

**O-170-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION Nos. 3056251 & 3056256  
STANDING IN THE NAME OF  
GALA TENT LIMITED**

**AND**

**IN THE MATTER OF A REQUEST FOR DECLARATIONS  
OF INVALIDITY THERETO UNDER No.500764 &500765  
BY INSTANT PROMOTION (UK) LIMITED**

## BACKGROUND

1) The following trade marks are registered in the name of Gala Tent Limited (hereinafter GTL):

Mark	Number	Filing & registration date	Class	Specification
Pro 40 Pro40 Pro-40	3056251	20.05.14 31.10.14	6	Gazebos [metal structures]; Foldable Gazebo; Collapsible Gazebo; Scissor Action Gazebo.
A series of three marks			22	Foldable Marquee; Collapsible Marquee; Scissor Action Marquee.
Pro 50 Pro50 Pro-50	3056256	20.05.14 31.10.14	6	Gazebos [metal structures]; Foldable Gazebo; Collapsible Gazebo; Scissor Action Gazebo.
A series of three marks			22	Foldable Marquee; Collapsible Marquee; Scissor Action Marquee.

2) By applications dated 18 February 2015 Instant Promotion (UK) Limited (hereinafter IPUK) applied for declarations of invalidity in respect of these registrations. The ground is, in summary, that the term PRO 40/ PRO 50 has been used for many years in the UK by several companies in the same field to indicate a 40mm/50mm frame diameter, and as such it is used generically throughout this particular industry. The mark therefore offends against section 3(1)(d) of the Act.

3) GTL provided counterstatements, dated 16 April 2015 subsequently amended, in which it denies the above grounds. It accepts that certain companies use the terms as a way to steer traffic towards their own websites on the guise that it is of the same specification framework, even though they are not. It points out that IPUK has purchased a large number of its products and so is well aware of the use that GTL makes of its marks. The term "PRO" was first coined by GTL in 2006 after a competitor started using the term "industrial". The term "PRO" is a reference to its use by professionals and also to the unique profile aluminium joints that are the subject of a patent application. It contends that no-one else uses this type of profile joint. It states that since 2006 it has sold 57,892 structures under the marks and has spent £911,007 on promoting its marks.

4) Both parties filed evidence. Both sides ask for an award of costs. Neither side wished to be heard although both provided written submissions which I shall refer to in my decision as required.

## EVIDENCE OF IPUK

6) IPUK provided three witness statements. The first, dated 14 August 2015, is by Jordan Robert Christian Law a Director of IPUK. He states that he began selling "gazebos" and like goods in 2003 as a sole trader before starting his company in 2008. He claims to be well versed in the industry. He states that he became aware of the instant registrations in November 2014 when he received an email from GTL (exhibit JL1) which amounts to a cease and desist letter. He states that the terms PRO 40 and PRO 50 have been used in the UK (and elsewhere) in the gazebo industry with the term PRO being short for profile

and the numbers 40/50 indicating the size of tubing used in the frame. He states that his company has been using the term PRO40 since 2009 and PRO50 since 2010. He provides the following exhibits:

- Exhibit JL2: This has copies of pages from a number of websites all of which, apart from the GAZEBOSHOP pages are after the relevant date:

Gazeboshop which refers to its “Aluminium Extreme Pro 40” range which its states was introduced in 2005. The pages are dated July 2015. The same outlet also offers its “Aluminium Extreme Pro 50” range which the website declares was introduced in 2006. The numbers relate to the thickness of the legs.

Rock Awnings website, dated July 2015. They offer a Rhino Pro40 and Rhino Pro50 awning range. The numbers refer to the thickness of the legs.

Pop-up Gazebos dated July 2015. This company offers a range of Pro 40 gazebos and also Trader Extreme Hex 40 and Trader Extreme Hex 50 ranges, where the term Hex is clearly shorthand for hexagonal (legs) as explained in the description and the terms 40/50 refer to the thickness of the legs.

MTL dated July 2015. This company offers its MTL Pro-40 range as well as MTL Hex 50. It is clear from the description that Hex is shorthand for hexagonal and the number refers to the thickness of the leg.

Dancover UK dated July 2015. These offer a range of gazebos ranges under the following names Light, Pro, ProStyle, Pro Pagoda and Pro-Xtreme.

Sussex Flags dated July 2015. This company offers a Hex Pro 40 and Hex Pro50 range. In both cases the term Hex is shorthand for hexagonal and the number refers to the thickness of the legs. It also has a Pro X range.

Mayflower Marquees dated July 2015. This company offers a PRO-Marq 40 /50 range of gazebos or marquees.

- Exhibit JL3: Examples from the IPUK brochure dated 2009 which shows a Pro40 range of gazebo.
- Exhibit JL4: Change of name certificate from Instant Awnings Ltd to IPUK on 16 March 2011.
- Exhibit JL5: Samples of invoices dated between December 2011 and June 2012. These three invoices show sales for Pro40 and Pro50 gazebos.

7) The second witness statement, dated 13 August 2015, is by Luigi Pannozzo a director of PitBitz Ltd a UK company which trades as Gazeboshop.co.uk (see exhibit JL2 above) a position he has held since 2006. He states that his company is a competitor to both the companies in the instant case. He states that he has a good knowledge of the UK gazebo industry and that his company first began to use the terms PRO 40 and PRO 50 to describe the 40mm and 50mm series of instant shelters, pop up gazebos and mini

marquees in 2011 (exhibit JL2 above claims use from 2005). He states that the same terms are used by others in the industry prior to 2011, but does not provide corroboration.

8) The third witness statement, dated 30 August 2015 is by Richard Walmsley a director of Buyer Direct Ltd, a position he has held since March 2012, although he has involved in the industry since 2003. He states that his company first began using the terms Pro40 and Pro50 to describe 40mm and 50mm gazebos in 2012. He states that he is aware of others in the industry using these terms prior to this date but does not provide corroboration for either date.

## **EVIDENCE OF GTL**

9) GTL filed a witness statement, dated 3 November 2015 by Jason Mace the founder and director of GTL (formerly known as AJM Shopping Ltd). He states that he has been in the business of marquees and pop up gazebos since 1999 having been in the events industry prior to this. He states that his company introduced a range in 2001 which in 2005 became two gazebos called the "Max" and the "Pro" gazebos. The former was for the general public the latter for professionals as it was more robust. In April 2007 his company introduced the PRO 50, so called as it has a 50mm x 50mm hexagonal leg. In May 2008 they introduced the Pro40 which had a 40mm x 40mm hexagonal leg. However, at exhibit JM1 a screenshot from 10 September 2006 the only reference is to a GALA SHADE PRO. At exhibit JM2 are two invoices dated 23 May 2007 and 28 May 2008, these show sales of GALA SHADE PRO 50 and GALA SHADE PRO 40 respectively. In addition Mr Mace contends that his company also sold a range of gazebos under the names PRO MX and GALA SHADE PRO. He refers to exhibit JM3, but this shows the items offered as GALA SHADE PRO MX, GALA SHADE PRO 40 and GALA SHADE PRO 50.

10) Mr Mace states that his company has a reputation for its range of PRO gazebos as testimonials from customers show (exhibit JM4 refers). He contends that since 2007 IPUK have purchased cast iron gazebo feet from his company. Similarly Buyer Direct Ltd (who have provided evidence in this case) also purchased cast iron gazebo feet in 2015. Along with the invoice the buyers would have received a copy of the terms and conditions, which states that they do not offer any copying rights. He states that these companies are therefore in breach of these terms and conditions. He also points to the contradiction in the witness statement of Mr Pannozzo which states that use began in 2011 and the exhibit JL2. He also states:

"22. The PRO term is widely used across many products in lots of different industries, however Gala Tent initially used the PRO phrase name in 2006 to describe a professional gazebo, which was designed and built by my company. Later on in 2007 and 2008 we branded our gazebos as PRO 40 and PRO 50, and in recent years, this concept has been copied by operators in the same industry and we have asked them to desist calling their products the same name as our own."

11) That concludes my review of the evidence. I now turn to the decision.

## **DECISION**

12) The invalidity is brought under section 47 of the Act which reads:

**47.** - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

13) Invalidity is sought under the single ground based on section 3(1)(d) which reads:

“3(1) The following shall not be registered –

(a) .....

(b) .....

(c) .....

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

14) The issue of whether the marks in suit were signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade has to be determined as at the date of the application for registration. Both marks were applied for on 20 May 2014 and so this is the relevant date.

15) When considering this issue I take into account *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, where the General Court summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and

circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)."

16) I also look to *Nude Brands Ltd v Stella McCartney Ltd*, [2009] EWHC 2154 Ch, where Floyd J. stated that:

"29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c)."

17) It is clear from the evidence that GTL has not used the marks in suit on their own, but always as part of other trade marks. However, the evidence of use by other in the trade is less than convincing. In his witness statement Mr Pannozzo states that he has used the marks PRO 40/ PRO 50 since 2011 whereas exhibit JL2 states use by his company since 2005. Neither date is corroborated with documentation such as invoices or webpages from the actual dates. Most of the exhibits provided are after the relevant date. The only clear use prior to the relevant date is by IPUK. One other company using the marks does not make them "customary in the current language or in the *bona fide* and established practices of the trade". The ground of invalidity against both marks therefore fails.

## **CONCLUSION**

18) The invalidity actions under Section 3(1)(d) both fail.

## **COSTS**

19) As GTL has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement x 2	£300
Preparing evidence	£200
Preparing submissions	£200
TOTAL	£700

20) I order Instant Promotion (UK) Limited to pay the sum of £700 to Gala Tent Limited. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 5th day of April 2016**

**G W Salthouse  
For the Registrar  
the Comptroller-General**