

TRADE MARKS ACT 1994

IN THE MATTER OF Trade Mark Registration N^o: 1402537 in the name of Laboratoires Goemar

and

An Application under N^o: 10074 for Revocation by La Mer Technology Incorporated.

BACKGROUND

1. The trade mark LABORATOIRE DE LA MER, was applied for on 10th October 1989 for 'Perfumes and cosmetics containing marine products; all included in Class 3'. It now stands on the register in the name of Laboratoires Goemar, ZAC. de la Madeleine, St. Malo, 35403, France.
2. In an application dated 27th March 1998 La Mer Technology Incorporated applied for revocation of the mark. Their Statement of Grounds said:

'Inquiries have revealed that trade mark Registration No. 1,402,537 LABORATOIRE DE LA MER has not been used by the registered proprietor or with its consent on any of the goods for which it is registered during the past five years.

It is contended that there are no proper reasons for the non-use.

It is therefore contended by the applicant that the registration be revoked under the power which is contained in Section 46(1) of the Act and removed from the Register for all of the goods for which it is registered.'

The registered proprietors (RPs) deny the ground.

3. Both sides filed evidence in these proceedings and a hearing took place on 23rd February 2001. The RPs were represented by Mr Mellor of Counsel, instructed by Lane and Partners, and the applicants by Mr Tritton, also of Counsel, instructed by Gill Jennings & Every.
4. The applicants in this matter are also involved in parallel proceedings for revocation (N^o 10073) of the same mark, registered under 1338514 for 'Pharmaceutical, veterinary and sanitary products, dietetic products for medical use; all included in Class 5 and all containing marine products'. There also appears to have been an earlier revocation action for the mark in suite under revocation N^o 9638 (the fate of that is unclear; it is not now extant). The evidence presented is common to the two subsisting cases as the parties have adopted that from both into each. Not all of this is relevant, of course. This matter is concerned with the goods listed at paragraph 1 above.
5. The relevant sections of s. 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) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

.... ,

(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.

.... ,

(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. S. 100 of the Act places the onus of proof on the registered proprietor:

‘If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.’

7. In the light of this I want to consider the applicants use of their mark, as given in their evidence, during the relevant period, which is the five years before the application date of 27th March 1998, i.e. the years preceding that date back to 27th March 1993. No proper reasons for non-use were presented in evidence or at the hearing; thus the RPs case stands or falls on this evidence.

8. In a Statutory Declaration dated 19th January 1999 (which I will call the ‘main declaration’) Mr Simon Bertaud, the Managing Director of Laboratoires Goemar (the RPs), describes the RPs’ business:

‘My company’s products are mainly used for cleansing and moisturising the skin, although my company also manufactures liquid dietary supplements. Details of these products, as shown by a copy of Health Scope Direct’s “Special Needs Collection” magazine are now produced and shown to me marked Exhibit 1. Products marketed under the brands IODUS, GOEFORM and THALASSO BAIN are featured in the magazine, together with brief descriptions of the use of the products. All of these products are derived from marine products, in particular seaweed/algae..’.

9. Mr Bertaud describes his relationship with UK distributors:

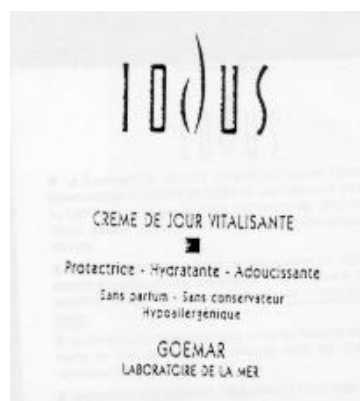
‘My company has been selling products bearing the trade mark LABORATOIRE DE LA MER in the United Kingdom since November 1996. Initially, the products were supplied to a company called Meadow Breeze Limited who distributed them in the United Kingdom. Meadow Breeze subsequently changed its name to Health Scope Direct which continues to market my company’s products’.

10. Against this background, after careful study of the evidence, the RPs use of their mark can be itemised as follows:

(1) In Exhibit 1 to Mr Alasdair Lennie MacQuarrie’s Statutory Declaration dated 1st October 1997 (which is Exhibit 1 of his Statutory Declaration to these proceedings, dated 16th July 1998) are copies of, what I take to be, two invoices, listing products supplied by the RPs to their then agents in the UK, Meadow Breeze Limited. One of these documents is dated 29/10/96; the other 14/04/97. This puts them within the relevant period. There is no use of the mark on either. However, Mr MacQuarrie says that ‘..some or all..’ of the goods featured bear the mark. He provides copies of labels of which, he says: ‘I am told by my clients’ French attorneys that these goods ... are equivalent to those goods listed in the invoices which bore the trade mark LABORATOIRE DE LA MER.’ This amounts to second-hand hearsay. However, in his main declaration (paragraph 8) Mr Bertuad confirms that the products in the photocopies are identical to the products on the invoices. Those appearing on both are:

Complex Regenerant
Creme de Jour
Fluide Demaquillant Purifiant
Fluide Corporel Regenerant
Brume Tonique Oxygenate

There is also photocopy of a product called Thalasso Bain Lait Coporel Marin, which I will return to later. Only the latter contains English. The following is a typical example of the way in which the mark is used:



The net total on the two invoices is: FF17297 - around £1800; however, not all of this applies to the products above. I note that Mr Bertrand states that these items were distributed in the UK.

(2) In a declaration dated 18th February 1999, Mr Bertaud responds to a criticism directed to these invoices by Mr Ake Neuman, the Managing Director of Estee Lauder Cosmetics

Limited (declaration dated 14th October 1998) that ‘..there is no evidence here that any goods were ever delivered to the United Kingdom.’ Enclosed in Exhibit 1 to his declaration, Mr Bertaud refers to a number of ‘deliver sheets’. These coincide with the two invoices and also allude to other material as well. Deliveries before the relevant date are summarised below, including those indicated on the invoices.

Product	Quantity				
	14/11/96	7/01/97	17/03/97	15/04/97	16/05/97
Complex Regenerant	12	14		36	
Creme de Jour	12	12		36	
Fluide Demaquillant Purifiant	12	12		36	
Fluide Corporel Regenerant		12		36	4
Brume Tonique Oxygenate			24	36	2

(3) In his main declaration Mr Bertaud gives the following sales figures ‘to Meadow Breeze/Health Scope Direct in the UK’:

Year	£
1996	220
1997	5,399
1998	2,661

He says: ‘These figures are not particularly high since the products are relatively new to the United Kingdom and the market is still being established’. The relevant period ended on 27th March 1998. There is no indication of the proportion of this attributable to cosmetics or to other products.

(4) Exhibit 4 to Mr Bertaud’s main declaration encloses a letter, dated 15th December 1998, from Fraser J Hays, Managing Director of Health Scope Direct. It contains the following passage:

‘I, the undersigned, hereby certify that the following documents:

- i) Your Business Bible
- ii) Start Your Own Health Business
- iii) Wholesale Order Form.

were made in the year 1996, whilst the following documents:

- i) The Healthscope Direct Special Needs Collection
- ii) Health Bites

were made in 1997.

All of the above documents were for the marketing and selling of Goemar Le Laboratoire De La Mer in the United Kingdom as agent for the manufacturers’.

A copy of ‘Your Business Bible’ is included in Exhibit 4; the RPs main name ‘Goemar’ is featured on every page. I can find no reference to a date, while there is a reference to the trade mark in suite on the ‘Wholesale Order Form’ at the back of the document.

‘The Healthscope Direct Special Needs Collection’ document (featured in Exhibit 1 of Mr Bertaud’s declaration) is obviously produced by or for the RP’s UK distributor but, again, there is no date, and no mention of the mark in suite.

- 11. At the hearing, Mr Tritton, appearing for the RPs, said that he had to concede that there had been no use on of the mark on perfumes. Following s. 46(5), this is effectively an admission to revocation of the mark to the extent the specification applies to that product. The rest of this decision is concerned with ‘..cosmetics containing marine products; all included in Class 3’.
- 12. Mr Tritton then referred me to s. 46(2) and said:

‘ “ use in the Unit Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.” I place emphasis on that aspect. It is quite clear therefore that if one was merely affixing the mark to the goods, but not selling the goods in the country, but exporting them abroad, that would constitute use, even though there are no sales in the United Kingdom whatsoever’.

I was also referred to s. 10(4) of the Act, which defines use of a mark, for the purposes of infringement, as affixing it to the goods or packaging thereof; offering or exposing for sale; *importing* or exporting goods under the sign. Mr Tritton made a connection between this section and s. 46(2) in that both include export in ‘use’. He said; ‘..if one is using the mark in exporting...one is clearly using it when importing into the UK..’

- 13. Mr Tritton also explained his view on the meaning of ‘genuine use.’ I was referred to *DDM Italia SpA v Zippo Manufacturing Co* [1999] RPC 173 and *Euromarket Designs Inc. v Peters* [2000] ETMR 1025. *Zippo* states (page 185):

‘I conclude that the substantial (or degree) of use is one factor that must be considered in deciding whether use of a mark is genuine. But where, as in this case, it is established that a mark has been used, and the genuineness of such use is not in question, detailed consideration of the substantiality of that use serves no purpose.’

- 14. Mr Tritton noted the background to the *Euromarket* case in that Jacob J was presented with evidence of use abroad that had expressed itself in this country. Jacob J states:

‘It seems to me that genuine use must involve that which a trader or consumer would regard as a real or genuine trade in this country. This involves quantity as well as the

nature of the use. In part, it is a question of degree and there may be cases on the borderline. If that were not so, if Miss Vitoria were right, a single advertisement intended for local consumption in just one United States city, in a journal which happens to have a tiny UK distribution, would be enough to save trade mark monopoly in this country and yet the advertisement would not be a sham. This to my mind shows that Miss Vitoria's gloss on the meaning of genuine use is not enough. The only stopping place after that is real trade in this country. I think all the examples relied upon are examples of trade just in the United States.'

Mr Tritton's commented that the distinction Mr Justice Jacob made was between a mere physical presence of the mark in the UK as opposed to genuine use. The Claimant in *Euromarket*, was relying upon the former. Thus 'Mr Justice Jacob is quite right to say it is not sufficient to show it was not a sham. You must show that there has been a real trade in the country'. Against this background, Mr Tritton remained of the view espoused in *Zippo*, that once genuine use had been established, the extent of it was irrelevant.

15. Mr Mellor, of course, rejected this. He said that *Euromarket* overrules *Zippo* - in establishing genuine use in this country, one must look at what '...a trader or consumer..' would consider genuine use, and this includes quantity and nature of the use. He added:

'Mr Justice Jacob is ... saying you have got to look at everything in the round. The substantiality of use is one of the factors you are going to have to take into account. You do not decide first whether it is genuine and then examine the substance of the use. You have got to do them together.'

16. I think Mr Mellor must be right. It seems to me that a trader or consumer, in assessing whether actual trade has taken place, would approach the matter in this way - the manner and extent of use will determine the authenticity of the trade at issue. This is the approach now adopted by the Registry - for example, in the *Roy of the Rovers* Decision (SIRIS 0/212/01), the Hearings Officer (Mr Salthouse) referred to the *Bon Martin* [1989] RPC 537 case, where Whitford J commented:

'To my mind what plainly emerges from the authorities is this ... the substantiality of the use is undoubtedly a relevant factor to be considered and at the end of the day one has got to consider every relevant factor. It must always be remembered that what one is directed to by Section 26 of the Act is the question as to whether there has been any *bona fide* use. Although the extent of the use is a factor which may be of significance, some of those factors may lead to the conclusion that although the use could not in the commercial sense be described as anything other than slight, nonetheless it may be appropriate to reach a conclusion, in the light of the circumstances as a whole, that the use ought to be regarded as *bona fide*.'

Mr Salthouse then commented:

'I accept that the *Bon Martin* case was concerned with the Trade Marks Act 1938 where the statutory language in Section 26 focussed on whether or not the use had been "*bona fide*", whereas under the new law the reference in Section 46 of the 1994 Act is to "genuine use". However, in my view no substantial change in the law has been brought about by the different use of language and the above remarks are still apt in relation to the new law. Therefore, substantiality is a factor to be considered within the overall test of genuineness and not a separate hurdle that a registered proprietor must overcome'.

17. Later, in *Euromaket*, Jacob J makes a comment that is relevant to Mr Tritton's submission on s. 10:

'In this connection it should be borne in mind that the Directive does not include an all-bracing definition of "use", still less of "use in relation to goods". There is a list of what may *inter alia* be specified as infringement (Art. 5(3), corresponding to s. 10(4)) and a different list of what may, *inter alia*, constitute use of a trade mark for the purpose of defeating a non-use attack (Art. 10(2), equivalent to s.46(2)). It may well be that the concept of "use in relation to goods" is different for different purposes. Much may turn on the public conception of the use.'

18. These remarks are *obiter* and there is not much guidance in them; however, there is enough for me to be uncomfortable about connecting 'use' for the purposes of s. 10 with its appearance in s. 46. It seems clear that if the definitions were the same, there would be no need to specifically mention export in the latter part of s. 46(2), as it is already listed in s. 10(4). In my view, the mention of export in s. 46(2) is a specific inclusion present in the Act for its own sake, in all probability to provide clarity. I would not argue that because export signifies use, and is not trade to consumers, import signifies use for the same reason.
19. Rather, following Jacobs J's test for genuine use, I think most traders (if not consumers) would regard, *prima facie*, import from a French Company to a UK company as an in the nature of genuine use, whether or not this trade has continued further along the supply chain to consumers. On this point Mr Tritton stated:

'We submit that there is plainly genuine use. The fact that it is relatively slight is reflected in the fact that it is a start-up market for these people. It has taken a bit of time, but it is genuine use. It is a trade in the country. It is importation. It is something which is deemed, in our submission, to be an act of use of a sign in the UK'.

While I do not think I can argue with the principle here, following *Euromaket*, I must consider a number of other factors before I can come to a final conclusion. Mr Mellor conceded at the hearing that there had been use. He said that it could not be regarded as genuine. Various points arise.

20. First, Mr Tritton challenged those present at the hearing to give an instance where the mark was not used on the examples of the RPs' products shown in the evidence. Mr Mellor's response was that we are shown no actual examples of the products imported - they are '...similar to...' or we are assured that they did (e.g. paragraph 2 of the Declaration in Exhibit 1 to Mr MacQuarrie's first Declaration and paragraph 8 of Mr Bertaud's main Declaration). Further, the invoices and delivery notes list other products for which there is no evidence of use of the mark at all. Of course there is no evidence they did not - but it is for the RPs to provide this material.
21. Next, there was a submission based on the 'illegality' of the imported goods under s. 6 of the Cosmetic Product (Safety) Regulations 1996 (CPR). This requires a list of ingredients '...in lettering which is visible, indelible and easily legible...'. Also required in same way, on the container of a product, is an indication of function, unless that is clear from its presentation (s. 6(2)(h)). Mr Mellor commented:

‘This point applies because an awful lot of these products were supplied in packaging that was only expressed in French. Perhaps the best example is Brume Tonique. I do not know what on earth that product is. You might think because it has seaweed in you are not supposed to drink it, but that is an example of a product that falls seriously foul of s. 6(2)(h)’.

22. Further, the CPR applied to the supply of these items from 1st January 1997 and, in particular, to importation from that date (s. 1(2)). Mr Mellor’s comment was ‘..no respectable retailer would take these products knowing that they were in breach of these Regulations and that again tells you about the genuineness of the trade’.

23. Mr Tritton commented:

‘It may well be they did not conform to the regulations. Merely because I sell £5 million worth of products in this country bearing French labelling and bearing the mark, because it happens to violate some secondary piece of statutory instrument, does not mean I have not made genuine use of it. Otherwise you are going to have to spend the whole time considering every single statute in order to decide whether there has been genuine use. The Trade Marks Registry would be snowballed.’

On the latter point, Mr Tritton is, of course, correct about assessing the effect of other legislation on the use of trade marks. However, the legality of the RPs sales has been raised by the applicants in this case and thus requires consideration here. On the more general issue of the effect of illegality, Mr Mellor explained that he was not going so far as to say that import of an illegal product can never amount to evidence of genuine use. Rather it is a factor that should be taken into account in determining whether genuine use had occurred or not. It is something I have to consider as part of an overall test of genuineness.

24. Third, Mr Mellor dealt with the extent of the trade. He pointed out that the sales of these products was rather small (see table, paragraph 10) and, after April 1997, literally ‘..peter out’, before picking up again. He said this was consistent with the striking off of Meadow Breeze Limited, on 21st October 1997 (see the declaration of Mr Per Ake Neumann, dated 14th October 1998, paragraph 12).

25. Next, Mr Mellor also noted out that not all the products listed were cosmetics within the terms of the Act. For example, soap - which is listed separately in Class 3. Nor bubble baths. Mr Tritton argued against this conclusion, saying the soaps supplied ‘..were not normal soaps’. In Exhibit 3 of Mr Bertaud’s declaration they are described as enriched with glycerin and sea weed extract, and as moisturising ‘..the upper layers of the epidermis and respects its hydrolipidic film. It gently cleanses and leaves your skin delicately perfumed.’

26. Giving the word ‘cosmetic’ its ‘normal, natural meaning’, as a product applied to the body with the intention of beautifying it, one would identify makeup as an example. Does moisturiser fit into this definition? If it did not, the RPs would be struggling to describe any of their products as cosmetics. Mr Mellor accepted some did, and included the products listed in the table on paragraph 10. I will do so too. Of course, it is possible that a soap can have a cosmetic effect - such as moisturising or exfoliating - but its primary purpose is still that of a soap - i.e. to cleanse. I note that ‘perfumes’ are also listed separately in Class 3. Mr Tritton stated that he was not prepared to argue that because these soaps were also ‘perfumed’ they could be

‘perfumes’ within the terms of the Act. In keeping with his approach, I do not see how soaps with a cosmetic effect make them any less soaps for the purposes of classification in Class 3.

27. There was also a doubt about the only product mentioned in paragraph 10 that appeared to comply with s. 6 of the CPR (see Exhibit 1 of Mr MacQuarrie’s first Declaration). This is the Thalasso Bain Lait Coporel Marin. First, Mr Neuman suggests that this product is intended for the US, not the UK, market (paragraph 20 Declaration dated 14th October 1998), as

‘..it bears an Imperial measurement of quantity (in fluid ounces). As a result of the EU’s metrication regulations, imperial measurements are no longer permitted under French legislation to be used in respect of cosmetics and have not been required in Britain for many years. As a practical matter, imperial measurements are no longer in use within Europe by any cosmetics manufacturer save in cases where the packaging is intended for use in the USA.’

28. Further, and fatally, Mr Mellor argued that this product was not that referred to on the invoices and delivery notes as supplied during the relevant period. Having studied these documents, I think Mr Mellor is right. There is a clear reference to the product at issue on the delivery sheet dated 10/11/98 (after the relevant period, and thus of no moment) as ‘Lait Corp. Mar. Thal. FT. 100ml’ (see Exhibit 1 to Mr Bertaud’s 18th February 1999 decision). This is different to the name used on the invoice and delivery sheets dated before 27th March 1998. For example, on the invoice dated 14/04/97 (Exhibit 1 of Mr MacQuarrie’s first Declaration), the product is called: TROUSSE THALA ‘lait Corp No. 2’. The order numbers are also different. That on the invoice is not clear, but it is on the delivery sheet confirming it, and on another delivery sheet dated 06/01/98, as CH0502. The ‘marin’ product carries the order number CH0641100. Further, while the ‘marin’ product comes in a ‘unit’ (unité) of a tube, the other product is given the unit appellation ‘UN’. I cannot but conclude that these products are not the same item.
29. Taking the products which remain - those that are clearly cosmetics, clearly used in the relevant period and carry the mark in suite - 296 items appear to have been supplied over a period from the November 1996 to May 1997. Mr Mellor calculated this as around £800 worth of sales, based on the unit prices given in the invoices. Of course, none of the delivery sheets have prices - these have been extrapolated from the invoices. However, it does not seem unreasonable that a practice established with the invoices should not continue thereafter.
30. Fifth, the document ‘Your Business Bible’ (Exhibit 4 to Mr Bertaud’s main declaration) appears to contain instructions on how to set up a business for the RPs products (see page 9ff); in particular, a mail order business (certainly the name of the distributor ‘Health & Beauty Direct’ would tend to support this conclusion as to the nature of the business). This suggests that the document was a ‘pre-sale’ document; it is certainly no evidence that sales to the public actually took place, despite overtly confident claims to this by M. Bertaud. In fact, there is no evidence anywhere that the products listed were *ever* marketed in the UK. In view of their likely illegality this is hardly surprising.
31. Sixth, the relationship between the RPs and their agent in the UK is questioned by Mr Neuman in his evidence (see paragraphs 13 - 16 of his declaration dated 14th October 1998) who suggests that the UK ‘agent’ - Meadow Breeze/Healthscope Direct - is merely an extension of the RPs, and the supply was thus ‘in-house’. Mr Neuman points out that Mr Hay is also a Director of a UK company called ‘Goemar (UK) Limited’, which (PAN1) was incorporated in

1996. Mr Bertaud responds (main Declaration paragraph 16) by stating that this company is not a subsidiary of the RPs and that Mr Hay had no authority to register a company using the Goemar name. In response, Mr Neuman refers to a copy of the 'Wholesale Order Form' in Exhibit 4 to Mr Bertaud's main declaration and notes that 'Goemar Le Laboratoire de La Mer' is actually trading from the premises of Health & Beauty Direct in Banff.

32. I have studied this evidence closely. Certainly the RPs are very much in the forefront of the 'Business Bible' document, with the putative agent only mentioned in the address for supply. Then again, the Healthscope Direct Special Needs Collection (see Exhibit 4) features references to the RPs only in the body of the text of that document. However, even there the introduction to the products on offer seems to make no distinction between the agent and RPs: 'The seaweed we use is the purest, highest quality..'. All this might invite a conclusion that the transaction between the RPs and Health & Beauty Direct/Meadow Breeze was, if not an 'in-house' activity as suggested by Mr Neuman, a transaction appertaining to a business entity in the UK whose only purpose was to establish a 'bridgehead' for the RPs' trade in the UK. It might invite it, but I cannot come to any such a conclusion without further evidence. There is not enough in the material before me to come to the result suggested by Mr Neuman. His views, based on the evidence, are conjecture - they may not contradict the evidence, but that not amount to proof.
33. In passing, I note that the RPs were supplying products in to the into the UK via a different agent (see Exhibit 5 of Mr Bertaud's main declaration) in 1998. This does not lend support to the interpretation given to the evidence above, that Healthscope Direct/Health & Beauty Direct/Meadow Breeze were the RPs' 'arm' in the UK. It suggests that the RPs had no particular commercial commitment to these other concerns, and that they were distinct entities.
34. Next, there is the latter from Mr Hays dated 15th December 1998 (see point (4), paragraph 10 above). This is informative for what it does not say rather than for what it does. Nowhere is there a statement to the effect that the documents listed were in fact *used* in marketing the RPs products - they were made in 1996 and 1997 (in the UK or outside it?) 'for the marketing and selling' of the RPs' products. Mr Bertaud, in his main Declaration, says 'All these documents show that the products bearing the trade mark LABORATOIRE DE LA MER were available for purchase in the years 1996-1997'. This is rather equivocal to say the least. Having products *available* for sale is not same as actual sales.
35. Before completing my assessment of the evidence and submissions, there is one other point with which I must deal, which was not subject to much argument at the hearing, but was raised by Mr Neuman in paragraphs 9 and 10 of his first declaration:

'Because of the manner in which the phrase is used, I am in no doubt that any businessman, or member of the public, who was to scrutinise this packaging and see on it the phrase LABORATOIRE DE LA MER, would consider that phrase to be a description of GOEMAR, being the name of the manufacturer which appears immediately before it. As such, the phrase in small print LABORATOIRE DE LA MER - whatever its legal significance may be - does not appear to have been intended by the registered proprietor to function as a conventional trademark ...The phrase LABORATOIRE DE LA MER never appears on its own. It is not the means employed by Goemar to identify their goods. It does not appear anywhere in the invoices which were produced by Mr MacQuarrie. Apparently it is not trusted by its registered proprietor as the means of identification of the

goods. Moreover, so small and insignificant does the phrase appear on the packaging that, as a practical matter, in the form as used by Laboratoires Goemar SA on this packaging, it is incapable of distinguishing the goods of the registered proprietor from the goods of other manufacturers. Plainly these goods can be distinguished from those of other manufacturers, but this distinctiveness derives from the highly distinctive Marks IODUS or THALASSO BAIN and/or GOEMAR and does not in practice stem from the use of the phrase LABORATOIRE DE LA MER.’

36. I don't accept that the RPs' use of their mark cannot be trade mark use. 'Goemar' is the RPs' name, and it is hardly surprising that should be present. Further, it is not unusual for manufactures of cosmetics and the like to use more than one trade mark on their products. Also, even if consumers in the UK came across the mark in this form, those that are able to translate the phrase (many, I would suggest, but not all by any means) into 'laboratory of the sea' would not consider this as is not so meaningful as to be overtly descriptive. There is enough that is unusual about the phrase to, in my view, obviate such a response. Certainly, the applicants believe that DE LA MER can inherently function as a trade mark, as they wish to make use of it themselves (see paragraph 1 of Mr Neuman's first declaration), and that is - following Mr Neuman's contention - arguably more descriptive of products containing marine-sourced ingredients (and misleading if they do not).
37. Considering all the arguments and submissions I have come to the conclusion that the RPs have done enough to meet the onus placed on them and have demonstrated genuine use of the mark within the relevant period. Though I have not found this an easy decision to make, it seems to me that the applicants do not disturb the substance of the following submission from Mr Tritton:

‘..that unless there has been doubt cast upon the act of importation itself, that somehow or other the act of importation was not genuine [t]he fact that you do not have evidence of where those goods are going to go afterwards is irrelevant. All I say is, in this case, as I said in opening, if goods are imported over a period of 18 months is one to really infer there was not genuine importation occurring here? Why else would he be importing unless he was concerned with trading in the products in the UK?’

38. Whatever the requirements of UK legislation, on the basis of the evidence, the RPs have simply responded to an order from a business in the UK. Viewed from this perspective, trade occurred using the mark in 1997 and 1998. The products might have been strictly illegal in the UK market. But I do not think this makes the trade, in this case, any less real. If the RPs' agents in the UK were unable to sell the products on because of this, the fact they were on the receiving end of bad bargain does not mean the purchase from Goemar was 'sham'. Further, though one might allege (Mr Mellor certainly did) that the extent of the trade was small viewed against the background of the cosmetics industry as a whole (though it may be significant in terms of such products based on marine extracts), £800 pounds worth of business is not trivial. Taking this matter in the round, I think it is enough to amount to genuine use.
39. As a result, registration N^o: 1402537 is revoked, in as far as it applies to perfumes, from the date of the application for revocation. The specification of the product now stands as:

‘Cosmetics containing marine products; all included in Class 3.’

40. Neither side has been wholly successful in this case. I therefore decline to make any order for costs.

Dated this 19 Day of June 2001.

**Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller General.**