O/0287/25

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003889370
IN THE NAME OF GEMTEX SDN BHD
FOR THE FOLLOWING TRADE MARK:

GEMTEX

IN CLASSES 9 AND 45

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 506636
BY GENTEX CORPORATION

BACKGROUND AND PLEADINGS

1. Gemtex SDN BHD ("the proprietor") applied to register the trade mark on the cover page of this decision in the UK ("the proprietor's mark"). The application was published for opposition purposes on 31 March 2023 and entered into the register on 9 June 2023. The proprietor's mark stands registered for the following goods and services:

> **Class 9:** *Fire extinguishing systems, namely gaseous fire suppression systems; Fire extinguishing apparatus, namely gaseous fire suppression apparatus; Fire extinguishers; Sprinkler systems for fire protection.*
>
> **Class 45***: Fire prevention consultancy; Fire fighting services; Rental of fire extinguishers; Providing information relating to the rental of fire extinguishers.*

2. On 20 October 2023, Gentex Corporation ("the applicant") sought a declaration of invalidity against the proprietor's mark under section 47 of the Trade Marks Act 1994 ("the Act"). The application for invalidity is based on section 5(2)(b) of the Act, the applicant relies on the following mark:

GENTEX

UK00009082629911

Filing date 15 April 2009; Date of entry in register 17 February 2010

Relying on the following goods:

("the applicant's mark")

Class 9: *Smoke detectors and alarms, fire detectors and alarms, carbon monoxide detectors and alarms, audible and visual notification appliances, and combinations thereof.*

[1] The applicant's mark is a comparable mark based upon an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their European counterparts.

3. The applicant claims that there is a likelihood of confusion because the proprietor's mark is highly similar to its own mark and the respective goods and services are similar. The proprietor filed a counterstatement denying the claims made against it.

4. Only the applicant filed evidence in chief. The proprietor did not file submissions nor evidence. The applicant is represented by Kilburn & Strode LLP and the proprietor is represented by Trademarkit LLP.

5. The provisions of the act relied upon in these proceedings are assimilated law as they are derived from an EU law. Although the UK has left the EU section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

6. The applicant's evidence came in the form of two witness statements, one of Ryan Pixton and the other of Scott P Ryan. Mr Pixton's evidence is dated 27 March 2024 and is accompanied by one exhibit labelled RP1. Mr Pixton is a Chartered Trade Mark Attorney at Kilburn & Strode LLP. This evidence consists of a snapshot from the 'wayback machine' demonstrating the Gentex website on three dates between 2020 and 2022.

7. Mr Ryan's evidence is dated 26 May 2024 and is accompanied by three exhibits labelled SPR 1-3. Mr Ryan is the Vice President, General Counsel and Corporate Secretary of the applicant. He has held these positions since October 2018. Mr Ryan's evidence has been provided to prove use of the applicant's mark in relation to the goods and services relied upon.

8. I do not intend to summarise the evidence at this stage (or their submissions for that matter). However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

9. Section 5(2)(b) of the Act has application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:

"47. (1) […]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

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

(b) […]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

(a)the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered—

(i)within the period of 5 years ending with the date of application for the declaration, and

(ii)within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or**]**

(b)it has not been so used, but there are proper reasons for non-use

[…]

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) […]

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) […]

(3) […]

(4) […]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

10. Section 5 of the Act reads as follows:

"(2)A trade mark shall not be registered if because—

(a)it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b)it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

PROOF OF USE

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"(6)(1) In this Act an "earlier trade mark" means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[…]

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered,

would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

12. Section 100 is also relevant, which reads:

> "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."

13. The applicant's mark qualifies as an earlier trade mark under the above provisions because it was applied for prior to the filing date of the proprietor's mark. As it completed its registration process over five years prior to (1) the filing date of the contested mark and (2) the date of the application at issue, it is subject to the use provisions. As set out above, the proprietor requested that the applicant provide proof of use in respect of its mark. Therefore, the applicant's mark is subject to proof of use.

14. Given that the applicant's mark is a comparable mark, paragraph 9 of part 1, schedule 2A is relevant. It reads:

> *"Grounds for invalidity of registration of a trade mark based upon an earlier comparable trade mark (EU)*
>
> 9(1)Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.
>
> (2)Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day—
>
> (a)the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and
>
> (b)the references in section 47 to the United Kingdom include the European Union.

(3)Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day—

(a)the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b)the references in section 47 to the United Kingdom include the European Union."

15. In *EasyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439, Case C-259/02 La Mer Technology Inc v Laboratories Goemar SA [2004] ECR I-1159, 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 I9223, 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], Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], 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], Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 Ferrari SpA v DU [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a subcategory of goods or services, the principles 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: Ansul at[36]; Sunrider at [70]; Verein at [13]; Centrotherm at [71]; Leno at [29]; Ferrari at [32].

(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]; Centrotherm at [71]; Leno at [29]; Gözze at [37], [40]; Ferrari at [32].

(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]. 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].

(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]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34]; Leno at [29]-[30], [56]; Ferrari at [33].

(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]; 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]."

16. As regards the territorial scope of the use of an EUTM, in *Walton International,* Arnold J (as he then was), after setting out the eight applicable principles when assessing genuine use (which are the same as the eight principles he subsequently set out in *easyGroup Ltd* - which are detailed above), added the further three principles when assessing genuine use in the EU:

"118.*The law with respect to genuine use in the Union*. Whereas a national mark needs only to have been used in the Member State in question, in the case of a EU trade mark there must be genuine use of the mark "in the Union". In this regard, the Court of Justice has laid down additional principles to those summarised above which I would summarise as follows:

(9) The territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to genuine use in the Union: *Leno* at [44], [57].

(10) While it is reasonable to expect that a EU trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be deemed genuine, since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]–[55].

(11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory of a single Member State, and in such a case use of the EU trade mark in that territory might satisfy the conditions for genuine use of an EU trade mark: *Leno* at [50]."

17. I am also guided by *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

"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."

18. I also note Mr Alexander Q.C.'s comments in *Guccio Gucci SpA v Gerry Weber International AG*, Case BL O/424/14. He stated:

"The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. […] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the best evidence first time round – or lose it"" [original emphasis]

19. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

20. As per section 47(2B) of the Act (cited above), the relevant periods for the present assessment are the five-year periods ending with the filing date of the contested mark (being 15 March 2023) and the date of application at issue (being 20 October 2023). The relevant periods are, therefore, 14 March 2018 to 15 March 2023 ("the first relevant period") and 19 October 2018 to 20 October 2023 ("the second relevant period"). Given that there is a significant overlap in the relevant periods, my assessment of the evidence of proof of use will be directed to the evidence that relates to use between 14 March 2018 to 20 October 2023.

21. Proven use of a mark which fails to establish that the commercial exploitation of the mark is real because the use would not be 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 is not, therefore, genuine use.

The applicant's evidence

22. Mr Ryan states, in his witness statement, that the applicant introduced the first dual-cell photoelectric smoke alarm and that today the applicant has smoke detectors in schools, dormitories, hotels and hospital buildings throughout North America and the world. In addition, Mr Ryan also states that the applicant has sold fire protection products under its mark in the UK since 2014.

23. The applicant provided evidence consisting of screenshots from the waybackmachine, information sheets concerning the applicant's products and extracts from its company website. I note the following in regard to the evidence:

a) Exhibit RP1 is a snapshot from the waybackmachine of the applicant's website (which has a global jurisdiction of '.com') on 7 August 2020, 25 January 2021 and 18 August 2022. The screenshots display various fire/smoke alarms.
b) Exhibit SPR1 are information sheets for the applicant's products, in particular, wall mounted speakers, outdoor evacuation signals, ceiling/universal mounted speakers and selectable candela evacuation signals. The bottom of the information sheets bears the applicant's mark. I note that the information sheets are undated and the address at the bottom of the information sheets appears to be a US address. I have no indication that this pertains to the brand based in the UK.
c) Exhibit SPR2 – the first couple of pages of this exhibit appear to be the same as exhibit RP1. The exhibit was taken outside of the relevant periods on 27 February 2024, however, that does not mean that it does not provide an indication of the website during the relevant periods. The pages that differ from RP1, continues on to show: accessories, audible/visual signalling appliances, bells and speakers, carbon monoxide alarms, photoelectric smoke alarms and smoke detectors that are provided by the applicant. In his witness statement, Mr Ryan states that this exhibit shows the website with a '.co.uk' jurisdiction but the webpages themselves are described in the exhibit as being from a '.com' jurisdiction. Mr Ryan explains that when the '.co.uk' website is accessed it resolves to take the user to its '.com' website.
d) Exhibit SPR3 is another screenshot from the applicant's website which provides a UK listing of a distributor, being *'Fireguard Safety equipment Company, Ltd'.* Similarly to the above, the exhibit was taken outside the relevant periods on 27 February 2024.
e) Mr Ryan in his witness statement submits that 2064 units were sold to UK consumers during the period of 2018 to 2023. The evidence does not provide any indication of how much these items were sold for. Further, no invoices or commentary has been provided to indicate the geographic scope of the sales.

Form of the mark

24. Before considering whether the applicant has made sufficient use of the mark and, if so, for what goods, I shall deal with the question of the form of the mark. The evidence shows use of the mark in plain font as 'GENTEX'. This is use of the mark as registered, therefore in all instances where the applicant has used the mark in plain text it is clearly use upon which the applicant can rely.

25. Throughout its evidence, the applicant has also used its mark in the following ways shown below:

Example 1

Example 2

26. As per the case of *Colloseum*,[2] use of a mark generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark. Some of the evidence shows the use of the mark with the additional words 'Corporation', as seen in both examples 1 and 2. In the examples where the words 'Corporation' appear, that word is likely to be viewed as an indication of the overarching 'GENTEX' corporation. In these examples, I consider that the word 'GENTEX' maintains its role as an independent indication of origin. I do not consider that the word 'corporation' alters the distinctive character of the mark as registered.[3] As a result, and in accordance with *Colloseum*, I consider the marks shown above are all examples of use of the applicant's mark as registered.

[2] *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12
[3] *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

Genuine use of the mark

27. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. In making my assessment, I am required to consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods for which use has been shown;
- the nature of those goods and the market(s) for them; and
- the geographical extent of the use shown.

28. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[4] As the applicant's mark is a comparable mark it is possible for the applicant to rely on evidence of use in the EU up until the end of the transition period as set out in Tribunal Practice Notice 2/2020 and Schedule 2A of the Act.[5] I note that no evidence of use in the EU has been provided. However, as per the case law, I recognise that use in a single member state may be sufficient to satisfy the conditions of a EUTM, therefore, use solely in the UK prior to the IP completion date could be sufficient.

29. The onus is on the applicant to provide sufficiently solid evidence to show that the mark has been used within the relevant periods. Moreover, I note that as referenced above in paragraph 17 in *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Daniel Alexander Q.C. (as he was then) as the Appointed Person, stated that the burden lies on the applicant to prove use. As stated, *"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*

[4] *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09
[5]https://www.gov.uk/government/publications/tribunal-practice-notice-22020-end-of-transition-period-impact-on-tribunal-proceedings/tribunal-practice-notice-22020-end-of-transition-period-impact-on-tribunal-proceedings accessed 1/2/2022.

and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid."

30. Further, the case law summarised in the passage from *easyGroup,* quoted above in paragraph 15, makes it clear that real commercial exploitation of the trade mark must be shown. Even in a case where the use is not sham, i.e. it is not use engineered solely to preserve the trade mark registration, the use must be more than trivial if it is to be considered genuine. An example of this can be seen in *Memory Opticians Ltd's Application,* BL O/528/15, where the Appointed Person, Professor Ruth Annand, upheld the decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local, from 3 branches of an optician. There was no advertising of the goods under the mark, and the evidence indicated that they were only displayed in-store on occasion. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain a market under the mark.

31. In its submissions in lieu, the registered proprietor criticised the applicant's evidence on a number of deficiencies. Specifically, the proprietor's observations were as follows:

a) The evidence filed provides no turnover figures for the UK;
b) The evidence provides no figures for advertising or promotional activities in the UK;
c) The domain name www.gentex.co.uk simply re-directs to the US website www.gentex.com. There is no evidence that there exists an independent functioning UK website;
d) No invoices have been provided to show actual sales in the UK;
e) No screenshots have been provided of online retailers such as Amazon.co.uk featuring the applicant's products for sale;
f) No evidence has been provided from distributors, importers, or UK retailers showing the presence of any goods in the UK."

32. Whilst these criticisms are noted and have been duly considered, the issue as to proof of use is based upon my own assessment of the evidence whilst bearing in mind the relevant legislation and case law. I will address these comments (where needed) below in my assessment of the evidence.

33. The proprietor has criticised that the applicant's '.co.uk' jurisdiction website redirects to a '.com' jurisdiction; they submit this demonstrates that there is no independent functioning website in the UK. I note that the evidence does not need to indicate that there is an independent functioning website, rather, it must target UK consumers and UK consumers must consider that it targets them. In my view, it is common practice for companies to redirect local jurisdictional websites such as '.co.uk' to a global jurisdiction and this alone does not hinder the applicant. In this instance, I bear in mind the case of *Lifestyle Equities CV v Amazon UK Services Ltd*,[6] which found that use of a non-UK website must target UK consumers and UK consumers would have to *"consider that it is targeted at them"*. *Athleta (ITM) Inc. v Sports Group Denmark A/S & Anor*[7] addresses this issue in relation to use for a revocation action specifically, where some of the use relied upon pertained to use on a US website and social media. David Stone, sitting as a Deputy High Court Judge, found that *"purely foreign use cannot count as relevant use for the purposes of a United Kingdom revocation for non-use counterclaim".* The judge referred to the notion of targeting of websites etc, saying that it required more than mere accessibility. He stated:

> *"54. […] Take, for example, a physical store in Sydney, Australia with no on-line presence. This use would not count as use of a UK trade mark even if British tourists were known to visit Sydney, and were known to visit the store and purchase goods. The proprietor is attempting to create and maintain a market for those goods in Sydney, not in the United Kingdom. The same must be true of the on-line world - it is not sufficient (as I have set out above) to say that British consumers can access the website and purchase goods. There must be something more - and that something more is the targeting described by the Supreme Court in Lifestyle Equities. Will consumers accessing the site consider that it is targeted at them?"*

[6] [2004] UKSC 8
[7] *[2024] EWHC 2449 (Ch) (30 September 2024)*

34. Taking the above case law into account, I consider that, based on the applicant's evidence, the website targets UK consumers and that UK consumers would consider that it targets them, despite the redirection from a '.co.uk' website jurisdiction to a '.com' jurisdiction. This is on the basis that the initial interaction is with a '.co.uk' website. I do note that no evidence has been provided of the location or reach of the visitors of the UK webpage, which would have strengthened the applicant's position. Therefore, contrary to the proprietor's position, I consider that the applicant's webpages could be accessed by UK consumers during the relevant periods and can support the applicant's claim of use.

35. In relation to promotional materials and turnover figures, I agree with the proprietor that none of this evidence has been provided. Further, I have no evidence or submissions from the parties to assist me on the matter of the size of the UK/EU market for the goods concerned. I recognise that the applicant submits, in relation to no turnover/advertising figures that:

> *"such details are not required in order to establish that there has been use in the UK. Gentex is not attempting to prove reputation, but rather confirming that the mark has been put to genuine, commercial use in the UK with a view to creating or preserving market share.*
>
> *11. Mr Ryan's statement confirms that 2064 units were sold to UK customers in the period 2018 to 2023. That is not token or internal use: it is external, genuine use of the mark in relation to goods bought by customers. There is no threshold for the quantity of goods that constitute genuine use, but in any case it is clear from Mr Ryan's statement that Gentex have been selling goods under the Gentex mark to customers in the UK for at least ten years."*[8]

36. I agree that this does not preclude a finding of genuine use and it is correct that there is no de minimis rule. However, I note that genuine use requires a global assessment of the evidence as a whole. I remind myself that *easyGroup* states in paragraph 6 that "*all of the relevant facts and circumstances must be taken into*

[8] Applicant's submissions in lieu, para 10-11

account in determining whether there is a real commercial exploitation of the mark", which I shall do now.

37. There are some clear deficiencies in the evidence provided by the applicant. There is a lack of evidence in relation to the distribution of marketing and advertising evidence and there are no turnover figures. Whilst the evidence demonstrates that there is a UK distributor, I have no indication of where that distributor is located in the UK, regardless, without other corroborating evidence which demonstrates that that distributor distributed the goods nationwide, the existence of a sole distributor is not in itself evidence of widespread use across the entirety of the UK/EU. The applicant has stated that they sold 2064 products between 2018 to 2023. These figures in relation to the sale of the applicant's goods are far from overwhelming for the 5-year period, and I have no indication of the value of the goods to help contextualise the number of products sold. I also have nothing before me to indicate who the sales were made to; therefore, I cannot determine whether they were made to a single customer or multiple customers. I also have no indication of whether the items sold bore the applicant's mark and I have little for me to identify how consistent and repeated the pattern of sales were throughout the relevant periods (for example if they primarily took place in a particular year). Consequently, the applicant has produced insufficient evidence to demonstrate use. On this point, I note the oft-quoted guidance of Mr Daniel Alexander QC who, sitting as the Appointed Person in the case of *Awareness Limited v Plymouth City Council,*[9] noted that the burden to prove use lies on the party required to prove it and that the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which that party is legitimately entitled to.[10] In my view, this is relevant here in that the evidence provided by the applicant in respect of the goods is insufficiently solid to assist in determining genuine use of the mark.

CONCLUSION

38. The applicant has failed to establish genuine use of the specification of its registration within the relevant periods. Where proof of use provisions apply, an

[9] Case BL O/236/13
[10] *Guccio Gucci SpA v Gerry Webber International AG*, BL O/424/14

applicant cannot rely on its registration unless those provisions are satisfied. Consequently, as the applicant has not provided use of its registration, it cannot rely on its registration for the purposes of this invalidation and the invalidation fails at the first hurdle. Subject to appeal, the invalidation is dismissed, and the proprietor's mark will remain registered.

COSTS

39. The proprietor has been successful and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023 as the proceedings commenced after 1 February 2023. In the circumstances, I award the applicant the sum of £550 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement	£250
Considering the other side's evidence	£300
Total	**£550**

40. I therefore order Gentex Corporation to pay Gemtex SDN BHD the sum of £550. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 27th day of March 2025

A KLASS
For the Registrar