

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION
FOR REVOCATION (REVOCATION NO 8775)
OF TRADE MARK NO 1130205 IN THE NAME
OF FMC CORPORATION**

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DECISION

15 Doverstrand Limited applied on 5 December 1995 to rectify the Register of Trade Marks by the removal therefrom, or the restriction thereof, of Trade Mark No 1130205 in Class 1 in the ownership of FMC Corporation. The mark in question is the word AQUACOAT and was registered as of 12 March, 1980 in respect of the following specification of goods:

20 “Artificial and synthetic resins, all for coating purposes; water based polymer compositions included in Class 1 for coating pharmaceutical tablets”.

25 This application has been made by Doverstrand Ltd under the provisions of Section 46(1)(b) of the Trade Marks Act 1994 on the grounds that the registered trade mark was not used by the proprietors, or with their consent, during the period of five years up to a date three months prior to the filing of the application. The applicants, therefore, seek the removal of Trade Mark No 1130205 from the Register.

30 The applicants say they have made application to register their trade mark AQUACOAT in respect of “Water based compositions for applying to substrates in the manufacture of wallcoverings; chemicals and chemical compositions, all for coating paper, paper products and textiles; all for use in improving resistance to damage, improving acceptance of printing inks, and/or for providing a textured finish; all included in Class 1.” In the alternative, therefore, they say that they are not aware of any use by the proprietors, or with their consent, during the relevant period in respect of any goods for the coating of paper or textiles and they ask that the registration of Mark No 1130205 be restricted accordingly.

The applicants also ask for their costs.

40 Section 46(1)(a) and (b) read as follows:

“46.- (1) The registration of a trade mark may be revoked on any of the following grounds -

45 (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with

his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

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

Where an application is made under Section 46 the burden of showing use of their mark rests with the registered proprietors, as is made clear by Section 100 of the Act. This section reads as follows:

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“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.”

15 The registered proprietors filed their counterstatement within the period allowed and denied the applicants claims. At the same time they filed a Statutory Declaration dated 14 March 1996 by Ms Sara Jane Leno, Trade Mark Attorney at Forrester Ketley & Co, the registered proprietors’ trade mark agents. She states at paragraph 2 of her declaration:

20 “I have read the Statement of Case filed on behalf of Doverstrand Limited alleging that there has been no use of the trade mark AQUACOAT in the United Kingdom. There is now produced and shown to be marked Exhibit A a photocopy of the leaflet evidencing the products sold under the AQUACOAT trade mark. On the last page of the leaflet there is an address in Brussels which I am given to understand by FMC
25 Corporation is their European Sales Office and which would deal with enquiries from the United Kingdom.”

The exhibit provided by Ms Leno consists of leaflets about the AQUACOAT product which is described as a water based coating system designed for masking and controlling drug
30 release applications. The leaflets bear USA and Brussels addresses but no indication that the product is available or sold in the United Kingdom.

Evidence of the Applicants for Revocation

35 The applicants’ evidence consists of a Statutory Declaration dated 19 July 1996 by Mr David Valentine Dodgson, who is their Senior Scientist. He states that on 1 January 1996 Doverstrand Limited changed its name to Synthomer Limited. Nothing turns on this change of name.

40 Mr Dodgson repeats the background to his company’s application (as set down in the application to revoke), and goes on to say that enquiries made with, for example, the Kompass Directory of Trade Names, no references to the registered proprietors’ trade mark were found. Further enquiries with other directories such as Sell’s and Dun & Bradstreet had also drawn a blank. Copies of pages from the Kompass Directory for the years 1990/91 and
45 1993/94 through to 1996/97 show an entry for FMC Corporation (UK) Ltd for three marks but none for AQUACOAT. Mr Dodgson also states that he is familiar with chemicals and

chemical compositions for use in the treatment of wall coverings and for coating paper, paper products and textiles and expresses the opinion that FMC have never used their mark AQUACOAT in relation to such goods.

5 With reference to the declaration of Ms Leno, Mr Dodgson says he does not accept that it establishes that FMC have used their mark AQUACOAT in the United Kingdom. He points to the fact that the declaration has been completed by an employee of the registered proprietors' agents who is unable to make a declaration as to actual use. Additionally the exhibit only carries addresses in the USA and Brussels and the statement that Ms Leno is
10 "given to understand" that trade enquiries would be dealt with by the Brussels Office. There is no evidence of actual enquiries, sales, marketing or advertisement in the United Kingdom. Furthermore, the exhibit provided by Ms Leno only indicates use of the mark AQUACOAT in relation to water based compositions for pharmaceutical purposes. At the very least, submits Mr Dodgson, the registered proprietors' specification for mark No 1130205 is much
15 too broad.

That completes my review of the evidence and the matter came to be heard on 23 January 1998 when the registered proprietors were represented by Mr C Birss of Counsel, instructed by their trade mark agents, Forrester Ketley & Co. The applicants were not represented but
20 their agents Haseltine Lake & Co made written submissions.

I first summarise the submissions of Haseltine Lake & Co in their letter of 6 January, 1998. They maintain the applicants request for full revocation or at the very least partial revocation of Mark No 1130205. They cast doubt on the evidence of use provided by Ms Leno and
25 indeed dispute that she was authorised to complete her declaration dated 14 March 1996. They ask that Ms Leno's declaration be rejected as it does not constitute proper evidence by the proprietors.

If Ms Leno's declaration is admitted then Haseltine Lake submit that no proper evidence of
30 use in the United Kingdom has been submitted and therefore Mark No 1130205 should be revoked. In any event such evidence as has been provided indicates that the mark AQUACOAT has only been used in relation to coatings for pharmaceutical products. Thus at the very least the registration should be reduced in scope to those specific goods.

35 Haseltine Lake also draw attention to the Swiss Miss case 1997 RPC 219 where it was held that:

40 "A great deal of time and energy had been expended in considering the mark in relation to the full specification of goods If the applicant wished to use the mark in the United Kingdom in respect of a narrower class of goods, it would have to make a fresh application for registration."

In this case Haseltine Lake submit that the registered proprietors have increased the applicants costs by maintaining their full specification of goods. They should not now be
45 allowed to reduce their specification even if they want to.

In relation to costs, the agents say that the applicants have unnecessarily prolonged proceedings by requesting repeated extensions of time and generally showing a lack of interest in the proceedings. They ask for any award of costs to be realistic to take account of the attitude of the registered proprietors.

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On behalf of the registered proprietors Mr Birss submitted that the evidence of Ms Leno should be accepted into the proceedings since there is no dispute that Forrester Ketley are the proprietors' authorised agents and Ms Leno is the employee within that firm who handles the registered proprietors' case. In the circumstances of this case I am prepared to accept Ms Leno's declaration into the proceedings.

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In his submissions Mr Birss suggested that the evidence of Ms Leno provided a modicum of support for the view that the registered proprietors had used their mark in the United Kingdom during the relevant period and he pointed to the fact that the brochure exhibited is in English and that it was reprinted in 1992. This brochure shows that the registered proprietors do use their mark in relation to coatings for pharmaceuticals and the availability of an address in Brussels confirms a presence in the EU. Ms Leno states in her declaration that this office would deal with enquiries from the United Kingdom.

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While not going so far as to criticise the applicants' evidence, Mr Birss suggested that it did not establish beyond doubt that the registered proprietors had not used their mark in relation to coatings for pharmaceutical preparations. I add here that under the 1994 Act there is no onus on them to do so and that the onus to show use rests on the registered proprietors.

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As regards the matter of discretion Mr Birss urged me to take account of all the surrounding circumstances including the fact that the registered proprietors had submitted evidence of use of the mark at issue, including copy invoices, but because it had been out of time it had not been accepted into the proceedings.

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I have considered carefully how I should proceed in this case because I do not wish to send the wrong message to others who might be engaged in proceedings of this nature. Despite Mr Birss eloquent arguments I am not convinced from the evidence before me in these proceedings that the registered proprietors have established use of their mark. However, taken account of all the other circumstances, there does appear to be an opportunity to satisfy both parties to the proceedings and in such circumstances the Registrar believes it right to take that opportunity, if such a decision can be arrived at which can be to the benefit to both parties and which would not be to the detriment of the public interest.

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The registered proprietors specification covers two distinct groups of goods as follows:

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- (a) artificial and synthetic resins, all for coating purposes
- (b) water-based polymer compositions included in Class 1 for coating pharmaceutical tablets.

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The evidence filed in these proceedings establishes that the registered proprietors only trade in goods as described at (b) above and that the applicants trade in goods which are at least similar to the goods listed at (a) above. What is clear, however, is that the two parties operate in quite different fields and that cancellation of the goods described at (a) above would allow the applicants to register their mark and continue with their normal business activities. Cancellation of the goods described at (a) above would also meet the demands of the applicants since their claim was for either full revocation or for partial revocation.

To conclude, therefore, if the registered proprietors are prepared to reduce their specification they should file Form TM21 to cancel “Artificial and synthetic resins, all for coating purposes” from the specification of Mark No 1130205. If this form is not filed within one month following the end of the appeal period, the registration will be revoked in its entirety.

There remains the matter of costs. As the applicants have been successful in these proceedings they are entitled to a contribution to their costs. It is my view that they are also entitled to their costs in respect of a preliminary hearing where the registered proprietors failed in their request for an extension of time to file evidence in the proceedings. I am also conscious of the fact that the delays occasioned by the registered proprietors in, apparently, paying insufficient attention to these proceedings have added to the applicants’ costs. In all the circumstances, therefore, I believe that an award of some £500 above the normal scale of costs, to be justified in this case. I therefore order the registered proprietors to pay to the applicants the sum of £1,500.

Dated this 17 day of February 1998

N A HARKNESS
Assistant Registrar of Trade Marks
For the Registrar
the Comptroller General