

O/875/22

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 3142026
IN THE NAME OF GUMBIES LIMITED OF THE TRADE MARK**

GUMTREE

IN CLASSES 18, 25 AND 28

AND

**THE APPLICATION FOR REVOCATION THERETO UNDER NO.
503872
BY GUMTREE.COM LIMITED**

Background and pleadings

1. Trade mark registration 3142026 completed its registration procedure on 1 April 2016 for the following goods:

Class 18: Leather and imitations of leather; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; articles of luggage being bags; baggage; travel baggage; travel bags; weekend bags; work bags; toiletry cases sold empty; tool bags [empty]; sports bags; shopping bags; bags for clothes; bags made of leather; bags made of imitation leather; bags made of plastics; money bags; school bags; shoe bags.

Class 25: Clothing; footwear; headgear.

Class 28: Sports equipment and accessories therefor.

2. It stands registered in the name of Gumbies Limited (“Gumbies”), having been assigned on 23 September 2021 from the original owner, Michel Roger Maurer.¹

3. This decision concerns an application by Gumtree.com Limited (“the applicant”) to revoke the registration under section 46(1)(a) of the Trade Marks Act 1994 (“the Act”). The applicant claims that the trade mark was not put to genuine use by the proprietor or with its consent between 2 April 2016 and 1 April 2021 (“the relevant period”), seeking an effective date of revocation of 2 April 2021. The application form TM26(N) was filed on 24 May 2021 and records that the applicant gave the registered owner notice on 25 February 2021 of its intention to seek revocation (“registered owner” being the term used in the Form TM26(N)).

4. The original owner, Michel Roger Maurer, filed a defence and counterstatement (prior to the assignment), denying the claim:

¹ A form TM16 was filed at the Intellectual Property Office on 8 October 2021 to record the change of ownership.

“We deny that the subject trade mark has not been put to genuine use in the UK within the period of 5 years following the date of completion of the registration process.”²

5. The applicant is represented by CMS Cameron McKenna Nabarro Olswang LLP and Gumbies is represented by Bristows LLP. Only Gumbies filed evidence. Both parties filed submissions during the evidence rounds and the applicant filed written submissions in lieu of an oral hearing.³ I make this decision after a careful reading of all the papers, referring to the evidence and submissions as necessary.

6. The relevant parts of Section 46 of the Act state:

“46. - (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) [...]

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name

² The defence and counterstatement was filed by Mr Maurer’s professional representatives at the time.

³ Gumbies filed submissions with its evidence and in reply to the applicant’s submissions.

of the proprietor), 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) [...]

(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 existing at an earlier date, that date”.

7. The onus is on Gumbies to show genuine use because Section 100 of the Act states:

“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.”

8. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch), Arnold J (as he then was) summarised the law relating to genuine use, as follows:⁴

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark:

⁴ “CJEU” is the abbreviation for the Court of Justice of the European Union. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive, which is why this decision continues to make reference to the trade mark case-law of EU courts.

Ansul at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic

sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

9. In its written submissions filed with its evidence, Gumbies says:

“24. The Proprietor does not dispute the revocation application against the goods in classes 18 and 28 in their entirety and for the remaining goods in class 25, namely “*Clothing; headgear*” and voluntarily surrenders these classes and specific class 25 goods from the Registration.”

10. As a result, the registration is revoked under section 46(6)(b) in respect of classes 18 and 28 and *Clothing; headgear* in class 25, with the effective date of revocation being 2 April 2021.

Evidence

11. Gumbies has filed evidence from two witnesses. Michel Maurer is Gumbies' Director, and the previous owner of the mark.⁵ The other witness is Fanny Zhuang, the General Manager of the company which manufactures goods for Gumbies which bear the contested mark.⁶

12. Mr Maurer has been a Director of Gumbies since 2006. As the previous owner of the contested mark, he authorised Gumbies to use the mark from 1 April 2016. Mr Maurer states that the purpose of his evidence is to demonstrate that the mark has been put to genuine use in respect of 'footwear products'.

13. Mr Maurer states that Gumbies has a strong environmental and sustainability focus. The mark was applied for in December 2015 in the UK and initial discussions were held with a company called Flourishing Fanny Trading Company Ltd ("FF") from 2016 onwards to agree a manufacturing process which aligned with Gumbies' sustainability commitment. Mr Maurer states that the manufacturing process is not something that can be completed easily and the goods cannot be mass-produced whilst also maintaining the sustainability commitment. As an example, Mr Maurer states that "recycled rubber is the primary material, which is mixed with jute before sandwiching an ethylene-vinyl acetate (EVA) layer in the middle and adding a layer of natural canvas on top."

14. Exhibit MRM1 comprises copies of some of the email exchanges between Gumbies and FF: these are all from 2020. An email dated 21 August 2020 from Gumbies to FF refers to "Gumbies GUMTREE flip-flop samples ... that you had kindly sent to us a while ago." The email went on to enquire as to whether the inside of the strap could be made in cotton or bamboo, and a reply four days later from FF said that the straps could be lined in cotton. The reply confirmed that a trial sample would be made. On 31 August 2020, FF confirmed by email that a sample had been sent to

⁵ Witness statement dated 27 October 2021 with exhibits.

⁶ Witness statement dated 19 October 2021 with exhibits.

Gumbies by DHL. On 3 September 2020, Gumbies confirmed that the sample was acceptable and that it would like to proceed with the version of the flip-flop.

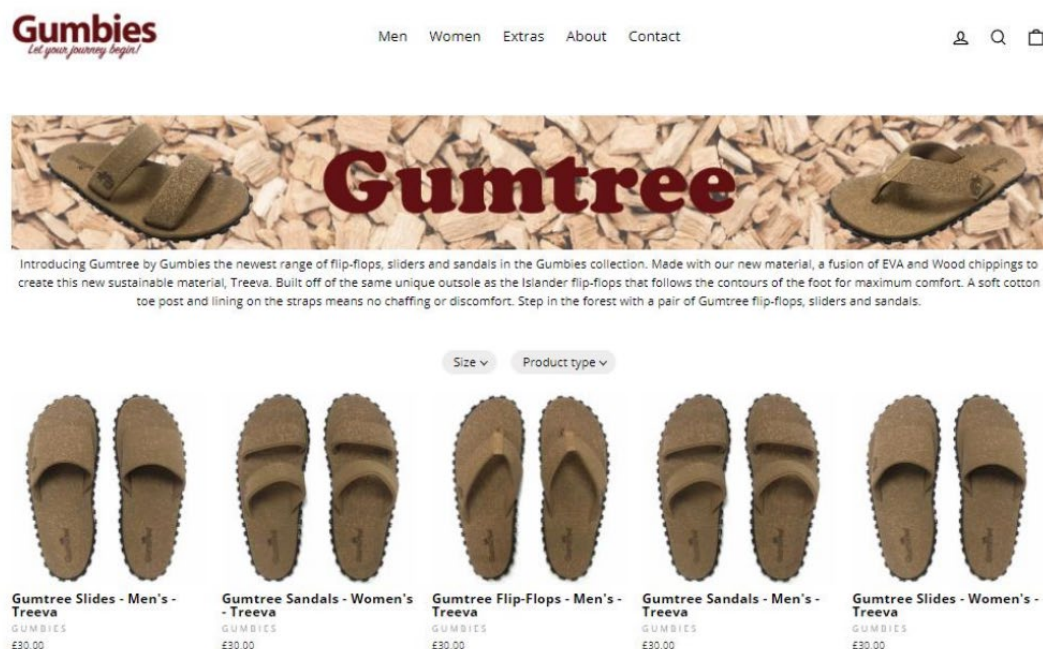
15. Mr Maurer states that, in anticipation of the launch of the new, sustainable goods, display stands were created in 2018 bearing the contested mark and used as in-store displays and at trade shows to present the goods. Exhibit MRM2 comprises photographs of the stand and a copy of an email from the creator of the stand to Mr Maurer about the price and the font style. The email is dated 19 February 2018. The stand looked like this:

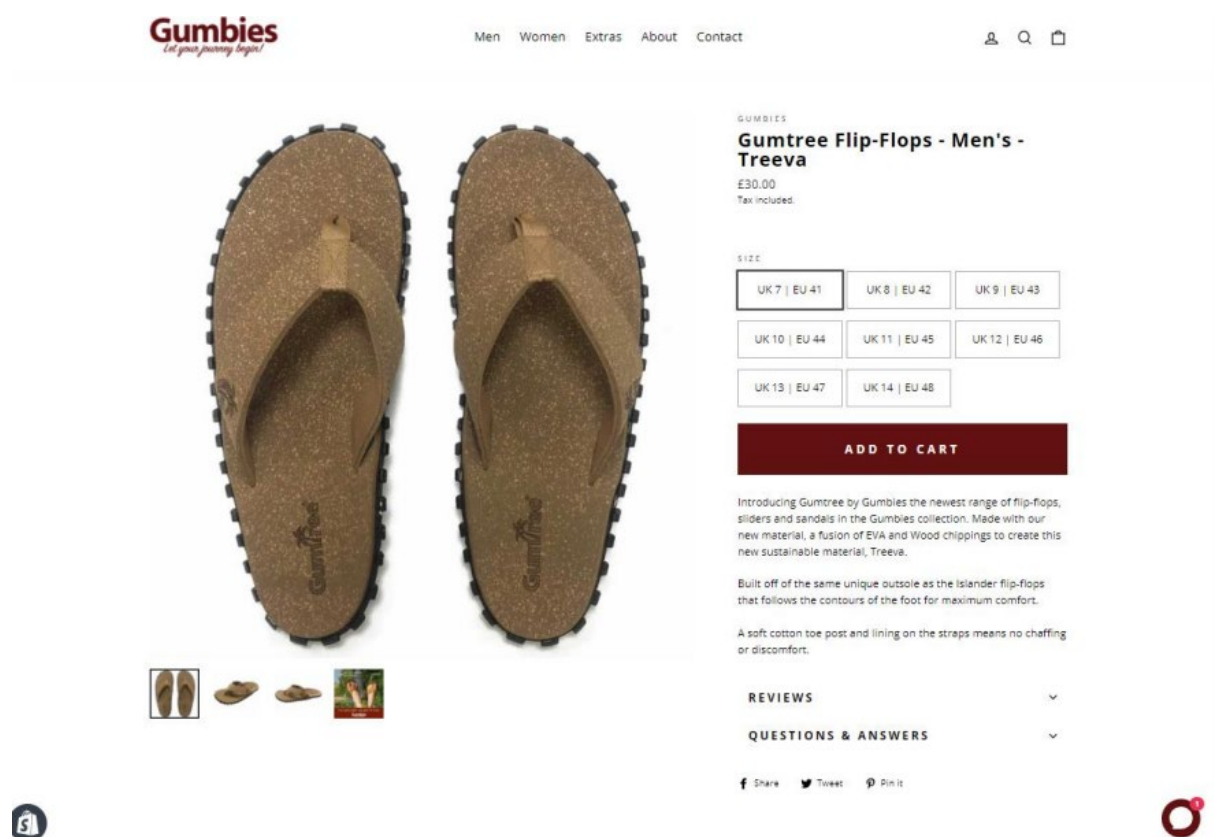


16. Mr Maurer explains that following the lengthy manufacturing process and the various delays due to the global pandemic, which he dates as ensuing from December 2019, a production order for goods bearing the contested mark was placed by

Gumbies in November 2020. Exhibit MRM3 comprises a copy of the sales invoice for the order relating to what Mr Maurer describes as the “vast amount of money invested in the Products.” I note that the invoice records that the shipment was from China to the UK by sea and that the invoice is dated 24 November 2020. There are other marks mentioned on the invoice. In respect of GUMTREE “Sandal”, “Slider” and “Flip-flop”, the numbers ordered were, respectively, 528, 528 and 972. The order for GUMTREE goods came to US\$8,078.34, with a unit price of around US\$4.

17. Mr Maurer states that the goods bearing the mark were shipped to the UK in March 2021. Exhibits MRM4 and MRM5 comprise undated screenshots of the goods on the Gumbies.co.uk website, retailing at £30 per pair:





18. Exhibits MRM6 and MRM7 comprise photographs of packaging and sales tags. An undated photograph of a box in Exhibit MRM6 is as follows:



An undated photograph of goods in Exhibit MRM7 is as follows:



19. Mr Maurer states that “[a]lthough the Products had only recently been listed in respect of the end of the relevant period, they were released for sale on 25/03/2021.” This was about a week prior to the end of the relevant period, and the first actual sale took place on 29 March 2021. A single sales invoice of that date is provided in Exhibit MRM8, for a pair of women’s sandals at a cost of £30. The invoice refers to “1x Gumtree by Gumbies”, to a customer in Kent. Mr Maurer states that sales amounted to £60 in the relevant period, which I infer to amount to sales of two pairs, in the last few days of the relevant period, since he states that the first sale took place on 29 March 2021. In the six months after the end of the relevant period (April to September 2021), Mr Maurer states that sales amounted to £7,567.67. A single example of a summer sales campaign marketing email, sent outside of the relevant period, is shown as Exhibit MRM9. It is dated 19 September 2021:

Gumbies
Let your journey begin!



Our Gumtree range of flip-flops, sliders and sandals are designed to help you re-connect with nature. Made with our most sustainable material yet, a fusion of EVA and Wood chippings. Furthermore, with every order we plant 10 Mangrove trees on your behalf. Tree-mendous!

20. Fanny Zhuang, the General Manager of FF and Gumbies' other witness, begins her witness statement by stating that FF is the Chinese based manufacturer of the footwear products bearing the mark. She states that these have been developed by Mr Maurer and his company in the UK. She confirms that the goods have been in development since 2016 when Mr Maurer and Gumbies approached FF. She states that the material for the goods is a mixture of EVA and tree chippings. Ms Zhuang states;

"It is a difficult material to create and manufacture with, so it took a long time to perfect. Tree chippings are natural and renewable resources and reduces dependence on non-renewable oils. Due to the type of materials used, more time is spent collecting and drying the wood chippings and in the production of the products. Wood chippings can easily go mouldy in a humid or wet environment, so we have to pay more attention and try to produce the products at a time when the environment suits the requirements.

21. Ms Zhuang confirms that Gumbies placed a production order for footwear goods bearing the contested mark in November 2020 and that FF began to ship the goods to the UK in March 2021. She attaches the same invoice from FF to Gumbies that Mr Maurer exhibits.⁷ Ms Zheung states:

“Due to Covid-19, some material factories and shoe factories were unable to fulfil production times as normal.”

Decision

22. Some of the evidence points to manufacturing difficulties, which are often a feature of revocation cases in which defences are based upon proper reasons for non-use. Gumbies’ written submissions refer to “special circumstances outside of the Proprietor’s control” and:

“27. Should the Registry be minded to not find that there is genuine use of the Mark during the Relevant Period, it is respectfully submitted that there have been significant delays outside the Proprietor’s control and which affected the production and manufacturing process due to the special circumstances surrounding the COVID-19 pandemic.”

23. Notwithstanding the £60 of sales in the last week of the relevant period, it is not open to me to consider whether the evidence amounts to proper reasons for non-use because this has not been pleaded as a defence.⁸ The defence is based upon genuine use. I will consider the evidence about manufacturing difficulties as proffering an explanation as to why genuine use had not been made earlier, but that there had, nevertheless, been genuine use within the relevant period.

24. Mr Maurer and Ms Zhuang both state that discussions about the manufacturing process began in 2016 (they do not say when in 2016), which is the year when the contested mark became registered (1 April 2016). However, the evidence about

⁷ Mr Maurer’s Exhibit MRM3 and Ms Zhuang’s Exhibit FZ2.

⁸ See the decision of Mr Geoffrey Hobbs KC, sitting as the Appointed Person in *Furnitureland.co.uk Limited v Furniture Village Limited*, BL O/128/14.

discussions between them dates from the latter half of 2020. One of the emails (21 August 2020) refers to GUMTREE samples that were sent to Gumbies from FF “a while ago”. This begs a question as to how long “a while ago” was. Matters progressed thereafter, with approval of the sample (sent on 31 August 2020) given by Gumbies on 3 September 2020 and an order placed on 24 November 2020 for a shipment of the goods to the UK, four months before the end of the relevant five-year period. The shipment was made in March 2021, the final month of the relevant five-year period.

25. The shipment was for about 2000 pairs of sandals, ‘sliders’ and ‘flip-flops’. Only two sales took place in the relevant period, at the end of March 2021, a week before the period expired. Gumbies has explained that its chosen manufacturing method took time to bring to fruition, because of the focus on sustainability rather than mass production using standard materials for footwear. This was a choice made by Gumbies, after it had applied for and registered the contested trade mark in the UK.⁹ Both of Gumbies’ witnesses mention manufacturing delays caused by the Covid-19 pandemic, but do not give specifics. 2020 was the first year of the pandemic, when most of the world was in prolonged and severe lockdowns or restrictions, but there is no explanation as to what progress was made with respect to manufacturing prior to 2020 (i.e. during 2016, 2017, 2018 and 2019). Assessments of genuine use must take into account evidence of use, not evidence explaining non-use.¹⁰

26. There is also little evidence regarding other activity relating to preparations to bring the goods bearing the mark to the UK market. I note that the display stands were created in 2018. Mr Maurer states that these were “used as in-store displays”, but the rest of the evidence shows that the goods were not available in the UK before March 2021. The photographs of the stand appear to be in a storage facility, not on a shop floor. Mr Maurer does not say in which shops the display stands were used or how many shops used them for in-store displays. Similarly, he states that the stands were used at trade shows to present the goods, but gives no details as to what the trade shows were, where they took place or when they took place.

⁹ Evidence provided concerning a trade mark registration in China is irrelevant.

¹⁰ CJEU Case C-252/12, *Naazneen Investments Ltd v OHIM*, paragraph 74.

27. This is important because whilst the rest of the evidence points overwhelmingly to there being no GUMTREE goods in the UK prior to March 2021, it would be a point in Gumbies' favour if it could show that it had advertised its anticipated goods under the mark in order to secure customers. The goods were anticipated because there weren't any in the UK prior to March 2021 and none were available for sale until 25 March 2021. It is not fatal to a proprietor's case that no actual goods existed, if efforts have been made to secure customers. Mr Daniel Alexander KC, in *Hoho Entertainment Limited v Clevercat Productions Limited* ("The Baba House"), observed:¹¹

"16. Second, in *Ansul* paragraph [37] (which is reproduced above as cited in paragraph [30] of the Hearing Officer's decision) the CJEU did not in terms state that it was a necessary requirement of genuine use in EU law that the goods in relation to which the mark was said to have been used had to exist at the time of use. The CJEU indicated that it was a requirement that use of the mark had to relate to goods or services already marketed or about to be marketed but the CJEU contemplated a broad enquiry having regard to the particular circumstances of the trade."

28. *The Baba House* concerned children's animated films, which the proprietor had created and shown to potential customers (such as the BBC). Mr Alexander continued:

"25. As I read the decision, the Hearing Officer treated the fact that the full films and other products did not exist and that no-one had bought them as determinative (see underlined passage in the extract from the decision above). This meant that he left out of account in reaching his conclusions the fact that there had been strenuous and detailed efforts to interest the market specifically in films, including the supply of a prototype cartoon which put the market into a position to decide whether it wished to purchase the relevant goods or not. Although this did not lead to commissioning of a full film series, it did attract

¹¹ BL O/049/15.

interest and was activity directed at creating (and if possible maintaining) a market for those films.”

29. Where there are no actual customers, the mark must have been used externally so as to constitute “preparations by the undertaking to secure customers”, per *Ansul* at paragraph 37 (emphasis added):

“It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.”

30. In *Spartan Race Inc v Bio-Synergy Ltd*, Mr Simon Clark, sitting as the Appointed Person, stated:¹²

“28. Mr Walters therefore argued that the references to “*goods ... which are about to be marketed*”, “*preparations to secure customers*” and use “*to create ... an outlet for the goods or services that bear the mark*” are broad enough to include discussions between a trade mark proprietor and a third party to market goods, prior to any public disclosure of those goods. As an example, he gave discussions between a proprietor and a third party to develop client databases. He therefore submitted that the statement in the amended counterstatement referring to discussions to use the Trade Mark on all the goods of the registration amounted to evidence of genuine use, and while he accepted that

¹² BL O/923/21.

the reference to draft agreements did not amount to separate evidence of genuine use, he suggested that they put those discussions in context.

29. In my view, this is not a correct interpretation of the case law.

30. Paragraph 37 of the judgment in *Ansul* commences:

“It follows that ‘genuine use’ of the mark entails use of the mark **on the market** for the goods or services protected by that mark and not just internal use by the undertaking concerned.” (emphasis added)

31. The later sentence, which refers to preparations to secure customers, must therefore be read in that context:

“Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns.”

31. Preparations by the undertaking to secure customers are required, not merely preparations to use the mark. Gumbies has provided no dated evidence about its preparations to secure customers. There is no evidence that there were goods bearing the mark in the UK shown at trade shows or put on the display stands prior to March 2021. If there were, it has not been explained how they were obtained, given the lengthy manufacturing trials and a single sample supplied in August 2020. No orders by Gumbies for the goods were made before 24 November 2020. The website exhibits are undated; the only reference to the timing of the website is that Mr Maurer states that “[a]lthough the Products had only recently been listed in respect of the end of the relevant period, they were released for sale on 25/03/2021.” This is vague and suggests that when the products were released for sale, which was in the week just before the end of the relevant period, it was prior to the website going live. Mr Maurer states that Gumbies has a global presence, “having over 57,000 people liking its UK Facebook page.” The use of the present tense indicates that this figure is contemporaneous with the date of Mr Maurer’s witness statement, 27 October 2021,

nearly seven months after the end of the relevant period. There is no evidence of any advertising or, for example, approaches made to retailers; nor of any other external use of the contested trade mark by Gumbies (or Mr Maurer, or with his consent), to secure customers (including trade customers) during the relevant period.

32. This case differs from *The Baba House* (which the Appointed Person acknowledged was borderline). In that case, there was detailed evidence about the use made of the mark in the relevant period by the proprietor to secure customers. *The Baba House* product was commissioned. The goods in the present case are everyday consumer items for which there is a huge market and which are not bespoke, commissioned, or niche. Notwithstanding Gumbies' own issue with manufacturing and materials, the characteristics of the footwear market are that it is generally fast-moving. The goods are relatively easy to produce and do not require a long lead time (in contrast with, for example, television films and programmes, or cars). Mr Alexander, sitting as the Appointed Person in *James Grant Group Limited v James Arthur*, said (emphasis added):¹³

“21. In addition to the case law referred to above, *Abanka dd v Abanca Corporación SA* [2017] EWHC 2428 (Ch), [2018] Bus LR 612 which was approved in *Walton*, emphasised the importance of showing some steps taken by the proprietor to develop the market for its products (see paragraphs [91] and [102] referring to the need to show serious efforts to develop the market and that very limited use may itself be evidence that the proprietor has not taken steps to develop the market for the goods in question). In this case, there was no evidence that this had been done in any meaningful way.

22. Third, the Appellant says that the hearing officer was inconsistent in finding that “numbers do not matter and then imply[ing] they do”. This is a different way of formulating the second argument discussed above. The answer to it is that genuine use is not exclusively about numbers but numbers are some indication of the extent to which use is to be regarded as satisfying the legal test. Where there have been substantial sales in a relevant period, the tribunal will readily

¹³ BL O/543/20

conclude that real efforts have been made to develop the market. Sales may be evidence of that. However, in a case where there have been almost no sales over a 5 year period, a proprietor may have to do more than point to that tiny number alone to show that, despite the small number, real efforts have been made to develop the market. This is a situation in which on the evidence, there were sales in some whole years of just a handful of articles.”

33. The evidence falls far short of showing preparations to secure customers in the relevant period, not merely preparations to use the mark. The only dated evidence of external use or advertising is the summer sales campaign, dated over five months after the end of the relevant period. Mr Alexander, sitting as the Appointed Person in *Awareness Limited v Plymouth City Council*, stated that:¹⁴

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

34. Gumbies has not shown that there was genuine use of the contested mark in the relevant period. The sale of two pairs of sandals in the final week of the five-year period, without an explanation as to what efforts had been made in the previous five

¹⁴ BL O/236/13.

years to secure customers, to create a share in the market for the goods in question, and what had been done in 2016, 2017, 2018 and 2019, is insufficient.

35. In its written submissions filed with its evidence, Gumbies says:

“4. No evidence of use is filed in respect of classes 18 and 28 in their entirety, nor for the remaining goods in class 25, namely “clothing; headgear”. The Proprietor wishes to voluntarily surrender these goods from the Registration.

5. As a result, in accordance with section 46(3) of the Trade Marks Act 1994, the GUMTREE Registration cannot be revoked for non-use insofar as the class 25 “footwear” goods are concerned.”

36. Reliance upon section 46(3) is a defence which must be pleaded.¹⁵ It was not pleaded as a defence in the counterstatement. However, since it was raised in written submissions filed with Gumbies’ evidence, rather than in submissions at the end of the proceedings, I will deal with the point.

37. Section 46(3) of the Act states:

“(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.”

¹⁵ *Furnitureland.co.uk Limited v Furniture Village Limited, supra.*

38. As stated earlier in this decision, the applicant gave the registered owner notice on 25 February 2021 of its intention to seek revocation, and the application for revocation was filed on 24 May 2021. The goods were shipped to the UK in March 2021 and the first sales (£60) took place in March 2021, after the date on which the applicant gave Gumbies' notice of its intended application. Although the order for the goods from FF was made prior to the applicant giving notice of its intention to file the revocation application, I do not think that Gumbies can rely upon section 46(3) of the Act.

39. The use referred to in that section is use which commenced or resumed after the expiry of the five year period. Gumbies' case is that it commenced use prior (albeit just prior) to the expiry of the five year period. The use must also have been before the application for revocation was made (24 May 2021). This means that I could potentially take into account the sales amounting to £7,567.67 if I knew that the sales or a proportion of them took place between 2 April 2021 and 23 May 2021. The problem is that I do not know when those sales took place, which amounted over the six month period after the end of the relevant period only to about 250 pairs of sandals, assuming a retail price of £30 per pair. Sales figures for the period between 2 April 2021 and 23 May 2021 cannot be assumed given the very seasonal nature of the goods, as shown in the invoice for the sale of sandals on 29 March 2021.

40. The only other evidence is the marketing email, but this dates from 19 September 2021, five months after the expiry of the five-year period and well after the application for revocation was made. The evidence does not show that Gumbies can rely on section 46(3) of the Act.

Outcome

41. The application for revocation succeeds in full. Under section 46(6)(b) of the Act, the registration is revoked from 2 April 2021.

Costs

42. The applicant has been successful and is entitled to a contribution towards its costs, based on the scale published in Tribunal Practice Notice 2/2016. The award is as follows:

Official fee	£200
Preparing a statement of case and considering the counterstatement	£200
Considering and commenting on the proprietor's evidence	£500
Written submissions in lieu of a hearing	£300
Total	£1200

43. I order Gumbies Limited to pay to Gumtree.com Limited the sum of **£1200**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of October 2022

Judi Pike
For the Registrar,
the Comptroller-General