

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 9305 BY
IJM TIMBER ENGINEERING LTD FOR REVOCATION OF
TRADE MARK NO. 1214649 IN THE NAME
OF RHODIPOR ECOBUILD LIMITED**

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 9305 BY IJM TIMBER ENGINEERING LTD FOR REVOCATION OF 5 TRADE MARK NO. 1214649 IN THE NAME OF RHODIPOR ECOBUILD LIMITED

DECISION

10 Trade mark number 1214649, ECOBUILD, is registered in Class 19 in respect of “building elements made wholly or principally of non-metallic materials”.

15 The registration stands in the name of Rhodipor Ecobuild Ltd (previously Multitherm Ecobuild Ltd).

20 By application dated 26 November 1996 IJM Timber Engineering Limited applied for this registration to be revoked on the grounds that it has not been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods for which it is registered within the five years following the date of completion of the registration procedure. Further, or in the alternative, they say that such use has been suspended for an uninterrupted period of five years. They add that there are no proper reasons for non-use. These grounds go to Section 46(1)(a) and (b) of the Act.

25 The registered proprietors filed a counterstatement and evidence denying the above grounds.

Both sides ask for an award of costs in their favour.

30 The matter came to be heard on 19 January 1999 when the applicants were represented by Mr R Onslow of Counsel instructed by A A Thornton & Co, Trade Mark Attorneys and the registered proprietors by Mr T B Alexander of Boulton Wade Tennant, Trade Mark Attorneys.

Registered proprietors' evidence

35 This consists of a Statutory Declaration dated 7 February 1997 by Mr Jack Abbott, Director of Rhodipor Ecobuild Ltd, a position he has held for five years.

40 He firstly explains the history of the trade mark registration and the change of company name (so far as I can see nothing turns on the latter point).

45 He says that the goods sold under the trade mark, ECOBUILD, are components for the construction of insulated walls for any type of building. The wall is formed of CFC-free fire-retardant non-toxic polystyrene mouldings with a ready-mixed structural concrete core. The mark has been used in connection with the goods continuously “for at least the past five years” and has always been used in the same way. In support of this he exhibits

JA3 - product information literature dated June 1992

JA4 - exhibits relating to various trade shows held in 1993 and 1995 at which the company exhibited ECOBUILD goods

5 JA5 - an extract from a booklet called 'Hybrid Concrete Construction' published by the British Cement Association in 1995 featuring the goods

JA6 - papers relating to the company's participation in construction industry research projects into energy efficient in-situ concrete housing (1995 and 1996)

10 JA7 - specimen invoices for customers dated 31 August 1993 and 4 June 1996.

That completes my review of the evidence.

Sections 46(1)(a) and (b) of the Act read as follows:

15

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

20

(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;

25

(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) and (3) are also relevant to these proceedings and read:

30

"(2) 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.

35

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

40

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

45

The trade mark registration in question was filed on 13 March 1984 and was registered on 8 May 1986. The evidence showing use of the mark appears to date from 1992 and would, therefore, fall outside the five year period applicable in accordance with Section 46(1)(a). However it is clear from Section 46(3) that any commencement or resumption of use after the initial period (and subject to the operation of the proviso) is sufficient to defend a registration from attack. I make this point for clarification, no point having been taken in relation to the operation of these provisions at the hearing.

Mr Onslow put his case against the registered proprietors on two main grounds. Firstly that the use shown is not as a trade mark but rather a company name and secondly that the use is of a different mark RHODIPOR ECOBUILD rather than ECOBUILD on its own. In support of this he relied on Orient Express Trade Mark 1996 RPC 25 and Elle Trade Marks 1997 FSR 529.

I will deal firstly with the company name issue. In the Orient Express case the Registry's Hearing Officer had held that use of the words Orient Express Trading Company Limited on one side of a swing label (with the words HUNTING WORLD on the other side) was not use of the trade mark ORIENT EXPRESS. The decision was upheld on appeal when Mummery J also came to the following view:-

“The mark ORIENT EXPRESS was not used anywhere on its own in relation to the goods. It was never used in the orders for goods or in the invoices. It was not used on the label stitched into the goods by Thornproof. The words only appeared on one side of the swing label where the words were printed so as to appear to be a part of the name of the company. Prima facie, the words “Orient Express Trading Company Ltd” on the ticket are used to identify and refer to the appellant company by its proper name. It is the corporate name of the appellant. On the authority of *Pompadour Laboratories Limited v. Stanley Frazer* [1966] RPC 7, 12, a case the correctness of which was not questioned in the later case of *Duracell International Inc. V. Ever Ready Ltd.* [1989] FSR 71, 80 to 83, the Registrar was entitled to conclude from the evidence before him that the words “Orient Express” were used as part of the corporate name to identify the appellant company and were not used as a trade mark ORIENT EXPRESS. On that view of the facts, there was no use of the mark in a trade mark sense. In my judgment, it is a question of fact in every case whether words are used as a trade mark or in a trade mark sense or whether they are used as part of the corporate name or business name of a registered proprietor. As the hearing officer observed, there was no evidence before him that the words “Orient Express Trading Company Limited” were accepted in the trade as a trade mark indicating the goods of the appellant. I am not prepared to infer that it was used in a trade mark sense, simply from the facts that the words “Orient Express” were in bigger, bolder and more prominent type than the rest of the words and were arranged in an order that did not read either clockwise or anti-clockwise in a continuous manner as “Orient Express Trading Company Limited.”

I regard the circumstances of the above case as being some way removed from those before me. I entirely accept Mr Onslow's contention that some of the exhibits filed by the registered proprietors show use of the company name Rhodipor Ecobuild Limited but that in itself does not prevent the same words (individually or collectively) from performing the function of a trade mark or marks. For reasons which will become apparent when I deal with the second of Mr Onslow's

points, I do not consider there is any doubt that the registered proprietors are so using the word in circumstances where it would not be construed as use of the company name.

5 The applicants say that the mark ECOBUILD has not been used on its own and invariably appears
in conjunction with the word RHODIPOR. Such use, it is said, would not be within the meaning
of Section 46(2). Related questions were also raised as to whether the use shown was in relation
to the goods (I take the view that it clearly is) and a suggestion that the presence of RHODIPOR
might perhaps reduce the impact of ECOBUILD insofar as the latter might be said to allude to
10 the character of the goods. I do not think I should make too much of the latter point. There has
been no challenge to the validity of the registration other than the non-use grounds currently
before me. The issue before me is simply whether the registered proprietor can rely on the use
shown to defend their registration.

15 The point at issue in the ELLE case was whether use of the word ELLE (in upper case and on
its own) did or did not alter the distinctive character of the mark in the form in which it was
registered (“elle” in lower case in the middle of a circle with a cross off the circle bottom right i.e.
the scientific symbol for the female gender). It was held that the form used did alter the distinctive
character of the mark and could not, therefore, be relied upon for the purposes of the Section.
20 The circumstances of that case are in my view distinguishable from those before me. It seems that
there was no use of the mark as registered in the ELLE case whereas here there has been use of
ECOBUILD in the form registered. The issue I have to consider is whether the registered
proprietors use this mark in such a way (that is in association with RHODIPOR) that they cannot
rely on such use to defend their registration of ECOBUILD. It follows that, although I do not
25 find the ELLE case of particular assistance, I cannot lightly dismiss Mr Onslow’s underlying
point. Equally Mr Alexander quite rightly took the view that it is common practice for trade
marks to be used both on their own or in combination with other matter such as house marks.
He instanced car brand names which are sometimes used in conjunction with the manufacturers’
name and sometimes on their own. Each case will turn on its own facts.

30 The registered proprietors appear to have a mixed practice in terms of how they use their marks
(it seems that RHODIPOR is also registered). There are, for instance, a number of references in
the body of the product literature (JA3) to RHODIPOR ECOBUILD insulated walling. Had the
matter rested narrowly on such examples of use the registered proprietor might have faced some
difficulty in relying on it to defend their registration of ECOBUILD. However, I am persuaded
35 that the registered proprietors have made it clear that RHODIPOR and ECOBUILD are separate
marks rather than a composite mark made up of the two words. Thus the product literature
referred to above containing the words RHODIPOR ECOBUILD insulated walling has a very
prominent heading with the words each having an ® symbol attached to them to indicate their
status as separate marks. The position is further reinforced by the references in the product
40 literature indicating that “RHODIPOR and ECOBUILD are Registered Trade Marks” (see
example in Annex). Whilst I would agree with Mr Onslow that not all such references make the
point with equal clarity most of these other references are within the narrative text of documents,
the headings of which make clear the independent status of the respective trade marks. I
remarked at the hearing that the evidence showed the company name was (prior to 23 July 1992)
45 Multitherm Ecobuild Ltd which suggests that ECOBUILD has been a constant element in the
business. However, I do not rely on this point as there is no evidence as to what trade mark(s)
was being used in earlier years (as distinct from Ecobuild featuring in the corporate name).

In the event, therefore, I am satisfied that the registered proprietors have demonstrated use of the mark ECOBUILD and that such use is genuine. The evidence confirms use in relation to insulated walling, flooring and formwork. At the hearing Mr Alexander took the view that the specification of his clients' registration should survive intact. The applicants for revocation have made a general claim of non-use and have not directed their attack at any particular goods. Nor has any indication been given that they would be seeking partial revocation in the event that I decided that the registered proprietors' had demonstrated use of the mark on certain goods. It seems to me that the specification set out at the start of the decision consists of rather broad terminology that could be held to cover a number of items on which use has not been demonstrated and which might otherwise suffer the consequences set out in Section 46(5). Equally, however, I do not disagree with Mr Alexander that broadly speaking the specification is reasonably apt to describe or encompass the registered proprietors' goods. In the circumstances I do not intend to partially revoke the registration.

As the registered proprietors have successfully defended their registration they are entitled to a contribution towards their costs. I order the applicants to pay the registered proprietors the sum of **£535**.

Dated this 29 day of January 1999.

**M REYNOLDS
For the Registrar
The Comptroller General**



Permanent Insulating Formwork

kern-haus

The Ultimate Concrete Walling for Housing

Energy Efficient

U-values better than

0.293 W/m² K - 250mm (unfaced wall)

0.197 W/m² K - 300mm (unfaced wall)

Structurally Efficient

150mm homogeneous in-situ concrete core

Loadbearing - 30 N/mm²

Site Labour Efficient

Assembly Rate - calculated in "square metres per manhour"

Striking Rate - ZERO (the ultimate striking rate)

Well Engineered

Concrete placed by pump in storey-high lifts.

Accommodates such reinforcement as may be specified

Can be assembled around prefabricated reinforcement

Vibration of concrete permitted

Ideal curing conditions for concrete

Precision moulded expanded polystyrene mouldings

CFC-free fire-retardant non-toxic EPS mouldings

Joint-free NO COLD BRIDGES NO FIRE BRIDGES

HIGH VALUE materials LOW labour COSTS

(RHODIPOR and ECOBUILD are Registered Trademarks)