

O-286-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2456707
IN THE NAME OF SMILE STUDIO UK LTD**

AND

**OPPOSITION THERETO UNDER NO 96919
BY DR GURSAWINDER SINGH HAP GILL**

Background

1. Application No. 2456707 is for the following series of four marks:

smilestudio

SMILESTUDIO

SMILE STUDIO

Smilestudio

2. The application was filed on 26 May 2007 and stands in the name of Smile Studio UK Ltd. ("Smile").

3. Following publication in the *Trade Marks Journal* Smile filed an amendment to its application in respect of the services for which it sought registration. The amendment was allowed and the specification now reads:

Teeth whitening; massage services; aromatherapy.

4. Notice of Opposition was filed by Dr Gursawinder Singh Hap Gill. The Notice of Opposition was filed prior to the amendment of the specification of the application though, for the purposes of this decision, nothing hangs on this. The opposition to the registration of the mark is founded on sections 5(1) and 5(3) of the Act based on two earlier registrations, under nos. 2297794 and 2356276, both registered in respect of *dentistry services* in class 44. Both registrations claim the colours silver and blue as an element of the mark and are as follows:

2297794



2356276



5. Smile filed a counterstatement in which it denied the claims made by Dr Gill. It stated that it did not deny Dr Gill has used the mark SMILE STUDIO but made no admissions as to its relevance to these proceedings. The counterstatement contained a request that Dr Gill be required to prove use of his registrations. Smile further claimed that it had been using the marks for which it seeks registration from a date prior to the registration dates of Dr Gill's marks.

6. Neither party requested to be heard but both filed brief written submissions in lieu of a hearing. I make this decision after a careful consideration of all the papers before me.

Dr Gill's evidence

7. This takes the form of a witness statement dated 10 November 2008 from Dr Gill who says he has been a self-employed dentist since 1991 and has been trading under the name Smile Studio since 1999. He says he first used the name as a trade mark in 2002 in respect of dentistry services including teeth whitening, providing them in London, Surrey and Middlesex.

8. Dr Gill attaches the following exhibits:

- GG1 A print from the WHOIS database showing Dr Gill to be the registrant for the domain name smilestudio.co.uk, registered on 4 November 1999;
- GG2 A sample of Dr Gill's business card which he states has been used "in its various guises" since 2002. He does not explain what he means by this nor does he explain when the particular sample provided was used. It does not show either of the earlier marks relied on in these proceedings;
- GG3 A letter addressed to the Trade Marks Registry and dated 22 September 2008. The letter is from Dr Gill's business bank manager and bears a reference to these proceedings. The letter indicates that Dr Gill has been trading under the name Smile Studio since August 2001, some two years later than Dr Gill himself claims;
- GG4 An undated letter bearing a reference to these proceedings from a Dr Banner indicating that Dr Gill has been a self-employed associate at Dr Banner's practice since 6 June 1994, trading as Smile Studio since November 1999;
- GG5 A sheet of A4 headed paper which again Dr Gill says "has been used in its various guises" since 2002. Dr Gill does not explain when the particular headed paper was used but again, it does not show either of the earlier marks relied upon;
- GG6 A copy of a feature said to have appeared in the magazine "in the know" in 2006. The feature appears to be two pages from the magazine but the photocopying is poor in that neither page is shown

complete. There is a reference to a Dr Gill being a cosmetic dentist but I cannot see any reference to the marks relied upon;

- GG7 A copy of a feature from “Reveal” magazine dated 28 July to 03 August 2007 (and therefore after the relevant date in these proceedings) which refers to “Dr Hap Gill of the Smile Studio in London”;
- GG8 A copy of a feature from “Essentials” magazine of January 2007 which refers to “Dr Hap Gill at Smile Studio” and gives his website address;
- GG9 A copy of a feature from “Men’s Health” magazine of April 2008 (again after the relevant date) indicating that Dr Gill is an expert contributing to the feature, describing him as founder and director of Smile Studio;
- GG10 A copy of a feature from “new You” magazine of May 2008 (again after the relevant date). Another incomplete photocopy of the page, it makes reference to “The Smile Studio” and Dr Gill;
- GG11 A copy of a CD bearing digital images which Dr Gill says is evidence of use of his mark on his business premises and has been used “in its various guises” since 2002. The three images show what I take to be the entrance to Dr Gill’s business premises. There is a sign affixed to the wall on each side of the door. I do not know when the photographs were taken but none of the images make any reference to the marks as relied upon in these proceedings.

9. Dr Gill states that as a result of the use made by him for many years, the mark Smile Studio is well known to the general public, media and other dental colleagues as a provider of dentistry including teeth whitening, a field in which, he says, he is regarded as an expert. I shall return to this later in this decision.

Smile’s evidence

10. Smile’s evidence takes the form of a witness statement from Michael Stanley Brown of Alpha & Omega, its trade mark agent. Mr Brown attaches the following exhibits:

- MSB1 A copy of a witness statement from Bing Wing, Benjamin, Mak dated 6 December 2007 with its own exhibits, as to which, see below;
- MSB2 A copy of an article featured in “Dentistry” magazine showing the nominations for the top 50 most influential persons (internationally) in the dental community in 2008 with Dr Chan, founder of Smile appearing at number 34;
- MSB3 Copies of advertisements said to be from major UK dentistry publications namely “Dental Tribune”, “Dentistry” and “Private Dentistry” for seminars at which Dr Chan, founder of Smile has lectured;

MSB4 A copy of a report appearing in Dental Tribune of September 29-October 5 2008 reporting the making of an award, at the 2008 International Association of Dental Research, to Dr Chan;

MSB5 Sample advert from Dentistry magazine of September 2008.

11. Each of the articles at MSB2-5 were published after the relevant date in these proceedings.

12. Mr Mak's witness statement confirms that he became a director of Smile on 21 June 2006. He states that the mark the subject of this application was first used in the UK in January 2002. He explains that Dr Whyman Chan is a director of and major shareholder in Smile which was formed on 30 September 2003 and that before this time Dr Chan used the mark as a sole trader.

13. Mr Mak states that the "smilestudio" concept of a "dedicated teeth whitening spa completely detached from the look and feel of a dental clinic" was started about June 2001 with the name smilestudio first being used on documents in January 2002. The premises opened in March 2002 and was the first teeth whitening spa in the UK. Since its launch, the concept has become well-known and well-liked amongst dentists. In August 2003, he says, Dr Chan started licensing the name and concept to other dental practices in the UK. There are now over 100 licensed users of the mark in most regions of England and in Scotland.

14. Turnover and advertising figures for Smile and its predecessor in title (not including those of any franchisee) are given as follows:

Year ending April	Turnover (£s)	Advertising (£s)
2002	12,000	19,000
2003	176,000	106,000
2004	205,000	29,000
2005	462,000	41,000
2006	511,000	38,000

15. The following exhibits are attached to Mr Mak's witness statement:

- BM1 copies of letters and documents including invoices, bank statements and Inland Revenue returns showing use of the name smilestudio as a trading name from 2002;
- BM2 various press articles reporting the opening of the spa on 4 March 2002;
- BM3 a copy of an invitation to the above opening;
- BM4 what are said to be three "generations" of promotional leaflets but for which no dates are given;

- BM5 copies of articles appearing in various publications including specialist and general interest magazines and a newspaper between December 2002 and January 2007;
- BM6 extracts from a case study produced by Smile's PR company reporting on the outcome of PR undertaken for the launch of the spa;
- BM7 the "press page" from Smile's website which appear to be a link to articles in various publications. No dates of these are discernable nor have the articles themselves as available via those links been provided;
- BM8 undated sample literature distributed to potential licensees;
- BM9 pages from Smile's website together with a listing from the Wayback Machine showing details going back to 1 April 2002.

Dr Gill's evidence in reply

16. Dr Gill's second witness statement is dated 1 June 2009. He clarifies that whilst his business bank account came into existence in 2001, he started trading under the name in 1999 and "receive[d] my trademark" in 2002. I am not entirely sure what he means by this latter statement. Attached to Dr Gill's witness statement are exhibits GG12 to GG31. I do not intend to set out the content of these exhibits in any detail. Suffice to say that the vast majority of them relate to Dr Gill himself and most are undated or post date the relevant date in these proceedings. None bear any reference to the marks as relied on in these proceedings.

17. No further evidence was filed by either party.

Decision

18. I deal first with the objection based on section 5(1) of the Act. This reads:

"5. -(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected."

19. 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, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(b)

(c)

(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.”

20. In these proceedings, Dr Gill is relying on two registered trade marks both of which have an application date prior to that of the application for registration. Each qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 28 March 2008 and Dr Gill’s trade marks were registered on 27 September 2002 (no. 2297794) and 3 December 2004 (no. 2356276). I go on to consider the position under The Trade Marks (Proof of Use, etc) Regulations 2004, the relevant sections of which read as follows:

“6A (1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

- (a) 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

(b) 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)

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7)....”

21. Also of relevance is section 100 of the Act which states:

“**100.** 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.”

22. Under section 6A(1)(c) only earlier trade mark no. 2297794 is subject to the Trade Marks (Proof of Use, etc) Regulations 2004 and I go on to consider whether genuine use has been shown of this mark. In doing so, I take into account that the relevant period is the five year period ending with the date of publication of Smile’s application, i.e. 29 March 2003 to 28 March 2008.

23. The guiding principles to be applied in determining whether there has been genuine use of a mark are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003]RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

-genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);

- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);

- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);

- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

24. Earlier trade mark no. 2297794 relied upon by Dr Gill consists of a letter S within a squared border above the words smilestudio as shown in paragraph 4 above. The colours silver and blue are also claimed as an element of the mark. In reaching a conclusion on whether genuine use has been made of this earlier trade mark within the relevant five year period, I am mindful that the evidence filed by Dr Gill suffers from a number of defects which I have set out above i.e. some exhibits are undated and others post date the relevant period. Whilst a reasonable volume of evidence has been filed, the majority of it relates to Dr Gill personally and, whilst I have no reason to doubt the truth of its content, it is of no assistance in relation to the issues to be determined. Nowhere in the evidence have I been able to identify any use of the mark as registered neither have figures of any turnover generated or advertising spend etc. made under the mark been provided.

25. In his evidence, Dr Gill repeatedly refers to his use of his website. Although registered in 1999 there is no evidence of when the domain name was first used. There is evidence that he uses that domain name on his current stationery (his witness statements are presented on this paper). There is evidence of use of his domain name at his premises and on business cards. None of this later evidence is dated, however, and it would be insufficient to show use within the relevant period. Within the evidence are exhibited various magazine articles. These refer to Dr Gill himself and, to a much lesser extent, his business, though most of these post-date the relevant period. That said, the exhibits at GG7 and GG8 include two articles published in the January 2007 and July/August 2007 editions of the relevant magazines. Within the text, the articles make a brief mention of Dr Gill at (or of) Smile studio/smilestudio and the latter article also refers to his website address. But that is as far as the evidence goes and cannot be taken to be trade mark use made with a view to creating or preserving an outlet for the relevant services. Rather, the mentions appear to me to be indicative of Dr Gill's professional involvement in the area of cosmetic dentistry.

26. In any event, ownership and mere use of a domain name is not conclusive as to trade mark use. As stated in Kerly's Law of Trade Marks and Trade Names (14th edition), page 723, paragraph 23-017:

"A domain name registration as such is not an intellectual property right: it is a contract with the registration authority controlling the Top Level Domain concerned allowing communications to reach the domain name owner's computer via Internet links channelled through the registration authority's server. It does not create a monopoly or any other form of exclusive right. It is in many ways akin to a company name registration which is a unique identifier of a certain company but of itself confers no intellectual property right."

27. Proof of use either by the proprietor of the earlier mark, or with his consent, is a matter of fact to be established by evidence. The onus here is on Dr Gill. In my view, the evidence he has filed fails to prove any use within the relevant period of his registration no. 2297794. **As he has failed to prove use of his mark within the relevant period, as required by section 6A(3), the objection under section 5(1) based on the earlier right under no. 2297794 must fail.**

28. Dr Gill also objects under section 5(1) on the basis of his earlier registration no. 2356276. This mark is not subject to the proof of use requirements and I go on to consider it further.

29. In *LTJ Diffusion SA and Sadas Vertbaudet SA*, Case C-291/00, the ECJ considered the provisions of Article 5(1)(a) of First Council Directive of 21 December 1988 (89/104/EEC). The Court noted that article 5(1)(a) (Rights conferred by a trade mark) does not require evidence of a likelihood of confusion. Article 5(1)(a) of the Directive and section 5(1) of the Act contain equivalent provisions in relation to identity between marks in the context of grounds for refusal of an application. The protection offered in circumstances where the marks and goods or services are identical, is absolute. The Court's guidance was as follows:

"54. In those circumstances, the answer to the question referred must be that Article 5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

30. The Court had explained, earlier in its judgment, the considerations behind this guidance:

"50. The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects. Indeed, the absolute protection in the case of a sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, which is

guaranteed by Article 5(1)(a) of the Directive, cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by Article 5(1)(b) of the Directive.”

31. Dr Gill gives no explanation of the basis for his claim that the respective trade marks are identical. Smile are similarly silent when defending the claim. The application is for a series of four marks, two presented in upper case, one in lower case and one a mixture of the two. Whilst in three marks of the series the words are conjoined, all, essentially, consist of the words SMILE STUDIO. The earlier mark consists of a letter S within a squared border above the words smilestudio as shown in paragraph 4 above, with the words The Centre for Aesthetic Dentistry in cursive script extending to the right of the boxed letter S. The colours silver and blue are also claimed as an element of the mark.

32. I have no doubt that the earlier mark was intended to be seen as a whole and that is how the average consumer would approach it. The differences between it and the mark of the application are clear and would not go unnoticed. The respective marks are not identical. **That being the case, the objection under section 5(1) based on the earlier right no. 2356276 also fails.**

33. I go on to consider the grounds of opposition under section 5(3) of the Act which reads:

(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

34. Dr Gill relies on the same two earlier rights as he did under section 5(1). As set out in paragraph 20 above, the proof of use requirements also apply to objections brought under Section 5(3) and again the requirements apply only to earlier trade mark no. 2297794. I have already found, on the basis of the evidence filed, that Dr Gill has failed to prove his use of the mark within the relevant period. **Having failed to prove use of his earlier mark as required by section 6(A)(3) of the Act, his objection under section 5(3) based on this earlier mark must similarly fail.**

35. The remaining objection under this section is based on earlier registration no. 2356276 and can be dealt with fairly promptly. In order to found an objection under section 5(3), the mark relied on must be shown to have a reputation.

36. The test for the actual reputation that is required is long established and was set out in *General Motors Corp v Yplon SA* [2000] RPC 572. The Court concluded that the required reputation implies a certain degree of knowledge amongst the general public which degree would have been reached when the earlier mark is known by a significant part of the public concerned with the goods or services covered by that

mark. This requires consideration of all relevant factors including the duration, intensity and geographical extent of use, market share and level of advertising.

37. Despite a thorough and careful review of all the evidence filed, I can find no evidence of any use of this earlier registration. That being the case, I am unable to find the mark has any reputation. **The ground of opposition under section 5(3) based on earlier registration no. 2356276 therefore also fails.**

38. The opposition has failed in respect of all the grounds of opposition which were raised. That being the case Smile is entitled to an award of costs in its favour. I therefore award Smile costs on the following basis:

Considering Notice of Opposition	£200
Filing counterstatement	£300
Preparing and filing evidence	£300
Considering Dr Gill's evidence	£150
Total	£950

39. I order Dr Gursawinder Singh Hap Gill to pay Smile Studio UK Ltd the sum of £950. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of September 2009

**Ann Corbett
For the Registrar
the Comptroller-General**