

O-312-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 2367468  
IN THE NAME OF N.L.WILLIAMS GROUP LIMITED**

**AND**

**IN THE MATTER OF AN APPLICATION FOR A  
DECLARATION OF INVALIDITY NO. 82198  
THERE TO BY ILLINOIS TOOL WORKS INC.**

**IN THE MATTER OF** trade mark registration No. 2367468  
in the name of N.L.Williams Group Limited

**AND**

**IN THE MATTER OF** an application for a Declaration of Invalidity  
No. 82198 thereto by Illinois Tool Works Inc.

## **BACKGROUND**

1. The trade mark CICOL was the subject of an application for registration filed on 6 July 2004 and has been registered since 10 December 2004 under number 2367468 and stands in the name of N.L.Williams Group Limited (subsequently referred to as NLW). It is registered in respect of:

Class 02:

Epoxy resin coatings; epoxy resins for use in covering floors; surface coatings made wholly or principally of epoxy resins.

Class 19:

Flooring products; flooring materials; flooring screeds; surfacing materials for the coating of flooring, resinous flooring materials.

2. On 22 June 2005, Illinois Tool Works Inc. (subsequently referred to as ITW) filed an application for a declaration of invalidity of the registration. The action was filed on Form TM26(I) together with the appropriate fee. The statement of case accompanying the application set out the grounds of action, which are under sections 47(2)(b) and 5(4)(a) of the Act.

3. In the statement of case the applicant, ITW, asserted that they are a US corporation with a UK subsidiary, ITW Limited, which has a division called ITW Rocol Site Safety Systems. The history of this company and the trade mark is claimed to be as follows:

- Fosroc BV registered the original trade mark CICOL in the UK on 27 June 1979, under number 1116523 in class 19 for “mortars, asphalt, pitch and bitumen”, but through failure to renew this expired on 2 August 2000 and was removed from the register on 31 January 2001.
- On 14 March 1990 ACMEFLOORING Limited entered into a distributorship agreement with Fosroc BV to be the exclusive distributor of the product “CICOL ET system and subsequent derivatives” in the UK for specific market sectors.
- Rocol Limited acquired ACMEFLOORING Limited in approximately 1994, ACMEFLOORING Limited then changing its name to Rocol Site Safety Systems Limited in 1995.

- ITW asserts that it is the successor in business to Rocol Limited, having purchased that company on 7 April 1999.
- No royalty payments have been made by ITW or its predecessors in business since 1997, therefore ITW regard the distributorship agreement with Fosroc BV as having lapsed and Fosroc BV as having no further interest in the trade mark. ITW assert that they and their predecessors in business have continued to use the trade mark CICOL for “epoxy resins; epoxy resins for use in covering floors and the like surface; epoxy resin coatings; epoxy resin anti-slip surface coatings; coatings for roads, decks, ramps, stairs, bridges; surfacing systems for use in pedestrian and vehicle environments” since that date.
- It is also asserted that at one time NLW were an approved contractor employed by ITW and/or their predecessors in business to apply CICOL coatings to bridges and the like surfaces but that NLW have no rights in or to the trade mark CICOL in respect of the goods specified above. In the later filed evidence, witness statement of Justin Kerslake Exhibit JK22, it appears that N L Williams Engineering Ltd. were supplied with CICOL branded products by ITW during 1999 and 2000.
- On 27 May 2005 trade mark agents acting for NLW raised objection to the use of the trade mark CICOL by ITW on the basis that they had registered the trade mark in suit.

They give figures for their annual sales under the CICOL trade mark in the UK from 1995 to 2005, see below.

<b>Year</b>	<b>Value (£)</b>
1995	310,000
1996	150,000
1997	120,000
1998	120,000
1999	130,000
2000	140,000
2001	510,000
2002	105,000
2003	60,000
2004	90,000
2005 (to date)	55,000
<b>Total</b>	<b>1,790,000</b>

They also assert that sales of goods under the CICOL trade mark have been throughout the UK, including Tower Bridge, the Humber Road Bridge, York Millennium Bridge, Gateshead Millennium Bridge and Hyde Park Barracks. ITW are the applicant for Community Trade Mark application number 3960333 for the trade mark CICOL ACME

GRIP, which NLW have threatened to oppose on the basis of UK registration number 2367468.

4. On 29 June 2005 a copy of the application for invalidation and the statement of grounds were sent to the address for service of NLW. The consequences of failure to defend the registration were set out in the letter dated 29 June 2005, namely that the application for declaration of invalidity could be granted in whole or in part. No defence was filed on behalf of NLW within the period set

5. It does not however follow that the uncontested nature of this action will automatically mean success for the applicant for invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicant for invalidity to make the case that the registration should be declared invalid.

6. I am mindful of the decision in the *Firetrace Case* [2002] RPC 15 where the Hearing Officer, at paragraph 17, stated:

“ . . . It is not sufficient to simply allege that a registration offends either Section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case. . . .”

7. The reason that the Hearing Officer arrived at this view is the statutory presumption in Section 72 of the Act which states:

“In all legal proceedings.....the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transaction of it.”

8. With this in mind, on 25 August 2005, the Registrar wrote to the applicant's representative inviting them to file any evidence or make any submission which they felt would support their client's application to, at the least, establish a prima facie case. They were also invited to state whether they wished to be heard or would accept a decision from the papers filed.

9. On 6 October 2005 the applicant for invalidity provided a witness statement, with exhibits, to support the case the applicant alleged against the proprietor of the trade mark.

10. The evidence and exhibits submitted consist of a witness statement by Justin Kerslake, business unit manager of Rocol Site Safety Systems, dated 5 October 2005, and thirty-three exhibits. The witness statement first refers to the position of Rocol Site Safety Systems as a division of ITW Limited, which in turn is a subsidiary of ITW; that ITW purchased the business now trading as Rocol Site Safety Systems, along with the

intellectual property rights of the former company (Rocol Limited), on 7 April 1999, prior to which the business operated under the name Rocol Limited, a company owned by The Morgan Crucible Company Plc; That Rocol Limited had acquired Acme Flooring Limited in 1994, and changed the name of that company to Rocol Site Safety Systems Limited in 1995, and that company first used the trade mark CICOL in 1995; That the trade mark CICOL is used for non-slip surfacing composite, particularly a combined anti-slip wearing course and water-proof membrane suitable for use on steel concrete and aluminium substrates; CICOL ET is used to identify a solvent free, three component product based on epoxy resin, refined coal tar and mineral fillers composite, mixed to form a homogenous slurry which is dressed with a hard wearing aggregate, and is used on structures where the deadweight of a traditional surfacing would be detrimental to the design solution, for example on lift bridges, swing bridges, gantries, footbridges and RORO (Roll On, Roll Off) ramps; a recently introduced CICOL product, identified by the letters NT, comprises a tar and solvent free, three component product based on epoxy resin and inert mineral fillers, when mixed these form a homogenous slurry which is dressed with aggregate to provide a hard wearing anti-skid surface; Mr Kerslake estimates that the share of this specialised market held by Rocol Site Safety Systems has been – 40% in 1999, 40% in 2000, 70% in 2001 (which includes resurfacing the Humber Road Bridge), 35% in 2002, 30% in 2003 and 34% in 2004; following a review of the Acme Flooring Limited files a number of testimonial letters were found relating to projects carried out in the years before 1990. Details of the exhibits are as follows:

- Exhibit 1 – a marketing brochure issued by Rocol Site Safety Systems Limited in March 1997, this refers to the CICOL ET™ SYSTEM, features Tower Bridge London, Merchants Bridge Manchester, Portsmouth RORO and Prince's Landing Stage Liverpool, it also lists 34 other projects where the product was used.
- Exhibit 2 – a copy of a facsimile transmission dated 18 October 2000 relating to the potential use of CICOL ET as a waterproofing and wearing course for The Millennium Link Opening Bridges.
- Exhibit 3 – a copy of a facsimile transmission dated 6 June 2001 relating to the specification of CICOL ET as a waterproofing and wearing course for the Willow Bridge Footbridge, part of the Doncaster North Bridge Project.
- Exhibit 4 – a copy of a pre-tender enquiry from City of Sheffield for the supply of an anti-slip surface system (CICOL ET™ SYSTEM) for a disabled ramp/footbridge at Manor Lane depot, the tender due date is shown as 16 November 2002.
- Exhibit 5 – a copy of a brochure of the Rocol Site Safety Systems product range, two pages refer to CICOL™ ACME grip projects, including Hammersmith Bridge London, Humber Bridge, Millennium Bridge Gateshead, Foot Passenger Link Bridge Dover, Cardiff Bay Barrage Bridges and Millennium Footbridge York. Although undated there is a reference to ITW on the back page, this would imply that the document could not have been produced before April 1999.

- Exhibit 6 – a print dated 29 September 2005 from the Humber Bridge web site, this being a Bridge Resurfacing report published on 16 October 2001 and relates that CICOL ET will be used as a waterproofing substrate.
- Exhibit 7 – a copy of a technical datasheet for CICOL™ Acme Grip NT, dated 7 April 2004.
- Exhibit 8 – a copy of a technical datasheet for CICOL™ Acme Grip ET, dated 12 May 2004.
- Exhibit 9 – a copy of a technical datasheet for CICOL™ Acme Grip Primer, dated 22 June 2004.
- Exhibit 10 – a copy of an invoice to Midland Industrial Flooring Ltd. for CICOL Primer and CICOL ET Slurry kit, dated 29 May 2001.
- Exhibit 11 – a copy of an invoice to Burgess Engineering Ltd. for CICOL Base, CICOL Hardner and CICOL ET Slurry kit, dated 25 September 2001.
- Exhibit 12 – a copy of an invoice to Ringway Highway Services Ltd. for CICOL Primer, CICOL Base, CICOL Hardner and CICOL ET Slurry kit, dated 28 March 2002.
- Exhibit 13 – a copy of an invoice to Colas Ltd. for CICOL ET Slurry kit, dated 30 August 2002.
- Exhibit 14 – a copy of an invoice to Fife Council for CICOL ET Slurry kit, dated 9 April 2003.
- Exhibit 15 – a copy of an invoice to Waterseal Ltd. for CICOL Primer, CICOL Base, CICOL Hardner and CICOL ET Slurry kit, dated 24 September 2003.
- Exhibit 16 – a copy of an invoice to C Spencer Ltd. (Barrow on Humber) for CICOL Acme grip ET Slurry Base, CICOL Acme grip ET Slurry Hardener and CICOL Acme grip ET Slurry kit, dated 23 April 2004.
- Exhibit 17 – a copy of an invoice to Jerram Falkus Construction Ltd. for CICOL Acme grip concrete primer, CICOL Acme grip ET Slurry Base, CICOL Acme grip ET Slurry Hardener and CICOL Acme grip ET Slurry kit, dated 16 November 2004.
- Exhibit 18 – a copy of an invoice to Huntingdon Specialist Coatings for CICOL Acme grip concrete primer, CICOL Acme grip ET Slurry Base, CICOL Acme grip ET Slurry Hardener and CICOL Acme grip ET Slurry kit, dated 21 February 2005.

- Exhibit 19 – a copy of an invoice to Waystone Ltd. for CICOL Acme grip concrete primer, CICOL Acme grip ET Slurry Base, CICOL Acme grip ET Slurry Hardener and CICOL Acme grip ET Slurry kit, dated 24 February 2005.
- Exhibit 20 – a copy of a unit sales analysis for Site Safety Systems Limited for December 1996, showing sales for CICOL/Dynagrip for 1995 and 1996.
- Exhibit 21 – a copy of a unit sales analysis for Site Safety Systems Limited for December 1997, showing sales for CICOL/Dynagrip for 1996 and 1997.
- Exhibit 22 – a copy of a unit sales analysis and sales analysis, by alphabetic listing of customers, under the CICOL trade mark for Rocol Site Safety Systems for the years 1999 to 2005 (to date) inclusive.
- Exhibit 23 – a copy of a listing of pedestrian and vehicular applications of products under the CICOL trade mark for the years 1997 to 2002.
- Exhibit 24 – a copy of a promotional document for the Hyde Park Barracks project completed in 2000.
- Exhibit 25 – a copy of a promotional document for the Transport for London NE Footbridge project completed in 2001.
- Exhibit 26 – a copy of a promotional document for the West Mill Bridge project completed in 2002.
- Exhibit 27 – a copy of a testimonial letter sent to Acme Flooring Limited, dated 5 November 1991, from Suffolk County Council Highways Department praising the CICOL ET product used on the Lowestoft Bascule Bridge resurfacing in 1978.
- Exhibit 28 – a copy of a testimonial letter sent to Acme Flooring Limited, dated 12 November 1991, from London Docklands Development Corporation praising the CICOL ET product used on the Millwall Cutting Bascule Bridge surfacing in 1985.
- Exhibit 29 – a copy of a testimonial letter sent to Acme Flooring Limited, dated 12 November 1991, from London Borough of Havering, Borough Engineer & Surveyor, praising the CICOL ET product used on the A12/A127 Trunk Road – Gallows Corner Flyover Romford surfacing in 1983 and 1984.
- Exhibit 30 – a copy of a testimonial letter sent to Acme Flooring Limited, dated 15 November 1991, from London Borough of Barking & Dagenham praising the CICOL ET product used on the A13 Movers Lane Flyover surfacing in 1989.

- Exhibit 31 – a copy of a testimonial letter sent to Acme Flooring Limited, dated 26 November 1991, from County of Avon, Director of Highways, praising the CICOL ET product used on the Victoria Street Flyover Bristol surfacing in 1975.
- Exhibit 32 – a copy of a testimonial letter sent to Acme Flooring Limited, dated 7 January 1992, from The Department of Transport, Eastern Regional Office Network Management Division, praising the CICOL ET product used on the A47 Breydon Bridge surfacing in 1984.
- Exhibit 33 – a copy of a testimonial letter sent to Acme Flooring Limited, dated 9 December 1991, from Strathclyde Regional Council, Department of Roads, praising the CICOL ET product used on the Temple Bridge Glasgow resurfacing in 1984.

11. Acting on behalf of the Registrar and after a careful study of the papers before me I give the following decision.

### **DECISION**

12. The applicant claims that the registration should be declared invalid as per section 47 of the Act on the basis of the provisions of section 5(4)(a). The relevant parts of the Act are as follows:

“47. - (1) . . . .

(2) The registration of a trade mark may be declared invalid on the ground-

(a) . . . . , or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

“5. - (1) . . . .

(2) . . . .

(3) . . . .

(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.”

13. With regard to section 5(4)(a) of the Act the requirements for this ground of action 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 these proceedings, the three elements that must be present can be summarised as follows:

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

14. In the statement of case it is asserted that the applicant is the successor in title to companies that have used the trade mark since 1990, in the evidence there are testimonial letters relating to surfacing/resurfacing of road surfaces under the trade mark dating back to the 1970’s. The registered proprietor has not defended their registration and has made no attempt to refute the statements, I therefore take the applicants evidence at face value even though this is far from perfect. As stated by Pumfrey J. in *REEF* Trade Mark [2002] RPC 19 at paragraphs 26 to 28:

“. . . . . As Mr Hobbs QC said in *Wild Child TM* [1998] R.P.C. 455, the registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. The second question follows: how cogent must the evidence be upon which the registrar should act in upholding an opposition on this ground?

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 [section 5(4)(a) TMA] 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.

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. . . .”

15. It is clear from the statement of case and evidence that the marks are identical, even though the applicant has additional material added to the trade mark the primary element is always CICOL. Likewise the goods are identical in as far as all the evidence demonstrates use of the trade mark on a range of epoxy resin based materials used as surface coatings for pedestrian and vehicular roadways.

16. The evidence indicates that the applicant has a significant market share in the field of epoxy resin based anti-slip/anti-skid pedestrian and vehicular surface coatings. That they supply specialist contractors with the materials to carry out this work, these contractors are listed at Exhibit JK22 and include N L Williams Engineering Ltd, which I take to be part of NLW. This contention is supported by the statement of case, which relates that NLW were, at one time, an approved contractor employed by ITW. In my opinion the evidence establishes, prima facie, that ITW, and their predecessors in title, have a reputation in the trade mark CICOL.

17. That misrepresentation will occur, as the marks and goods are identical, is self evident and the applicant is likely to suffer damage as a result of that misrepresentation.

18. The facts set out in the witness statement, which have not been challenged by the registered proprietor, in my view, establish that a prima facie case has been made out and that, at the date of the application for registration by N.L.Williams Group Limited of the trade mark in suit, Illinois Tool Works Inc. had an earlier right which was protectable under common law in the United Kingdom. **The application for a declaration of invalidity made under section 47(2)(b) based upon section 5(4)(a) of the Act therefore succeeds.** I direct that trade mark registration No. 2367468 be removed from the register and in accordance with Section 47(6) of the Act the registration is deemed never to have been made.

19. As to costs, the applicant for invalidity has been successful, and I order N.L.Williams Group Limited to pay them £700. 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 1st day of November 2006**

**Graham Attfield  
For the Registrar  
the Comptroller-General**