

O/228/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF THE CONSOLIDATED OPPOSITION UNDER NO 96851**

**BY DAVID PAUL BAMBER**

**IN RESPECT OF APPLICATION NO 2453912**

**BY MILLERS OILS LIMITED**

**AND APPLICATION FOR REVOCATION UNDER NO 83181**

**BY MILLERS OILS LIMITED**

**IN RESPECT OF REGISTRATION NO 2178147**

**OF DAVID PAUL BAMBER**

1) Registration no 2178147 is for the trade mark:



The registered proprietor is David Paul Bamber. The application for registration was filed on 25 September 1998 and the registration procedure was completed on 24 November 2000. The registration is for goods and services in classes 3, 4, 11, 37 and 40 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. These consolidated proceedings only concern the class 4 goods, namely:

*industrial oil and greases; lubricants; dust absorbing, wetting and binding compositions; fuel (including motor spirit).*

Mr Bamber only relies upon these goods in his opposition and Millers Oils Limited (Millers) only seeks revocation of the registration in respect of these goods.

2) Section 46 of the Trade Marks Act 1994 (the Act) states:

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

(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;

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

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(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.

(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.

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.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that——

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from——

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

Section 100 of the Act states:

“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.”

Consequent upon section 100, in revocation for non-use proceedings the onus is upon the registered proprietor to prove that he has made genuine use of a trade mark, or that there are proper reasons for non-use.

3) In relation to the application for revocation for non-use Millers relies upon both sections 46(1)(a) and (b) of the Act. Millers states that Mr Bamber’s registration has not been used in respect of the class 4 goods since the date of registration nor in the five year period from 8 April 2003 to 7 April 2008. It seeks revocation of the trade mark in respect of the class 4 goods from 25 November 2005, under section 46(1)(a) of the Act, and from 8 April 2008, in respect of section 46(1)(b) of the Act.

4) Mr Bamber denies that the trade mark had not been used for the class 4 goods in the material periods. Mr Bamber comments upon the motivation of Millers in seeking revocation of the trade mark registration. The motivation of an applicant is not pertinent. Any person may seek the revocation of a registration on the grounds of non-use and whether the revocation succeeds is simply a matter of fact. In *La Mer Technology Inc v Laboratoires Goemar SA* [2001] EWHC 492 (Ch), Jacob J commented upon why non-use provisions are important:

“There is an obvious strong public interest in unused trade marks not being retained on the registers of national trade mark offices. They simply clog up the register and constitute a pointless hazard or obstacle for later traders who are trying actually to trade with the same or similar marks. They are abandoned vessels in the shipping lanes of trade.”

In this case Millers has filed the application for revocation as it considers that Mr Bamber has not used his trade mark for goods in class 4 and it wishes to use its trade mark; the registration of which Mr Bamber has opposed.

5) On 27 April 2007 Millers applied to register the trade mark ECLIPSE. The application was published for opposition purposes on 11 January 2008 with the following specification:

*industrial oils and greases; lubricants; lubricating oils and greases; fuels, including gasoline and diesel fuels for motor vehicles; non-chemical additives for fuels, lubricants and greases; gear oils; transmission oils.*

The above goods are in class 4 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.

6) The opposition was the subject of a joint hearing on 27 August 2009. A written statement of grounds was issued on 9 October 2009. No appeal was lodged against the decision. The basis of the opposition proceedings is based on the decision made as a result of the aforesaid hearing and the consequent amended pleadings. (Also, Mr Bamber, on two occasions, has tried to adduce without prejudice material into the proceedings. These attempts were the subject of a decision issued on 26 April 2011; in which the without prejudice material was excluded from the proceedings.)

7) The opposition is based on sections 3(6) and 5(2)(b) of the Act. Section 3(6) of the Act states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

Mr Bamber states:

“It is submitted that the application is made in bad faith in that the applicant’s behaviour shows a lack of integrity and falls markedly below the standard of commercial behaviour, which would be regarded as acceptable by the community at large, as set out in the following paragraphs.

The applicant selected the name ECLIPSE for a product and proceeded to advertise and sell the product before taking steps to register the name ECLIPSE as a trade mark in class 04. Having, belatedly, submitted an application for registration, the applicant discovered that there was an existing similar trade mark (ie. ECLIPS) registered for class 04 goods.

The applicant was thus confronted with a problem of his own making, which he could easily have avoided. Subsequently he sought to remedy his failure and achieve his own ends by bullying and threatening the opponent, ignoring Trade Mark Registry guidance in the process.

A letter MAS/T1171133GB dated 29 August 2007 from the applicant’s agent to the opponent states:

‘Miller Oils Limited wishes to cancel your registration in relation to these goods (ie. Class 4 understood). It would be more advantageous however if you voluntarily withdraw your application in relation to Class 4 goods only. Our client is aware that your mark falls also in classes 2, 3, 11, 37 and 40, and it is happy to refrain from cancelling your mark in relation to any of these goods and services, many which it knows are not used by you.’

This can only be reasonably interpreted as, 'If you do not give up Class 4 voluntarily as we suggest, then you are in grave danger of us (Miller Oils) taking whatever action we can to revoke all of your classes and put you out of business.' It is understood that Miller Oils has no use in its commercial activities for classes 2, 3, 11, 37 and 40 of the ECLIPS trade mark.

This bullying and threatening approach by Miller Oils, a large established company, is regarded as an attempt to intimidate a small developing company with limited resources into complying with their demands.

The opponent has made considerable efforts by letter and telephone offering to meet the applicant with a view to negotiating a solution acceptable to both parties. These efforts have been ignored and the applicant has made it clear that it has no intention of entering into any discussions with the opponent.

It is submitted that the combination of circumstances set out above, - the failure to comply with normal commercial practice, the bullying and threatening attitude of a large company towards a small company and the failure to make any real effort to achieve a negotiated settlement in contravention of Trade Mark Registry guidance – indicates a general lack of integrity and amounts to bad faith on the part of the applicant in seeking to register its trade mark.”

8) In this pleading Mr Bamber sets out no basis for claiming that the application was made in bad faith; ie that the filing of the application on 27 April 2007 was an act of bad faith. He attacks the behaviour of Millers following the application; behaviour which in no way reflects upon the position at the date of the filing of the application. He claims that Millers did not make a clearance search, whether a clearance search is made or not is not representative of an act of bad faith. **As there is no basis in the pleadings for finding that the application was made in bad faith, this ground of opposition must be dismissed.** (Mr Bamber interprets the letter referred to above as stating the exact opposite of what is written, ie that Millers will not attack the other classes. He decries that Millers will not negotiate. There is no requirement in law or under the practice of the registrar for parties to negotiate. Parties will decide what they consider the appropriate course of action. The letter, seeking voluntary cancellation, relates to behaviour that is common and normal. Mr Bamber was given the opportunity to avoid litigation. He made the decision that he wished to become involved in litigation. Millers had decided that, in class 4, Mr Bamber's trade mark was an abandoned vessel and has taken action in relation to this.)

9) Section 5(2)(b) of the Act states:

“(2) A trade mark shall not be registered if because -

.....  
(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Mr Bamber relies upon the class 4 goods of the registration which is the subject of the application for revocation. Consequently, if the section 46(1)(a) ground is successful the opposition must fail as at the date of the application for registration, the registration would be revoked in respect of these goods. In its counterstatement Millers also seeks proof of use of the class 4 goods upon which Mr Bamber relies, as per section 6A of the Act <sup>1</sup>. The material period for proof of use in relation to the earlier trade mark is 12 January 2003 to 11 January 2008.

10) Only Mr Bamber adduced evidence to the proceedings.

11) Mr Bamber filed three sets of submissions and Millers two sets of submissions.

12) The Court of Justice of the European Union (CJEU) in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 stated:

“36. “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

Mr Bamber must establish that his trade mark has been used for the class 4 goods of his registration to create or preserve an outlet for the goods and that the use is warranted in the economic sector concerned.

13) The evidence of Mr Bamber shows that no class 4 goods have been produced or sold under the trade mark. Mr Bamber must then rely upon showing that he has been creating a share of the market for goods under the trade mark.

14) Mr Bamber has been developing an environmental closed loop incineration process (ECLIPS). He has been trying to sell the process around the world. Most of the evidence points to him offering process design (as per slide 13 of exhibit E14). As part of the process, waste products are produced, which may be sold. Slide 11 of E4 gives a list of the waste products and their potential uses:

<u>Carbon Dioxide</u>	-	Cleaning	-	Clothes / Buildings / Car Parts
		Fire Safety	-	Fire Extinguishers
		Fumigation	-	60% Wheat & Rice Food Storage
		Refrigeration	-	Transport of Food
		Market Garden	-	High Vegetable Growth
		“Fizzy” Drinks	-	Bubbles in Coca Cola
		Food Industry	-	Fat Free Milk - Caffeine Free Coffee
		Oil Industry	-	Increases oil well production
<u>Oxygen</u>	-	Re-use in Eclips	-	Efficiency/Economy
<u>Nitrogen</u>	-	Food Industry	-	Sealing Tinned Food
		Steel Industry	-	Annealing Steel
		Electronics	-	Purity of “Chips”
		Glass Industry	-	Glass Manufacture
		Medical R&D	-	Blood/Gene Storage
		Ammonia Prod	-	Household Cleaning Agents
<u>Water</u>	-	Drinking Quality		or for Batteries

A company brief is exhibited at E5. Mr Bamber refers to page 6, which he states: "highlighting oil for sale in class 4 of the trade mark as a by-product of the ECLIPS process". In fact there is a list of by-product uses which includes oil extracted from tyres. Mr Bamber also refers to a brochure exhibited at E6 where there is a reference to "Recoverable incineration by-products for sale", a list follows that includes heating oil. There is nothing to suggest that any waste products will be sold under the trade mark of Mr Bamber. The brochure advises that "The ECLIPS incinerator is 'tailor-made' offering a wide range of sizes and designs to address the various types and quantities of waste disposal needs. Its innovative modular design is based on well known, tried and tested incineration technology with the added benefit of the unique environmentally friendly 'closed loop' system." The brochure refers to the design and configuration of a waste to energy ECLIPS system for use in Oklahoma; there is no indication that it has ever been built.

15) The whole basis of the claim of genuine use by Mr Bamber is that the process will produce waste products and that these include the class 4 goods of his registration. This does not show that he is creating a market for class 4 goods by reference to his trade mark but that the purchaser of the process will have waste products that may have some commercial value. Mr Bamber has not tried to enter the market for class 4 goods. He has not offered class 4 goods or advertised class 4 goods by reference to his trade mark. He has not gone to the purchasers of class 4 goods and sought their custom. He has made no attempt to bring class 4 goods onto the market, by reference to any trade mark. It will be the user of the incinerator who is producing the waste product so, if they do market the waste products, there is no reason that they would be marketed under the trade mark of Mr Bamber; in fact the very opposite as this could give rise to trade mark infringement, absent any licence. If one buys a product/system the buyer does not normally use the trade mark of the supplier of the equipment for the finished products or products derived from the product/system. All that the evidence of Mr Bamber shows is that he advances, as one of the commercial advantages of his system, that the user of the system may commercialise the waste products that it creates.

16) Mr Bamber has failed to establish any genuine use of his trade mark in respect of the class 4 goods of his trade mark since the date of the completion of the registration process. **The class 4 goods of Mr Bamber's registration are revoked under section 46(1)(a) of the Act with effect from 25 November 2005.**

**17) Consequently, Mr Bamber cannot rely upon his earlier registration under section 5(2)(b) of the Act and so this ground of opposition is dismissed. The ground of opposition under section 3(6) of the Act has already been dismissed. The opposition is dismissed in its entirety.**

18) In his written submissions of 9 May 2012 Mr Bamber criticises the Intellectual Property Office (IPO) for not following its own procedures in relation to Millers' application at the examination stage. The official letter of 8 June 2007 issued to Millers does follow the practice at the time of the IPO. Prior to the change of the law in relation to relative grounds objections, on 1 October 1997, the IPO allowed applicants to postpone the publication of their applications until 1 October 2007; in order that their applications would be considered under the amended provisions. This is what happened in this case.

### **Costs**

19) Millers having been successful in both the opposition and the application for revocation is entitled to a contribution towards its costs. Costs are awarded on the following basis:

Revocation fee:	£200
Preparing statements and considering the statements of Mr Bamber:	£500
Considering the evidence of Mr Bamber:	£500
Written submissions:	£300
Total	£1,500

**David Paul Bamber is to pay Millers Oils Limited the sum of £1,500. 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 6<sup>th</sup> day of June 2012**

**David Landau  
For the Registrar  
the Comptroller-General**

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<sup>i</sup> Section 6A of the Act reads:

“(1) This section applies where –

(a) an application for registration of a trade mark has been published,

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(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) 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

(b) 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.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“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.”