

O-103-04

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 2315664
STANDING IN THE NAME OF HOME PRIDE LTD**

AND

**IN THE MATTER OF A REQUEST FOR A DECLARATION
OF INVALIDITY IN RELATION THERETO UNDER No. 81358
BY LEON YOUNG TRADING AS TECHNICHEM**

TRADE MARKS ACT 1994

**IN THE MATTER OF Registration No. 2315664
standing in the name of Home Pride Ltd**

and

**IN THE MATTER OF a request for a declaration of
Invalidity in relation thereto under No. 81358
by Leon Young trading as Technichem**

Background

1. The mark FOG OFF is registered under No. 2315664. It stands in the name of Home Pride Ltd in respect of a specification of goods in Class 1 of the International Classification system which reads; “chemicals used in industry, science and photography”. The registration has a filing date of 13 November 2002 and was placed on the register on 2 May 2003.

2. On 17 July 2003 Leon Young, trading as Technichem applied to have this registration declared invalid. The applicant’s amended statement of case indicates that:

“Leon Young is the proprietor of the Trade Mark FOG OFF in respect of chemical preparations which prevent and/or clear condensation forming on polycarbonate surfaces. These preparations can also be used for cleaning and de-greasing, and have antistatic, antimicrobial and other properties useful in an industrial and scientific environment. Mr Young trades under the name Technichem.

Mr Young developed this preparation in partnership with Mr Riazi Farzad in 1988. The business was incorporated as a company under the name of Technichem Limited, with Mr Young and Mr Farzad as the only shareholders. The company was dissolved a few years ago and all the assets were acquired by Mr Young, including the intellectual property rights in these preparations. Mr Young has traded under the name Technichem since then.”

3. It is said that FOG OFF has been used continuously since 1988. Sales are made through a distributor to a wide variety of industries in the UK and overseas.

4. On the basis of this trade a declaration of invalidity is sought under the provisions of Section 47(2)(b)/Section 5(4)(a). Reference is particularly made to the law of passing off.

5. In the alternative, invalidity is sought under the provisions of Section 47(1)/Section 3(3)(b) in that the mark in issue would deceive the public if it were to be used in respect of goods other than those capable of preventing condensation forming on surfaces (ie. fogging).

6. The registered proprietors did not file a Form TM8 and counterstatement within the period allowed with the result that the Registry wrote to the applicant's attorneys indicating, inter alia, that:

"... this does not mean that the registrar will declare the registration invalid without considering the merits of the case. Every registration is presumed valid, see section 72 of the Act, and your attention is drawn to the Hearing Officer's comments in the *Firetrace* decision [2002] RPC 15."

7. The reference to *Firetrace* was to a decision of a Registry Hearing Officer where it was held that, even in an uncontested invalidation action there is still an onus on the applicant to make out a prima facie case. The applicant subsequently filed a witness statement in substantiation of his claim and indicated that he was content to have the matter decided from the above mentioned material and without recourse to a hearing.

8. Acting on behalf of the registrar I give this decision.

Decision

9. Section 47(2)(b) reads as follows:

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

- (a)
- (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."

and Section 5(4)(a) 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."

10. The requirements for this ground are set out in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to invalidity proceedings, the three elements that must be present can be summarised as follows:

- (1) that the applicant for invalidity'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 proprietors (whether or not intentional) leading or likely to lead the public to believe that goods offered by them are goods or services 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 proprietors' misrepresentation.

11. It is clear from Article 4(4)(b) of the Directive on which the above provision is based that the right to prohibit use of the applicants' trade mark must have been established at the date of application.

12. In support of his claim to a protectable goodwill Mr Young has filed a witness statement which in summary establishes that:

- FOG OFF is used in relation to a chemical preparation for preventing and/or clearing condensation forming on polycarbonate PVC and other visual surfaces. It also has cleaning, de-greasing, anti-static, anti-microbial and other useful properties;
- the product was developed in 1988 (I take the reference in paragraph 2 of Mr Young's statement to 1998 to be a misprint in view of the remainder of the statement);
- Mr Young acquired the rights in the business from his previous partner, Dr Riazi-Farzhad and has traded since 1994 as Technichem;
- the product is sold via a distributor, Respirex Ltd;
- Respirex are responsible for promoting the product and do so by promoting it in their manuals and literature, on their website and at national and international fire and safety exhibitions;
- sales are to organisations such as fire services, civil defence bodies, Ministry of Defence, health authorities, the petrochemical industry and many others;
- the product enjoys Ministry of Defence and Fire Brigade approval;
- sales in units of 100ml, have been running consistently at 3000 per annum from 1990 to 2002.

13. Exhibits LY 1 to 6 are supplied in support of the above. These include early (1989) sales lead letters, confirmation of the arrangement with Respirex, sample orders, delivery notes and invoices, early advertising and magazine articles, safety and testing information and other miscellaneous documents showing use of the mark.

14. As the registered proprietors have taken no active part in these proceedings none of the above claims or the substantiating material has been challenged. I conclude without further ado that the applicant has established goodwill under the sign FOG OFF in relation to the business of supplying chemical preparations in the form of anti-condensation products to a wide range of industries and public bodies.

15. The registered proprietors have an identical mark and a specification that covers chemicals in Class 1 used in industry, science and photography. In the absence of any statement from the proprietors it is not possible to say whether their intention is to trade in the same goods area as the applicants, but given the nature of the mark I cannot rule out such a possibility. So far as 'chemicals used in industry, science' are concerned (and allowing for the notional scope of those terms) I must assume that the proprietors' mark and the applicant's sign may be used on the same goods and in relation to a broadly similar target group of customers. The applicant has not referred to his goods being used in the field of photography which is the third area of trade specified by the proprietors. However, I note that the applicant is expanding his trade in terms of application areas. Reference is made to a projected development of the business involving supply of the anti-condensation product to a manufacturer and supplier of motor cycle helmets. The collective force of the evidence suggests that the FOG OFF product may find applications wherever an anti-condensation requirement exists. I see no reason why that should not include the photographic industry and its suppliers. I, therefore, regard chemicals for use in the photographic industry to be a closely related area of trade.

16. It is not in any case necessary that a common field of activity exists as is illustrated by the following passage from *Harrods v Harrodian School* [1996] RPC 697:

“What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties. The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration ‘... whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant: *Annabel's (Berkeley Square) Ltd v G Schock per Russell LJ.*”

17. I believe it is self-evident that confusion will occur 'among the common customers of the parties' were the registered proprietors to trade under their identical mark in the area occupied by the applicant. For the most part that arises because, allowing for the notional scope of the former's specification, a common field of activity exists. If or to the extent that the proprietors' potential area of trade may be said to go beyond the applicant's current trade then it is in a closely related application area for the goods at issue.

18. The third element of the action is damage. In *Mecklermedia Corporation and DC Congress GmbH* [1997] ETMR 265, Mr Justice Jacob, as he then was, said:

“Now in some cases one does indeed need separate proof of damage. This is particularly so, for example, if the fields of activity of the parties are wildly different (*e.g.* *Stringfellow v McCain*, nightclub and chips). But in other cases the court is entitled to infer damage, including particularly damage by way of dilution of the plaintiff’s goodwill.”

19. This case falls into the latter category. The applicant’s case under Section 5(4)(a) has accordingly been made out.

20. In the circumstances I see no need to consider the alternative ground under Section 47(1)/Section 3(3)(b).

21. The application for a declaration of invalidity has been successful. The registration will be declared invalid and, in accordance with Section 47(6) will be deemed never to have been made.

22. The applicant is entitled to a contribution to his costs. I order the registered proprietors to pay him the sum of £800. 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 14th day of April 2004

**M REYNOLDS
For the Registrar
the Comptroller-General**