

O-090-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2404830
BY ANTHONY O GORMAN
TO REGISTER THE TRADE MARKS (A SERIES OF TWO):**

hymac

HYMAC

IN CLASSES 7 AND 12

AND

**THE OPPOSITION THERETO
UNDER NO 94505
BY
HYDAC TECHNOLOGY GMBH**

Trade Marks Act 1994

**In the matter of application no 2404830
by Anthony O Gorman
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and the opposition thereto
under no 94505
by Hydac Technology GmbH**

Introduction

1) On 25 October 2005 Mr Anthony O Gorman applied to register **hymac** and **HYMAC** as a series of two trade marks. The application was published for opposition purposes on 21 April 2006 with the following specification:

*construction machines; excavators tracked and wheeled; mini diggers; rollers;
dozers; tractors; forklifts; dumpers forward tip and rear tip.*

The above goods are in classes 7 and 12 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 21 July 2006 Hydac Technology GmbH, which I will refer to as HTG, filed a notice of opposition to registration of the application. HTG opposes the trade mark under section 5(3) of the Trade Marks Act 1994 (the Act). It relies upon four trade mark registrations in support of its opposition:

- Community trade mark registration no 44347 of the trade mark HYDAC. The application to register the trade mark was made on 1 April 1996 and the registration procedure was completed on 5 November 1998. The registration encompasses goods and services in classes 6, 7, 8, 9, 11, 12, 16, 17, 24 and 42, however, HTG only relies upon the goods in classes 7 and 12, namely:

hydropneumatic storage units being machine parts; hydraulic, hydropneumatic and reflective sound, vibration and pressure dampers; filters and membrane filters being machine parts and for land, air and water vehicles, filter apparatus, filter equipment and filter installations, filter elements and membrane filters being parts of machines, vehicles and motors for filtering liquid and/or gaseous media of differing viscosity and composition; heat exchangers (parts of machines) for stationary and mobile application for exchanging heat between liquids and/or gaseous media; shut-off equipment, shut-off apparatus, stop valves and valves being parts of machines and vehicles, in particular for hydraulic and pneumatic

fuels and media, in particular flow control valves, directional control valves, pressure valves with indicators and monitors, vent valves; control apparatus being parts of machines and vehicles, in particular for hydraulic and pneumatic installations, in particular transition coils and control blocks; hydraulic and pneumatic control units consisting of at least one valve or several valves, including directional control valves, pressure valves and flow control valves; hydraulic or pneumatic operating cylinders; hydraulic or pneumatic drive units for land, air and water vehicles and being parts of machines, in particular for materials processing for general machine construction and for vehicles, in particular for construction machines, for machine tools, machines for manufacturing plastics, for drives for tools, for presses, for transport installations, for sea and air travel, for chemical and reactor technology, for mining and iron and steel works, and for rolling mills, in particular consisting of at least one hydraulic pump, at least one drive motor and at least one container of metal or plastic for liquids; hydraulic motors; control apparatus, in particular electric, electro-mechanical and electro-hydraulic control apparatus (included in class 7); dosage dispensers, lubricating apparatus and equipment, lubricating installations, supply apparatus, in particular distributors for stationary and mobile application; mechanically operated clamping apparatus, clamping machines and clamping tools; hand operated or motor driven hydraulic pressure and feed pumps, adjustable and non-adjustable; mechanical instruments, devices and equipment parts for manufacturing and engineering; hydraulic drive units for elevator and lift operating apparatus, in particular consisting of a hydraulic pump, a drive motor and a container of metal or plastic for liquids;

hydropneumatic storage units for land, air and water vehicles; control apparatus for vehicles.

The above goods are in classes 7 and 12 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- United Kingdom registration no 871202 of the trade mark HYDAC. The application to register the trade mark was made on 3 November 1964. The trade mark is registered for the following goods:

hydraulically operated valves (being parts of machines); hydraulic pumps; and hydraulic actuating mechanisms.

The above goods are in class 7 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- United Kingdom registration no 1476689 of the trade mark HYDAC. The application to register the trade mark was made on 13 September 1991 and the

registration procedure was completed on 17 March 1995. The trade mark is registered for the following goods:

machines and machine tools, all for use in the field of fluid and gas technology; machine coupling and belting; hydraulic and pneumatic machines and motors; elevators, hoists, lifts, conveyor belts; control and fuse fittings for gas and/or fluid apparatus and gas and/or fluid pipes, all being parts of machines; filters and membrane filters, all being parts of machines; filter apparatus, filtration plants; filter elements, being parts of apparatus, filtration plants and machines; heat exchangers for stationary and mobile application of heat exchange between liquid and/or gaseous substances; shut-off appliances and apparatus; stopcocks and valves, all being machine parts for hydraulic and pneumatic driving and powering mechanism; flow control valves, directional valves, pressure valves with indicators and monitors, vent and aeration valves; operating mechanisms being machine parts for hydraulic and pneumatic installations; operating and controlling mechanisms, all being elevator, hoist and lift control gears; hydraulic and pneumatic control units, all being directional valves, pressure valves and flow control valves; hydraulic and pneumatic working cylinders; hydraulic and pneumatic drive assemblies, all being machine parts for building machines, machine tools, plastics processing machines, for the propulsion of tools, presses, conveying machines, chemical and reactor technology, mining and foundry and for rolling mills; hydraulic drive assemblies for elevator, hoist and for lift control gears; operating mechanisms and regulators, all for machines; apparatus for supplying measured quantities of any substances for lubricators; lubricating apparatus; grease appliances; mechanically and manually operated gripping apparatus, all being machines or parts thereof; stretching machines; hand-operated and motor-driven hydraulic pressure and feed pumps; electro-technical and mechanical apparatus and parts and fittings therefor, all for production engineering and materials processing; hydraulic, hydro-pneumatic and reflective sound absorbers, vibration absorbers and pressure impact absorbers, resonators, dampers, hydro-pneumatic accumulators, filters and membrane filters, filter elements for filtration of liquid and/or gaseous substances of various viscosities and of variable composition, hydraulic and pneumatic drive assemblies, valves being parts of machines; parts and fittings for all the aforesaid goods; all included in Class 7.

The above goods are in class 7 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- United Kingdom registration no 1476692 of the trade mark HYDAC. The application to register the trade mark was made on 13 September 1991 and the registration procedure was completed on 11 November 1994. The trade mark is registered for the following goods:

valves for vehicle tyres; anti-pollution filters for exhaust gases of internal combustion engines; all included in Class 12.

The above goods are in class 12 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

HTG claims that it has used the trade mark HYDAC in relation to all of the goods listed above within five years of the date of the publication of Mr O Gorman's application. It also claims that it has a reputation in respect of all of the goods listed above.

3) HTG claims:

“The opponent, directly, and through its UK subsidiary is a leading manufacturer of industrial and engineering components in the fluid technology sector. The application differs from the opponents established and well known trade mark HYDAC, by only one letter. It is submitted that use and registration of the term HYMAC, in relation to machinery dilutes and devalues the opponent's reputation in their trade mark HYDAC.”

HTG seeks the refusal of Mr O Gorman's application in its entirety.

4) Mr O Gorman filed a counterstatement. In his counterstatement Mr O Gorman did not require HTG to prove use of its earlier trade marks (as HTG is only relying upon section 5(3) of the Act and so has to show reputation, this is an academic point). In his counterstatement Mr O Gorman states that HYMAC excavators have been known throughout the world since 1956. They were built in Wales. The machines have iconic status in the excavator world. The name HYMAC has precedence over HYDAC. The only way that there could be confusion is if the names were not correctly spelt. Mr O Gorman has never come across HYDAC as a name or a company either on the Internet or in any other search that he has conducted. If HYMAC is entered on the Internet HYMAC comes up, never HYDAC. Mr O Gorman considers that the opposition is without substance.

5) Both sides have had evidence accepted into the proceedings.

6) A hearing was held on 20 March 2008. HTG was represented by Mr Bruce Marsh of Wilson Gunn. Mr O Gorman represented himself.

Evidence

Witness statement of George Muscat for HTG

7) Mr Muscat has been managing director of Hydac Technology Limited (HTL) since 1 April 1999. HTL is part of the Hydac Group and acts as a distributor and service

provider for HTG. HTL has made use of the HYDAC trade mark in the United Kingdom with the full knowledge and permission of HTG.

8) The trade mark HYDAC was first used in trade by HTL in the United Kingdom in 1997. (HTL has previously been known as Hydac-Flupac Limited and Flupac Limited.)

9) HYDAC has been used on industrial and engineering components in the fluid technology sector since 1997. Mr Muscat states that HYDAC has been used in relation to the following:

filters and filtration systems for hydraulics;
process filtration;
accumulators;
fluid service products;
coolers;
electronics and sensors;
diagnostic equipment for hydraulic systems;
valves and manifold assemblies;
accessories and clamps;
compact hydraulics and mini hydraulic power packs;
hydraulic systems and assemblies;
related consultancy services;
related distribution services.

(The italicised goods would appear to be alien to classes 7 and 12; the services are clearly alien to classes 7 and 12. As the opposition is based on class 7 and 12 goods only, I cannot see that use in relation to these goods can assist HTG.)

10) Turnover figures for Great Britain, in euros, of the companies in the Hydac group, which use the HYDAC trade mark with the permission of HTG, for the goods and services listed above are given below:

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	1997	1998	1999	2000	2001	2002	2003	2004	2005	2006
Hydac Technology	1,357,579	1,233,660	1,032,802	1,483,612	974,104	1,179,836	1,314,983	1,593,248	1,755,870	3,245,736
BSO	38,314	9,727	3,906	2,298						
Hydac Filtertechnik	2,243,031	1,850,614	1,853,888	2,189,476	1,978,550	2,097,529	2,226,507	2,087,247	2,722,616	2,547,856
Hydac System						1,623	123,023	122,385	128,801	217,994
Hydac Fluidtechnik	723,768	594,669	573,338	531,330	623,148	470,056	439,606	513,043	537,423	533,715
Hydac Electronic	106,491	114,849	98,930	112,997	117,435	134,496	119,393	151,534	136,346	160,786
Hydac Service										48,727
Hydac Accessories	181,858	254,768	245,185	247,906	277,242	347,313	465,310	351,468	308,575	339,334
Hydac Process Tech		63,226	21,000	41,452	42,350	80,161	162,102	235,114	153,014	237,211
Hydac Cooling										11,596
Total	4,651,041	4,121,513	3,829,049	4,609,071	4,012,829	4,311,014	4,851,286	4,850,924	5,742,645	7,342,955
Sterling equivalent*			2,527,172	2,903,714.	2,407,697	2,802,159	3,347,387	3,250,119	3,847,572	5,066,638.

*The sterling euro rate as of 30 June (the mid-point of the year) for each of the above years from 1999 was 0.66, 0.63, 0.60, 0.65, 0.69, 0.67, 0.67 and 0.69 respectively has been used to effect the conversion. (These figures are derived from Oanda.com. Oanda.com does not have historical date for 1997 and 1998.) The 2006 turnover figures cannot assist the claim to reputation by HTG as the material date for the proceedings is 25 October 2005.

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11) Pages from HTL's website are exhibited. These pages were downloaded on 15 March 2007 but bear a copyright date of 2005. The products of HTL are placed into the following categories: filters, accumulators, fluid service products, coolers, electronics, compact hydraulics and valves, clamps & accessories.

12) The pages from the website describe the categories of products in the following terms:

- Filtration technology – “Components and systems for filtering solid, liquid and gaseous contamination and for extracting water from hydraulic, lubricating, non-flam and biological operating fluids”.
- Accumulator technology – “Components and systems of all types of hydraulics accumulator – bladder, piston and diaphragm accumulators, hydraulic dampers”.
- Fluid engineering – “Hydraulic Fluid Engineering is a comprehensive package of technical services for our end customers”.
- Cooling systems – “Modular series of components and systems in cooling technology. Application-based engineering designs, developed and manufactured in product-orientated laboratories, testing and production facilities for applications in mobile and industrial machines and systems”.
- Electronics – “Measurement Technology. Solenoid and Vehicle Technology. Components, sensors and systems in electronic measurement technology, analysis, diagnostics, control, regulation and solenoid technology, including the best EMC characteristics”.
- Accessories – “Ball valves and ball valve controls for fluid and gaseous media. Display and monitoring units for fluid level and pressure. Rigid and flexible elements and systems of mounting technology for pipes, hoses, cables, reservoirs and machine components.”
- Compact Hydraulics – “Components, modules, sub-systems, complex drive units and controls including electronics, developed in state-of-the-art laboratories, supported by field trials, manufactured in modern production facilities, tried and tested in the toughest applications. Range of valves in cartridge technology, pressure, flow control, shut-off valves, directional valves, leak-free directional seat and proportional valves, nominal sizes from 1 to 20. Solenoid valves with specially developed and adapted solenoid systems, highly efficient and resistant to high pressure. Compact power units and drive units for medium and high pressure”.

13) A list of distributors and service partners for HYDAC products in the United Kingdom is exhibited; this was downloaded from HTL's website on 15 March 2007. The distributors are in Leicestershire, Walsall, Cwmbran, Exeter, Worcester, Tyne & Wear, Bolton, Middlesbrough, Reigate, Huddersfield, Rotherham and Derby. The service partners are in Norfolk, Tyne & Wear, Leeds, Middlesbrough, Walsall, Glasgow, Tewkesbury and Coventry.

14) HTL's goods and services are promoted by a monthly advertisement in *Hydraulics and Pneumatics* magazine, a trade magazine relating to the fluid technology industry.

There is also promotion in other journals such as *Engineering*. No copies of the magazines or the advertisements have been exhibited.

15) The trade mark has been used on the goods and services listed in paragraph 9 in all parts of the United Kingdom. HTL's customers include JCB, CAT, Terex, Vetco-Gray, Corus and most companies associated with hydraulic systems.

16) Mr Muscat is aware of HYMAC as the name of a manufacturer of earth moving machinery which went into receivership in 1983.

Evidence of Mr O Gorman

17) The evidence of Mr O Gorman is not in the proper format. Evidence in proceedings before the Office has to be way of witness statement, statutory declaration or affidavit¹. A witness statement must be verified by a statement of truth and must conform to the practice and procedure of the High Court. Mr O Gorman has headed his evidence with the title 'witness statement' but there is no statement of truth. Consequently, the evidence should not have been admitted into the proceedings. In the normal course of events I would have two options in dealing with the evidence:

- 1) To take no cognisance of the evidence and make no comment upon the evidence.
- 2) To return the evidence to Mr O Gorman in order that it can be regularised.

(Mr O Gorman's initial evidence was rejected by the Trade Marks Registry (TMR), in a letter dated 11 July 2007, as it did not comply with the Trade Marks Rules 2000 (as amended) (the Rules), in that it was not in proper evidential form. As the result of an apparent oversight the revised evidence was admitted into the proceedings.) In this case, having considered the evidence, I do not consider that I need to follow either course of action.

18) Mr O Gorman has not been legally represented but, of course, he still has to conform to the requirements of the Rules. There is not one law for those with legal representation and those without; the law must apply and be applied equally to both sides in a dispute. In this case I will summarise Mr O Gorman's evidence in order that he can be assured that it has been considered; I do so as the contents of his evidence have no bearing upon the outcome of the case and so will not weigh in my reaching my decision.

19) Mr O Gorman is the registered owner of trade mark registration on 2404714 for the trade mark HY-MAC. The application for registration was filed on 24 October 2005 and the registration process was completed on 4 August 2006. It is registered for:

construction machines, farm machines, excavators tracked and wheeled, cranes, rollers, mini diggers;

quad bikes, tractors, fork lifts, dumpers.

The above goods are in classes 7 and 12 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

20) The name HYMAC has been in use on construction machinery since 1965. The original tracked excavator was made by Hymac Ltd, Wales. Mr O Gorman is designing construction equipment and will market it under the HYMAC name. He has no connection with the original Hymac company but is very proud of the Hymac legacy in relation to its design of undercarriages and servo controls. Mr O Gorman wants to take the HYMAC name forward and to protect it.

21) Mr O Gorman owns various domain names commencing with hymac or hy-mac.

Witness statement of Judith Tonner for HTG

22) Ms Tonner is a trade mark attorney. Her evidence consists of a commentary/critique on the contents of the evidence of Mr O Gorman. There is no evidence of fact in her statement and so I will say no more about it.

Sections 5(3) of the Act

23) Section 5(3) of the Act reads:

“(3) A trade mark which is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

24) In order for the ground under section 5(3) of the Act to be considered must establish that the trade mark at the date of the application for registration was known by “a significant part of the public concerned by the products or services coveredⁱⁱⁱ”. In relation to the Community trade mark HTG has to establish that it has the requisite reputation in the European Union, not just the United Kingdomⁱⁱⁱ.

25) The turnover figures supplied by HTG do not identify specific goods to which they pertain. They divide the turnover by reference to Hydac group companies. There are goods and services included in the turnover figures which are not included in the claim in relation to reputation; there is no claim at all to reputation in relation to services. *Electronics and sensors* and *diagnostic equipment for hydraulic systems* are not included in the goods for which it is claimed that there is a reputation; these are class 9 goods, as are solenoids and solenoid valves to which reference is made in the evidence. There is no indication as to the cost of the goods involved or the number of goods that have been sold. HTG refers to companies to which it has supplied goods but does not identify the

nature of the goods (or services) which it supplies to the individual companies. The fact that it supplies goods to “most companies associated with hydraulic systems” tells me little as I don’t know which specific goods have been supplied to these companies. There is no indication of market share at all, so it is impossible to ascertain how big a player HTG is in relation to the goods in which it claims a reputation. The 2006 turnover figures, which relate to a period after the material date, show a substantial increase from the 2005 figures and so indicate that there was room for expansion in the market. To establish that its trade mark HYDAC was known by a significant part of the public concerned with the products covered, it would be necessary, at the very minimum, to consider the sales figures within a context of market share. In relation to goods which are of a fairly specialised and technical nature, it would also be helpful to have evidence from the trade; in order to glean the perception of the relevant consumer. From the evidence furnished by HTG it is difficult to gain a clear view of the market in which it operates. Mr Marsh commented on several occasions that HTG had been trading for a number of years in the United Kingdom. I cannot see that this can equate to establishing the necessary reputation; otherwise any undertaking with sufficient longevity could lay claim to protection under section 5(3) of the Act. If it had furnished copies of the periodicals in which it advertises, this could have assisted. It may be that HTG at the material date did have the appropriate reputation in relation to specific goods but on the basis of the evidence I simply cannot find that such a reputation in the United Kingdom existed at the material date. *A fortiori* the position of HTG is worse in relation to its Community trade mark registration as there is no evidence in relation to the position in the European Union, outside of the United Kingdom (although I note that it has a distributor in Ireland).

26) As HTG has failed to substantiate its claim to a reputation the ground of opposition under section 5(3) of the Act must be dismissed.

COSTS

27) Mr O Gorman has been successful and is entitled to a contribution towards his costs. Mr O Gorman has not been represented in this case. In *Adrenalin Trade Mark*, BL O/040/02, Simon Thorley QC, sitting as the appointed person, observed that:

“8 It is correct to point out that the Registrar’s practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.”

Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

“48.6—(1) This Rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

Consequently, the **maximum** that Mr O Gorman can receive is two thirds of the scale costs. I award costs on the following basis:

Considering the notice of opposition	£100
Statement of case in reply	£100
Considering evidence of opponent	£100
Preparation for and attendance at hearing	£100
Total	£400

Owing to the nature of Mr O Gorman’s evidence I do not consider that it is appropriate to make any costs award in relation to it.

28) I order Hydac Technology GmbH to pay Mr Anthony O Gorman the sum of £400. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28 day of March 2008

David Landau
For the Registrar
the Comptroller-General

ⁱ Rule 55 (1-4) of the Trade Marks Rules 2000 (as amended) states:

“(1) Where under these Rules evidence may be admitted by the registrar in any proceedings before her, it shall be by the filing of a statutory declaration or affidavit.

(2) The registrar may in any particular case take oral evidence in lieu of or in addition to such evidence and shall, unless she otherwise directs, allow any witness to be cross-examined on his statutory declaration, affidavit or oral evidence.

(3) Where these Rules provide for the use of an affidavit or statutory declaration, a witness statement verified by a statement of truth may be used as an alternative; the Registrar may give a direction as she thinks fit in any particular case that evidence must be given by affidavit or statutory declaration instead of or in addition to a witness statement verified by a statement of truth.

(4) The practice and procedure of the High Court with regard to witness statements and statements of truth, their form and contents and the procedure governing their use are to apply as appropriate to all proceedings under these Rules.”

ⁱⁱ *General Motors Corporation v Yplon SA* Case C-375/97 [2000] RPC 572.

ⁱⁱⁱ See the decision of Richard Arnold QC, sitting as the appointed person, in *Mobis Trade Mark* BL O/020/07:

“30. The opponent contends that, where an opponent relies upon a Community trade mark, it is sufficient for the purposes of section 5(3) to show that it has a reputation in the United Kingdom and that the hearing officer was wrong in law to hold that it was required to show a reputation in the Community.

31. I am unable to accept this argument. Section 5(3) on its face expressly distinguishes between what is required in the case of an earlier national mark, namely “a reputation in the United Kingdom”, and what is required in the case an earlier Community trade mark, namely “a reputation ... in the European Community”. This distinction reflects the difference between Article 4(4)(a) of the Directive, which requires that “the earlier [national] trade mark has a reputation in the Member State concerned”, and Article 4(3), which requires that “the earlier Community trade mark has a reputation in the Community”. The same distinction is also to be found in Article 5(5) of Council Regulation 30/94 of 20 December 1993 on the Community trade mark. I cannot see any basis on which the Act, the Directive and the Regulation can be interpreted as merely requiring that the Community trade mark relied upon should have a reputation in the Member State in question. Nor did the opponent’s attorney cite any authority or commentary to support such an interpretation. Furthermore, as the applicant’s attorney pointed out, the judgment of the ECJ in Case C-375/97 *General Motors Corp v Yplon SA* [1999] ECR I-5421 at [25]-[29], while not directly on point, tends to support the opposite interpretation.

32. It follows that the hearing officer did not make the error of law alleged.”