

**TRADE MARKS ACT 1938 (AS AMENDED)  
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 1536363  
BY BAIRD TEXTILE HOLDINGS LTD**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 43059  
BY M S DHALIWAL, J K DHALIWAL, P R S DHALIWAL  
TRADING IN PARTNERSHIP AS GEMINI FASHIONS**

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15 **TRADING IN PARTNERSHIP AS GEMINI FASHIONS**

**DECISION**

20

On 31 August 1995, Baird Textile Holdings Ltd, applied under Section 17(1) of the Trade Marks Act 1938 to register the trade mark GEMINI in Class 25. The application was advertised in respect of the following specification of goods.

25

“Articles of outer clothing; articles of under clothing; all included in Class 25; but not including footwear”.

On 31 August 1995, M S Dhaliwal, J K Dhaliwal, P R S Dhaliwal, trading as Gemini Fashions, filed notice of opposition. In summary, the grounds on which the opposition is based are as follows:

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1. Under Section 11, by reason of their use of, and reputation in, the trade mark GEMINI FASHIONS in respect of “articles of clothing and footwear”;
- 35 2. Under Section 12, by reason of the fact that the trade mark the subject of this application so nearly resembles the trade mark GEMINI FASHIONS applied for by the opponents under No. 1588341 in respect of the same goods and/or goods of the same description, that it is likely to deceive and cause confusion;
- 40 3. Under Section 17(1) because at the date of application, the applicant could not claim to be the proprietor of the trade mark GEMINI.

Details of the opponents’ application, referred to above, are as follows:

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No.	Mark	Class	Specification
1588341	GEMINI FASHIONS	25	Articles of clothing for women and girls; shoes; all included in Class 25.

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5 The opponents ask that the Registrar refuse to register the trade mark or alternatively impose a suitable restriction to the specification of goods before doing so.

In their counterstatement, the applicants admit that the trade marks the subject of the  
10 respective applications Nos. 1536363 and 1588341 are confusingly similar and that the  
opponents are the proprietors of the said application. But the remaining grounds are denied  
and the applicants ask that the Registrar exercise his discretion to allow the application to  
proceed to registration in the form advertised.

15 Each party seeks an award of costs in their favour.

Both sides filed evidence in these proceedings and the matter came to be heard on 24 February  
1998 when the applicant was represented by Mr Hodgkinson of Marks and Clerk, their trade  
mark agent. The opponents were represented by Ms Ayers of Withers and Rogers, their trade  
mark agent.

20 By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in  
accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance  
with the transitional provisions set out in Schedule 3 to that Act, however, I must continue to  
apply the relevant provisions of the old law to these proceedings. Accordingly, all references  
25 in this decision are references to the provisions of the old law.

#### **Opponents' Evidence (Rule 49)**

30 The opponents evidence comprises a Statutory Declaration dated 9 July 1996 from Mr P R S  
Dhaliwal. Mr Dhaliwal states that he is the sole proprietor of the opponents business, Gemini  
Fashions. The other named opponents are family members who, until recently, formed a  
trading partnership of the same name. Although the business was formed during the 1970's,  
trading under the name of GEMINI FASHIONS did not commence until 1981, when Mr  
Dhaliwal joined the business; he provides at Exhibit PRSD 1, three photocopied documents,  
35 viz:

- 40 i. A letter to Mr & Mrs Dhaliwal from Mr A C Wilkins, the manager of the Upton Park  
Branch of the Midland Bank. In his letter, Mr Wilkins confirms that, by way of his  
office's records, references to use of the business name GEMINI "commenced as long  
ago as 1983";
- ii. A certificate of registration for Value Added Tax in respect of GEMINI FASHIONS  
issued on 12 January 1984;
- 45 iii. A certificate of registration of a business name dated 27 October 1981, which bears the  
name GEMINI FASHIONS.

Mr Dhaliwal goes on to describe the activities of the business in 1981, during which time only  
50 items of women's and girls' clothing were sold. These were invariably sold to the trade rather  
than the general public. Whilst some of these items bore the name GEMINI FASHIONS, or  
alternatives incorporating the name GEMINI (for example GEMINI COLLECTION) on the

5 inside label or swing tag, larger customers requested that the label and tags bore their own  
trade mark. Mr Dhaliwal states that this practice continues to the present day. Exhibit  
PRSD2 consists of two such items, a blouse to which a label and swing tag bearing the name  
10 GEMINI COLLECTION are attached, and a skirt which bears another party's trade mark  
(INSPIRATION). Twelve to eighteen months after the commencement of the business under  
the name GEMINI, it started to produce shoes. Mr Dhaliwal states that all the shoes sold bear  
the name GEMINI FASHIONS on the insole and one such insole is produced under Exhibit  
PRSD 3. As with the clothing, all of the shoes sold are he says for women or girls.

Mr Dhaliwal estimates that 10% of the business' turnover is derived from sales in the United  
15 Kingdom, the remainder, some 90%, is generated by sales throughout the remainder of the  
European Union. Nearly all of the shoes produced are sold abroad. No turnover figures are  
available prior to 1989, but those for the subsequent five years are as follows:

Year	Amount (£)
20 1990	254,589
1991	188,962
1992	147,301
1993	218,870
25 1994	316,425


No advertising figures are produced. Mr Dhaliwal explains that his company is located in the  
Whitechapel area of London, one of only two areas in London renowned for clothing and  
30 footwear businesses; the Finsbury Park area being the other. In view of this, potential  
customers simply visit premises in these areas. If the need to advertise arose, his company  
relied on individuals to distribute in the street handbills containing his company's address and  
telephone details. However, in recent years it has not been necessary to do this as his  
company has an established reputation and new customers are directed by word of mouth.

### 35 **Applicants' Evidence (Rules 50)**

The applicants evidence consists of a Statutory Declaration by Mr P McDonald dated 9 April  
1997. Mr McDonald has been employed by the William Baird Group since 1973. He has held  
40 the position of Finance Director of Banner Limited, a wholly owned subsidiary of the  
applicant, Baird Textiles Holdings Limited, since 8 December 1982. As a duly authorised  
representative of Baird Textiles Limited, his declaration is made from his own knowledge or  
from the records of the company to which he has full access.

Mr McDonald states that the trade mark GEMINI was first used in 1972 by Gemini (UK)  
45 Limited, in respect of childrens' outerwear covering all types of childrens' garments. Use of  
the trade mark has been made throughout the United Kingdom since this date. Mr McDonald  
explains that Gemini (UK) Limited was acquired by Beau Brummel Limited on 16 December  
1992. Relevant extracts from the main agreement for the purchase of the business are given  
under Exhibit PMDC1, They show that Beau Brummel Limited acquired the goodwill in the  
50 business and all intellectual property rights. Subsequently, Beau Brummel Limited merged  
with Banner Limited, a wholly owned subsidiary of Baird Textile Holdings Limited. In 1990

5 all group trade marks were assigned to Baird Textile Holdings Limited and thus when Beau Brummel Limited acquired Gemini (UK) Limited, Trade Mark Registration No. 892484 was assigned from Gemini (UK) Limited to the applicant, Baird Textile Holdings Limited. Details of this registration are provided in Exhibit PMCD3 and are as follows:

10	No.	Mark	Class	Specification
15	892484		25	Shirts, corduroy jackets, raincoats, articles of underclothing all for men and boys; anoraks, gym blouses and articles of knitted clothing. Entry cancelled under Section 34(1) (d) of the Trade Marks Act 1938, in respect of:- :Ladies stockings and panty-hose and goods of the same description as ladies stockings and panty-hose.
20				
25				

In support of his company's use of the trade mark in suit, Mr McDonald submits Exhibit PMCD2 which comprises various labels and swing tags bearing the trade mark GEMINI. Mr McDonald states that the current application was filed to extend the use of the existing registered trade mark.

Exhibit PMCD4 gives details of the annual turnover for the sale of goods bearing the trade mark GEMINI. The figures represent the company turnover and also the turnover of Gemini (UK) Ltd prior to the business being acquired by Beau Brummel Limited. These figures and an indication of the retail value of the goods sold under the trade mark are as follows:

	Year	Turnover	Retail Value
40	1979	970,750	1,361,625
	1980	1,721,850	2,583,775
	1981	1,763,950	2,645,925
	1982	2,137,390	3,419,824
	1983	2,171,400	3,474,240
	1984	2,105,630	3,369,008
45	1985	2,199,810	3,519,696
	1986	1,781,600	3,028,720
	1987	1,707,800	2,903,260
	1988	1,623,700	2,760,290
	1989	1,556,500	2,646,050
50	1990	1,252,900	2,255,220
	1991	1,005,600	1,810,080

5	1992	1,105,400	1,989,720
	1993	898,100	1,796,200
	1994	679,800	1,359,600
	1995	366,766	733,532
	1996	115,112	230,224

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Mr McDonald provides at Exhibit PMCD5 examples copy invoices from January 1993 to date sales of goods under the trade mark GEMINI. A further example of a sale under the trade mark is provided under Exhibit PMCD6 which comprises a customer's order for goods under the GEMINI trade mark. No information or figures are given in relation to either the

15 advertising or promotion of the name GEMINI by either the applicant company or their predecessor in business.

In relation to the opponents' claim to have been using the company name Gemini Fashions since 1981, Mr McDonald states that his company (or its predecessors in title) have been using

20 GEMINI as a trade mark in relation to a wide range of clothing, including footwear, since 1972. He concludes that it is his belief that his company's existing trade mark registration, together with the use made by his company (or its predecessors in title), demonstrates that his company has long standing and extensive rights in the trade mark GEMINI and, therefore, is

25 entitled to registration of the current application.

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**Opponents' Evidence in Reply (Rule 51)**

In response to the evidence of Mr McDonald, the opponents filed evidence in reply. This consisted of a further Statutory Declaration dated 6 October 1997 by Mr Dhaliwal. In his

30 declaration, Mr Dhaliwal observes that Mr McDonald has stated that his company, Baird Textile Holdings Limited, use the trade mark GEMINI on a range of "childrens' outward". However, examination of the details of Registration No. 892484, which forms Exhibit PMCD3, reveal that the specification of goods covers "various garments for men and boys, gym blouses and articles of knitted clothing". He goes on to point out that the current

35 application covers "articles of clothing" in general. In support of this, he submits Exhibit PRSD/1, a computer printout of the said application.

In response to Exhibit PMCD2, the collection of swing tags and labels, Mr Dhaliwal notes that no brochures or garments have been submitted which actually demonstrate that the labels are

40 used on the clothing itself. Mr Dhaliwal seeks to cast further doubt on the applicants' use of the trade mark, namely in respect of footwear, as no reference is made in relation to the sale of these goods in the printed material.

Mr Dhaliwal continues by disagreeing with the implication, in Mr McDonald's Declaration, that the opponent company has not used the trade mark GEMINI in a trade mark sense. Mr

45 Dhaliwal points out that his previous evidence clearly illustrates the mark GEMINI has been used as trade mark in respect of various items of women's and girls' clothing and footwear since 1981.

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5 With regard to Mr McDonalds' assertion that the applicants existing registration and their use  
of the trade mark GEMINI demonstrate longstanding and extensive rights in the trade mark,  
Mr Dhaliwal points out that the earlier registration consists of the word GEMINI in  
combination with the device of "two cherubs". From the evidence supplied, it would appear  
10 that this combination has not been used for sometime and, in fact, no examples of this  
representation appear in Exhibits PMCD2 or PMCD5. Additionally, he notes that  
Registration No. 892484 does not cover those goods sold by the opponents under the trade  
mark GEMINI. Whilst he admits that the specification of the current application does cover  
such goods, by Mr McDonald's own admission, the applicant company only uses the mark in  
respect of children's clothing. On this basis, Mr Dhaliwal disputes the applicants' claim that  
15 the trade mark should proceed to registration in respect of all of the goods applied for.

Finally, Mr Dhaliwal states that he only became aware of Baird Textile Holdings Limited's  
right to proprietorship of the trade mark GEMINI when he was advised of the existence of  
this trade mark application. In view of his experience within the clothing trade, Mr Dhaliwal  
20 concludes that the applicant company's reputation in the mark GEMINI is not substantial.

That concludes my review of the evidence, but before considering the substantive issues  
involved I must record that at the Hearing, and as a preliminary point, I was asked by Mr  
Hodkinson, on behalf of the applicant to consolidate these proceedings (Opposition No.  
25 43059) with opposition No. 47265 where Baird Textile Holdings Ltd are opposing an  
application, No. 1588341 by Gemini Fashions, to register the trade mark GEMINI  
FASHIONS in Class 25. This request was not supported by the opponents.

In the event, and after considering submissions from the parties, I determined that the two sets  
30 of proceedings should not be consolidated. First of all the Registrar is always reluctant to  
consolidate proceedings in the face of an objection by one of the parties, as in this case. In  
this case also, the other proceedings are at a relatively early stage and because some of the  
issues are different, I was told, it was not simply a matter of adopting the evidence filed in  
these opposition proceedings in the other opposition proceedings. It would thus mean that  
35 further evidence rounds would be required. If consolidation of the proceedings were to take  
place it would have meant adjourning the Hearing for a period of up to 18 months to allow the  
other proceedings to catch up. In my view that was not justified taking account of all of the  
circumstances.

40 At the start of the Main Hearing, Ms Ayers, for the opponent indicated that the ground of  
opposition based upon Section 17(1) was not being pursued. As there was, in my view, no  
evidence filed which could have supported a finding that the applicant was not the proprietor  
of the trade mark GEMINI in respect of goods falling within Class 25 I formally dismiss the  
ground of opposition based upon Section 17(1).

45 I turn to consider the ground of opposition based upon Section 11 of the Act which states:

50 "11. It shall not be lawful to register as a trade mark or part of a trade mark any  
matter the use of which would, by reason of its being likely to deceive or cause  
confusion or otherwise, be disentitled to protection in a court of justice, or would be  
contrary to law or morality, or any scandalous design."

5 The established test in respect of opposition based upon this Section of the Act is that set down in Smith Hayden & Co Ltd's application but as adapted by Lord Upjohn in the BALI trade mark case (1969) RPC 496. Adapted to the matters in hand the test may be expressed as:

10 "Having regard to the user of the opponents' mark GEMINI FASHIONS, is the tribunal satisfied that the mark applied for, GEMINI if used in a normal and fair manner in connection with any goods covered by the registrations proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?"

15 In this case I consider that the respective trade marks are substantially the same. The opponents have used the word GEMINI together with the term 'Fashion' or 'Collection', neither of which are distinctive in relation to the goods covered by the specification. The applicant has used the word GEMINI on its own and they also have a registered trade mark in  
20 respect of goods which fall into Class 25 and which consists of the word GEMINI together with two cherubs. In my view, the word GEMINI is the predominant element in this latter trade mark. Therefore, normal and fair use by either party of their respective trade marks would result in each sides trade marks being known as GEMINI trade marks.

25 I am satisfied that the applicants have used their trade mark since 1972; there has been no argument or challenge to that by the opponents. The opponents on the other hand claims use of the trade mark only since 1981, and I am satisfied that this is the case. Some of the opponents use could be described as use as a business name, as submitted by the applicants, but I have no doubt that this use was also 'trade mark use'. It was the means by which the  
30 word GEMINI was presented to the public as a badge of origin of the opponents goods for sale in the United Kingdom and for export.

On the face of it the applicant was first to use the trade mark and therefore it is the use by the opponent of the trade mark GEMINI which is likely to result, using the 'Smith Hayden' test,  
35 in the confusion and deception of a substantial number of people, and that should decide the matter in the applicants' favour. However, the opponents in their evidence and in the submissions of Ms Ayers at the Hearing claimed that in fact the parties' reputations in relation to the trade mark GEMINI have been built up in different sectors of the clothing market. The applicant, it was stated, has established its reputation in respect of children's clothing whereas  
40 the opponents reputation is in ladies' outerwear. The opponents therefore consider that if the application is allowed to proceed it should do so only on the basis of those goods on which their reputation is based ie. children's clothing. But, at the Hearing, in connection with submissions by Ms Ayers on the matter of the use by the opponents of the trade mark GEMINI, I was shown letterheads which indicated that the opponent too was a supplier of  
45 childrens wear, in addition to ladies outerwear and shoes.

It appears therefore from the evidence submitted to me and the documents that were made available to me and submissions made at the Hearing that both parties to these proceedings are suppliers of ladies' and children's clothing and footwear. The evidence filed in relation to  
50 turnover and advertising by both parties is not broken down to an extent where a more precise area of reputation can be established. I therefore have had to reach a view as best I can on the



5 material available. In doing so I hold that both parties have used the trade mark GEMINI on  
the same goods and that each has established a reputation in the same trade mark. Though the  
applicants sales figures are significantly larger than the opponents, and therefore their  
reputation may be greater, each has, it seems to me, established a niche in the clothing market.  
10 But, notwithstanding the above, in terms of the grounds of opposition pleaded under Section  
11, I must hold that the applicant has established first use of and a reputation in the trade mark  
GEMINI (by almost 8 or 9 years) and therefore under the test laid down earlier it is the  
opponents use of the same trade mark which is likely to cause confusion or deception.  
Therefore the opposition based upon Section 11 is dismissed.

15 Pleadings were also submitted in respect of Section 12(3). However, as I have found that the  
applicants have an earlier claim to registration over the opponent (and matters have not  
otherwise been settled between the parties) I do not need to refer the matter to the Court.  
Nor, in view of my findings in relation to the ground of opposition based upon Section 11, is it  
20 necessary or appropriate to exercise the Registrar's discretion.

As the opposition has failed and the applicants have been successful I order the opponent to  
pay to them the sum of £800 as a contribution towards their costs.

25 **Dated this 16<sup>th</sup> day of March 1998**

**M KNIGHT**  
**For the Registrar**  
**The Comptroller General**

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