into the proceedings and also increase costs. As such, I find that it would be disproportionate to entertain the admission of this evidence at this very late stage and leave to admit it is refused.

CONCLUSIONS

39) In finding that the trade mark has not been used on “articles of clothing”, I do not need to decide the applicant’s secondary argument that, as an alternative, I should consider a limited specification reflecting a commercial sub-category of goods.

40) In summary, I find that there has been no use within the relevant time periods and the registration shall be revoked in its entirety under the provisions of Section 46(1) (a) in respect of all the goods with effect from 23 June 2006.

COSTS

41) The applicant for revocation has succeeded and is entitled to a contribution towards its costs. I award costs on the following basis:

Preparing and filing TM26(N) and accompanying statement	£300
Consideration of counterstatement	£200
Considering evidence	£500
Preparation for, and attending hearing	£700
TOTAL	£1700

42) I order Mr Ishtiaq Hussain to pay Guccio Gucci S.p.A. the sum of £1700. 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 3rd day of November 2008

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