

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 8830
by Oro-Produkte -Marketing GmbH
for the revocation of trade mark registration No 1223766
in the name of Brunner Mond & Company limited**

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15 **DECISION**

On 27 December 1995, Oro-Produkte-Marketing GmbH applied under Section 46 of the Trade Mark Act 1994 for the revocation of trade mark registration number 1223766. The trade mark consists of the word GRANSIL and it is registered in Class 1 for:-

20 ‘Chemical products for use in industry’.

The mark was placed upon the register on 30 October 1985. The registration currently stands in the name of Brunner Mond & Company Limited.

25 The grounds for revocation are that:

30 1. The applicants for revocation are also the applicants for the registration of the trade mark GLANCIL in Classes 1 and 3. Registration number 1223766 stands in the way of the registration of this mark.

35 2. The trade mark registered under No. 1223766 has not been used during the five years preceding the date of the application for revocation ‘in the course of putting on sale in the UK the goods for which the mark is registered’;

40 3. As a consequence of ‘2’, the applicants seek the revocation of registration number 1223766 in its entirety;

45 4. Or in the alternative the revocation of the registration in respect of:

“Detergents and solvents; bleaching chemicals, bleaching preparations; water purification and water treatment chemicals; water purification and water treatment preparations; dressing and finishing preparations for textiles; preparations for treating metals; chemicals for treating glass; anti-tarnishing chemicals for treating windows, and goods of the same description”;

50 5. Or in the further alternative, the limitation of registration number 1223766 to goods intended for export from the UK;

6. Or in the further alternative, the limitation of registration number 1223766 to ‘granulated silicate products, and/or ‘granulated silicate products, all for export’.

5 The registered proprietors deny the grounds of revocation with the proviso that:

10 “Although the Trade Mark registered under number 1223766 has been applied to products sold in the United Kingdom, such products have not been sold to customers who are incorporated in the United Kingdom. Products have been sold to customers under contractual terms whereby title to those goods has passed in the United Kingdom”.

The registered proprietors ask that the registration be sustained in its entirety. Both sides ask for an award of costs.

15 Both sides subsequently filed evidence and the matter came to be heard on 10 February 1998 when the applicants were represented by Mr M Hutchins of Fry, Heath and Spence, Trade Mark Agents, and the registered proprietors by Mr K Hodgkinson of Marks and Clerk, Trade Mark Agents.

20 **REGISTERED PROPRIETORS EVIDENCE**

The registered proprietors’ evidence takes the form of a Statutory Declaration dated 19 April 1996 by John Szostek, who is their Sodium Silicate Marketing & Sales Manager.

25 Paragraphs 3 to 5 of his Statutory Declaration and exhibits JS1 and JS2 thereto is the subject of a Confidentiality Order dated 31 May 1996 and made under Rule 45 of the Trade Mark Rules 1994.

30 Accordingly, these parts of Mr Szostek’s evidence and detailed descriptions of them will be masked from the copies of this decision that are to be made available to the public.

Mr Szostek declares that:

35 “Originally owned by Imperial Chemical Industries PLC, the trade mark GRANSIL has been used by the current proprietor in the United Kingdom between December 1993 and now in respect of chemical products for use in industry, specifically a combination of sodium silicates, soda ash and sodium bicarbonates, which have many uses in industry, such as in the detergent industry for buttering, emulsification, soil suspension, corrosion inhibition, deflocculation and as a surface active agent.



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Mr Szostek continues:

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APPLICANTS EVIDENCE

35 The applicants' evidence takes the form of a Statutory Declaration dated 3 September 1996 by Michael John Cowland, who is a searcher and general administrator employed by Fry, Heath and Spence, the applicants' Trade Mark Agents.

40 Mr Cowland states that in August 1995 he contacted a total of 16 chemical wholesalers, whose names and telephone numbers he lists. The purpose of his enquiries was to establish whether GRANSIL was known to any of the wholesalers contacted. He states that he contacted a number of the same wholesalers again in October 1995, this time mentioning the registered proprietors' name as a possible source of GRANSIL. Mr Cowland states that no-one he contacted had any knowledge of GRANSIL.

45 **THE LAW**

The relevant Sections of the Act are set out below:

50 Section 46(1) (a) & (b)

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

5 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;

10 (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

Section 46(2)

15 For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and 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.

20 Section 46(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.

25 Section 100

If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

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DECISION

The applicants claim that there has been no genuine use of the trade mark within the 5 year period preceding the filing of their application. Consequently, the relevant period in this case is 35 27 December 1990 - 27 December 1995.

Although Section 100 places the onus of showing use of the mark on the registered proprietors, I find it convenient to consider the applicants' evidence first.

40 Mr Cowland lists 16 companies that he says he spoke to during his enquires, but he does not state who he spoke to in any of these companies. In the absence of this information Mr Cowland's evidence is probably second hand hearsay. Mr Hodgkinson took no point on the admissibility of this evidence. However, I record here that I do not intend to rely upon it in reaching my decision. In the event, nothing appears to turn on this because the registered 45 proprietors have not filed any evidence which could seriously support a claim to have offered goods for general sale under the mark on the UK market.

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Mr Szostek puts it like this in his declaration,

[REDACTED]

5 At the hearing, Mr Hodgkinson contended that [REDACTED]
[REDACTED] amounted to sales under the
mark within the UK and he did not need to rely on the provisions of Section 46(2) relating to
the use of a trade mark on goods solely for export.

10 This could be an important point because there is no evidence that the goods [REDACTED]
[REDACTED] had the mark GRANSIL fixed to them or to the packaging for the
goods so as to bring the user within the provisions of Section 46(2).

15 Mr Hutchins took no point on whether the registered proprietors' description of use, if
accurate, amounted to use within the UK. He did criticise the accuracy of the registered
proprietors' evidence by suggesting that some of the sales claimed in the evidence could have
been conducted entirely between companies based outside the UK. I don't consider that the
registered proprietors' evidence is open to this interpretation. Mr Hutchins directed his main
20 submissions to the scale of the registered proprietors' claimed use and the contrast between the
width of the specification of goods for which the mark is registered and the very specific
goods in relation to which the mark appears to have been used.

I have no evidence before me as to the size of the market for silicate-based products. Taking
25 the best view I can of the matter, I consider that if the registered proprietors' description of
use amounts to use within the UK, it is more than de minimis in scale. There is some doubt in
my mind about whether the registered proprietors' description of use does amount to use
within the UK, but I do not consider it necessary to decide this point in order to give the
applicants the relief they seek.

30 The applicants request for relief takes a number of alternative forms, as described earlier.
The purpose behind all these alternative forms of relief is to clear the way for their own
application to register the trade mark GLANCIL in classes 1 and 3. Their application is
currently blocked by the registration of GRANSIL.

35 Mr Hodgkinson objected to each of the forms of relief sought by the applicants.

He considered that the addition of a long list of excluded goods, together with goods of the
40 same description as these excluded goods (a term that is no longer recognised under the new
law) would not be appropriate because it would leave the scope of his clients' registration too
uncertain. I agree.

Mr Hodgkinson further submitted that it was not open to me to limit the specification so that it
only covered goods for export from the UK. I also accept that submission. Section 13 of the
45 Act makes provision for a registered proprietor to voluntarily record a geographical limitation
of rights. That appears to me to be a separate matter as compared to the scope of the
specification of goods.

Finally, Mr Hodgkinson argued that the restriction to 'granulated silicate products' sought by
50 the applicants was too severe a restriction given the availability of other products which
perform the same function as these goods. It appears to me that that submission overlooks the

5 broader rights provided by Sections 5 and 10 of the Act, which extend to use and registration
of the same or similar mark for similar goods (to the extent that this is likely to result in
confusion of the public). However, I am not convinced that it is necessary to restrict the
specification of goods to reflect the granulated form of the registered proprietors' goods.
Further, it appears from the registered proprietors' evidence that their goods include other
10 chemicals besides silicates.

I consider that the relief that the applicants seek could equally be achieved by revoking the
registration in respect of all goods except:

15 'Sequestration agents for use in the production of detergents'

- which is essentially how the registered proprietors' goods are described in exhibit JS2 to Mr
Szustek's declaration.

20 Mr Hodgkinson drew my attention to the alternative uses for the chemicals that make up his
clients' goods as set out in paragraph 2 of Mr Szustek's evidence. He urged me to exercise
the Registrar's discretion in favour of his clients in framing any more limited specification so
as to cover these alternative uses for the product. It is no doubt true that the same substance
(possibly in different forms) can be used for other purposes, but there is no evidence that the
25 registered proprietors' goods have been offered for sale as being suitable for any other
purpose.

Given the nature and scale of the registered proprietors' use, I do not consider that I would be
justified in exercising any discretionary power I may have in order to leave them with a
30 specification that is any wider than the bare use shown in their evidence. I therefore intend to
use the power provided under Section 46(5) of the Act to revoke the registration to the extent
indicated above.

The applicants for revocation having succeeded in these proceedings are entitled to a
35 contribution towards their costs. I order the registered proprietors to pay them the sum of
£600.

Dated this 2nd Day of March 1998

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ALLAN JAMES
For the Registrar
The Comptroller General

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