

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

**IN THE MATTER OF APPLICATIONS Nos 1452837,
1452838 AND 1452841 BY CHEMTRONICS INC TO
REGISTER A MARK IN CLASSES 1, 2 AND 6**

AND

**IN THE MATTER OF OPPOSITIONS THERETO UNDER
Nos 39924, 39928 AND 39929 BY
COOKSON GROUP PLC**

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thereto under Nos 39924, 39928 and
39929 by Cookson Group Plc**

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DECISION

On 14 January 1991 Chemtronics Inc of Georgia, United States of America applied under Section 17(1) of the Trade Marks Act 1938 to register the following mark:

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Applications were made in three classes for specifications of goods which read as follows:-

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Chemical products for use in industry; gases for use in industry; tempering and soldering preparations; unprocessed artificial resins; adhesives; all included in Class 1.

Paints, lacquers, varnishes and coatings; all included in Class 2.

Solders, tubes, wires, wicks; all included in Class 6.

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The applications are numbered 1452837, 1452838 and 1452841.

On 21 June 1994 Cookson Group Plc filed notice of opposition to application No 1452837 and on 22 June 1994 they also filed notice of opposition to application Nos 1452838 and 1452841.

5 In their Form TM7 (Notice of opposition) and statement of case as originally filed the
opponents referred to objections under Section 12(3) (on the basis of their own later filed
applications) and under Section 9(1)(e) in that the mark at issue was not distinctive. They also
referred to extensive use of their own mark pre-dating any use made by the applicants.
At the hearing leave was requested to file an amended statement of grounds to (i) recast the
10 Section 12 ground to one based on subsection (1) (the opponents own applications having by
this time achieved registration), (ii) clarify that a Section 11 objection was intended, and (iii)
delete the Section 9(1)(e) ground in the light of the fact that the applications in suit had
proceeded to advertisement with Part B claims only. I allowed submissions in relation to these
various issues and have decided to proceed on the following basis. Firstly the
15 deletion of the Section 9(1)(e) ground is necessary in any case and I need say no more about
it. The introduction of wording to indicate that in the opponents' view the applications are
open to objection under Section 11 is in my view no more than making explicit what was
already implicit. I, therefore, have no difficulty in accepting this amendment. It is, however,
convenient to mention at this point to two authorities relied
20 upon by Mr Hobbs (Re Vandervell's Trusts (No 2) White and others v Vandervell Trustees
Ltd (3 All ER 205) and Drane v Evangelou and others (2 All ER 437)) in support of the
amendment request. In essence the point being made was that it is sufficient for the pleader
(opponent in this case) to state the material facts even if the legal result is not spelt out. The
amendment to allow a Section 12(1) claim raises a point of law which I will deal
25 with later in the decision.

The applicants filed counterstatements denying the grounds of opposition and asking the
Registrar to allow the applications to proceed to registration in the exercise of his
discretion.

30 Both sides seek an award of costs in their favour.

Both sides filed evidence and the proceedings were subsequently consolidated. The matter
came to be heard on 9 February 1998 when the applicants were represented by
35 Mr Roger Wyand of Her Majesty's Counsel, instructed by Wildbore and Gibbons, their trade
mark attorneys and the opponents were represented by Mr Geoffrey Hobbs, of Her Majesty's
Counsel, instructed by Boulton Wade Tennant, their trade mark attorneys.

40 By the time this matter came to be heard, the old Act had been repealed in accordance with
Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having
begun under the provisions of the Trade Marks Act 1938 however, they must continue to be
dealt with under that Act in accordance with the transitional provisions set out at Schedule 3
of the 1994 Act. Accordingly, all references in this decision are references to the provisions
of the old law, unless otherwise indicated.

Opponents' evidence (Rule 49)

The opponents filed three statutory declarations dated 24 May 1995 by Mr Ian Wilkie who until his retirement on 1 September 1992 was Group Executive - Corporate Relations for
5 Cookson Group Plc, a position to which he was appointed in January 1985. Mr Wilkie's declarations were filed prior to the cases being consolidated but are in all material respects identical.

Mr Wilkie firstly describes the background to the adoption of the device which he refers to as
10 the corporate logo. He says that it was agreed that Lead Industries Group plc would change their name on 1 September 1982 to Cookson Group plc. As part of the development of the new corporate image a designer, Mr Wolf Spoerl, was commissioned to produce a corporate logo for use by Cookson Group Plc and its subsidiaries. The Cookson logo was submitted to the board at their meeting on 29 July 1982 and received approval. He exhibits (IW-1) a copy
15 of the Minutes of the Board Meeting held on 29 July 1982 approving the new logo.

The Cookson logo was revealed on 31 August 1982 in a memorandum from Ian McNeil, the Company Secretary at that time, which was distributed to all Managing Directors of subsidiary companies. The stationery bearing the Cookson logo, was to be available for both
20 external and internal use from 1 September 1982. He exhibits (IW-2) a copy of Mr McNeil's memorandum of 31 August 1982 introducing the new logo and (IW-3) a copy of the first brochure launching the new Cookson in Autumn 1982.

The first use of the Cookson logo by Cookson Group plc occurred in 1982 since which time
25 Mr Wilkie says the logo has been used continuously and on a growing scale by Cookson Group plc and its subsidiaries. He goes on to describe the history of the development and use of the logo by reference to supporting material as follows (the references are to the accompanying Exhibits).

30 IW-4 - annual reports for the years 1982 to 1984 showing the mark in use on a corporate level.

IW-5 - a copy of a group brochure launched in 1985 at the time when
35 Mr Wilkie says that he was responsible for the greater implementation of the use of the logo at subsidiary level to cover both publicity and product areas.

IW-6 - a copy of the Cookson Ceramics and Antimony product brochure.

40 IW-7 - a copy of a video featuring the logo. The video appears to have been produced in 1985 to accompany the relaunch of a principal subsidiary, Associated Lead Manufacturers Ltd, as Cookson Industrial Materials (CIM).

45 IW-8 - CIM advertising material from 1985.

- IW-9 - a copy of a 1985 report to employees.
- IW-10 - Cookson Minerals Ltd letterhead from 1986.
- 5 IW-11 - copies of the 1986 and 1987 company directories. These documents are in the nature of guides to Cookson Group companies and products.
- IW-12 - a copy of the 1987 employees' report showing an advertisement that had appeared in the national press.
- 10 IW-13 - a copy of the group brochure for 1987.
- IW-14 - Cookson Materials Division and Cookson Fry brochures which, Mr Wilkie says, demonstrate that use of the logo by subsidiary companies was widespread by 1988.
- 15 IW-15 - a Cookson Metals and Chemicals Division brochure showing use of the logo in relation to a range of products and on the company's lorries.
- 20 IW-16 - an extract from the Wall Street Journal at the time the interim results for the first half of 1988 were published.
- IW-17 - a brochure containing a summary of advertisements from a major advertising campaign in 1988-1989.
- 25 IW-18 - a Cookson Aerospace brochure produced for Farnborough 1988.
- IW-19 - a selection of brochures produced during 1988/89.
- 30 IW-20 - the company directory of March 1989.
- IW-21 - annual reports for 1990 and 1991.
- 35 IW-22 - Vesuvius' brochure for 1991. (The brochure bears the Cookson logo so I take it to be a Cookson Group company.)
- IW-23 - further examples of use of the logo by various subsidiaries. Mr Wilkie says that the majority of Cookson Group plc's subsidiary companies now use the logo.
- 40 IW-24 - the logo in use on company post.

Applicants' evidence (Rule 50)

The applicants filed a statutory dated 4 April 1996 by David John Coker who is the Company Secretary of The Morgan Crucible Company plc, a position he has held since 1989. His
5 company wholly owns Chemtronics, the applicant company (for ease of reference I will refer to it as his company).

Mr Coker firstly describes the circumstances leading up to the advertisements of his company's marks in the Trade Marks Journal. He says it appears that Cookson were unaware
10 of the Chemtronics C device until the applications were published but filed their own applications shortly afterwards (copies are exhibited at DJC1). Thereafter the parties considered their positions in relation to possible opposition but Chemtronics decided in the event not to oppose Cookson's applications. Mr Coker says that what he calls the Chemtronics C device and the Cookson C device are distinguishable and neither Chemtronics
15 or its parent company sees any conflict between them.

Mr Coker goes on to say that his company is in competition with Cookson in the field of technical ceramics. He believes that the oppositions may have been filed because they
20 (Cookson) feared that the applicants or their parent company intended to extend use and registration of their device to those products. He adds that Cookson took no action against Chemtronics use of the C device until the latter's applications were advertised for opposition purposes.

Turning to the opponents' C device trade mark he poses the question as to why Cookson did
25 not apply to register it much earlier. He suggests that this may have been either because they did not look upon it as a trade mark but only as a trade name/company name or that they did not believe it to be sufficiently distinctive for registration. He also points out that the opponents in their evidence refer to "the Cookson logo" and make no mention of the letter C despite disclaimer text in the Trade Marks Journal advertisement that "registration of this
30 mark shall give no right to the exclusive use of a letter "C". A similar disclaimer was imposed on the Chemtronics device applications. Mr Coker draws the conclusion that each company has rights in their specific stylised versions of the letter C rather than any letter C. He makes further observations on the comparison of marks issue and says he understands that when the (later filed) Cookson applications were examined the Registry did not consider the
35 marks to be confusable.

Mr Coker says that Chemtronics have their C device registered in the United States of America under No 1706085 claiming first use since 31 December 1986. He exhibits (DJC2) a
40 print out of the registration. His company commenced using the C device in the United Kingdom in early 1987. It appears, he says, on practically every product, literature, invoice, cheque and correspondence generated by the company and is on all can labels, braid bobbins and accessories sold. The principal market in which Chemtronics is involved is service and repair in the electronics field. This is generally small repair shops, third party repair companies and large original equipment manufacturers. Sales of the goods under the
45 Chemtronics C device have also been made in electrical and telecommunications fields and it is said that the Chemtronics C device goods are applicable to any industry that utilises printed

circuit boards. Goods under the Chemtronics C device are sold in the United Kingdom via catalogues circulated to the trade and updated at regular intervals. Mr Coker says that a conservative estimate of the number of catalogues circulated in the United Kingdom per month is 5,000. In view of the nature of the goods sold under the Chemtronics C device, 5 Chemtronics do not advertise in the United Kingdom. It is the circulation of catalogues by Chemtronics' distributors which makes the trade mark known in the United Kingdom. In support of this he exhibits (DJC3) a sample of the Chem-Wik product showing the C device and a brochure originating in the United States of America dated 1989 (DJC4). The brochure would, he says, have been circulated, inter alia, to Chemtronics' distributors in the United 10 Kingdom. He says that it is difficult to isolate from Chemtronics' European sales the exact sales figures for the United Kingdom but he estimates that these average £86,000 per year.

In conclusion he says that the marks are different. Both marks are in use in this country and there has been no confusion between them.

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Opponents' evidence in reply (Rule 51)

The opponents filed evidence in reply in the form of a statutory declaration dated 3 April 1997 by Glen Michael McDonnell who is the Legal Adviser and Deputy Company Secretary 20 of Cookson Group, a position he has occupied since 1994. He is responsible for Intellectual Property matters of his company. He makes a number of points which I summarise as follows:-

- 25 - he says that the Cookson C device was initially introduced as a corporate mark but within a few years had become a trade mark and was being used in connection with a wide range of goods. The company has considered registering its C device trade mark prior to the filings referred to by the applicants but had relied on common law rights up to that point.
- 30 - Cookson had been unaware of Chemtronics' mark prior to the publication of the applications at issue here.
- he comments on the respective devices. (I take these comments into account in my decision.)
- 35 - he says that the corporate colours of his company are blue and white and the Cookson C device is almost without exception used in these colours. He exhibits a copy of the Cookson mark and a United States Chemtronics' brochure showing use of their C device in very similar colours (GMM1 and 2). 40 He says that use of similar colours greatly increases the risk of confusion.
- he refers to his company's application for the C device in Class 17 which has had two of the applications at issue here (Nos 1452837 and 1452841) raised as citations against it. He suggests that this shows that the Registry does consider 45 the marks to be confusingly similar despite Mr Coker's claims to the contrary.
- he refers to the Registry's classification practice in respect of devices (it seems the parties respective marks have not been placed in the same category) but

notes that the disclaimers recognise that the marks are derived from a letter “C”.

5 - finally he says that the applicants’ mark has been used on a very small scale for a limited range of goods and in practice normally appears in close proximity to the word Chemtronics. He believes that if Chemtronics were to extend and expand their sphere of activities, particularly if they used their mark in the colour blue, there would certainly be confusion and deception.

10 That concludes my review of the evidence.

I will deal firstly with the ground based on Section 11. This Section of the Act reads as follows:-

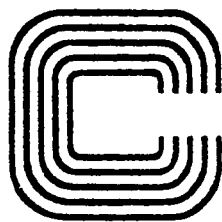
15 “11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous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

20 The established test is that set down in Smith Hayden & Co Ltd’s application as adapted by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand the test may be expressed as:

25 “Having regard to the user of the opponents’ mark ((a) below), is the tribunal satisfied that the mark applied for, ((b) below) 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?”

30 The marks at issue are:-

Opponents’ mark
(a)



Applicants’ mark

(b)



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Note: I have for convenience used the opponents' mark in the form registered. The evidence shows that it is used in the above form, in blue and white, and in a variant form of presentation. I will comment on these points later in the decision.

5 It will be useful to set out firstly what I consider to be the main points established by the evidence. The opponents claim use of their mark from 1982. Mr Wilkie's evidence makes it clear that the Cookson Group has very wide ranging interests in both raw materials and finished products. Mr Hobbs used Exhibit IW-13 to illustrate the range of goods offered. An extract from the Exhibit is at Annex A for ease of reference. The Annual Report and
10 Accounts for 1990 show a turnover of £1,955 million. The applicants quite properly say in their evidence that they do not dispute Cookson's evidence. It can safely be said, therefore, that the opponents are a company of considerable substance and widely diversified interests within their chosen area of activity.

15 The applicants are a subsidiary of another British company, The Morgan Crucible Company plc. Chemtronics are said to have commenced using their mark in early 1987 and sell to companies in the electronics field. An indication of the range of products offered by the applicants can be gauged from the contents page of Exhibit DJC4 (the list includes precision cleaning agents, flux removers, bulk solvents, circuit refrigerants, contact cleaners, gas
20 dusters, precision wipers, pads and swabs, antistatic compounds, magnetic head cleaners, conformal coatings, lubricants, braids and soldering products). Sales are said to average £86,000 per year. There was some discussion before me about the seemingly high number of brochures said to be circulated each month (5000) but I do not think this is a point on which the case is likely to turn.

25 It is not, I think, disputed that there is overlap between the parties' goods on the basis of the applicants' proposed specifications and the use shown by the opponents. No proposals have been put forward for limiting the applicants' specifications to avoid conflict. The main issue before me, therefore, is that of comparison of marks.

30 Mr Wyand, for the applicants, suggested that the marks were easily distinguishable. The opponents' mark, in his view, would be seen as a closed letter C with the whole having the appearance of a maze. The applicants' mark, on the other hand, would not necessarily be seen as a C at all if not seen in association with the company name Chemtronics. He also
35 pointed to the irregular width and spacing in his clients' mark which further served to differentiate.

Mr Hobbs, for the opponents, said that I should approach the matter on the basis of the principles set down in *De Cordova v Vick* 1951 RPC 103. The passage he had in mind is, I
40 think, the following at page 106 lines 17-23:-

45 "The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail and

that marks are remembered by general impressions or by some significant detail than by any photographic recollection of the whole.”

5 In his view the respective marks shared common characteristics in terms of their concentricity and not too much should be read into the points of difference identified by Mr Wyand.

10 In my view the De Cordova v Vick test above is a useful starting point. Whilst the marks can be distinguished when placed side by side as I have done for ease of reference this is of course in practice an artificial approach to the matter. The comparison must take account of the normal circumstances of trade including first impressions and imperfect recollection of actual or potential customers. In this respect it seems to me that the marks have much in common in terms of the idea behind them (stylised representations of a letter C) and the structural content of the marks. The fact that both marks have a common derivation is not in itself fatal to the applicants’ cause; nor is it a defence that their mark represents the first letter of their company name. Conceptually the marks have much in common and I do not think the stylistic differences are sufficient to save the applicants’ mark. It may of course assist purchasers to differentiate the marks if the applicants were to use their mark in close association with their company name but for Section 11 purposes I must of course consider the mark as applied for. Given the directly conflicting nature of the respective goods I have come to the view that there is a likelihood of confusion in the terms of the test set out above.

25 I should add at this point that it was put to me by Mr Wyand that no actual instances of confusion had been identified despite the fact that the applicants had been using their mark for over ten years. Mr Hobbs’ response was that there was no evidence of enquiry into the question of confusion and, therefore, no reliable evidence as to the reason for its absence. I do not think the absence of actual instances of confusion can be conclusive. It may simply reflect use by the applicants in a narrow product area. For Section 11 purposes I must consider the position across the full range of goods covered by the applicants’ specifications. In short I consider that there is a real risk of confusion if the applicants use their mark on the goods applied for.

35 There is, however, the question as to whether the opponents’ use is as a trade mark or simply as a corporate logo. Mr Hobbs contended that such distinctions are academic and that in practice logos can function at a number of levels simultaneously. I do not think the point can be dismissed without a proper consideration of the opponents’ evidence not least because I acknowledge Mr Wyand’s criticism that the opponents have filed little in the way of detailed supporting material (labels, invoices and the like). As a general proposition I think Mr Hobbs must be right in saying that a logo can serve both as a corporate identifier and a trade mark. Whether a particular logo serves both (or other) functions is, it seems to me, a matter to be decided on the facts and circumstances of the case.

45 The early examples of use of the logo exhibited by Mr Wilkie are largely in relation to Group Reports and Accounts. In the absence of other material I am not convinced that such use is in relation to the goods in which the company or its subsidiaries trade. Similar doubts must exist in respect of items such as Reports to Employees. Such use probably reflects the fact that, in its conception, the purpose of the logo was to give a common corporate identity to the

activities of a large group whose business operations are conducted through a large number of subsidiaries (not all of whom carry the Cookson name). Exhibit IW-3, on the other hand, is an early brochure intended, I think, as an introduction to the group and its products and is arguably early evidence that the logo served a wider purpose. However the process of what Mr Wilkie describes as “greater use of the logo at subsidiary level to cover both publicity and product areas” appears to date from about 1985. Certainly Exhibit IW-5 shows the logo in use not just on the cover of a Group brochure (launched in 1985) but also in relation to the principal product and activity areas. Such use is in the nature of a house-mark and in all probability other ‘second tier’ marks are also being used. But that is no more than a reflection of common commercial practice and does not disqualify the logo from acting as a trade mark. The material after this date provides further support for the view that the logo was in use in relation to the goods. It is true that the evidence is very limited in terms of detailed supporting material as distinct from brochures but I think this is largely attributable to the nature of the goods and the corporate structure of the Group and does not in itself undermine the opponents’ case.

There is a further issue in relation to the respective logos arising from what the evidence shows about the form in which the parties actually use their marks. There are a number of examples in the opponents’ evidence of use of what is in effect a two dimensional image of the mark in three dimensional form. It appears both in the brochures and the promotional video (IW-7). It seems from the applicants evidence that they use a similar method of presenting their mark. The examples in Annex B drawn from the Exhibits serve to illustrate the point. It seems to me that such usage by the applicants must serve to compound the underlying problem. It is accordingly a factor to which I have regard.

In the event, therefore and taking all the above factors into account, I have concluded that the opponents’ have established their position and are successful under Section 11.

Before leaving the Section 11 issue there is a further point arising out of the evidence which I have not relied on in coming to the above view but which serves to point up the opponents’ concerns. This relates to Mr McDonnell’s claim that blue and white are Cookson’s corporate colours - (a point supported in my view by the evidence where the logo is usually in blue). He has also produced evidence (GMM1) to suggest that the applicants too use a very similar blue for their mark. The Chemtronics brochure referred to is said to have been circulated in the United States and there is no clear evidence that the mark would be used in the same colour in this country. For this reason it would be wrong to place any great store by it. Certainly, however, if the opponents’ fears were realised it could only add to the likelihood of confusion.

I now turn to the Section 12 issue raised at the hearing. The opponents, on their Form TM7, indicated a ground of opposition under Section 12(3) based on their own pending (but later filed) applications. At the hearing Mr Hobbs sought to introduce an amendment to item 4 of the statement of case to the effect that “... it would be contrary to Section 12(1) of the Trade Marks Act 1938 to allow registration of the former (the Chemtronics application) after registration of the latter (the later filed Cookson applications)” (my parentheses). The Cookson applications had, by the time of the hearing, been registered (details of the

registrations are at Annex C). It is not unusual for earlier filed pending applications owned by opponents to have matured to registration during the course of proceedings and Hearing Officers will normally take account of such changes in their decisions. What is unusual about this case is that the pending applications (now registered) were filed after the Chemtronics applications.

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The first matter I have to consider is whether to allow the amendment to the statement of grounds. Mr Wyand objected to the amendment and said that it would prejudice his clients. His view was that if they had known they faced a claim based on Section 12(1) they would have sought to mount an honest concurrent use claim under Section 12(2). Having given careful consideration to the points put to me at the hearing I have decided to allow the amendment requested by Mr Hobbs and will accordingly deal with the submissions on the substance of the matter. I do so because it seems to me that what is being requested is not so much a new ground of objection but a decision on a point of law which arises from the facts and circumstances of the case before me. It has not involved further evidence from the opponents. It would, nevertheless, have been desirable for the opponents to put the applicants on warning about the issue at an earlier stage but I do not think failure to do so should necessarily disentitle them from having the matter considered on the basis of submissions at the hearing. Even so there is the question of possible prejudice to the applicants to consider. It seems to me, however, that they must have been aware from the grounds of opposition and the evidence subsequently filed that they were at least facing a Section 11 case. It would, therefore, have been open to them to signal that they wished to bring forward a claim to honest concurrent use under Section 12(2). It is, I think, well established that such a claim can be made in the face of a Section 11 objection as well as one based on Section 12(1) - see, for instance CHELSEA MAN Trade Mark 1989 RPC 111. I, therefore, go on to consider the point of law raised in relation to Section 12(1).

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The nub of the issue under Section 12 is the date at which I have to determine the applications in suit. Mr Hobbs sought to persuade me that the law and a line of authorities led to the conclusion that the position should be considered at the date the applications would actually fall to be registered rather than the date of the applications themselves (that is to say the filing dates). The difficulty arises because the term "registered" has to be construed in the context in which it occurs in the Act. Thus for example for the purposes of Section 19 (registration) a trade mark, when registered, is registered "as of the date of the application for registration" whereas by contrast for the purposes of the five year non-use period in Section 26 it is the date of actually placing the mark on the register that constitutes the trigger point - see BON MATIN 1988 RPC 553. Mr Hobbs took me to a number of passages in the GE Trade Mark case 1973 RPC 297 in dealing with the legislative background and the construction to be placed on the words of the Act. He also referred me to a number of other reported cases. I will deal with these in due course.

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I should say by way of background that, for the purposes of applications for registration it has been the long established practice of the Registry to regard the date of filing of an application as being the material date. Thus, at the examination stage the Registry conducts a search for conflicting marks but only insofar as they have an earlier filing date than the application in suit. By the same token if an applicant wishes, or needs, to bring forward evidence of use of

his mark for any reason the critical date is regarded as being the application filing date and any use after that date will not assist the applicant. In opposition proceedings too the position is normally determined by reference to the position of the parties at that material date. I am not aware that the Registry's general approach to this issue has been criticised or found to be

5 wrong in law on appeal to the Courts. Indeed the Registry has been guided by the view taken by the Courts in a number of reported cases - see ROTOLOK 1968 RPC 227 at page 230 lines 4 to 22; BLUE PARAFFIN 1977 RPC 473 at page 487 lines 19 to 25; and the reference to "past" user in the YORK TRAILERS case 1984 RPC 231 at page 244 lines 12 to 20.

10 However, at the hearing Mr Hobbs referred me to a number of reported cases which, he submitted, provided a clearly established line of authority for his view. I will comment firstly on the GE Trade Mark case 1973 RPC 297 as Mr Hobbs argued that this case provided House of Lords support for the position adopted by the Registry and the Board of Trade on appeal in the cases referred to later in this decision. Particular attention was drawn to the construction

15 placed by Lord Diplock on the words "it shall not be lawful to register" appearing in Section 11 of the 1938 Act and comparable provisions of earlier statutes. In particular Lord Diplock said that "...to register" must, in my view, refer not only to the act of making an entry on the register but also to permitting the continuance of the entry of a trade mark on the register". These comments were in relation to Section 6 of the 1875 Act which combines what is now

20 found in Sections 11 and 12 of the 1938 Act (it is said the point of construction reads across also to Section 12). Persuasively though Mr Hobbs put his case, one must not, I think, lose sight of the context in which the remarks were made, namely a rectification action. The main point before the House of Lords was whether, as a result of events since registration of the mark at issue, it was an entry wrongly remaining on the register within the meaning of

25 Section 32(1). I agree with Mr Wyand that it is not clear from the GE case that the Court was seeking to distinguish between the date when the mark was actually put on the register and the date when the mark was applied for. Rather it was the circumstances in which the continuance of the registration might be open to challenge that was the point at issue.

30 I will now briefly outline the circumstances of the other cases before considering their relevance to the current proceedings.

PALMOLIVE Trade Mark 1932 RPC 269 - this was a Registry decision under the 1905 Act. The applicants faced opposition from the trade and also objections arising from the presence

35 on the register of conflicting marks. The applicants were able to file cancellation requests in respect of the cited marks to be activated only in the event that the other objections were overcome. The following passage, which was relied on in the context of the case before me, deals with Mr Hobbs' point. For ease of understanding in what follows, Section 19 is equivalent to Section 12 of the 1938 Act and Section 16 equivalent to Section 19 of the 1938

40 Act:-

"Mr Whitehead [for the opponents in the action] argued that, even supposing the Applications made for the cancellation of the three prior Marks were now acted upon, registration of the Marks propounded would still be prohibited by Section 19 of the

45 Acts. That Section states that, with exceptions not here material, "no trade mark shall be registered in respect of any goods or description of goods which is identical with

one belonging to a different proprietor which is already on the Register with respect to such goods or description of goods, or so nearly resembling such a trade mark as to be calculated to deceive”. Mr Whitehead’s argument was that, if such a conflicting Mark was upon the Register at the date of an Application for registration, that Application ought to be refused notwithstanding that the obstructing Mark might have been removed from the Register between the date of the Application for registration and the date when that Application was otherwise in order for entry upon the Register. Now it is true that, under Section 16 of the Acts a Trade Mark when registered must be registered as of the date of the Application for registration, and that such date is to be deemed for the purposes of the Acts to be the date of registration. It seems to me, however, that Section 16 deals only with the position after registration, while Section 19 envisages the position before registration; that when Section 19 says that “no trade mark shall be registered” it is referring to the actual making of the entry of the Mark upon the Register; and that, in considering the operation of that Section, regard must be had to the state of the Register at the date upon which the new entry therein is proposed to be made.”

POLYMAT Trade Mark 1968 RPC 124 - in this case the Registry refused an application under the provisions of Section 12(1). On appeal to the Board of Trade attention was drawn to the fact that the cited earlier mark had lapsed owing to non-renewal. (It had in fact lapsed the day before the subject application was filed but was still being taken into account under Section 20(4) at the time of the oral hearing before the Registrar). It was held that:-

“although by section 19(1) of the Act a mark was deemed registered as of the date of application for registration, nevertheless both the practice of the Registry and authority condoned the acceptance of marks for registration where an objection to registration under section 12 was removed between the date of application and the date of actually entering the mark on the register.”

In particular Mr Tookey said

“My attention was drawn to the provisions of section 19 of the 1938 Act, which provide that a mark, when registered, shall be registered as of the date of application for registration, and that date shall be deemed for the purposes of the Act to be the date of registration. The point was raised whether, having regard to that provision, a section 12(1) objection had to be determined as of the date of application. I do not consider that to be so. Firstly, section 16 of the 1905 Act, which was in operation at the time of the Texas Company’s case, contains a provision similar to that which I have quoted from the 1938 Act, and yet that case took the course which I have described. Secondly, I consider that section 12(1) is dealing with actual circumstances, that is to say the words “no trade mark shall be registered” relate to the act of putting on the register, whatever the date of registration may be deemed to be for the purposes of the Act.”

(The underlined words were published by means of an errata and replace the previous text.)

KERAION Trade Mark 1977 RPC 588 - this was an opposition case in the Registry where the opponents' prior mark was removed from the Register during the pendency of the opposition. The opponents contended that their mark, being on the Register at the date of application, was a citable mark under Section 12(1) even though it had now ceased to be on the Register. The applicants contended that the relevant date for Section 12(1) was the date of registration of their mark and that accordingly the opponents' mark should be disregarded as a citation. The Registry's Hearing Officer followed POLYMAT and held that the relevant date for assessing the Section 12(1) objection was the date of registration of the mark being applied for and that the opponents' mark, being no longer on the Register at this date, was not a citable mark.

RUNNER Trade Mark 1978 RPC 402 - another Registry decision where renewal fees had not been paid on a cited mark. The case is principally of interest in relation to the decision not to suspend the application to await the expiry of the one year period specified in Section 20(4) and was distinguished from POLYMAT in this respect.

In addition to the reported cases referred to above Mr Hobbs drew my attention to Kerly's Law of Trade Marks and Trade Names (Twelfth Edition) at chapter 10-27 regarding the date at which Section 11 applies. I should also add that several of the above cases draw on a much earlier case Texas Company's Application (1915 RPC 442) where, before an appeal by the Registry came to be heard by the Court of Appeal, the cited mark had been removed from the Register. Counsel for the Registrar expressed the view that "the whole substance of the appeal has gone". When, therefore, Mr Tookey decided POLYMAT by following the Texas case he was not, I think, deciding a general point of law in the all embracing way Mr Hobbs is suggesting but coming to a view on the narrow facts of the case before him ie that the substance of the objection had disappeared by virtue of the cited mark lapsing through non-renewal. In fact it is a point common to all the cases referred to that by the time the applications in suit came to be decided the causes of action, if I may put it that way, whilst valid at the material date had fallen away or could have been treated as such. (The precise circumstances in PALMOLIVE and RUNNER were different but do not detract from the general proposition in my view). I have said that the ground of objection in each case was valid at the material date for the good reason that it is a feature of all these cases that they involved citations which pre-dated the applications in suit and were, therefore, consistent with the Registry's general view on what constitutes the material date. That is a very different matter from Cookson's position in the proceedings before me where, undeniably, their applications bear later application filing dates than the Chemtronics' applications they are opposing. I would have great difficulty in accepting that the later filed Cookson applications, having achieved registration, now have a retrospective status as Section 12(1) objections at the material date in these proceedings (14 January 1991).

For these reasons I do not think the cases to which I was referred support the opponents' claim to have the Section 12 position determined at the date the applications in suit would otherwise fall to be placed on the register. However that is not quite the end of the matter as Mr Hobbs also referred me to a decision in the Bombay Court of Appeal, Ciba Ltd v M Ramalingam AIR 1958 Bombay 56 relating to the inter-action of the Indian equivalents (Sections 10(1) and 16(1) of the Trade Marks Act 1940) of Sections 12(1) and 19(1) of the

Trade Marks Act 1938. A copy of that decision was supplied after the hearing. In outline the facts of the case were that Ciba Ltd (C) applied for registration of a number of marks. About 18 months later and before C's marks had progressed to registration M Ramalingam and another (R) applied to register a similar mark. Both parties' marks were eventually registered, C having missed an opportunity to oppose R's mark. C then launched a rectification action against R's registration. It was argued on behalf of R that when considering for the purposes of Section 10(1) whether there is a trade mark already on the register the point of time is not the date of registration of the respondents' (R) trade mark but the date when the application was made (at which time C's marks were not registered). In finding for the appellants (C) the Bombay Court of Appeal held that, as the appellants' trade mark was on the register at the time the respondents's mark was itself registered there was a prohibition against the registration of the latter. Prima facie this case appears to lend support to the opponents' position but in practice the nature of the case and the underlying facts are in my view quite different. Firstly the facts of the case were being considered from the perspective of a rectification action and not opposition proceedings. In deciding the matter the way it did the Court of Appeal was responding to the specific argument advanced on R's behalf at the hearing. It was not disputed that C had applications with earlier filing dates. That might suggest that the Court could have decided the matter in favour of C on a rather different basis by considering the position of the parties at the filing date of R's application. In effect the registration of C's marks and the rectification of the register in respect of R's mark confirmed a priority position that already existed in terms of filing dates.

In choosing to decide the matter on the basis of the position at the date R's mark was put on the register the Court may have had regard to another factor which is referred to in the report of the case. R's mark was in fact amended from a label form (containing it would seem Tamil characters and Devnagiri script) to a transliterated word that brought it into conflict with C's marks. C objected to the form of the mark as readvertised and registered but not the mark as filed. I do not say that this wholly explains or serves to distinguish this Indian decision but the circumstances were such that it would seem unsafe for me to rely on it to support the proposition the opponents would have me accept. I note also that the Bombay Court of Appeal did not suggest they were following any established authorities in deciding the particular case in the way they did. Nor is it suggested that the finding has been adopted and followed in other contexts in the Indian Courts let alone other jurisdictions. In short this case does not displace the view that I have reached on the question of the date at which I have to determine the applications in suit and I therefore remain of the view that it is the position at the filing date of the applications in suit that must be considered for the purpose of these proceedings. In short I decline to deal with the opposition on the basis of a claim based on Section 12(1) of the Act.

As the opponents have been successful under Section 11 they are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of **£800** in respect of the consolidated proceedings.

Dated this 11 day of March 1998

M REYNOLDS
For the Registrar
the Comptroller-General

Cookson Group

ADDING VALUE TO THE MATERIAL WORLD

Cookson is an industrial group with a track record of expansion and growth that belies all talk of Britain's decline in manufacturing output and expertise.

Cookson Group manufactures industrial materials which are in constant use everywhere in daily life - at home, at work, in transport and the printed news media, as well as in textiles, furnishing, paints and ceramics, and many other domestic items used around the home.

Cookson Group flourishes world-wide, through a network of subsidiaries throughout the USA, Canada, Europe, India and the South East Asia/Pacific basin.

Cookson specialist industrial materials are to be found everywhere within manufacturing industries - chemicals, engineering, aerospace, automotive, glass, batteries, jewellery, ceramics, building, electronics, computer hardware and software.

Cookson Group researches, experiments, investigates, employs and exists to serve the needs of the consumer.

Cookson Group adds value to the material world.

① Ceramic Pot

Cookson supplies virtually every aspect of the ceramics and glass industries from prepared raw materials to glazes and colours.

② Books & Magazines

The Group includes one of the world's leading manufacturers of offset printing plates, printing chemicals, processing equipment and sundries, and also makes constituents for paper coatings and pigments.

③ Television

Special compounds are produced for the manufacture of TV tubes, as well as a number of components.

④ Video

Cookson is the world's largest manufacturer of solder, used in every conceivable type of electrical and electronic equipment. Specially coated copper foil is also manufactured for printed circuit boards.

⑤ Video Cassette

Recycled polypropylene is used for many plastic mouldings such as video cassette cases, plant pots and garden tools.

⑥ Cable Sheathing

The Group is the world's largest producer of PVC stabilisers for use in PVC compounds of all descriptions.

⑦ Safety Matches

Sulphides of antimony are used in safety matches, pyrotechnics and explosives.

⑧ Lead Crystal Vases

Red lead is used to produce the finest lead crystal.

⑨ Light Bulb

Raw materials and additives for a wide variety of domestic and industrial glass.

⑩ Pewter Tankard

The tankard is manufactured by Cookson subsidiary, Englefields, the world's oldest pewterer using both tin and antimony produced by other Cookson subsidiaries.

⑪ Telephones

Lead weights for telephones, sash windows and curtains.

⑫ Flame Retardant Fabrics

Cookson flame retardants and smoke suppressants are used in textiles, polymers, paint and rubber articles of all descriptions.

⑬ Paint

Pigments are supplied for a wide product range including cosmetics.

⑭ Heating

A wide range of solders is supplied for all types of plumbing applications.

⑮ Jewellery

Cookson companies supply silver ingots, fine castings and precious metals for many jewellery applications.

Through the Window

⑯ Transport

The Group's contribution to the world's various forms of transport is enormous. From the specially moulded tiny lead weights which operate inertia reel seat-belt systems, to reprocessed plastics and plastic compounds and colours, and the lead and lead compounds for batteries and constituents in brake and clutch linings, rubber tyres, glass, and pigments and additives for paint.

Advanced technical ceramics are supplied for use in aircraft engines - for their lightness and resistance to high temperatures. Newly developed special casting techniques are used to manufacture turbine blades to the incredibly fine tolerances necessary.

⑰ Road Surfaces

Enormous quantities of bauxite are supplied for use in anti-skid road surfaces, as well as new additives for greatly prolonging road life.

⑱ Bricks

An enormous range of brick colourants is putting a fresh face on buildings around the world.

⑲ Roofs

Cookson are leaders in the UK lead sheet and flashing market and also supply strip for leaded lights. Lead clad steel - a unique Cookson development - combines the beauty of lead with the strength of steel.

ANNEX B

Cookson Metals & Chemicals Division

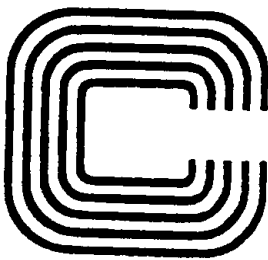
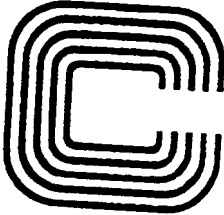
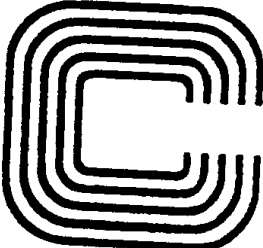


Cookson 

ADDING VALUE TO SPECIALIST INDUSTRIAL MATERIALS



COOKSON'S REGISTRATIONS

5	No	Mark	Class	Journal	Specification
10	1518395		1	6034/4341	Chemicals for use in industry; solder creams, solder pastes, solder flux; all included in Class 1
25	1518396		2	6034/4344	Organic and inorganic pigments for use in the printing ink, paint, nylon and plastics industries; all included in Class 2
35	1518398		6	6034/4360	Metals and metal alloys; soldering materials, solders, soldering preparations; all included in Class 6
40					
45					