

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

**IN THE MATTER OF APPLICATION NO 1316378  
BY UGNSGRUPPEN SCANFURNACE AB  
TO REGISTER A TRADE MARK IN CLASS 11  
AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 32964 BY TABO SA**

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

**IN THE MATTER OF Application No 1316378  
by UGNSGRUPPEN SCANFURNACE AB  
to register a trade mark in Class 11**

**and**

**IN THE MATTER OF Opposition thereto under  
No 32964 by Tabo SA**

**DECISION**

On 21 July 1987, Ugnsgruppen Scanfurnace AB applied under Section 17(1) of the Trade Marks Act 1938 to register the trade mark TABO. The application was made in Class 11 and after examination proceeded to advertisement for the specification of goods comprising:-

Furnaces; all for use in crematoria; parts and fittings for all the aforesaid goods; all included in Class 11.

The application, numbered 1316378 was advertised for opposition purposes on 17 June 1992 and on 16 September 1992, Tabo SA filed notice of opposition to the application.

The grounds of opposition are in summary:-

**1. Under Section 11** By virtue of the use the opponents have made of the trade mark TABO, the use of the trade mark applied for by the applicant in relation to the goods in respect of which the application is made is likely to deceive or cause confusion.

**2. Under Section 17(1)** The applicants cannot make a bona fide claim to be the proprietor of the mark and their application is not valid

The opponents ask the Registrar to exercise his discretion and refuse the application and that costs be awarded against the applicant..

The applicants filed a counterstatement denying the grounds of opposition, saying that there is no reason for the registrar to refuse the application and ask that the Registrar exercise his discretion in favour of the applicants and that they be awarded costs.

Both sides have filed evidence in these proceedings and the matter came to be heard on 12 October 1998, when the opponents were represented by Mr D Campbell of Counsel, instructed by Brookes & Martin, their trade mark attorneys. The applicants were not represented.

By the time this matter came to be determined, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994.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 1938 Trade Marks Act must continue to be dealt with under that Act, in accordance with the transitional provisions set out in Paragraph 17 of Schedule 3 of the 1994 Act. Accordingly, all reference in this decision are references to the 1938 Trade Marks Act.

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

The opponents' evidence consists of three Statutory Declarations. The first, dated 21 January 1994, is made by Pierre Vidallet, President and Chief Executive Officer of Tabo SA, a position he has held since the formation of the company in 1979. Mr Vidallet states that in 1980, Tabo Cremators Limited, (a United Kingdom company) commenced work on the installation and rebuilding of cremation furnaces at the Southend-on-Sea and City of London crematoria. He says that the parts for the cremation furnaces were supplied by Tabo BV (a Dutch company) and that the trade mark TABO was either marked upon the parts or on the packaging. Mr Vidallet also confirms that Tabo BV supplied personnel to supervise the installation of the parts.

He refers to Exhibit PV1 which consists of five copies of invoices relating to the work at Southend-on-Sea crematorium. Two are made out to Southend-on-Sea Borough Council and relate to a range of electrical and electronic components. The first invoice dated 14 September 1981 bears the word TABO in large letters placed above the name and address of the supplier, Tabo BV. The second invoice dated 9 October 1981 bears no reference to Tabo. The remaining three invoices are made out to Tabo Cremators Ltd, and relate to the work undertaken for "Supervision" and "services according to the attached specification", and the supply of various components. These are dated in November and December 1980 and apart from the name of Tabo Cremators Ltd bear no reference to TABO.

Mr Vidallet goes on to refer to exhibit PV2 which consists of invoices for parts and services provided by TABO BV although in all but two cases there is no mention of this company. They relate to work undertaken for Tabo Cremators Ltd, for parts supplied to Tabo UK Ltd, and for work and parts supplied to Crematorium City of London and DM Tabo Ltd. All relate to work carried out at crematoria in Southend-on-Sea and London and date from before the relevant date although in each case the only reference to TABO is in the company names mentioned. He next refers to exhibit PV3 which consists of a specification for a crematorium, supplied by Tabo BV to Dowson and Mason Limited. This bears the heading TABO BV and is dated 3 August 1985. Mr Vidallet says that Dowson & Mason subsequently changed its name to DM-Tabo Limited and refers to exhibit PV4 which consists of a letter dated 10 January 1986 from that company to Tabo Sarl. Mr Vidallet draws the conclusion from the statements contained within the letter that DM-Tabo Limited recognised that it had no rights in the trade mark TABO.

Mr Vidallet next refers the draft declaration of Phillip Marie Guilguet which is set out in detail later in this decision. He confirms the accuracy of the information in paragraph 7 which relates to a claim to the acquisition of the rights in the mark TABO by Nevico BV, and their subsequent change of name to Tabo BV effected on 6 January 1989. Mr Vidallet says that Nevico BV (now Tabo BV) had been set up as, and remained a wholly owned subsidiary of his company and as this company supplied all parts and services in the United Kingdom under the mark TABO, it follows

that his company is entitled to those rights. Mr Vidallet goes on to say that throughout this time he was European Manager for the British, French and Dutch companies referred to in the declaration, as well as President and Chief Executive Officer of Tabo Sarl (now Tabo SA), and that from this he is very familiar with the technology, sales and installations of Tabo furnaces and parts in the United Kingdom. He refers to exhibit PV5 which consists of a copy of a telex dated 14 October 1986, sent to DM-Tabo Limited regarding the new features in the Tabo furnace.

Mr Vidallet goes on to say that his company and the present Tabo BV have continued to use the trade mark TABO from 1986 in advertisements placed in the main United Kingdom trade publications, Pharos International and Resurgam, and refers to exhibit PV6 which consists of a copy of an advertisement endorsed "Pharos International" dated as 1989, and depicting a machine described as a "TABO cremator" and giving a contact address for Tabo Sarl in France, and Tabo BV in Holland. The sheet also bears the word TABO in a stylised form. Mr Vidallet next says that he has attended all Cremation Society conferences in the United Kingdom since 1986 and has attempted to sell his company's products under the TABO trade mark, although had been unsuccessful until 1991 when his company and Adamant Refractory Settings Limited, their UK agents, jointly commenced work on installing cremation furnaces at Perry Barr Crematorium in Birmingham. He refers to exhibit PV7 which consists of invoices dating from 31 March and 31 July 1992, headed TABO and made out to Adamant Refractory Settings Limited for the provision of services and parts.

Mr Vidallet concludes saying that in August 1990, his company set up a new UK subsidiary company known as Tabo UK Limited who are now undertaking all marketing supply and installation of TABO cremation furnaces in the United Kingdom. He says that his company has not used Adamant Refractory Settings Limited since September 1992.

The second Declaration dated 21 January 1994 comes from Phillippe Marie Guilguet, a European Patent Attorney. Mr Guilguet states that he is a consultant to Cabinet Armengaud Aine, a firm of European Patent Attorneys, and was previously manager of the Industrial Property department of Thomson CSF. Mr Guilguet says that in May 1992, his firm was instructed by Tabo SA to act on behalf of the opponents in relation to the applications the subject of these proceedings.

Mr Guilguet begins by outlining the history of the rights to the TABO mark starting with the creation of Tabo Sarl in 1979 as a subsidiary of a Swedish company, Ugnsbolaget Tabo AB. He refers to exhibit PG1 which consists of the Articles of Association of Tabo Sarl. Mr Guilguet says that at the same time, a number of other subsidiaries were created in other countries, including Tabo BV in the Netherlands. He continues saying that Ugnsbolaget Tabo AB went into liquidation in November 1980 and shares of the subsidiaries including Tabo Sarl and Tabo BV were transferred by an agreement dated November 1981 to another Swedish company, Tabo Processteknik KB which was set up for this purpose. Mr Guilguet refers to exhibit PG2 which consists of a certified translation of the agreement into French. No English version has been provided.

He goes on to say that Tabo Processteknik KB were struck off the register in October 1987, but by this date another Swedish company, DM Tabo AB had purchased all shares in the subsidiary companies, although on 3 March 1987, DM Tabo AB itself went into liquidation. At the same time, Tabo Sarl ran into trading difficulties and on 4 July 1987 a receiver appointed by the Court

agreed that C.I.D, a French company, should purchase all shares in Tabo Sarl. Mr Guilguet refers to exhibit PG3 which consists of a copy of the judgement of the Court.

5 Mr Guilguet continues saying that on 9 February 1988, Tabo Sarl was reorganised as a Societé Anonyme and became Tabo SA, and refers to exhibit PG4 which consists of a copy of the French Register of Trade Marks. He next states that on 25 March 1987, Tabo BV went into receivership. He continues saying that around the time that Tabo BV went into receivership, Tabo SA created a Dutch company known as Nevico BV who, by an agreement dated 13 September 1988 between the liquidator of Tabo BV and Nevico BV, purchased the assets of Tabo BV. Mr Guilguet refers to exhibit PG5 which consists of a copy of the agreement and specifically to Article 1.1 of the Agreement which states that Nevico BV agreed to purchase amongst other things the rights to the tradename TABO. He concludes saying that subsequent to this agreement, Nevico BV changed its name to Tabo BV and remains a wholly owned subsidiary of Tabo SA.

15 The third Declaration, dated 3 February 1994, comes from Roger David Mason, who is Managing Director of Tabo (UK) Limited. Mr Mason says that he was employed by Dowson & Mason Limited in the United Kingdom from 1966 until July 1987 when the company went into receivership. He says that following the acquisition of Dowson & Mason Limited by Tabo of Sweden, in January 1986 the company changed its name to DM-Tabo Limited. Mr Mason states that whilst employed with these companies, he held the positions of Draughtsman, Estimator, Assistant Manager and Manager of the Cremator division.

25 Mr Mason says that Dowson & Mason Limited supplied and installed cremation furnaces under the trade mark Dowson & Mason. He states that in the late 1970s a company called Tabo Cremators Limited was formed and carried out the same business of supplying and installing cremation furnaces. Mr Mason says that Tabo Cremators Limited was owned by a Swedish company, Tabo Industriugnar AB, who, in 1985 acquired Dowson & Mason Limited and changed that company name to DM-Tabo Limited. He goes on to say that in the time leading up to the takeover, Tabo Cremators Limited had become dormant, and in 1989 the company and its shares were acquired by DM-Tabo Limited and the company dissolved. Mr Mason states that throughout the time that Tabo Cremators Limited were installing the cremation furnaces, Tabo BV, a Dutch company provided the expertise and supervision. He cannot recall whether this company also supplied the parts, but states that as far as he was aware, the Swedish company which owned Tabo Cremators Limited and subsequently, Dowson & Mason Limited/DM-Tabo Limited was solely responsible for technical support and administration.

40 He goes on to restate that Tabo Limited went into receivership. He says that he has no documentary evidence of the installations of cremation furnaces carried out in the United Kingdom, and concludes that any records must have been lost or destroyed.

45 Mr Mason next says that Tabo SA registered Tabo UK Limited in August 1990, and that he was appointed as Managing Director of the new company in August 1992 when Tabo UK Limited commenced selling and installing cremation furnaces in the United Kingdom. He says that prior to that date, Tabo SA had an agreement with Adament Refractory Settings Limited who acted on their behalf in the selling and installation of TABO cremators. Mr Mason says that he was employed by Adament Refractory Settings Limited as General Manager prior to joining Tabo UK Limited as Managing Director.

Mr Mason next refers to the installation of two furnaces in Birmingham started in September 1991 by Tabo SA jointly with Adament Refractory Settings Limited, and from August 1992, with Tabo UK Limited. He states that Tabo SA supplied a substantial part of the materials used, under the trade mark TABO, as well as labour for installation and supervision of other companies employees. He concludes saying that since August 1992, Tabo UK Limited has also completed the installation of furnaces at Newcastle-Under-Lyne and has contract to complete installations in five other locations in the United Kingdom.

**Applicants' evidence (Rule 50)**

This consists of two Statutory Declarations. The first, dated 4 July 1995 is made by Eskil Napoleon Marklund, Chairman of the Board of Directors of Ugnsbolaget Tabo Aktiebolag, a Swedish company. Mr Marklund begins saying that his company is the latest in a line of Swedish companies to have owned the worldwide rights in the trade mark TABO, and refers to the mark which is the subject of these proceedings. He refers to exhibit ENM1 which consists of a list of companies which have been involved with the mark dating back to 1945 saying that although some of these companies have undergone changes, from early 1981 the control of them, with the exception of DM-Tabo Aktiebolag, remained either with himself alone or together with his family.

Mr Marklund refers to the first company listed on ENM1, A B Tabougnar which was established in 1917. He says the company commenced production and marketing of cremation furnaces shortly after World War II when it changed its name and adopted the trade mark TABO. Mr Marklund refers to exhibit ENM2 which consists of an extract from the Swedish Industrial Encyclopaedia dated 1948 showing an entry for the company and stating their interest as industrial furnaces of all types with the word TABO clearly shown. He expresses his belief that the word TABO is an invented word derived from the name of the designer of the cremation furnace, T A Borgkvist, who, in conjunction with Aktiebolaget Ifoverken had set up AB Tabougnar.

He goes on to say that this company had changed its name on two occasions and when it was liquidated in 1985 was known as Ugnsbolaget Tabo AB and refers to exhibit ENM3 which consists of a copy of a certificate of registration for the company with the Swedish registry. Mr Marklund continues giving details relating to the establishment of Tabo SA in Belgium in 1973, Tabo BV in the Netherlands in 1973, Tabo Cremators Limited in the United Kingdom in 1975 and Tabo Sarl in France in 1979. He states that in each case, the sole or majority shareholder at the time of establishment was AB Tabougnar referred to in the previous paragraph, although subsequently passed to other Tabo companies. Mr Marklund refers to exhibit ENM4 which sets out the details relating to the formation of these, and other subsidiary companies, with the names of the parent companies. Mr Marklund states that throughout their existence these companies operated entirely as subsidiaries of the respective Swedish company and had no independent right to the TABO trade mark.

Mr Marklund goes on to refer to exhibit ENM5 which sets out details of registrations for the trade mark TABO throughout the world. Also to exhibit ENM6 which consists of a list of all cremation furnace installations carried out by the Swedish TABO companies from 1932 to date, and containing entries for three installations in the United Kingdom in 1976, 1978 and 1983. He again refers to the bankruptcy of Ugnsbolaget Tabo AB in 1980 and the termination of the proceedings in 1985, and goes on to refer to a purchase agreement dated 17 March 1981, a copy

of which is shown at exhibit ENM7. This agreement transferred the operations of the company relating to industrial and cremation furnaces to Eskil Marklunds Mekaniska Aktiebolag and included the rights to use the company name and an option to take over its foreign subsidiaries. Mr Marklund refers to exhibit ENM8 which is a certificate of registration for Eskil Marklunds Mekaniska Aktiebolag, a company incorporated Aktiebolaget Alvikskopia but through a series of name changes is now known as Ugnsbolaget Tabo Aktiebolag. He says that his company and a company then known as Wennenberg o Co Revisionbyra i Ostersund Aktiebolag jointly carried on the operations of Ugnsbolaget Tabo AB as a separate company under the name Ugnsguppen Tabo-Osmund AB. Mr Marklund refers to exhibit ENM10 which consists of a certificate of registration for this partnership, and ENM9 which lists the changes of name for this company to the present name, Utab Fastighets Aktiebolag.

Mr Marklund continues saying that up to the end of 1984, the operations of the partnership were carried out by three limited partnerships, of which, Tabo Processteknik Kommanditbolag carried out the work related to cremation furnaces and refers to exhibit ENM10 which consists of the certificate of registration of this company. He next refers to exhibit ENM11 which consists of a copy of an agreement, effective from 1 September 1981, by which the partnership forming Tabo Processteknik Kommanditbolag acquired all but a small number of the shares in each of the Belgian, Dutch, French and UK subsidiaries of the now bankrupt Ugnsbolaget Tabo AB.

He then refers to the sale by his company of a cremation furnace to the City of London Crematorium, which was made through Tabo Processteknik Kommanditbolag and a newly formed company, Tabo (UK) Limited. He refers to exhibit ENM12 which consists of a copy of a pro-forma invoice dated 28 June 1983 to Tabo (UK) Limited for the supply of apparatus referred to as a Tabo Cremator, and exhibit ENM13 which consists of a brochure for furnace equipment produced by Ugnsbolaget Tabo AB. The brochure contains a picture of two cremation furnaces bearing the name TABO, and a reference on the back page to a number of trademarks including two which incorporate the word TABO. The brochure does not show the date of publication and Mr Marklund says that although he cannot recall exactly when it was published, he believed the date to be in the late 1980s.

Mr Marklund next refers to two agreements. The first is dated 21 December 1984 is shown at exhibit ENM14, under which Eskil Marklunds Mekaniska Aktiebolag acquired all shares held by Weco Invest Aktiebolag in Ugnsbolaget Tabo AB. and three other limited partnerships. He states that following the acquisition, the three limited partnerships remained dormant and their operations were carried out by corresponding divisions of Ugnsguppen Tabo-Osmund AB, (by this time known as Ugnsguppen Swedefurn AB) and that this continued until 1987 when the three partnerships were removed from the commercial register. The second agreement is shown at exhibit ENM15 took effect from 15 December 1985, under which Ugnsguppen Swedefurn AB (by this time known as Ugnsguppen Scanfurnace AB) transferred the operations of Tabo Processteknik and all shares held in the three foreign subsidiary companies to a company under formation called DM-Tabo Aktiebolag. Mr Marklund states that 25% of shares in this new company were owned by him and the remainder by Mr Arne Gherke, who at that time was Managing Director of Ugnsguppen Scanfurnace AB. He next sets out the corporate structure in the United Kingdom stating that at that time, Ugnsguppen Scanfurnace AB had Tabo Cremators Limited, the subsidiary Tabo (UK) Limited, and DM Tabo Limited which was a subsidiary of Tabo (UK) Limited.

Mr Marklund goes on to refer to the declaration by Mr Mason filed as part of the opponents' evidence. He confirms the sequence of events and relationships between the UK companies set out in paragraphs 2 to 4 of that declaration, although disputes the date of establishment of Tabo Cremators Limited. He also states that it is not clear that with the exception of Dowson & Mason Limited, all of the companies referred to in these paragraphs were wholly owned subsidiaries of the Swedish companies. Mr Marklund also disputes the date of establishment of Tabo UK Limited which is stated in paragraph 5 as being 1990.

Mr Marklund next refers to exhibit ENM16 which is a certificate of registration of DM-Tabo Aktiebolag, stating that from 1985 to 1986 he and Mr Gherke were the board of directors, Mr Gherke being primarily responsible for the day-to-day management of DM-Tabo Aktiebolag. Mr Marklund says that in 1986 it became apparent that the group of companies was insolvent, and on 3 March 1987, DM-Tabo AB was adjudged bankrupt. He next refers to the French subsidiary Tabo Sarl, which on 2 February 1987 had been placed under administration by a French court. Mr Marklund refers to exhibit ENM17 which consists of a copy of the judgement of the court, making particular reference to the fact that the court ordered the shares of Tabo Sarl be transferred to C.I.D, a French company.

Mr Marklund moves on to refer to the Declaration of Mr Vidallet filed as part of the opponents' evidence. He refers first to paragraphs 2 to 6 stating that at the time all of the UK and Dutch companies referred to were wholly or the majority owned subsidiaries of the Swedish companies. Mr Marklund also makes reference to the first sentence of paragraph 8 saying that the statement by Mr Vidallet that he was European Manager for the British, French and Dutch companies is incorrect. Mr Marklund states that Mr Magnus Bjorkman was responsible for the running of the Belgian, French and Dutch subsidiaries, and refers to the fact that Mr Bjorkman is the signatory on the invoice shown as exhibit PV1 to Mr Vidallet's declaration and notes that the contact address at the bottom of the invoice is that of Tabo BV in Belgium. Mr Marklund also refers to the components specified in paragraph 6 of the declaration saying that with the exception of the items shown at the top of page 3 which were made by a subcontractor of Ugnsguppen Scanfurnace AB, they are standard and could be obtained from various European firms.

Mr Marklund states that having examined the invoices he believes the statement made by Mr Vidallet in paragraph 7 that "the former Tabo BV supplied all the parts marketed in the United Kingdom under the trade mark TABO." to be incorrect. He also challenges the conclusions Mr Vidallet draws from the letter from Dowson & Mason referred to in paragraph 6 that the rights in the TABO trade mark have passed to the present TABO SA by virtue of its ownership of Tabo BV.

Mr Marklund refers to exhibit ENM18 which consists of a copy of an agreement dated 17 March 1987, by which Ugnsguppen Scanfurnace Aktiebolag acquired from the estate of DM-Tabo AB, the Tabo manufacturing and marketing operations, including the name, drawings and the right to collect money owed by customers in Sweden and Denmark. He also refers to two further agreements dated 10 July 1987 and 26 August 1987 and shown at exhibits ENM19 and ENM20 respectively, and by which Ugnsguppen Scanfurnace Aktiebolag acquired all shares in Tabo SA and Tabo-Taiwan Branch Co Ltd, as well as copyright in computer equipment for the control of fuel fired furnaces and the right to collect money owed by customers in Sweden and Denmark.



Mr Marklund continues saying that from 1981 on, Eskil Marklunds Mekaniska AB were subcontracted to carry out the major part of the manufacture of all cremation furnaces marketed under the trade mark TABO by Ugnsgruppen Tabo-Osmund AB, DM-Tabo AB and the foreign subsidiaries. He says that design, development and technical assistance was provided by  
5 Ugnsgruppen Tabo-Osmund AB and DM-Tabo AB and the installation in foreign countries where a subsidiary company existed was carried out by the subsidiary.

He next says that in the second half of 1987, Ugnsgruppen Scanfurnace AB and Tabo Sarl (which by that time was no longer controlled by the Swedish company) entered into negotiations with  
10 a view to cooperating with each other. Mr Marklund says that although this did not result in any lasting cooperation, while negotiations were ongoing it was agreed that Eskil Marklunds Mekaniska Aktiebolag should deliver five cremation furnaces to Tabo Sarl for installation at sites on the continent and refers to exhibit ENM21 which is an invoice to Tabo Sarl for these furnaces. Mr Marklund states that at that time, Tabo Sarl had no production facilities having previously  
15 operated as a sales and service company.

Mr Marklund says that in the first half of 1989, the operations of Ugnsbolaget Tabo AB were transferred to Eskil Marklunds Mekaniska AB. He says that at that time, Ugnsbolaget Tabo AB, a wholly owned subsidiary of Eskil Marklunds Mekaniska AB, changed its name to UTAB  
20 Fastighets AB and carried on business as a commission agent for the parent company. From 1990 the marketing of cremation furnaces has been carried out by another wholly owned subsidiary, Ugnsbolaget Tabo Incinerator Aktiebolag.

Mr Marklund returns to the declaration of Philippe Guilguet filed as part of the opponents' evidence, and agrees with the statements made in paragraph 3 concerning Tabo Sarl, Tabo BV and the relationship of these companies with Ugnsbolaget Tabo Aktiebolag. He also confirms the information in paragraph 4 relating to the transfer of ownership of the Tabo subsidiaries to Tabo  
25 Processteknik KB and the transfer of shares in Tabo Sarl and Tabo BV to DM-Tabo Aktiebolag. Mr Marklund refers to exhibit PG3 of Mr Guilguet's declaration which he says is the same document as exhibit ENM17 to his own declaration. He refers to the fact that this document does not mention the transfer of any rights in the trade mark TABO from Tabo Sarl to C.I.D, which he says would be due to the fact that Tabo Sarl have never held any rights in the trade  
30 mark. He next refers to exhibit PG5 which is a document which he says purports to sell the rights of Tabo BV in to the trade mark TABO to Nevico BV. Mr Marklund concludes stating that at all times during its existence, Tabo BV had been a wholly or majority owned subsidiary of the Swedish companies and did not have any independent rights in the trade mark, and that the same  
35 applied to all other subsidiaries including Tabo Sarl.

The second declaration comes from Jens S. Bredal-Hansen who since 1979 has been a technical consultant permanently engaged by Sveriges kyrkogards-och krematorieforbund (Swedish  
40 Cemetery and Crematory Federation), an association of Swedish municipal cemetery and crematory administrations. Mr Bredal-Hansen says that he advises members of the association on matters concerning the establishment and operation of crematoria and the training of crematory personnel. He says that prior to this he had been employed for twenty years by Aktiebolag  
45 Tabougvar (which became Tabo Industriugvar Aktiebolag in 1972 and Ugnsbolaget Tabo Aktiebolag in 1977) as draughtsman, furnace designer and from the beginning of the 1970s had technical and economic responsibility for the production and marketing of destruction furnaces

including crematoria furnaces.

5 Mr Bredal-Hansen says that shortly after World War II, Mr Tage Borgkvist and his employer, Aktiebolag Ifoverken jointly established Aktiebolag Tabougnar to produce, amongst other things, cremation furnaces. He confirms that Mr Borgkvist had previously been employed as chief engineer and furnace designer with Aktiebolag Ifoverken and that he had close contact with Mr Borgkvist from who's family name he believed the trade name TABO had been derived.

10 Mr Bredal-Hansen goes on to set out the information he has collected relating to the installation of cremation furnaces in mainland Europe, Taiwan, the United States and Australia, the first installation being in 1946. He goes on to say that the first installation in the United Kingdom was in 1976 at the City of London Crematorium. He says the furnaces were shipped from Sweden and installed under his personal supervision. He refers to exhibit JBH1 which consists of a copy of a declaration by Mr Bengt Folke Orrling, dated 23 May 1991, and confirms that exhibits BFO1 and BFO2 to that declaration are engineering drawings and operating instructions relating to the installations at the City of London Crematorium. The engineering drawing is dated 26 March 15 1976 and bears the mark TABO, the instructions are not dated but refer to a "Tabo cremator".

20 Mr Bredal-Hansen goes on to say that in 1979, 6 cremation furnaces were sold for installation at the London/Southend crematoriums. He says that he personally signed the acknowledgement of the order, and that the furnaces were to be shipped from Sweden on 20 June 1979. He next says that in 1983, a further cremation furnace was installed at the City of London crematoria although he was not at that time employed by the company and had no involvement with the sale or installation. Mr Bredal-Hansen concludes saying that throughout his time with the company, the design and production of steel frames and other major mechanical components and 25 control/monitoring systems for the furnaces took place in Sweden.

### **Opponents' evidence in reply (Rule 51)**

30 This consists of a second Declaration dated 4 November 1996, made by Pierre Vidallet. Mr Vidallet states that he holds the position of President of Tabo Inex Holdings BV and that he is also a Director of Tabo Inex SA (formerly known as Tabo SA) which is a subsidiary of Tabo Inex Holdings BV.

35 Mr Vidallet confirms that Tabo SA were registered as proprietor of International registration number 513450 for the mark TABO, and that this was assigned to Tabo Inex Holdings BV on 31 May 1996. He refers to exhibit PV8 which consists of details of an International trade mark registration, and the domestic French trade mark registration filed on 24 March 1987 upon which it is based. Mr Vidallet goes on to refer to other trade mark registrations filed by Tabo SA, 40 acknowledging that these were filed after the application by Ugnsgruppen Scanfurnace AB in the United Kingdom. He also refers to four other trade mark registrations owned by Ugnsgruppen Scanfurnace AB in other countries and making the point that the International registration owned by Tabo SA is in force in the same countries and that the International trade mark pre-dates these registrations.

45 He next refers to exhibit PV10 which consists of a list of cremation furnaces installed by Tabo Inex Holdings BV, its subsidiaries including Tabo Inex SA and their predecessors. Mr Vidallet

makes the point that the list does not show all installations and none in the United Kingdom by Tabo BV prior to 1992.

5 Mr Vidallet confirms that he was appointed the European manager of Tabo SA in Belgium, Tabo BV in Holland and Tabo Sarl in France by Mr Arne Gherke, and refers to exhibit PV11 which consists of a handwritten agreement dated July 1985 between Mr Vidallet and Mr Gherke of behalf of the Ugnsggruppen Scanfurnace Group confirming his appointment as manger of these companies. Mr Vidallet says that although the agreement says that it would be formalised, this never actually happened.

10 Mr Vidallet next refers to the declaration of Mr Marklund, filed as part of the applicants' evidence. He first makes reference to paragraph 21 stating that some of the parts in the specification referred to did originate from Teleutveckling AB, a Swedish company, because they were the cheapest source. He next refers to paragraph 25 and confirms that the negotiations referred to did take place and that he was present, but denies that there was any agreement for five cremation furnaces to be delivered. Mr Vidallet refers to the fact that exhibit ENM12 to Mr Marklunds declaration is a proforma invoice, which he says, is an estimate and issued before work is carried out and would always be replaced by a proper invoice. Mr Vidallet states that the work may well have never been undertaken.

20 **Applicants' evidence (Rule 13(8))**

25 This consists of a Statutory Declaration dated 23 July 1998 by Mr Robert Ackroyd, a registered trade mark agent and partner in the firm of W P Thompson & Co, the opponents trade mark agents. Mr Ackroyd refers to exhibit RA1 which consists of a decision of the High Court of Lille and a ruling of the Court of Appeal of Douai in relation to litigation between Ugnsbolaget Tabo AB/Utab Fastighets AB as plaintiffs, against Tabo SA (now Tabo Inex SA) the opponents in these proceedings as defendant.

30 Mr Ackroyd says that he believes the proceedings in the French Courts have some relevance to these opposition proceedings. He refers to the ruling of the Court of Appeal confirming the findings of the High Court that the filing of an application for the trade mark TABO by Tabo Sarl (as predecessor to Tabo SA) was fraudulent, and that Tabo SA (now Tabo Inex SA) be forbidden to use the trade mark TABO in France. Mr Ackroyd says that this is because the Ugnsggruppen Scanfurnace AB, the applicant, is the holder of the rights in the TABO trade mark. He concludes saying that he has been advised that the date by which the decision of the Court of Appeal can be appealed has passed with no appeal being fled, and consequently, the ruling of the Court of Appeal is final.

40 **Decision**

Section 17(1) reads as follows:

45 **Section 17(1)** “Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.”

I have set out the details of the evidence filed by the parties at some length (and some of it relates to periods after the date of application) because I consider that this is a complex case. At the hearing, Mr Campbell referred to the grounds on which the opposition is based saying

5           “Firstly, there is the Section 11 ground relying on our business of manufacturing cremation furnaces prior to 21 July 1987 (the date of application of the mark under opposition) , and also the proprietorship ground, Section 17. In fact it is really a question of proprietorship to be decided first....”

10       I believe Mr Campbell is correct in saying that in this case the primary issue is the determination of proprietorship, and accordingly, I take the view that I should first consider the grounds under Section 17(1) of the Act. What I have to decide in relation to Section 17(1) is whether, at the time of filing, the applicant had a bona fide claim to be the proprietor of the mark, or whether in making such a claim, they were making a false representation to the Registrar.

15       Mr Campbell referred to the decision of the Court of Appeal in the Al Bassam trade mark case [1995] RPC 511. I take particular note of the following passages from that decision, which are essentially those referred to by Mr Campbell:

20       at page 522 line 6 et seq:

25           “Accordingly, it is necessary to start with the common law principles applicable to questions of ownership of unregistered marks. These are not in doubt and may be shortly stated. First the owner of a mark which had been used in conjunction with goods was he who first used it. Thus in Nicholson & Sons Ltd's application (1931) 48 RPC 227 at page 253 Lawrence LJ

30           “The case to which I have referred (and there are others to the like effect) show that it is firmly established at the time when the Act of 1875 was passed that a trader acquired a right of property in a distinctive mark merely by using it upon or in connection with his goods irrespective of the length of such user and of the extent of his trade and that such right of property would be protected by injunction restraining any other person from using the mark.”

35           Second the right to the used mark as an indication of the origin of the goods could not be assigned separately from the goodwill of the business in which it has been used for that would have been to assign the right to commit a fraud on the public.”

40       and at page 522 line 40 et seq:

45           “In my view it is plain that the proprietor is he who satisfies the principles of the common law to which I have referred. Accordingly in the case of a used mark, as in this case, the owner or proprietor is he who first used it in relation to goods for the purpose indicated in the definition of trade mark contained in Section 68 which I have already quoted. Ownership of the mark is a different concept to deceptiveness of the mark, the principles applicable to the two concepts are different and I do not see how one can determine whether there is likely to be confusion without first deciding who is the proprietor.”

and at page 524 line 52 et seq:

“..only Courtaulds have any goodwill or business in the United Kingdom in which there could have been use in accordance with common law principles.”

5

From this I take the following guidance:

10

i the owner of a used mark is he who first used it in relation to goods for the purpose indicated in the definition of trade mark contained in Section 68

15

ii a trader may acquire a right in a mark by using it upon or in connection with his goods irrespective of the length of such user and of the extent of his trade

iii when considering the question of goodwill, it is the goodwill in the mark in the United Kingdom

iv ownership of a mark is a different concept to deceptiveness of the mark

20

The evidence of both parties mainly addresses the relationships between the various companies over the years, and is limited in the information it gives on the actual use made of the mark. The applicants have the earliest record associating them with the TABO trade mark, but this is in a Swedish publication and does not substantiate that it has actually been used, or at any rate, used in the United Kingdom. Exhibit ENM6 to the declaration made by Mr Marklund lists work that was carried out in the United Kingdom by a Swedish company in the years 1976, 1978 and 1983 although it does not show use of the TABO trade mark or give much information beyond saying that this related to the installation of a cremation furnace. However, Mr Marklunds' statement is in part supported by exhibit JBH1 which contains an engineering drawing dated 26 March 1976 relating to the installation of a cremation furnace at the City of London crematorium. This bears the mark TABO and the company name Tabo Industriugnar AB, Stockholm, Sweden.

30

There is evidence also to show use of the trade mark TABO in the United Kingdom dating from 1980-81 by Tabo BV and Tabo Cremators Limited. From the declarations it appears to be common ground that at that date these companies were subsidiaries under the control of the applicants or their successors. It is well documented in recent case law that use by a subsidiary accrues to the parent company, see *Bostitch* [1963] RPC 183. With this in mind I come to the conclusion that it is the applicants that have first use of TABO as a trade mark in the United Kingdom. There is no dispute that the mark is a distinctive mark, and although the extent of use does not on the face of it appear to be substantial this is not a material consideration. However, given the nature of the goods and the size of the potential market I do not find this surprising.

40

There are references in the opponents' evidence to the rights in the TABO trade mark having transferred into their ownership following the acquisition of Tabo BV and Tabo Sarl, a claim disputed by the applicants. It is clear from the evidence that both parties share a common history which has made the determination of the ownership of the mark even more complicated than it otherwise would have been. However, there is nothing in the evidence which confirms that these companies, as subsidiaries of the applicant, have ever held any proprietary right in the trade mark TABO, and this being the case, I unable to find that any rights in the TABO trade mark have been

45

transferred out of the applicants ownership.

5 I come to the position that the applicants can claim the support of the first three points set out above, the final point being, I believe, a matter for consideration under Section 11 and has no bearing on the grounds under Section 17(1). I therefore conclude that if the ownership of the mark began with the applicants, there is nothing in the evidence to substantiate that this has changed, and taking the best view that I can, find that the attack under Section 17(1) of the Act fails.

10 The applicants, as part of their evidence filed a copy of the judgement of the Court of Appeal of Douai. The Court found that the registration for the trade mark TABO obtained by Tabo Sarl in France had been fraudulently obtained and the registration was struck out. The opponents were also forbidden to use the mark. While I take this as an indication that the French Court reached the same conclusion on the ownership of the TABO trade mark as I have come to, being a  
15 decision of a Court in another jurisdiction it can have no bearing on the current proceedings.

I turn next to consider the grounds under Section 11 of the Act, which reads:

20 **11.** It shall not be lawful to register as a service mark or part of a service 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 other scandalous design.”

25 The established test for objection under Section 11 is set down in Smith Hayden & Co Ltd’s application [Vol 1946] 63 RPC 101 as adapted by Lord Upjohn in the Bali trade mark case 1969 RPC 496. Adapted to the matter at hand the test reads as follows:

30 “Having regard to the user of the opponent’s mark is the tribunal satisfied that the mark applied for, if used in a normal and fair manner in connection with any services covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?”

35 The test requires me to consider the user established by the respective parties at the relevant date, that is, the date of application of the mark under opposition. I am satisfied that from the evidence before me that both the applicants and the opponents have used the trade mark TABO on the same goods in the United Kingdom prior to the date of application. However, it seems to me that from my findings above, it is the applicant that has the earlier use and therefore the reputation such that I must dismiss the opposition based on section 11. In doing so, however, I must record that the evidence of use of the trade mark by either party is thin but take into account the nature  
40 and size of the market in which they operate.

45 My findings under Section 11 is not however the end of the matter. Although the applicants have not claimed that they are entitled to have their application accepted by virtue of the provisions of subsection 2 of Section 12 of the Act, both companies appear to have been operating in the same area under the same mark and I consider it appropriate to consider the matter of concurrent use should I be found to be wrong in my determination of the ground founded under Section 11.

Section 12(2) states:-

5 (2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the Court or the Registrar may permit the registration by more than one proprietor in respect of:-

- 10 a. the same goods
- b. the same description of goods or
- 15 c. goods and services or descriptions of goods and services which are associated with each other.

15 of marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or Registrar, as the case may be, may think it right to impose.

20 It is generally accepted that Section 12(2) can be utilised to overcome a finding as to possible confusion under Section 11 of the Act. This point confirmed by Mr Justice Falconer in the CHELSEA MAN case 1989 RPC 111 at page 121 line 41 where he said:

25 “In the Spillers’ case, Danckwerts J after considering the decisions of the House of Lords in Case, Ratcliffe & Gretton Ltd v. Nicholson & Son Ltd (1932) 49 RPC 85 and in Alex Pirie & Sons’ Applications (1933) 50 RPC 147, stated, at page 337, line 15 of the report:

30 “It seems to me that the construction put by the House of Lords in the cases to which I have referred” - and I interpolate, those were the Bass, Ratcliffe v. Nicholson and Pirie cases - “on sections 11, 19 and 21 of the 1905 Act must also apply to sections 11 and 12 of the 1938 Act, and lead to the conclusion that cases where the Court or Registrar thinks fit to exercise the discretion conferred by section 12(2) do not fall within the general prohibition contained in section 11. This being so, it would appear logical in cases which come within section 12(1) to consider first whether the case is one in which the discretion conferred by section 12(2) should be exercised so as to allow registration of the mark, and if the answer is in the affirmative, it cannot be necessary to consider section 11 separately, because if there are reasons other than resemblance to an existing mark which cause the proposed mark to be disentitled to the protection of the court, such reasons must surely affect the exercise of the discretion conferred by section 12(2). It is not possible, as it seems to me, to apply the provisions of the Act as though they were in separate compartments.”

40 and again at page 122 line:

45 In Berlei v. Bali case, Megarry J had to consider whether section 12(2) could override a section 11 objection. After setting out section 12(2) he stated (at page 476):

“I think it is plain that this subsection” - that is section 12(2) - “provides a

discretionary path to registration notwithstanding section 12(1) and also notwithstanding section 11. Section 12(1) make this explicit in its opening words”, and he reads section 12(1). “In the case of section 11, there is no such explicit provision enabling section 12(2) to override the section. Section 11 provides”, and he reads that. Going on at line 14, he says, “Nevertheless, when one considers the origin of these sections, coupled with the fact that the Act of 1938 is a consolidation Act, I think that section 11 must be subject to section 12(2). In the Trade Marks Act, 1905, section 11 provided the origin of the present section 11, section 19 the origin of the present section 12(1) and section 21 the origin of the present section 12(2). In *Bass, Ratcliff & Gretton v. Nicholson & Son Limited* (1931) 49 RPC 88, the House of Lords held that the then section 11 was subject to the then section 19, the clear intention of section 19 being that, despite section 11, there was power to register in a case excepted by section 19. Section 19 excepted from its prohibition two cases, namely where there was an order of the court, and where the trade mark was in use before 13 August 1875. The Bass case fell under the latter head; but if that head not only escaped the specific prohibition of section 19 but also operated to override the general prohibition of section 11, so also, I think, must the former head. Correspondingly, under the Act of 1938, as section 12(2) plainly escapes the specific prohibition of section 12(1), so also must it operate to override the general prohibition of section 11. That plainly appears to have been the view of *Danckwerts J* in relation to the Act of 1938 (see *Spillers Limited’s Application* (1952) 69 RPC 327 at 337), and accordingly, despite the verbal contrast in the consolidation Act between section 11 and section 12(1), I do not think that this has changed the law. The specific case envisaged by section 12(2) accordingly permits registration, despite the general prohibition of section 11”.

The matters for consideration under Section 12(2) were laid down by Lord Tomlin in *Pirie’s Trade Mark* (1933) 50 RPC 147 at 159. They are:-

- i. The extent of use in time and quantity and the area of trade.
- ii. The degree of confusion likely to ensue from the resemblance of the marks, which is, to a large extent, indicative of the measure of public inconvenience.
- iii. The honesty of the concurrent use.
- iv. Whether any instances of confusion have been proved.
- v. The relative inconvenience which would be caused if the mark in suit was registered, subject if necessary to any conditions and limitations.

The evidence in relation to actual use is rather thin, but such as it is does not show a particularly active trade in terms of numbers of furnaces sold, or the areas of the country in which they have traded. That said, the applicant operates in a small and highly specialised market where the sale of one cremation furnace in a year could be considered significant, and with sales being on such a limited scale, the area of trade will be similarly limited in extent. The applicant and the opponent



use identical marks on identical goods, which on the face of it would appear to make confusion almost inevitable. If confusion has ever arisen there is nothing in the evidence to show this or to indicate that there has been any inconvenience to the public.

5 The applicants were the first to use the mark and there is no suggestion that their use has been  
anything but honest. Taking this into account and in the light of my decisions above, I come to  
the view that the opponents will suffer little inconvenience by the registration of this mark,  
whereas the applicants would be substantially inconvenienced if the mark was not, and I find that  
10 the applicants are entitled to the benefits of Section 12(2) of the Act by virtue of honest  
concurrent use. I also take into account the special circumstances surrounding this case, ie, the  
common history of the parties and the specialist nature of the goods and market.

15 Finally there is the matter of the Registrar's discretion under Section 17(2). Since the opposition  
has failed on all the grounds on which it was brought, I can see no reason why this discretion  
should be exercised in favour of the opponents. Accordingly, the applicants are entitled to an  
award of costs in their favour and I therefore direct the opponents pay to the applicants the sum  
of £635 as a contribution towards their costs.

20 **Dated this 5 Day of March 1999**

25 **Mike Foley**  
**Principal Hearing Officer**  
**For the Registrar**  
**The Comptroller General**