

O-278-08

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2448353
IN THE NAME OF THORWORLD INDUSTRIES LIMITED

AND

OPPOSITION NO 95405 THERETO
BY PLANT HANDLING LIMITED TRADING AS EASYRAMPS

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IN THE MATTER OF

Application No. 2448353
in the name of Thorworld
Industries Limited and
opposition No. 95405 thereto
by Plant Handling Limited
trading as Easyramps

Background

1. Application No. 2448353 is for the mark EASYRAMP and stands in the name of Thorworld Industries Limited (“Thorworld”). The application has a filing date of 3 March 2007 and seeks registration in respect of the following goods:

Ramps for the loading and unloading of goods vehicles; wheelchair ramps; doorway/threshold ramps; curb/step ramps” in class 7.

2. Following publication of the application in the *Trade Marks Journal* a Notice of Opposition was filed on behalf of Plant Handling Limited, trading as Easyramps (“Plant”). The grounds of opposition are, in brief:

- Under section 5(4)(a) of the Act on the grounds of passing off based on Plant’s claim to earlier use of EASYRAMPS. Plant says it has used the mark continuously since June 2004 on and in relation to “container loading ramps”, and;
- Under section 3(6) of the Act in that the application was made in bad faith.

3. Both parties filed evidence. Neither party sought a hearing nor did they file written submissions. I therefore reach this decision from the papers before me.

Evidence

Evidence of Plant

4. Plant’s evidence takes the form of a witness statement of Josh Fagan dated 9 February 2008. Mr Fagan explains that he is a partner in Plant which trades as Easyramps and which is a successor in business to Performance Handling Limited.

5. Mr Fagan states that his company first used the mark EASYRAMPS in the United Kingdom in June 2004 and has used it continuously since that date. He states that Plant operates a business selling and renting container loading ramps under the mark and enjoys a substantial goodwill and reputation in respect of the goods and services provided. He provides the following details of sales and advertising expenditure:

Year	Sales made	Advertising spend
2004	£114,255	£200
2005	£228,245	£800
2006	£388,810	£16,000

6. These figures are said to relate to the sales and promotion of goods and services under the mark. Sales are said to have been made throughout the United Kingdom.

7. Mr Fagan states that Thorworld are well aware of Plant's use of the mark and were so for at least two years before the application was made. He further states that the two companies have common component suppliers. He provides details of Plant's attendance at the International Materials Handling Exhibition (IMHX) which took place at the NEC in Birmingham 13-16 March 2007. He goes on to say that Mr Meale of Thorworld attended that exhibition with the two meeting there on the second day (14th). On this same day, Easyramp Limited, a company having the same registered address as Thorworld, was incorporated.

8. Having become aware of Thorworld's application for registration of the trade mark, Mr Fagan wrote to their representatives to inform them of Plant's unregistered rights and proposing the transfer or withdrawal of the application for registration. He later received a response to that letter rejecting the proposals.

9. Mr Fagan states that he has not come across any use of the mark EASYRAMP by Thorworld.

10. Mr Fagan exhibits the following:

- JF1: a printout of Plant's website homepage
- JF2: examples of the trade mark in use on company stationery
- JF3 and 4: printouts from WHOIS regarding the registration of www.easyramps.co.uk and www.easyramps.com by Plant on 18 June 2004
- JF5: printout of (part of) a Google search for "easyramps" showing Plant's website as the first result
- JF6: printout of (part of) a Google search for "container loading ramps" showing Plant's website as the third result
- JF7: letter from a Plant customer
- JF8 and 9: Invoices for services provided to Plant via the Google search engine relating to the mark EASYRAMPS
- JF10: a series of invoices for advertisements in the trade magazine IEM
- JF11: copy of Plant's advertisement appearing on page 76 of IEM published 26 February 2007 for "easyramps®" branded goods
- JF12: copy of Thorworld's advertisement appearing on page 75 of IEM published 26 February 2007
- JF13: Material relating to IMHX exhibition which took place in the NEC in Birmingham in May 2006
- JF14: photographs from that exhibition showing Plant's stand
- JF15: Sample invoices
- JF16: Press releases from: 22 and 26 February 2007 advising of Easyramps maiden appearance at the IMHX; 17 May 2006 announcing a new model of ramp and 12 Jan 2006 seeking new dealers
- JF17: Copy of a letter sent to Thorworld's representatives 11 May 2007
- JF18: Copy of response from Thorworld's representatives dated 20 June 2007
- JF19: Copy of extracts from Companies House re the incorporation of Easyramp Limited and Thorworld.

Evidence of Thorworld

11. Four witness statements have been provided. The first is that of John Meale, Managing Director of Thorworld since its incorporation in the 1980s, and is dated 3 March 2008.

12. Mr Meale states that Thorworld began to use the mark EASYRAMP (sometimes as EASYRAMPS) in 1996 and use has been continuous since that time. The mark was first used specifically in relation to “a disabled range of ramp products”. The mark has been used “sporadically” on other products though no details of these other products are provided. Mr Meale says that EASYRAMP goods were not core products of his company. He explains that by this he means that EASYRAMP products accounted for some £50,000 sales annually, which is “quite a small part of our overall business”.

13. Mr Meale explains that until 1999, Thorworld produced sales brochures twice yearly. Since that date, though brochures are still supplied where required, more emphasis has been placed on use of their website. At JM1 Mr Meale exhibits copies of the front and back covers and some inside pages of the 1997 brochure which, he explains, were obtained from a Mr Chalmers whose company were responsible for the artwork. At JM2 he exhibits printouts giving details of four domain names incorporating the words easy-ramp or easy-ramps which Thorworld registered on 13 August 2004.

14. Mr Meale goes on to explain that he first became aware of Plant and their use of EASYRAMPS in either 2005 or 2006 in “certain journals”. He goes on to state that because Plant was a very small business, and insignificant as a competitor, Thorworld were not, at that time, particularly concerned though that concern subsequently increased in early 2007 when they became aware of claims by Plant to have a registered trade mark for the mark EASYRAMPS, a claim which he states he later found was a misrepresentation.

15. The second witness statement is that of Robert Scott Chalmers and is dated 9 April 2008. Mr Chalmers is Managing Director of Tartan Web Scotland Ltd (formerly known as Viking Technology Limited), a position he has held since 23 June 1995. Mr Chalmers explains that in September 1996, his company was asked by Thorworld to undertake a design and marketing exercise relating to ramps for the disabled market. Thorworld had requested Mr Chalmers’ company to design various logos and leaflets. At RSC 1 Mr Chalmers exhibits a letter from his company to Thorworld dated 2 September 1996 accompanied by proposals relating to three possible marks including EASYRAMP. He also exhibits at RSC 2 a letter dated 14 January 1997. At RSC 3 is a letter dated 12 February 1998 with enclosures and at RSC 4 is a letter dated 3 April 2000 along with two early artwork proposals showing how Easyramp(s) might be used. These letters each relate to the design and production of various promotional literature. Mr Chalmers explains that the artwork was updated yearly for trade shows etc. until 2002 when more emphasis was placed on the web.

16. The third witness statement is that of David McSweeney and is also dated 9 April 2008. Mr McSweeney explains that he was employed by Viking Technology Limited as a design manager between 1995 and 2006 and that during that time one of the major accounts he dealt with was Thorworld. He was involved in web design, graphics, images and branding for that account. He states that EASYRAMP was his creation and was recommended to Mr Meale of Thorworld. Mr McSweeney recalls authorising the printing of leaflets and providing graphics for inclusion in Thorworld’s brochures. The mark was used primarily on branding for the disabled market and a shop ramp.

17. Finally, there is a witness statement of Gerry MaGuire dated 9 April 2008. Mr MaGuire explains that he is a former employee of Viking Technology Limited and Tartan Web Scotland Limited, working for them between July 2002 and October 2006. He confirms that during his period of employment he registered over 200 domain names for Thorworld including EASYRAMP and other derivatives in 2004.

18. No further evidence was filed by either party.

Decision

The objection under section 5(4)(a).

19. I consider first the objection under section 5(4)(a) of the Act. This section reads:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

20. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised thus:

- (1) That the opponent’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) That there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponent, and;
- (3) That the opponent has suffered, or is likely to suffer, damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

21. In *South Cone Incorporated v Jack Bessant and Others* [2002] RPC 19, Pumfrey J said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under S.11 of the 1938 Act (see *Smith Hayden & Co. Ltd’s Application (OVAX)* (1946) 63 RPC 97 as qualified by *BALI*

Trade Mark [1969] RPC 472. Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

22. The date at which the matter must be judged is not entirely clear from section 5(4)(a) of the Act. This section is intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is well settled that it is appropriate to look to the wording of the Directive in order to resolve matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date, therefore, may be either the date of application for registration of the mark in suit (but no later) or the date at which the acts complained of commenced, as per comments made in *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] RPC 429.

23. Plant claims that at the date of application (3 March 2007) it was entitled to prevent Thorworld from making normal and fair use of the mark EASYRAMP in relation to all of the goods for which registration is sought. Plant’s objection is based on its use of the word EASYRAMPS which it says it began using in June 2004. Thorworld claims it started using the mark EASYRAMP in 1996. It is not disputed that the two words are, effectively, identical.

24. In *Croom’s Application* [2005] RPC 2, Geoffrey Hobbs QC again sitting as the Appointed Person, set out the principles to be applied where rival claims to use of a mark are made. He said:

“ When rival claims are raised with regard to the right to use a trade mark, the rights of the rival claimants fall to be resolved on the basis that within the area of conflict:

- (a) The senior user prevails over the junior user;
- (b) The junior user cannot deny the senior user’s rights;
- (c) The senior user can challenge the junior user unless and until it is inequitable for him to do so.”

25. Mr Hobbs went on to say:

“46. The statutory powers carried forward into Sections 7, 11 and 12 of the Trade Marks Act 1938 reflected these principles: see *CLUB EUROPE Trade Mark* [2000] RPC 329 at pages 342 to 344. The principles themselves are, in my view, deducible from:

- (a) The right to protection conferred upon senior users at common law (*Sprints Ltd v Comptroller of Customs (Mauritius) CHIPIE Trade Mark* [2000] FSR 814 (PC) at

pages 818, 819 per Lord Clyde and AL BASSAM Trade Mark [1995] RPC 511 (CA) at page 522 per Morritt L.J.);

- (b) The common law rule that the legitimacy of the junior user's use of the mark in issue must normally be determined as of the date of its inception (see *J.C. Penney Co. Inc v Penneys Ltd* [1975] FSR 367 (CA) at page 381 per Buckley L.J., *Cadbury Schweppes Pty Ltd v Pub Squash Co. Pty Ltd* [1981] RPC 429 (PC) at page 494 per Lord Scarman; *Anheuser-Busch Inc v Budejovicky Budvar NP* [1984] FSR 413 (CA) at page 462 per Oliver L.J. and page 473 per Dillon L.J.); and
- (c) The potential for co-existence to be permitted in accordance with equitable principles (see *GE Trade Mark* [1973] RPC 297 (HL) at pages 325 *et seq* per Lord Diplock and *Anheuser-Busch Inc. v Budejovicky Budvar NP* [2000] I.P & T. 617 (CA) at pages 629 and 630 per Peter Gibson L.J. pages 632 and 633 per Judge L.J. and page 637 per Ferris J.)”

26. As both parties claim to have used the mark, I need to determine which one is the senior user. As I indicated above, Plant claims to have first used the mark in June 2004 in relation to container loading ramps. It has provided details of the value of sales made throughout the UK for the years 2004 to 2006 along with details of advertising spend in those same years. Plant's maiden attendance at the IMHX did not take place until after the relevant date in these proceedings but it registered its domain name in June 2004. Whilst both parties agree that the relevant market is large, no further details have been provided and I am unable to put the value of Plant's sales into context within that market. That said, I consider there to be sufficient evidence for me to be able to accept Plant's claim to use of the mark from June 2004, a claim which appears to have been accepted by Thorworld. Accordingly, I find that Plant has accrued a goodwill in the mark in relation to container loading ramps.

27. For its part, Thorworld claims to have used the mark since 1996 with sales of some £50,000 per annum having been made under it in relation to, primarily, a range of ramps for use by persons with a disability. A brochure dating from 1997 supports the claim that such ramps were available under the mark at that time. Witness statements from those involved in the ongoing preparation of sales and advertising material for these goods have also been filed. Use of the mark is said to have continued into 2004 (and beyond) and this is supported by the evidence of Mr Chalmers (paragraph 7) and Mr McSweeney (paragraph 6). Whilst the evidence of sales is not particularly detailed and, again, has not been put into context in terms of the market as a whole, none of the evidence has been challenged by Plant.

28. In *Extreme Trade Mark* (BL O/161/07) Richard Arnold QC, sitting as the Appointed Person, considered the issue of unchallenged evidence. The relevant part of his decision is as follows:

“Unchallenged evidence

33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

In general a party is required to challenge in cross examination the evidence of any witness of the opposing party if he wishes to submit to the court that the

evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.

This rules (sic) services the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficulty in submitting that the evidence should be rejected.

However the rule is not an inflexible one....’

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [2005] EWCA Civ 267, [2005 RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *Brutt Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness’s evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposition party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness’s evidence despite having had the opportunity to do so, then I consider that the rule in *Browne v Dunn* applies and it is not open to the opposition party to invite the tribunal to disbelieve the witness’s evidence.”

29. Thorworld claims to have used the mark EASYRAMP in relation to “a disabled range of ramp products” and “other ramps”. What form these “other ramps” take has not been specified. Certainly the pages from the promotional brochure included at exhibit JM1 are headed “EASYRAMP © FOR THE DISABLED” and the evidence from Mr Chalmers indicates that his company was asked to produce design and marketing material in relation to “ramps for the disabled market”.

30. The parties agree that they are competitors in respect of loading ramps and that the market for ramps is large. Mr Fagan’s evidence shows that container loading ramps are heavy duty products, used in commercial or industrial settings. They facilitate the loading of containers by spanning the gap between e.g. the loading bay platform and the container. The ramp allows apparatus including forklift trucks to be driven across the ramp and gain access to those containers. In contrast, Mr Meale’s evidence shows that ramps for use by persons with a disability are marketed on the basis of their lightweight and portable qualities to

facilitate safe access across doorways and kerbs, primarily by wheelchair users, in a domestic setting. It seems to me that container loading ramps and ramps for use by persons with a disability are within very different sectors of the ramp market. I am supported in my view by the fact that neither party has produced any evidence of instances of confusion despite the level of sales each party has made under the mark, a mark which is far from being a strong one in relation to the goods concerned.

31. On the basis of the evidence before me, I am satisfied that Thorworld is the senior user of the mark in relation to ramps for use by persons with a disability and this includes *wheelchair ramps; doorway/threshold ramps; and curb/step ramps* as included within the specification of goods as applied for. I cannot be satisfied, however, that there is any use in relation to other ramps. I note that only the covers and pages 26 and 27 of the 1997 brochure have been supplied and that these have been selected to show use of EASYRAMP. It is a reasonable inference that the remainder of the brochure, which judging by its front page covered container ranges, involved other marks including, but not necessarily limited to THOR/THORWORLD. That being so, the ground of opposition under section 5(4)(a) succeeds in relation to *ramps for the loading and unloading of goods vehicles*.

The objection under section 3(6)

32. The relevant section of the Act reads as follows:

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

33. Plant’s objection under this ground is detailed as follows in its statement of case:

“12. We submit that the Applicant has no bone fide intention of using the trade mark EASYRAMP.

13. We submit that the application has been filed by the Applicant as a spoiling tactic and an attempt to take the Opponent’s trade mark and/or inhibit the continued development of the Opponent’s business.”

34. A claim that an application has been made in bad faith can succeed where, or to the extent that, a claim to passing off has failed (see on this point *Fianna Fael Trade Mark O-043-08*). I need to consider matters under this ground in relation only to those goods which have survived the claim to passing off. These are: *wheelchair ramps; doorway/threshold ramps; curb/step ramps*. I have already found at paragraph 31 above, that Thorworld is the senior user in relation to these goods. That being the case, there can be no question of it acting in bad faith in applying for trade mark protection in relation to those goods. It may be that Thorworld applied for registration of the mark as a result of awareness which arose following contact made between the parties at IMHX but this does not alter that finding. It cannot be an act of bad faith to seek to protect an existing trade. On the contrary, it may be prudent for a party to adopt such a cause of action if it has become aware that a competitor is operating in, or intending to enter, a related area of trade under the same or a closely similar mark. The ground of opposition under section 3(6) fails in relation to the balance of the specification of goods as referred to above.

Summary

Subject to any appeal against my decision, the application for registration may proceed in relation to *Wheelchair ramps; doorway/threshold ramps; curb/step ramps*.

Costs

35. Both parties have achieved a measure of success. That being the case, I consider that each should bear its own costs.

Dated this 13th day of October 2008

**Ann Corbett
For the Registrar
The Comptroller-General**