

O-336-03

**TRADE MARKS ACT 1994
IN THE MATTER OF REGISTRATION No 2207546
IN THE NAME OF API GROUP PLC**

AND

**IN THE MATTER OF
AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NUMBER 81066
BY ANTONINE PRINTING INKS LIMITED**

Trade Marks Act 1994
In the matter of registration No 2207546
in the name of API Group plc

And

In the matter of opposition thereto
under number 80480 by Antonine Printing Inks Limited

BACKGROUND

1. Trade Mark registration No.2207546, for the trade mark API, is registered in classes 2, 6, 7, 9, 14, 16, 17, 39 and 42. The application stands against Class 2 of the registration, which contains the following statement of goods:

Class 02: Printing ink; printing foils; printers' pastes, printing compositions; metallic ink; coatings; light sensitive coatings; anti-corrosive preparations and substances; anti-corrosive bands; anti-corrosive substances coated on or impregnated into paper, board and fabrics; anti-rust greases; anti-rust oils; anti-rust preparations; printing foils for coding and labelling.

The registration stands in the name of API Group plc.

2. By an application dated 1 November 2002, Antonine Printing Inks plc, applied under Section 47(2)(b) for the registration to be declared invalid on the following grounds:

Under Section 5(4)(a) because the applicant is the owner of an earlier right and the registration was liable to be prevented by virtue of the law of passing off.

3. On 22 November 2002, the registered proprietor filed a counterstatement in which they deny the grounds on which the application is based.

4. The registered proprietor and the applicant for invalidity both ask for an award of costs in their favour.

5. Both sides filed evidence in these proceedings, The matter came to be heard on 29 July 2003, when the registered proprietor was represented by Mr James St Ville of Counsel, instructed by Messrs Page White Farrer, their trade mark attorneys. The applicant was represented by Mr N McKechnie of Kennedys, their trade mark attorney.

Applicant's evidence

6. This consists of a Witness Statement dated 8 January 2003 from Iain Harvie, Financial Controller of Antonine Printing Inks Limited, a position he has held since 1995.

7. Mr Harvie states that Antonine Printing Inks Limited was incorporated in 1979 (which is confirmed by the print from the Companies House website shown as exhibit IH1) and that his company has continuously traded under both this name, and the abbreviation "api" in the form shown at exhibit IH2 since that date. He gives the goods that the mark has been used in connection with as "printing inks, dyes and varnishes, flexographic and gravure inks and varnishes, water based and solvent based ink, standard colour, pantone matching and specialist matching print inks, printing pastes and compositions, and alcohol reducible and soluble inks and dyes". Mr Harvie refers to exhibits IH3 and IH4, which consist of company brochures detailing the products sold by Antonine Printing Inks Limited, Mr Harvie listing the products contained within, all of which fall within the descriptions given earlier. The cover of IH3 shows the letters "api" in close proximity and placed below the full company name, IH shows the letters placed above the company name, api being in a significantly larger font. Neither brochure contains a reference by which to date it.

8. Mr Harvie refers to the goods covered by the mark that his company seeks to invalidate, noting the correlation with those listed above, and that although he has not specifically mentioned printing foils and coatings, the goods that he has listed can be used on foils, films and coated products, and such goods having the same end users and trade channels, would be likely to be confused, particularly in view of the identity in the marks.

9. Mr Harvie lists the turnover figures for the years ending 31 May 1996 through to 31 May 1999, which ranges from £3,258,000, rising year on year to £4,886,000. He gives figures for the promotion of the mark in the same period, which range from £12,000 in the year ending 1996, rising to £15,000 for the year ending 1999. Mr Harvie introduces exhibit IH5 as consisting of examples of the promotional materials used by his company. All of the examples of advertisements, brochures, etc bear the api mark, but in all but one case clearly originate from after the relevant date. The one example that is relevant consists of an advertisement placed in a souvenir programme of a golfing event. The advertisement is headed Antonine Printing Inks Limited, has api on a separate black background, and bears the legend "MAJOR SPONSOR TO LENZIE GOLF CLUB PRO-AM COMPETITION SUNDAY 15 SEPTEMBER 1991- WISHING ALL COMPETITORS AN ENJOYABLE DAY".

10. Exhibit IH6 consists of copies of letters sent by Antonine Printing Inks Limited, the letter headings all bearing the company name and contact details, along with the letters api. The earliest dates from 1 July 1986, being sent to amend standing orders at a bank. The later examples relate to the ownership of company vehicles, one being a receipt by an employee, confirmation that the company will comply with the Transport Act, confirmation given to a bank regarding a telephone conversation relating to two cheques, and a reference for an individual. None of these relate to any trade in goods or services, but could be taken to be indicative of ongoing business activities.

11. Exhibit IH7 consists of photographs of dispensing machinery, labels for containers of ink and various items of business stationery, all bearing the company name along with the letters

api. None can be dated. Exhibit IH7 consists of a letter dated 19 April 2001, from the Managing Director of a company called Simpac, addressed to Kennedy's, the applicant's representatives, attesting to his company's business relationship with Antonine Printing Inks Limited, and their association of the letters api with that company. Mr Harvie concludes his Statement by outlining the reasons why the application should succeed, which although I have not summarised, I will take into account in my decision.

Registered proprietor's evidence

12. This consists of a Statutory Declaration and a Witness Statement. The Statutory Declaration is dated 5 March 2003, and comes from Edward John Richards, Assistant Company Secretary of API Group plc, the registered proprietor.

13. Mr Richards comments on the evidence filed by the applicant, asserting that it does not show a continuous trade under the name api from 1979 as claimed, that any use has been with the company name, Antonine Printing Inks Limited in close proximity, that exhibits are not dated and do not show when, to what extent and for how long Antonine Printing Inks Limited may have been trading in the goods shown. In relation to the figures for sales and publicity, he notes that they have not been externally verified, do not support a claim to use from 1979, in the case of the publicity figures are not significant, and that it is not clear or implied that the figures relate to a trade in goods under the mark api.

14. Mr Richards mentions Antonine Printing Inks' sponsorship of the golf tournament (exhibit IH5), stating that this does not show extensive use or reputation in the mark api, nor a goodwill in the business carried on under the mark. He comments that the distribution of the programme will have been confined to participants and spectators, and therefore had a limited circulation. He goes on to assert that the correspondence shown as exhibit IH6 do not show a trade in inks under the api mark, and that the copy of the letter at IH8 should be given no weight and in any event, should be regarded as hearsay.

15. Mr Richards gives the history of his company, stating that it was incorporated under the name Associated Paper Industries Limited in 1920, changing its name to API Group plc on 11 July 1990. He says that his company commenced use of the abbreviation API long before the incorporation of Antonine Printing Inks Limited. He refers to his company's ownership of various registrations for the trade marks API, API GROUP PLC, API DIELESS and API FOILS, details of which he lists as exhibit ER1, and which I have attached as an annex to this decision. Mr Richards says that his company is well know and respected in the printing and printing inks industries under the name API, and that its subsidiary, API Foils Limited is one of the worlds largest manufacturers of stamping foil.

16. Mr Richards concludes his Declaration by commenting on the lack of any claim to confusion despite the two companies having apparently traded concurrently, which he puts down to the fact that the applicant has been trading under the name Antonine Printing Inks Limited with api as a subsidiary or decoration.

17. The Witness Statement is dated 7 March 2003, and comes from Catherine Anne Wolfe, a trade mark attorney employed by Page Whilte & Farrer, the registered proprietor's representatives.

18. Ms Wolfe introduces exhibit CAW1, which consists of an extract obtained from the Companies House website relating to Associated Paper Industries Public Limited Company, showing the date of incorporation as 24 July 1920, and to it having changed its name to API Group plc on 11 July 1990. Exhibit CAW2 consists of the 1998 Annual Report and Accounts for API Group plc. In the report, the company refers to itself as API, and reports sales of £164,000,000. Exhibit CAW3 consists of an undated product folder for API Foils.

Applicant's evidence in reply

19. This consists of a Witness Statement dated 17 April 2003, by Iain Harvie. Mr Harvie appears to accept Mr Richards' contention that api is used in the proximity of the full company name, Antonine Printing Inks Limited, but in any event, asserts that based on the "BUD" case this does not mean that api cannot be regarded as a separate mark in its own right. He refutes the suggestion that his company's sales and publicity figures are small, stating that his company operates in a specialised industry, and consequently requires little expenditure on advertising, and argues that the correspondence exhibited at IH6 are illustrative of an ongoing trade, and therefore goodwill under api.

20. Mr Harvie comments that despite the applicant's company having been incorporated in 1920 and changed its name in 1990, there is no evidence to support their contention to having use of API prior to his company being incorporated. The remainder of the Statement contains Mr Harvie's submissions on the merits of the case, which although I have not summarised, will take into account in my decision.

Decision

21. The objection is founded under Section 5(4)(a). That section reads as follows:

“5.-(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

.....

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.”

22. Mr Geoffrey Hobbs QC sitting as the Appointed Person in *Wild Child* [1998] RPC 455, set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional

leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

23. To the above I add the comments of Pumfrey J in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002 RPC 19, in which he said:

“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 Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [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 at 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.”

24. The opponent says that their company was incorporated under the name Antonine Printing Inks Ltd in 1979, the exact date being confirmed as 20 April 1979 by the print from the Companies House website shown as exhibit IH1. They say that they have continuously traded under this name, and the abbreviation “api” from that date. Whilst the evidence indicates that they have been trading under the name Antonine Printing Inks Ltd, there is nothing that I can see that confirms the use of api from the date claimed. The earliest use of api shown in the evidence is in the heading of a letter written on company stationery, instructing their bank to amend two standing orders. There are other pieces of correspondence written on the same letter headed paper, all concerning matters related to the running of a business, for example, the registration of company vehicles, a receipt for a vehicle from a company employee, confirmation to the Department of Transport relating to a record system apparently required under the Transport Act 1968, and a reply to a reference request from a bank.

25. There is a letter (exhibit IH8) dated 19 April 2001, from Mr J Neil Young, Managing Director of a company trading under the name Simpac, addressed to the opponent's trade mark attorneys, apparently at their request. From their e-mail address packaging@simpac.co.uk it seems reasonable to assume that Simpac is involved in packaging. The letter confirms that Simpac have been dealing with Antonine Printing Inks Ltd for at least the last 15 years as the sole supplier of printing inks. They say that in that time they have referred to Antonine Printing Inks either by the full company name or api, an abbreviation they have seen on the company

stationery and labels over the past decade. They go on to say that having used them as a sole supplier of printing inks for several years, they have occasionally recommended them to friendly competitors, when doing so referring to them as api, an abbreviation that they and their contacts appear to recognise.

26. Mr Richards asserts that this letter should be disregarded, inter alia, because it has not been presented as a Statutory Declaration or Witness Statement, it was written after the material date, and that “internal references” to API by unnamed persons is not use of api in the course of trade, in particular in its stylized form, and should be regarded as hearsay.

27. Whilst it would have been preferable for the contents of this letter to have been formally declared, I cannot simply dismiss it just because it has not been. That it is written after the material date is immaterial; it casts light backwards to a time prior to this date. In saying “we have always referred to...”, Mr Young can be giving personal evidence, or evidence that could be regarded as hearsay, but the mere fact that it may be hearsay does not mean that it cannot be taken into account.

28. The best that can be said about the evidential value of the letter is that during the past decade Simpac have referred to Antonine Printing Inks Limited either by the full company name, or api, an abbreviation that they had seen on the stationery, a statement that could mean Simpac have referred to the company by the abbreviation for the preceding 10 years, or from some indeterminate time within that period. With regard to the abbreviation being represented in a stylised form, I would have to say that apart from the fact that the letters are shown in lower case, there is nothing much in the stylisation; it is a pretty ordinary font and very clearly the letters api.

29. Whilst the correspondence evidence could be taken as an indication that the company is active and trading, there is nothing that conclusively establishes that Antonine Printing Inks Limited have been using the api mark in relation to a trade in any particular goods, and whilst other evidence shows use of api in connection with printing inks, etc, it does not establish this to have been the case at, or prior to the date of application. In the *Radio Taxicabs (London) Limited v. Owner Drivers Radio Taxi Services Limited* [2001] WL 1135216, Mr John Randall Q.C., sitting as a Deputy Judge of the High Court, considered a passing off claim on the basis of goodwill in the name RADIO CABS, making various comments, inter alia, that he was faced with “*the total absence of evidence from members of the wider public*”. The judge went on to find that the burden of proving reputation with the general public lay on the claimant, stating at paragraph 96 of his decision:

“I consider it possible that the claimant may have built up a sufficient reputation in the ways relied but I cannot conscientiously put it any higher in the Claimant’s favour than that..... Thus one is left to speculate. Speculation is not enough. At the end of the day the burden of proving on the balance of probabilities, the requisite reputation with the general public in the name “Radio Taxis” lies on the claimant and I find that the claimant has not discharged it.”

30. Where Mr Randall QC refers to the “wider” or “general” public, I believe it is appropriate to read “the relevant consumer of the goods in question”, and taking this, and the comments in the *South Cone* case into account, on the evidence before me I find the applicant for invalidation to

have singularly failed to establish that, at the material date, they possessed a reputation or goodwill in the mark “API” (or api). This being the case, I do not see that there can be a finding of misrepresentation, or that there is anything that can be damaged by the registered proprietors use of their mark. The application is dismissed accordingly.

31. The application for invalidation having failed, I order the applicant to pay the registered proprietor the sum of , 1,700 as a contribution towards their costs. This sum 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 5th day of November 2003

**Mike Foley
for the Registrar
The Comptroller General**