

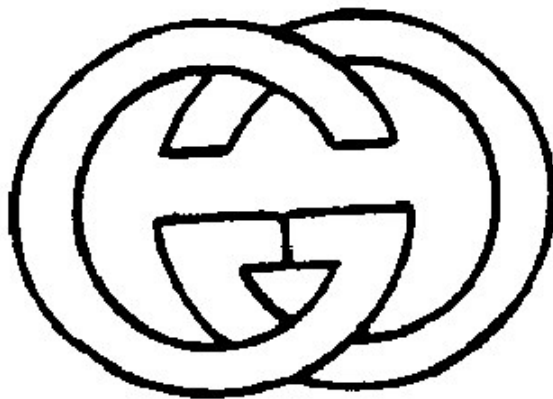
World Trademark Review *Daily*

Revocation of Gucci's 'interlocking Gs' mark for non-use exposes evidence gaps
United Kingdom - Burges Salmon LLP

**Cancellation
National procedures**

December 02 2013

In a [decision](#) that highlights the potential pitfalls in filing evidence of use, a hearing officer of the [UK Intellectual Property Office](#) has partially revoked [Guccio Gucci SPA's](#) UK trademark of two interlocking Gs (depicted below) for non-use, following a successful application by [Gerry Weber International AG](#):



Gucci's trademark was registered for a range of goods in Classes 3, 14, 18 and 25 of the [Nice Classification](#). Gerry Weber filed an application for invalidity in June 2012, seeking revocation of the mark in full under Section 46(1)(b) of the [Trademarks Act 1994](#), claiming that the mark had not been used in the five year period from February 1 2003 to January 31 2008, or alternatively in the five-year period preceding the application.

Gucci defended the application and filed evidence of use. When Gerry Weber did not file any evidence of its own, Gucci sought permission to file further evidence, which was refused.

Under the [Trademarks Rules 2008](#), trademark proprietors are permitted to file evidence in reply when evidence is filed by the applicant, but the evidence rounds close if the applicant chooses not to file any evidence of its own. Gucci's request was therefore considered under Rule 38(8), under which the registrar may exercise discretion to allow further evidence. The hearing officer observed that, when deciding such a request, the materiality of the further evidence in relation to the issues to be decided was of substantial significance. However, Gucci did not supply a copy of the further evidence that it wished to file and did not provide any explanation as to the difference that evidence might make to the decision, possibly because this would expose the gaps in its earlier evidence. The hearing officer formed the view that she could not exercise her discretion in Gucci's favour in the absence of this information.

In deciding the revocation application, the hearing officer noted that genuine use of the trademark required use which amounts to real commercial exploitation of the mark on the market for the goods, meaning that there must have been exploitation that is aimed at maintaining or creating an outlet for the goods or a share in the market. Pursuant to Section 100 of the act, the burden of proof was on Gucci to show genuine use of the mark.

However, the hearing officer identified numerous flaws in the evidence filed by Gucci. These included:

- a lack of explanation or elaboration in Gucci's witness statement to explain the exhibits;
- broad claims in Gucci's witness statement, without specific detail - for example, advertising figures were provided for Gucci's brands "including the mark", but not for the mark itself;
- Gucci stated that the mark was advertised in national magazines and was used on receipts, swing tags, bags and point of sale advertising, but no examples were exhibited;
- turnover figures were provided for goods in the relevant classes, but with the exception of some Class 3 goods, no invoices were provided to corroborate the figures - this was particularly relevant as the figures were not stated to be UK figures, varying currencies were used and the figures did not differentiate between different types of goods or indicate the number of goods sold;

World Trademark Review *Daily*

- the mark was not visible in photographs relied upon and catalogues relied upon were undated or only the first page was exhibited; and
- web pages relied upon did not clearly originate from the United Kingdom (some were in Italian and another had a US domain name).

Consequently, the hearing officer considered that there was insufficient evidence to corroborate Gucci's claims, and that sufficient evidence of use had been filed in relation to some of Gucci's Class 3 goods only. The application for revocation was successful in relation to the remainder of the goods.

This decision serves as a reminder of the strict attention to detail that must be paid by trademark owners when seeking to prove use, and the dangers of not filing its best evidence from the outset. As Jacob J commented in *Laboratoire De La Mer Trademarks* ([2002] FSR 51), which was referred to by the hearing officer:

"Those concerned with proof of use should read their proposed evidence with a critical eye - to ensure that use is actually proved - and for the goods or services of the mark in question. All the 't's should be crossed and all the 'i's dotted."

Jeremy Dickerson and Jennifer Gibson, Burges Salmon LLP, Bristol

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.