

1 THE PATENT OFFICE  
2 TRADE MARKS REGISTRY

3 Harmsworth House,  
4 13 - 15 Bouverie Street,  
5 London EC4.  
6 Wednesday, 12th April 2000

7 Before:

8 MR. G. HOBBS QC  
9 (Sitting as the Appointed Person)

10 -----  
11 IN THE MATTER OF THE TRADE MARKS ACT 1994

12 and

13 IN THE MATTER OF APPLICATION NO. 2126888 in  
14 the name of CASWICK LIMITED

15 and

16 OPPOSITION NO. 47537 thereto  
17 by THE THOMPSON MINWAX COMPANY

18 -----  
19 Appeal of the Opponent from the decision of Mr. D. Landau,  
20 acting on behalf of the Registrar, dated 5th July 1999

21 -----  
22 (Transcript of the Stenograph Notes of Marten Walsh Cherer  
23 Ltd., Midway House, 27/29 Cursitor Street, London EC4A 1LT.  
24 Telephone No: 0171-405 5010. Fax No: 0171-405 5026)

25 -----  
26 The Appellants/Opponents and Respondents/Applicants did not  
appear and were not represented.

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D E C I S I O N  
(As approved)  
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1 MR. HOBBS: On 15th March 1997, Caswick Limited applied to  
2 register the word CONSEAL for use as a trade mark in relation  
3 to a specification of goods ultimately limited to "extruded  
4 sealants for building products; but not including fire  
5 resistant materials or products specifically designed to  
6 incorporate fire resistant properties" in Class 17. The  
7 application was advertised for opposition purposes in June  
8 1997.

9 In September 1997, a notice of opposition was filed by  
10 Messrs. Dibb Lupton Alsop in the name of a Delaware  
11 Corporation called The Thompson Minwax Company. The statement  
12 of grounds accompanying the Notice of Opposition stated that  
13 The Thompson Minwax Corporation was the proprietor of ten  
14 specified trade mark registrations and two specified trade  
15 mark applications in the United Kingdom. It went on to assert  
16 that the company had used the word RONSEAL extensively in  
17 relation to the goods and services covered by the cited  
18 registrations and applications, and had thereby established a  
19 substantial goodwill and reputation in the mark RONSEAL in the  
20 United Kingdom. On the basis of these averments, relative  
21 objections to registration were raised under sections 5(2)(b),  
22 5(3) and 5(4) of the Trade Marks Act 1994. Absolute  
23 objections to registration were raised under sections 3(3)(b),  
24 3(4) and 3(6) of the Act. Caswick joined issue with these  
25 pleas in a counter-statement filed in December 1997.

26 On 6th April 1998, the Registrar issued a certificate of

1 assignment pursuant to an application received at the Trade  
2 Marks Registry on 5th March 1998. The certificate confirmed  
3 that The Sherwin Williams Company had been registered as  
4 proprietor of the trade marks cited in the statement of  
5 grounds filed in support of the opposition. According to the  
6 papers before me, The Sherwin Williams Company is a company  
7 organised and existing under the laws of the State of Ohio.  
8 It was the surviving corporation of a merger which took place  
9 under the laws of the State of Delaware with effect from  
10 11.59 pm on 31st March 1997. By means of that merger, three  
11 Delaware corporations, The Thompson Minwax Company, Thompson  
12 Minwax Holding Corp, and Thompson Minwax Management Corp, were  
13 merged with and into The Sherwin Williams Company.

14 The effect of the merger on the status of the companies  
15 involved is governed by the laws of Delaware. No evidence has  
16 been adduced as to the operation of the laws of Delaware in  
17 that connection. My understanding of the position disclosed  
18 by the documents is that the three Delaware corporations  
19 ceased to exist at the point in time at which they were merged  
20 with and into The Sherwin Williams Company, and that The  
21 Sherwin Williams Company thereupon became the successor to the  
22 rights and obligations of the extinguished corporations.  
23 Messrs. Dobb Lupton Alsop and their clients appear to accept  
24 that this was the nature and effect of the merger.

25 On that view of the matter, the Notice of Opposition  
26 filed by Messrs. Dobb Lupton Alsop in September 1997 was filed

1 in the name of a non-existent corporation. Evidence was filed  
2 in support of the opposition in March 1998. This consisted of  
3 two statutory declarations. The first of these was a  
4 statutory declaration made by Paul Barrow, the managing  
5 director of Ronseal Limited, on 12th March 1998. Mr. Barrow  
6 referred to the merger in passing in paragraph 1 of his  
7 statutory declaration: "My Company is a UK exclusive licensee  
8 and wholly owned subsidiary of the Opponents, whose company  
9 has recently been bought and merged with The Sherwin Williams  
10 Company of 101 Prospect Avenue, NW, 1100 Midland Building,  
11 Cleveland, Ohio, 44115-1075, USA."

12 The second statutory declaration was made by Alan  
13 Fiddes, head of trade marks at Messrs. Dibb Lupton Alsop, on  
14 24th March 1998. He says that he is authorised by "the  
15 Opponents" to make his declaration on their behalf. He says  
16 he has read the declaration submitted by Mr. Paul Barrow on  
17 behalf of "the Opponents". He exhibits as his exhibit AMF1,  
18 certified copies of what he describes as "the Opponent's  
19 registration numbers 1391655, 738414 and 797931". He goes on  
20 to say that "the evidence submitted by the Opponents  
21 demonstrates that the RONSEAL name has become well known in  
22 the United Kingdom in respect of the products sold by the  
23 Opponents, and that there has been substantial reputation and  
24 goodwill developed in association with the RONSEAL name".

25 The named opponent was The Thompson Minwax Company and  
26 these statutory declarations were expressed in terms which

1 suggested that The Thompson Minwax Company continued to exist  
2 and continued to own the earlier trade marks and rights  
3 asserted against Caswick's application for registration. They  
4 did so even though they were made after the application for  
5 recordal of a transfer which had been filed at the Trade Marks  
6 Registry on 5th March 1998 for the purpose of confirming the  
7 succession of The Sherwin Williams Company to the rights and  
8 obligations of The Thompson Minwax Company on 31st March  
9 1997.

10 Caswick filed evidence in answer to the opposition in  
11 September 1998. Its evidence did not comment upon either the  
12 existence or the identity of the named opponent.

13 The evidence in reply consisted of a second statutory  
14 declaration of Alan Fiddes filed under cover of a letter to  
15 the Registry dated 15th December 1998. The covering letter  
16 stated as follows: "Following the merger of The Thompson  
17 Minwax Company and The Sherwin Williams Company. The Sherwin  
18 Williams Company has been recorded as proprietor of the  
19 earlier rights relied upon in this opposition. It is  
20 therefore requested that the name of the Opponents be amended  
21 from The Thompson Minwax Company to The Sherwin Williams  
22 Company. The Sherwin Williams Company have confirmed to us  
23 that they have seen all of the documentation relating to the  
24 opposition, they are willing to stand by the Statement of  
25 Grounds of Opposition, and accept liability for any costs  
26 arising from the opposition."

1           The accompanying statutory declaration reiterated that  
2 ownership of the prior registrations relied upon in the  
3 opposition had been transferred from The Thompson Minwax  
4 Company to The Sherwin Williams Company following the merger  
5 of the two companies.

6           The request for amendment appears to have been made with  
7 reference to the Registrar's practice relating to a change of  
8 opponent upon transfer of the opponent's interest in the  
9 proceedings: see paragraph 3.9 of the June 1996 edition of  
10 Chapter 15 of the Trade Marks Registry Work Manual. However,  
11 that practice envisages the existence of a properly  
12 constituted opposition in which the change of opponent can  
13 legitimately be made following a transfer of the relevant  
14 interest during the pendency of the proceedings. It is not  
15 applicable to a situation in which the transfer of the  
16 relevant interest has occurred prior to the filing of the  
17 opposition, and the Notice of Opposition was filed in the name  
18 of the transferor after it had ceased to exist.

19           The Registry declined to allow the name of the opponent  
20 in the present proceedings to be amended from The Thompson  
21 Minwax Company to The Sherwin Williams Company on the ground  
22 that it would bring about an impermissible substitution of one  
23 opponent for another. Messrs. Dibb Lupton Alsop disputed the  
24 correctness of the position adopted by the Registrar. An  
25 interlocutory hearing was appointed to consider whether the  
26 amendment requested in their letter of 15th December 1998

1 could and should be allowed. The hearing was scheduled to  
2 take place on 19th May 1999. In the event, neither party  
3 chose to attend, but Messrs. Dibb Lupton Alsop lodged written  
4 submissions in support of the application for amendment.

5 In their written submissions, they maintained that their  
6 request was not a request for substitution of a new opponent.  
7 They insisted that it was merely a request to reflect an  
8 administrative change which had taken place in relation to the  
9 opponent by amending the name of the opponent to read The  
10 Sherwin Williams Company as opposed to The Thompson Minwax  
11 Company. Their stated position was that the merger which had  
12 taken place did not constitute an overall change in the legal  
13 entity involved in the opposition, and that the amendment  
14 should be allowed under the practice noted in the Trade Mark  
15 Registry's Work Manual. They also drew attention to the fact  
16 that the amendment was not opposed by Caswick.

17 The application to amend was refused by the Registrar's  
18 Hearing Officer, Mr. D.W. Landau. In his written decision  
19 issued on 5th July 1999, he took the view that the proposed  
20 amendment should be refused, firstly, on the basis that it  
21 would involve the substitution of a new opponent, and the  
22 Registrar had no power under the Trade Marks Act or rules to  
23 allow substitution; secondly, on the basis that the opposition  
24 should be dismissed because it was filed on behalf of a  
25 non-existent person.

26 In August 1999, Messrs. Dibb Lupton Alsop gave notice of

1 appeal from the Hearing Officer's decision to an Appointed  
2 Person under section 76 of the 1994 Act. The appeal was  
3 stayed pending the outcome of an appeal to the High Court in  
4 the case of BETAMAG 12 trade mark because it was foreseen that  
5 the judgment in that case would have a direct bearing on the  
6 first of the two grounds upon which the Hearing Officer had  
7 refused leave to amend in the present case.

8 The judgment of the High Court in the BETAMAG 12 trade  
9 mark case was delivered on 18th January 2000 (and has since  
10 been reported at [2000] IP&T 467). Pumfrey J held that the  
11 Registrar has an inherent power to permit a successor in  
12 interest to pursue properly constituted opposition proceedings  
13 in lieu of the original opponent. The learned judge indicated  
14 that the Registrar's practice, as summarised in paragraph 3.9  
15 of Chapter 15 of the Trade Marks Registry Work Manual,  
16 provided a sensible and workable system for substitution. His  
17 judgment has not been appealed. It is binding both upon this  
18 Tribunal and upon the Registrar. It follows that the first of  
19 the two bases upon which amendment was refused in the present  
20 case cannot be maintained.

21 That leaves me with the question whether the Hearing  
22 Officer's decision can and should be maintained on the second  
23 of the two bases upon which amendment was refused. It appears  
24 to me, on the basis of the judgment in the BETAMAG 12 trade  
25 mark case, and on the basis of the judgments of the Court of  
26 Appeal in **Mercer Alloys Corporation v. Rolls Royce Ltd** [1971]



1 1 WLR 1520, *The 'Sardinia Sulcis' and 'Al Tawwab'* [1991] 1 LLR  
2 201, and *International Bulk Shipping and Services Ltd. v.*  
3 *Minerals and Metals Trading Corporation of India* [1996] 1  
4 All.E.R. 1017, that:

5 (1) When a company which has brought opposition  
6 proceedings in the Trade Marks Registry is merged with and  
7 into another company during the pendency of the proceedings,  
8 the Registrar may allow the successor company to pursue the  
9 opposition in lieu of the original opponent and should  
10 normally do so.

11 (2) However, opposition proceedings brought in the name  
12 of a company which has previously ceased to exist as the  
13 result of such a merger cannot be pursued, and must be  
14 dismissed, if those who caused the Notice of Opposition to be  
15 filed in the name of the non-existent company did so intending  
16 to identify that company rather than its successor as the  
17 opponent.

18 (3) If, on the other hand, there is no reasonable doubt  
19 that the successor, rather than the non-existent company, was  
20 intended to be identified as the opponent, the Registrar has a  
21 discretion to allow an amendment to correct the misnomer.

22 I now turn to examine the application for amendment in  
23 the light of these considerations. Paragraph 2(f) of the  
24 Grounds of Appeal states: "The Registrar is incorrect in the  
25 belief that the Opposition should be dismissed on the basis  
26 that the Opponents had ceased to exist at the time of the

1 Opposition being filed. In this instance, the existence of a  
2 locus standi, and the clear Registry practice at the time,  
3 meant that the Opposition was correctly commenced in the name  
4 of the Opponents."

5 This appears to be the only ground upon which the second  
6 of the two bases for refusing amendment is challenged before  
7 me. I understand it to be asserting that the non-existent  
8 company, The Thompson Minwax Company, was not only identified,  
9 but correctly identified, as the opponent by those who caused  
10 the Notice of Opposition to be filed in the present case.

11 In written submissions filed by Messrs. Dibb Lupton  
12 Also on 5th April 2000, it is contended that the Notice of  
13 Opposition was correctly filed in the name of the non-existent  
14 company on 18th September 1997 because the merger of that  
15 company with and into The Sherwin Williams Company had not yet  
16 been recorded at the Trade Marks Registry, and the  
17 non-existent company was still identified in the Register of  
18 Trade Marks as the proprietor of the trade mark registrations  
19 and applications cited in support of the opposition.

20 In paragraph 5 of the written submissions, it is stated  
21 that: "In the present case, the Opponents had only ceased to  
22 exist by means of a merger, and therefore in essence the  
23 company and all the rights accruing to that company continued  
24 in the merged company, namely The Sherwin Williams Company.  
25 This, in conjunction with Registry practice at the time, means  
26 that there was no reason at the time of filing the Opposition

1 why it should not be filed in the name of the registered  
2 proprietor of the rights relied upon at the time, namely the  
3 Opponents."

4 It seems clear to me from these submissions that the  
5 Notice of Opposition was filed in the name of the non-existent  
6 company because that company, rather than its successor, was  
7 intended to be identified as the opponent.

8 At my request, the Treasury Solicitor wrote to the  
9 Registrar and the parties on 10th April 2000, drawing their  
10 attention to the judgments of the Court of Appeal in the three  
11 cases I have mentioned above. Messrs. Dibb Lupton Alsop then  
12 filed further written submissions in the following terms.

13 "1. The present case can be likened to the cases of  
14 **Mercer Alloys Corporation v. Rolls Royce Limited** (1971) 1 WLR  
15 1520 and **The 'Sardinia Sulcis' and 'Al Tawwab'** (1991) 1 LLR  
16 201, in that following the merger of The Thompson Minwax  
17 Company with and into The Sherwin Williams Company, the  
18 business and assets of The Thompson Minwax Company continued,  
19 and there was a legal successor in title to the business and  
20 its assets. The case can in the same way be distinguished  
21 from the case of **International Bulk Shipping and Services**  
22 **Limited v. Minerals and Metals Trading Corporation of India**  
23 (1996) 1 All.E.R. 1017, in that in that instance the  
24 Plaintiffs had been dissolved, and there was no legal  
25 successor in title to the assets and business and liabilities  
26 of the company.

1           "2. At merger, the liabilities as well as the assets  
2 and business of The Thompson Minwax Company would have been  
3 taken on by The Sherwin Williams Company, the newly merged  
4 company, and in a case where The Thompson Minwax Company would  
5 have been or could be Defendant, The Sherwin Williams Company  
6 would be expected to take on the liabilities and burden in  
7 place of The Thompson Minwax Company. It therefore seems just  
8 and fair that the reverse should be true in a case where The  
9 Thompson Minwax Company/The Sherwin Williams Company would be  
10 claimant/opponent.

11           "3. Given that there has been a merger of The Thompson  
12 Minwax Company with The Sherwin Williams Company, there can be  
13 no mistake by parties to the proceedings as to the identity of  
14 the persons filing the opposition, as this involves the  
15 ongoing business undertaken under the RONSEAL name, the trade  
16 mark upon which the action relies.

17           "4. It has been clear at all points the rights upon  
18 which the parties are relying, such rights being ongoing and  
19 existing after the date of merger.

20           "5. In the interests of fairness and justice, and to  
21 avoid multiplicity of proceedings, and given that the  
22 applicants Caswick Limited have at no point raised any  
23 objection to the substitution, (of which opponents are aware),  
24 we submit that the action should be allowed to continue with  
25 the substitution of The Sherwin Williams Company in place of  
26 The Thompson Minwax Company."

1 I do not find in these submissions any suggestion that  
2 it was ever intended that the Notice of Opposition should be  
3 filed in the name of any person other than the non-existent  
4 company. That appears to me to render the present case  
5 essentially indistinguishable from the **International Bulk**  
6 **Shipping and Services Limited** case.

7 The Registrar and the parties were not represented at  
8 the hearing before me. Doing the best I can, on the basis of  
9 the documents provided to me, I have come to the conclusion  
10 that the Notice of Opposition was intentionally filed in the  
11 name of the non-existent company rather than its successor  
12 with the result that there cannot be said to have been a  
13 misnomer susceptible of correction by amendment in the manner  
14 requested.

15 I therefore consider that the Hearing Officer was  
16 correct to hold that the amendment should be refused. It has  
17 not been suggested that The Thompson Minwax Company can, or  
18 will, be restored to the Register of Companies organised and  
19 existing under the laws of Delaware so as to validate,  
20 retrospectively, the filing of the Notice of Opposition in its  
21 name on 18th September 1997. I therefore consider that the  
22 Hearing Officer was correct to hold that the opposition should  
23 be dismissed because it had been filed on behalf of a  
24 non-existent person.

25 In the result, the appeal stands dismissed. In the  
26 absence of any applications for costs on the part of Caswick

1 or the Registrar, the appeal is dismissed with no order as to  
2 costs. The costs of the opposition proceedings in the Trade  
3 Marks Registry remain to be considered by the Registrar.

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