

O/0964/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 505914  
BROUGHT BY CONNEXION DEVELOPMENTS LTD

TO REVOKE ON THE GROUNDS OF NON-USE  
REGISTRATION NO. UK00801295503  
FOR THE MARK:



**CONEXO**

IN CLASSES 7, 9 & 42

OWNED BY  
GEMÜ GEBR. MÜLLER APPARATEBAU GMBH & CO.  
KOMMANDITGESELLSCHAFT

## BACKGROUND AND PLEADINGS

1. These proceedings concern the following trade mark which stands registered in the name of GEMÜ Gebr. Müller Apparatebau GmbH & Co. Kommanditgesellschaft (“the proprietor”):



Registration no. UK00801295503<sup>1</sup>

Filing date 1 December 2015; registration date 16 September 2016

Priority date: 3 June 2015 (Germany)

Registered for the following goods and services:

Class 7: Mechanical, pneumatic or hydraulic control elements and controls for valves; actuators for valves [machine parts]; control mechanisms for machines, engines and motors, namely drives of metal or plastic [operated manually or externally controlled]; pneumatic or hydraulic operated switches, valve diaphragms for actuating industrial plants [parts of machines]; valves, clack valves, diaphragms and taps of plastic and/or metal as machine parts for hydraulic and pneumatic media, included in this class; electric, pneumatic and hydraulic actuators for valves, namely electromagnetically, pneumatically or hydraulically operated cylinders; machines and installations composed thereof suitable for use in clean rooms for manufacturing of medical equipment, for manufacturing of data carriers, for display manufacturing, automobile manufacturing, micro-engineering, semi-conductor manufacturing and solar manufacturing, for manufacturing in the pharmaceutical industry, in the medical technology and for

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<sup>1</sup> The proprietor’s mark is a comparable trade mark based on a pre-existing International Registration that designates the EU. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing IRs designating the EU. As a result, the proprietor’s mark has the same filing and registration dates as the earlier IR.

manufacturing in the food and packaging technology; all above-mentioned goods exclusively provided with one or more electronic data memories.

Class 9: Measuring, detecting and monitoring instruments, indicators and controllers for gases and liquids; fittings for measuring technology and control engineering provided with one or more electronic data memories; apparatus for recording, transmission or reproduction of data and measurement, diagnostic and monitoring results for valves; flowmeters, flow controllers; pressure measuring apparatus and pressure regulating apparatus for hydraulic and pneumatic installations and electromagnetically operated relay valves; electric and electronic control and regulating apparatus, in particular for valves and for the installation in plants, for example manufacturing plants for the production of data carriers, manufacturing plants for the display or automobile industry, in micro-technology, in the semi-conductor, solar or pharmaceutical industry or in the medical technology, in the food or packaging technology; switches; none of the aforementioned products being or relating to computer software or hardware in the field of smart metering of energy, smart grids or energy management.

Class 42: Scientific and technological services and research and design services relating thereto; industrial analysis and research services; design of software; all aforementioned services in the field of measurement technology, drive technology, control and regulation technology for valves, including field bus technology and industrial communications; none of the aforementioned services relating to tracking and monitoring energy usage, and energy management.

("the proprietor's mark")

2. On 16 March 2023, Connexion Developments Ltd (“the applicant”) applied to revoke the proprietor’s mark in full. The application was brought in reliance upon sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (“the Act”).
3. The period during which the applicant alleges non-use under section 46(1)(a) is the five years after registration of the mark, being 17 September 2016 to 16 September 2021 (“the first relevant period”) with revocation sought from 17 September 2021. Under its section 46(1)(b) ground, the applicant is alleging non-use of the mark for the periods of 16 March 2017 to 15 March 2022 (“the second relevant period”) and 16 March 2018 to 15 March 2023 (“the third relevant period”), with revocation sought from 16 March 2022 and 16 March 2023, respectively. I note that the latter effective revocation date is the date of the application at issue.
4. The proprietor filed a counterstatement wherein it defended all of the goods and services subject to the application. In doing so, the proprietor claims to have put its mark to genuine use throughout the relevant periods and the relevant territories. Further, the proprietor claims to have commenced or resumed genuine use of the mark in the UK and the EU in respect of all goods and services before the date of three months prior to the application for revocation. If the latter argument is proven then regardless of any use in respect of the earlier relevant periods, the mark will remain registered in accordance with section 46(3) of the Act (which I will reproduce below).
5. The applicant is represented by Stevens, Hewlett & Perkins and the proprietor is represented by Stevens & Bolton LLP. Only the proprietor filed evidence. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful consideration of the papers.
6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying

assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **EVIDENCE**

7. The proprietor's evidence in chief came in the form of the witness statement of Mr Marcus Ripsam dated 28 August 2023. Mr Ripsam is the COO of inevo solutions GmbH, an affiliated company of the proprietor. As an executive officer of an affiliate company, I accept that Mr Ripsam is duly authorised to file evidence on behalf of the proprietor. Mr Ripsam's evidence is accompanied by fifteen exhibits, being those labelled MR1 to MR15, and his statement was adduced to demonstrate genuine use of all goods and services subject to these proceedings.
8. I do not intend to summarise the evidence or submissions of the parties in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

## **PRELIMINARY ISSUE**

9. I note that in its written submissions in lieu, the proprietor made reference to a previous decision issued by the Tribunal which concerned the same parties (BL O/0868/23). The mark at issue in these proceedings is the same as the earlier mark relied upon in the earlier opposition proceedings where it was subject to proof of use in relation to the same goods and services pertinent to the case before me. The submissions set out that in that decision, the Hearing Officer found genuine use for some class 9 goods but not in respect of the goods and services in classes 7 and 42. It does not appear to me that the proprietor is seeking to introduce this earlier decision to suggest that I should automatically find use in respect of class 9 goods. Instead, it appears that the proprietor's rationale for mentioning the previous decision is to put forward reasons as to why the Hearing Officer in that decision had erred in finding no genuine use for the remaining goods and services. In respect of the class 7 goods, the applicant argues that they *are* goods that are sold under the CONEXO branding and that

even if they are sold under branding that is used in conjunction with GEMÜ, then this does not mean that the proprietor's mark is not itself being used in respect of those goods.<sup>2</sup> This is an argument I will consider when determining genuine use of the proprietor's mark below. However, I raise the reference to the previous proceedings as a preliminary issue because I wish to confirm, for the avoidance of doubt, that the earlier decision of the Tribunal is not binding on me in any way.<sup>3</sup> Instead, the assessment I must make here is to be based on the evidence that is before me in these proceedings.

## DECISION

10. Section 46 of the Act states:

“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;

(c) [...]

(d) [...]

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<sup>2</sup> It is noted that this is the reason as to why the Hearing Officer in the previous decision did not find genuine use in respect of the proprietor's class 7 goods.

<sup>3</sup> Again, I repeat the fact that it does not appear as though this is what the proprietor is arguing.

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(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) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

11. Given that the proprietor's mark is a comparable mark, paragraph 8 of part 1, schedule 2A is relevant. It reads:

"8.— Non-use as defence in infringement proceedings and revocation of registration of a comparable trade mark (EU)

(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the "five-year period") has expired before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union".

12. Section 100 is also relevant, which reads:

“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.”

13. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at

[36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or

just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

14. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark”<sup>4</sup> is not, therefore, genuine use.

15. As I have set out above, the proprietor’s mark is a comparable mark based on an earlier IR designating the EU. This means that use of that mark in the EU prior to (and including) IP Completion Day (being 31 December 2020) is relevant to the present assessment.<sup>5</sup> By virtue of being a Member State prior to this date, the UK still forms part of the relevant territory of the EU. From 1 January 2021 onwards, however, the relevant territory is the UK only.

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<sup>4</sup> *Jumpman*, Case BL O/222/16

<sup>5</sup> See paragraph 4 of Tribunal Practice Notice 2/2020

16. I remind myself that there are three relevant periods for these proceedings. Those are 17 September 2016 to 16 September 2021 (“the first relevant period”), 16 March 2017 to 15 March 2022 (“the second relevant period”) and 16 March 2018 to 15 March 2023 (“the third relevant period”). While the relevant periods do differ, they all overlap significantly. Above, I discussed the fact that the proprietor has raised an argument in reliance upon on section 46(3) of the Act (which is reproduced above). This argument is such that if genuine use is proven for the lattermost relevant period but not the earlier relevant periods then, under section 46(3), the mark will survive revocation in respect of all relevant periods based on the later use.<sup>6</sup> As a result, while it would be open to me to focus solely on the latest relevant period, given the aforementioned overlap in relevant periods, I will proceed to consider the entirety of the evidence before me rather than focusing on one relevant period.

Form of the mark

17. I note that in its submissions, the applicant made an argument that the use shown in the evidence is not use of the mark as registered. The applicant argues that use of the following mark throughout the evidence has a material and distinctive difference to the proprietor’s mark. For illustrative purposes, these marks are as follows:

The mark in evidence	The proprietor’s mark
	

18. Firstly, the evidence before me includes a wide range of use of the proprietor’s mark as it is registered. Secondly, I do not consider that the argument raised by

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<sup>6</sup> So long as the use did not commence within three months of the date of the application, of course.

the applicant has any merit. In short, the mark shown in evidence differs only in the shade of red used and the circular devices that surround the centre of the word element. Dealing with these in turn, I do not consider that the different shade of red is likely to be noticed but even if it were, it has no impact on the distinctiveness of the mark. As for the additional components (being the circular devices), these are merely banal surroundings and do not alter the distinctive character of the mark.<sup>7</sup> As a result, I consider that the mark used in the evidence is an acceptable variant of the mark as registered in accordance with section 46(2) of the Act.

### Evidence of use

19. The evidence goes over the history of the GEMÜ brand since 1964, confirming that it began operating it in the UK in June 1981. In respect of the actual CONEXO brand, the opponent confirms that this was developed in 2015. The CONEXO system is confirmed as allowing the following:

- a. The electronic unique identification of valves and components through the use of Radio Frequency Identification (“RFID”) chips and QR codes; and
- b. Supports document management and paperless maintenance.

I note that the launch of the system was part of a major presentation at the AICHEMA trade fair in Frankfurt in June 2015. A copy of the brochure for this event is provided alongside a series of photographs of the proprietor’s stands at the event.<sup>8</sup> While the brochure and photographs show, primarily, the GEMÜ branding, the CONEXO brand does appear at several points throughout. As this event took place prior to any of the relevant periods, this evidence is of no real assistance to the issue of genuine use. That being said, I accept that this is when the proprietor began using the CONEXO brand.

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<sup>7</sup> See *Hyphen GmbH v EU IPO*, Case T-146/15 wherein the General Court made a similar finding in that the addition of a circle around a device element did not alter the distinctive character of the mark.

<sup>8</sup> MR1

20. The CONEXO system uses the proprietor's CONEXO tags, which can be read using the electronic CONEXO pen which feeds data from the tag to the proprietor's CONEXO software products via an app, portal and online system. The evidence goes on to state that the CONEXO system can either be purchased with GEMÜ products or purchased separately and retrofitted with the same. The CONEXO system can also be used in conjunction with third party components and systems. An excerpt of a catalogue has been provided which claims to show the proprietor's product range.<sup>9</sup> While noted, it is simply a list of contents for a catalogue and there is no reference to the CONEXO branding.

21. The proprietor has provided a range of 82 pages of evidence in respect of how the proprietor's mark has been used.<sup>10</sup> I do not intend to discuss each item of evidence but note that the CONEXO brand appears throughout, be that in informational brochures or in photographs of products. While noted, the photographs showing the products in situ are (1) undated and (2) make no reference to what the actual goods are. Clearly, the proprietor operates in a highly technical field and simply appending images of products is not particularly helpful, especially when it is wholly unclear what the products are. As an illustrative example, I have reproduced some of the proprietor's photographs below:



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<sup>9</sup> MR15

<sup>10</sup> See MR2. For completeness, I note that some of the pages within this exhibit are in the German language and have not been translated.



22. I note that this evidence does make reference to GEMÜ products being suitable for being retrofitted with CONEXO products<sup>11</sup> and the CONEXO app.<sup>12</sup> I also note that there are references to different product ranges such as GEMÜ SUMONDO. In addition, there is information and images in respect of the electronic pen that is used to read the CONEXO devices. While some of the images of this electronic pen are shown as being under the GEMÜ brand, the majority of the images show them bearing the CONEXO brand.

23. It is also noted from the evidence that the proprietor offers something that it refers to as 'The CONEXO portal'. This is explained as being an online management tool for all CONEXO system data, including locations, buildings, RFID tags, users, maintenance processes, maintenance intervals and history. This is an online portal that the evidence claims to give easy access to information and documents. It is also stated that it acts as an electronic inventory of goods. Examples of the interface of this portal are shown in evidence.<sup>13</sup> While noted, the accounts of the examples appear to be under Mr Ripsam's name and, further, there is nothing to confirm when these examples were accessed.

24. Turning to advertising efforts, I note that the evidence confirms that since 2016, the proprietor has spent over €500,000 in promoting and advertising the

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<sup>11</sup> See page 24 of MR2.

<sup>12</sup> See page 25 of MR2.

<sup>13</sup> MR5

CONEXO products and services. In addition, the evidence confirms that an additional amount of €66,000 was spent in 2022 in promoting the CONEXO system by inevvo solutions (being a company confirmed as a subsidiary company of the proprietor). Examples of these advertising efforts are provided in evidence.<sup>14</sup> I note that the examples provided are brochures from 2016 and 2017.

25. The proprietor's website as provided exemplifies the relevant CONEXO pages.<sup>15</sup>

I note that this webpage shows products such as CONEXO tags (seemingly these are RFID products that are retrofitted to products that have already been installed), the CONEXO Lite App, the CONEXO Webview, the CONEXO pen, the CONEXO App and the CONEXO Portal. This printout is not dated but the narrative evidence confirms that this is how the pages have appeared since 2016. While this claim is noted, the proprietor has provided an additional printout of its website taken from the internet archive facility, The Wayback Machine, showing the website as at 10 August 2019.<sup>16</sup> This printout clearly shows a different page. That being said, I note that the proprietor has provided another archived copy of its website which is dated 27 October 2021.<sup>17</sup> This printout does show webpages in line with the one mentioned above, and therefore, I am satisfied that the products listed above were available during the relevant period.

26. In respect of website visit data, I note that the proprietor has provided evidence as to visits to the inevvo solutions website (which does consist of the CONEXO branding)<sup>18</sup> between 1 January 2018 and 23 November 2022.<sup>19</sup> It is confirmed that during that time, there were a total of 9,597 visits from users in the EU, with 162 of those being from the UK. An additional Excel spreadsheet is provided in relation to visits to GEMÜ's own website (which has featured CONEXO products since 2017), with 4,365 visits from the EU and 430 visits from the UK.<sup>20</sup> I note while the exhibited evidence in respect of the visitor figures is in the German

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<sup>14</sup> MR6

<sup>15</sup> MR7

<sup>16</sup> MR8

<sup>17</sup> Also at MR8

<sup>18</sup> MR9

<sup>19</sup> MR10

<sup>20</sup> Also at MR10

language, it is clear to me what the evidence says and, further, the proprietor has provided a breakdown of these figures in its narrative evidence.

27. The evidence then moves to specifically discuss the proprietor's brochures. A copy of one of its brochures from 2019 is provided.<sup>21</sup> This is the same brochure that has appeared many times in other exhibits so I see no need to discuss it in any detail here. The evidence goes on to confirm that the proprietor's brochures have been issued in large numbers during the relevant periods and it has provided spreadsheets to demonstrate how many of these brochures were issued in English, German and French between 2016 and 2021.<sup>22</sup> I do not intend to discuss the data in the spreadsheets in any detail save to say that they clearly demonstrate a large number of brochures being distributed. In terms of the actual distribution method of these brochures, the narrative evidence confirms that they were given out at trade fairs in Germany and events in the UK, Denmark, Belgium, Ireland, Sweden and Italy. Photographs of the proprietor's stands at some of these events in the EU between 2016 and 2018 are also provided.<sup>23</sup> I note that they all show the CONEXO brand.

28. By 2 December 2022, the proprietor sold 1,343,000 CONEXO components globally. The narrative evidence confirms that a very large proportion of these components were sold in the EU, though it does not provide any breakdown as to EU use prior to IP Completion Day or any reference to UK use from after that date. That being said, it has provided turnover figures for the years 2017 to 2022 for a range of different countries in the EU. The evidence sets out that these figures cover GEMÜ components (valves, actuators, etc) which are equipped with a CONEXO RFID chip. The figures are as follows:<sup>24</sup>

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<sup>21</sup> MR11

<sup>22</sup> MR12

<sup>23</sup> MR13

<sup>24</sup> While the proprietor has provided information for each country for each year, I will provide only the overall figures across the EU (prior to IP Completion Day) and the UK (after IP Completion Day). I note that figures are provided for Switzerland and Norway, not being EU countries. While the Norway figures are from 2022 only (so would not be reflected in this table anyway), the Switzerland figures have been deducted from the table.

Year	EU Figures (€)	UK Figures (€)
2017:	1,390,335	-
2018:	7,135,186	-
2019:	8,073,190	-
2020:	2,372,052	-
2021:	-	5,994
2022:	-	14,961
Total:	18,617,004	20,955

### Assessment of the evidence

29. In assessing the evidence before me, I first wish to discuss the argument of the proprietor wherein it claims that when it sells its valves and actuators etc (being the goods that the turnover figures above expressly cover), they are branded as both GEMÜ and CONEXO. As a result, the proprietor's position is that when it sells these goods, the fact that the goods are co-branded with both GEMÜ and CONEXO means that it is acceptable as use of valves under the CONEXO brand. I deal with this point first because the outcome will inform how I treat the evidence of turnover. For example, if I conclude that I am in agreement with the proprietor's argument, then the entirety of the turnover can be said to be applicable to the CONEXO brand. If not, it gives rise to the question as to how much the turnover can actually be said to cover sales associated with the CONEXO brand. In addition, a determination on this point will also assist in framing a fair specification of the goods/services (in the event that there exists genuine use).

30. While there is clearly a corporate relationship between the GEMÜ brand and the CONEXO brand, I am of the view that the evidence is clear in the distinction between the brands on actual products. For example, when both the CONEXO and GEMÜ brandings appear on images of products in situ, it is not as part of the same mark. On the contrary, I am of the view that the evidence clearly shows two different marks. While there are only limited examples where both marks appear on the same goods shown in evidence, I reproduce some for illustrative purposes below:



31.I have given consideration as to whether there would be any scope for an argument that using the two marks on the same product is use of a composite

mark and that use may, therefore, be associated with either brand.<sup>25</sup> Firstly, I do not consider that the examples where both marks are shown will be viewed as a composite mark to the point that it will give rise to a finding that 'CONEXO' could be said to be the source of origin of the valve or actuator goods. Secondly, there is nothing to suggest how the consumers are confronted with the marks when selecting the valves/actuators and RFID chips. The only evidence that could be said to go to this point is the following image taken from a brochure:<sup>26</sup>

## Order examples



32. In my view, this evidence is clear in that the consumer can opt to select the GEMÜ 650 diaphragm valve with or without the CONEXO addition. In such a scenario, the consumer would be well aware that the valve was sold under the brand GEMÜ and that the additional RFID and connectivity benefits were covered by the addition of the CONEXO product. In short, there is nothing in the evidence before me that demonstrates that the consumers are confronted with both marks presented as a composite mark at the point of sale. As such, there is nothing to suggest that the consumer would, when buying a GEMÜ valve with a CONEXO RFID chip within it, consider that the valve is sold under the CONEXO brand as opposed to the GEMÜ brand. Lastly in respect of this point, I will say that the evidence before me is technical in nature and if the proprietor's submitted position

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<sup>25</sup> On this point, I refer to the oft cited case of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 which sets out that use of trade marks as parts of composite marks or use with other marks is capable of being use of those marks as registered so long as the marks remain indicators of origin.

<sup>26</sup> See page 13 of MR8.

was something that was specifically covered in the evidence, then it was for the proprietor to expressly direct me to it.

33. In support of my position in respect of this argument (and to illustrate my point), I wish to briefly discuss the fact that the way in which the proprietor sells its CONEXO products as part of its GEMÜ products is not too dissimilar to the way in which personal computers are often sold. I say this because computers are commonly sold with processors and other components that are expressly confirmed as originating from third-party brands distinct from the computer manufacturers themselves. For example, if a consumer was buying a Dell branded computer, it is likely that the processor within the computer would be under a separate branding such as Intel or AMD. At the point of purchase, the fact that the processor is separately branded to the computer itself is made clear to the consumer. It is also often the case that this fact is confirmed in a sticker placed on the desktop computer itself. In such a scenario, the consumer would be well aware of the separate source of origin of both the computer and the processor. In such a scenario, it cannot be the case that the producer of the processor itself would be able to prove genuine use for computers by relying on the sale of Dell branded computers on the basis that they had that undertaking's processors within them. This is because (1) the producer of the processor is not selling computers and (2) consumers would be well aware that they were buying a Dell computer with an Intel/AMD processor and would, in no way, see the Intel/AMD mark as covering the computer itself. In the present case, I appreciate that CONEXO and GEMÜ may be brands within the same corporate umbrella, however, I see no reason why a similar outcome would not apply here, namely that consumers would be aware of the different brands and what function the separate components offer.

34. As a result of the above, I find that the sale of the valves or actuators or any other products aside from the RFID chip and the electronic pen (more on these below) are not sales of goods under the CONEXO brand. This gives rise to two significant problems for the proprietor. The first is that the proprietor is unable to claim genuine use for goods such as valves and actuators on the basis that they are

clearly goods sold under the GEMÜ branding. The second issue is that there is no breakdown of the turnover figures and, as such, there is no information as to how they can be said to expressly relate to CONEXO branded products.

35. On the point of the turnover figures, I note that the applicant has taken issue with them on the basis that they are confirmed as relating to GEMÜ products with CONEXO chips equipped in them. The applicant argues that there is nothing to suggest how the consumers are confronted with the CONEXO brand at the point of sale. While noted, I am of the view that the evidence is clear in that where the GEMÜ product has a CONEXO chip within it, this is shown on the product itself. On this point, I refer to the images of products I have reproduced at paragraph 21 above. In addition, the brochure and promotional material included in the evidence is all clear in respect of the proprietor's use of the CONEXO branding when sold in conjunction with GEMÜ products. I appreciate the applicant's point that there is no breakdown as to how the turnover relates to CONEXO goods, however, I see no reason why a proportion of the turnover figures (which are in excess of €18 million) cannot be said to be attributable to the CONEXO brand.

36. As above, I am unable to accurately attribute a precise turnover figure to goods sold under the CONEXO brand. However, the fact that the entire turnover sits in excess of €18 million, I consider it reasonable to infer that even if a small proportion of sales were associated with CONEXO, this would still represent a respectable sales figure. I say this whilst bearing in mind that while I have no evidence as to the market at issue, the evidence as to the technical nature of the goods at issue suggests that it is a specialist market which would not attract overly significant volumes of sales and turnover. Further, I remind myself that assessments of genuine use are to be based on the evidence as a whole. As such, the issue of genuine use does not come down to the turnover figures alone. On this point, I refer to the proprietor's advertising expenditure evidence which sets out that in promoting the CONEXO brand, it has incurred a spend of over €500,000 during the relevant periods. I also refer to the evidence which confirms that the proprietor has distributed large volumes of brochures to consumers at a range of events across the EU and the UK. While the advertising figures are not

significant, I am satisfied that this, together with the distribution of the brochures and the turnover, represent a genuine attempt to create or preserve a market share for the proprietor's goods. Lastly, while the use shown by the proprietor may be at a low level, I remind myself that the case law that governs genuine use assessments (which I have reproduced above) sets out that use need not be quantitatively significant in order for it to be deemed genuine.

37. As a result of the above and in taking all of the evidence into account, I am satisfied that the proprietor has demonstrated genuine use of its mark during the relevant periods. While that may be the case, I do not consider that this finding extends to all the goods and services in the proprietor's specification. I will, therefore, proceed to consider an assessment as to a fair specification that accurately reflects the proprietor's use.

#### Fair Specification

38. In respect of the framing of a fair specification, I remind myself of the case of *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, ("*Titanic Spa*") wherein Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, summed up the law as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

39. Further, I note the case of *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been

used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

40. In considering a fair specification, I will deal with the separate classes of goods and services in turn.

#### Class 7

41. In light of what I have said above in respect of the valve and actuator products, I hereby find that the proprietor’s evidence does not demonstrate that its use of such goods (or any of the other class 7 goods, for that matter) was under the CONEXO brand. Instead, any use of those goods would, plainly, be associated with the GEMÜ brand. As a result, I find that there is no genuine use of said goods and, consequently, the proprietor’s mark is to be revoked for all of its class 7 goods.

#### Class 9

42. I consider that the class 9 goods represent the proprietor’s best case. I say this because these are the only goods shown in the evidence that can expressly be said to be CONEXO branded goods. Given the technical nature of the evidence before me, I consider it beneficial to refer to an infographic that is provided several times throughout the evidence. I do so because I consider that this infographic neatly summarises what it is that the CONEXO goods/services cover.

43. This infographic is as follows:



44. In addition, the evidence confirms the existence of a CONEXO Portal which is an offering wherein consumers can track and catalogue their CONEXO products via an online service.

45. The first issue with this evidence is that the proprietor's specification at issue does not cover downloadable software in class 9 and neither does it consist of any good which covers the provision of an online portal for monitoring devices. I note that the applicant has raised specific arguments in respect of the lack of download figures in respect of the CONEXO app but given that these goods are not covered by the contested specification, I see no reason to consider these arguments further.

46. In my view, the only goods that can be said to be covered by the actual CONEXO brand is the RFID chip (be that incorporated in a device or by way of a tag that can be attached to systems after installation) and the electronic pen that will transfer the data, electronically, to an application or a web portal. I appreciate that

the evidence sets out that all of the goods covered in the turnover figures include those that included the RFID chip. While this is not the case for the electronic pen (as the sales figures provided do not make any reference to these), it appears to me that this product is important for the reading of the RFID chip. In my view, it can be inferred that sales of RFID chips would have led to a suitable level of sales of the electronic pen. Therefore, I consider that my finding of genuine use covers both the RFID chips and the electronic pen device. In considering the specification before me, I note that it does not expressly include any term for RFID chips or electronic pens. However, I consider that both goods can be said to be a device or instrument that measures, detects and monitors certain aspects of the product it is installed in/on. Given that the RFID chips can be installed in/on a range of GEMÜ valves and that the pen is used to monitor the same, I consider it reasonable to conclude that they relate to the gases and liquids that pass through said valves and can be said to measure, detect and monitor the pressure of the same. As such, I consider that these goods fall within the following terms:

Class 9:           Measuring, detecting and monitoring instruments [and] indicators [...] for gases and liquids; fittings for measuring technology and control engineering provided with one or more electronic data memories; apparatus for recording, transmission or reproduction of data and measurement, diagnostic and monitoring results for valves; pressure measuring apparatus [...] for hydraulic and pneumatic installations and electromagnetically operated relay valves; none of the aforementioned products being or relating to computer software or hardware in the field of smart metering of energy, smart grids or energy management.

47. Given that the evidence before me demonstrates the use of two specific goods, I do not consider it appropriate to permit the proprietor to retain the above terms as they are registered. In making this finding, I appreciate that the case law (being the *Titanic Spa* case cited) above suggests that I am not to limit the proprietor's terms in the narrowest possible way. However, *Titanic Spa* also suggests that a proprietor should not be allowed to monopolise the use of its mark in relation to a

general category of goods simply because it has used it in relation to a few. On balance, I am of the view that the average consumer would suitably categorise the goods shown in evidence precisely as *RFID chips* and *electronic pens*. As a result, in the context of the terms as they appear in the proprietor's specification, I consider that it is permissible to limit the proprietor's class 9 goods in the following ways:

Class 9: RFID chips and electronic pens for use in measuring, detecting and monitoring instruments and indicators for gases and liquids; RFID chips and electronic pens for measuring technology and control engineering provided with one or more electronic data memories; RFID chips and electronic pens for recording, transmission or reproduction of data and measurement, diagnostic and monitoring results for valves; RFID chips and electronic pens for pressure measuring hydraulic and pneumatic installations and electromagnetically operated relay valves; none of the aforementioned products being or relating to computer software or hardware in the field of smart metering of energy, smart grids or energy management.

48. I turn now to consider the remaining class 9 goods, being flowmeters, flow controllers, electric and electronic control and regulating apparatus and switches (all specifically limited to certain fields or excluding certain areas of trade). While I appreciate that the valves themselves may be able to control or regulate the flow of whatever is passing through the valve, I do not consider that the RFID chip or the electronic pen offer any control functionalities. I say this because the evidence does not demonstrate that the RFID chip or electronic pen have any control functions whatsoever and are, instead, solely used for monitoring and measuring information. As such, I find that the proprietor has failed to demonstrate use for such goods and, therefore, its mark will be revoked in respect of the same.

## Class 42

49. Lastly, I turn to consider the class 42 services for which use is claimed. I remind myself that these are as follows:

“Scientific and technological services and research and design services relating thereto; industrial analysis and research services; design of software; all aforementioned services in the field of measurement technology, drive technology, control and regulation technology for valves, including field bus technology and industrial communications; none of the aforementioned services relating to tracking and monitoring energy usage, and energy management.”

50. Firstly, I wish to briefly discuss the CONEXO portal which is an online platform service that users can access to monitor the information of the RFID chips. In short, none of the above class 42 services can be said to cover the provision of online platforms. Therefore, any use that may be attributable to the CONEXO portal is of no assistance here.

51. Turning to the actual class 42 services covered by the specification, I accept that the proprietor is, clearly, a scientific and technological provider. However, there is nothing to suggest what services it offers under the CONEXO brand. In respect of the software design services, I note that it is not borne out in evidence that the proprietor designed the CONEXO app or online platform. However, even if it were the case that this app/portal was designed by the proprietor, this is not the same as providing design of software to customers. As such, there is nothing before me that to suggest that the proprietor has genuinely used its mark in respect of these services (or any other services, for that matter).

52. Given the lack of any evidence in respect of the above services, I consider that the proprietor has failed to demonstrate genuine use for any of the above services. Its mark will, therefore, be revoked in respect of the same.

## **CONCLUSION**

53. Subject to any successful appeal against my decision, my conclusion is that the proprietor's mark may remain registered only for the following goods, being those for which the proprietor has genuinely proven use:

Class 9: RFID chips and electronic pens for use in measuring, detecting and monitoring instruments and indicators for gases and liquids; RFID chips and electronic pens for measuring technology and control engineering provided with one or more electronic data memories; RFID chips and electronic pens for recording, transmission or reproduction of data and measurement, diagnostic and monitoring results for valves; RFID chips and electronic pens for pressure measuring hydraulic and pneumatic installations and electromagnetically operated relay valves; none of the aforementioned products being or relating to computer software or hardware in the field of smart metering of energy, smart grids or energy management.

54. As for the remaining goods and services (being those for which no genuine use has been found), the proprietor's mark is, subject to any successful appeal against my decision, revoked in respect of the same. Given that I have found no genuine use in respect of these goods and services during any of the relevant periods, it follows that the effective date of revocation for those goods and services is the earliest date claimed, being 17 September 2021.

## **COSTS**

55. The applicant has succeeded in revoking the majority of the targeted goods and services. Therefore, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. While I appreciate that the proprietor's mark may remain registered for some goods, I do not consider the

proprietor's limited success in defending these goods is such that the applicant's costs award should be reduced to any degree.

56. In the circumstances, I hereby award the applicant the sum of £1,200 as a contribution towards its costs. The sum is calculated as follows:

Preparing the revocation application and considering the counterstatement:	£200
Considering the evidence:	£500
Written submissions in lieu:	£300
Official fees:	£200
<b>Total:</b>	<b>£1,200</b>

57. I hereby order GEMÜ Gebr. Müller Apparatebau GmbH & Co. Kommanditgesellschaft to pay Connexion Developments Ltd the sum of £1,200. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 9<sup>th</sup> day of October 2024**

**A COOPER**  
**For the Registrar**