

O-012-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2340857 IN THE NAME OF  
MINIMAX GMBH & CO KG TO REGISTER THE TRADE MARK  
MINIMAX IN CLASSES 1 & 9**

**AND**

**OPPOSITION THERETO UNDER NO. 94093 IN THE NAME OF  
CHUBB FIRE LIMITED**

**Trade Marks Act 1994**

**IN THE MATTER OF application No. 2340857  
in the name of Minimax GmbH & Co KG  
to register the trade mark MINIMAX Classes 1 & 9**

**And**

**Opposition thereto under No. 94093  
in the name of Chubb Fire Limited**

**BACKGROUND**

1. On 15 August 2003, Minimax GmbH & Co KG made an application to register the trade mark MINIMAX in Classes 1 and 9 in relation to the following specifications of goods:

- |         |  |
|---------|--|
| Class 1 | Fire extinguishing agents and compositions; cable coatings for fire protection.  |
| Class 9 | Fire extinguishing and fire protection appliances, plants, systems and components therefor; fire-fighting equipment (including mobile equipment), foam tubes, mixers, foam-water hydrants, foam-water guns, portable fire engines; light foam generators, stationary and mobile fire-fighting plant, including plant for ships; sprinkler plant, electrical and electronic monitoring equipment, reporting equipment and control equipment as well as plant made from these; electrical and electronical apparatus and instruments for fire protection; electrical and electronical control apparatus for fire protection systems; fire detection systems and components therefor; smoke detectors, computer operating programs for fire protection systems; clothing for protection against fire, fire extinguishers and fire extinguishing devices, pipe fire stops, cable fire stops. |

2. On 30 January 2006, Chubb Fire Limited filed notice of opposition to the application, the ground in summary being as follows:

**Under Section 5(4)(a)** by virtue of the law of passing off.

3. The applicant filed a counterstatement in which they deny the ground on which the opposition is made.

4. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. Neither side took up the offer of an oral hearing, instead electing to rely on a decision from the evidence on file. After a careful study of this evidence, I now go on to give my decision.

### **Opponents' evidence in chief**

5. This consists of a Witness Statement dated 8 August 2006, from Rebecca Tew, a trade mark attorney with Marks & Clerk, the applicant's representatives in these proceedings. Ms Tew's Statement does no more than exhibit a copy of the evidence that was filed by the opponents in other proceedings involving the same parties whereby the applicants sought revocation of the opponents' registration No. 432900 for the trade mark MINIMAX. This evidence is shown as Exhibit RT1.

6. The Exhibit consists of a copy of a Witness Statement dated 4 May 2004, from Anthea Bowdler, Commercial Manager of Chubb Fire Limited, a position she has occupied since 1 July 1997. Ms Bowdler refers to her company's ownership of the MINIMAX trade mark stating that it was initially owned by Minimax Limited, who started using it in 1903 in respect of a "conical extinguisher". She goes on to set out some of the history of the MINIMAX mark, some historical material being shown as Exhibit AB1.

7. In 1955, Minimax Limited was purchased by the Pyrene Company Limited, that company in turn being taken over by Chubb & Sons in 1967 and operated under the Pyrene name until 1971 when Chubb Fire Security Limited (now Chubb Fire Limited) was formed. Ms Bowdler goes on to state that in 1981 Chubb Fire Security Limited launched a new range of Chubb fire extinguishers. There was a period of time when the MINIMAX mark was not used directly in relation to fire extinguishers and other fire fighting apparatus. The servicing, refurbishment and refilling of existing MINIMAX extinguishers and hose reels continued. In 1992 the Pyrene company introduced a new range of pressure model extinguishers under the MINIMAX brand. Ms Bowdler states that she has been unable to locate any supporting documentation, but that her company has retained a sample of the extinguisher that she believes was manufactured in 1999. A photograph of the extinguisher is provided as Exhibit AB2, and shows the Chubb name placed above "MINIMAX", the product being a powder fire extinguisher stated to be suitable for use in the home, car, caravan or on a boat. There is no means by which to accurately date this.

8. Ms Bowdler goes on to say that at the present time her company, through its divisions and service centres continues to service MINIMAX hose reels and also receives MINIMAX extinguishers for refilling and refurbishment from the trade. She says that the service centre at Stakehill Industrial Park, Middleton, Manchester has advised that they receive around 20 CO2 extinguisher for refills/refurbishment a year and around 6-10 old powder extinguishers. Ms Bowdler says that her company currently refills and refurbishes 75-100 of the MINIMAX stored pressure extinguishers each year, which

involves the provision of fire extinguishing compounds under the MINIMAX mark.

9. Ms Bowdler continues saying that around June 1999 and up until June 2000, her company made genuine and good preparations for the launch of a new MINIMAX product, a project which was headed by John Dus a design and development engineer with Chubb Fire Limited. Exhibit AB3 consists of a copy of the development file stated to have been kept by Mr Dus and clearly shows there had been negotiations, and research carried out into the development of a new extinguisher to be marketed under the MINIMAX brand. As part of this preparation, the corresponding design of the portable fire extinguisher was registered in the United Kingdom under 2083482, a copy of this registration is shown as Exhibit AB4.

10. Ms Bowdler goes on to give details of the preparations towards the launch of the new MINIMAX product, stating that these were interrupted in November 2000 by the reorganisation of the Chubb Group. She confirms that at that time her company was working upon a new domestic extinguisher that was to be launched in the UK under the MINIMAX brand. There is no evidence that this has taken place. Ms Bowdler goes on to comment on the reputation accruing to and remaining with the MINIMAX mark and the consequences if Minimax GmbH & Co KG were to use and register the mark.

### **Applicants' evidence**

11. This consists of a Witness Statement dated 5 March 2007, and comes from Francis Wombwell, a trade mark attorney with Potts Kerr & Co, the applicants' representatives in these proceedings. The Statement consists of submissions on the contents of the opponents' evidence, including its evidential value, and arguments relating to the substantive issues. As such it is not necessary or appropriate that I summarise the Statement. I will, of course take the contents fully into account in my determination of this case.

12. That completes my summary of the evidence insofar as it may be relevant to these proceedings.

### **Decision**

13. The opposition is founded on Section 5(4)(a) of the Act. 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

(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”.

14. 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] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents’ 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 opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

15. To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he 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 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.

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 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.”

16. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced, as per the comments in *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] RPC 429.

17. The starting point is to determine whether the opponents have any goodwill in MINIMAX, and if so, its nature and extent. In *Medgen Inc. v Passion for Life Products Ltd* [2001] F.S.R 30, goodwill is defined as the benefit and advantage of a name or get-up, and is the attractive force that brings in business. Passing off action is a remedy for the invasion of a right of property in the business or goodwill likely to be injured by any actionable misrepresentation. Goodwill does not exist separately from the business to which it is attached. In *IRC v Muller and Co's Margarine* [1901] AC 217 at 223, Lord Macnaughton explained what is meant by "goodwill" in very similar terms:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

18. The opponents' rights in the MINIMAX trade mark are suggested to originate from the ownership and use of the mark by Minimax Limited, who started using it in 1903 in respect of a "conical extinguisher". In 1955 the Pyrene Company Limited purchased Minimax Limited, that company in turn being taken over by Chubb & Sons in 1967. This company operated under the Pyrene name until 1971 when Chubb Fire Security Limited (now Chubb Fire Limited) was formed.

19. Ms Bowdler says that in 1992 the Pyrene company introduced a new range of MINIMAX pressure model extinguishers, but that the opponents have been unable to locate any supporting documentation relating to the launch. Exhibit AB2 is put forward as being a photograph of an extinguisher from the 1992 range, the example shown being believed to have been manufactured in 1999. The extinguisher shows the Chubb name placed above the word "MINIMAX", the product being stated as a powder fire extinguisher suitable for use in the home, car, caravan or on a boat. There is no means by which to date either the photograph, or the actual extinguisher.

20. Ms Bowdler says that from June 1999 up until June 2000 her company made genuine preparations for the launch of a new MINIMAX product, but that these were interrupted in November 2000 by the reorganisation of the Chubb Group. Taken at its face this means that at the relevant date the opponents will not have used the mark in connection

with any goods for well over five years. Preparations for use may, but do not necessarily generate goodwill. There must be existing customers or extensive pre-launch publicity with a positive intention to use the mark in the near future (See *Allen v Brown Watson* 1965 RPC 191 and *BBC v Talbot Motor Co.* 1981 FSR 228.) The *Bud* Trade Mark case [2002] RPC 38 at paragraphs 41 and 42 gives some limited guidance on advertising. Speculation over any preparations for use is somewhat academic because apart from Ms Bowdler's statement there is no evidence of any preparations, or that this product was advertised in, let alone reached the market.

21. It therefore seems that the opponents have not used the MINIMAX name in any trade in goods since 1999, but that does not necessarily mean that they cannot have generated or preserved any goodwill in the following years. In *Ansul BV v Ajax Brandbeveiliging BV*, paragraphs 40 - 42, the European Court of Justice in Case C40/01 stated:

“40. Use of the mark may also in certain circumstances be genuine for goods in respect of which it is registered that were sold at one time but are no longer available.

41. That applies, inter alia, where the proprietor of the trade mark under which such goods were put on the market sells parts which are integral to the make-up or structure of the goods previously sold, and for which he makes actual use of the same mark under the conditions described in paragraphs 35 to 39 of this judgement. Since the parts are integral to those goods and are sold under the same mark, genuine use of the mark for those parts must be considered to relate to the goods previously sold and to serve to preserve the proprietor's rights in respect of those goods.

42. The same may be true where the trade mark proprietor makes actual use of the mark, under the same conditions, for goods and services which, though not integral to the makeup or structure of the goods previously sold, are directly related to those goods and intended to meet the needs of customers of those goods. That may apply to after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services.”

22. Although written in the context of genuine use for the purposes of maintaining a registration of a trade mark, the principle seems to apply in cases where the consideration is whether there is use that will have maintained any pre-existing goodwill in the context of passing-off, usually expressed as residual goodwill. If the use is genuine then it must have genuine benefits in maintaining any pre-existing goodwill and reputation.

23. Ms Bowdler says that in recent years the MINIMAX mark has been used in relation to the servicing, refurbishment and refilling of existing extinguishers and hose reels through its divisions and service centres. The service centre at Stakehill Industrial Park, Manchester is said to receive around twenty CO2 extinguishers for refill/refurbishment

each year, and around six to ten old powder extinguishers. Ms Bowdler says that between seventy-five and one hundred of the later stored pressure MINIMAX extinguishers from the range launched in 1992 are refilled and refurbished each year, which involves the provision of fire extinguishing compounds under the MINIMAX mark, presumably as part of the service rather than as a separate product. There is no evidence to support the claim to use in relation to these “after-sales” services, but at no point do the applicants challenge this claim, be it in their own evidence or by seeking cross-examination of Ms Bowdler. In *Extreme Trade Mark* (BLO/161/07), Mr Richard Arnold QC sitting as The Appointed Person, considered whether the strict rules of evidence apply to the Registrar’s tribunal. The relevant part of his decision is as follows:

“*Unchallenged evidence*

33. *Phipson on Evidence* (16<sup>th</sup> 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 rule [sic] serves 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* [1993] 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 opposing 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 *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence."

24. From the evidence it would seem that the trade in MINIMAX extinguishers generated a goodwill up to 1999, and that the after sale service of refilling and refurbishment of the MINIMAX products would have kept this alive. There is no documentary evidence that supports Ms Bowdler's claims, but that does not take away their evidential value. Ms Bowdler is not some disconnected representative, but the Commercial Manager of Chubb Fire Limited a position she has occupied continuously since 1 July 1997. Although I do not know the exact nature of her responsibilities, in the absence of evidence to the contrary I see no reason why I should not accept this statement at face value. I am therefore satisfied that that at the relevant date the opponents had a goodwill and reputation in respect of the MINIMAX name in respect of fire extinguishers, and the servicing, refurbishment and refilling of extinguishers, as well as the servicing and refurbishment of hose reels.

25. Given that the mark applied for is identical to the mark used by the opponents, I believe it must follow that any use of the name by the applicants in respect of goods for which the opponents have an established goodwill will constitute a misrepresentation that will lead the public into believing that goods that they offer are the goods of the opponents, and as a result, the opponents are likely to suffer damage. The ground under Section 5(4)(a) therefore succeeds.

26. The opposition having been successful the opponents are entitled to a contribution towards their costs. I therefore order that the applicants to pay the opponents the sum of £1,950 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 day 18 of January 2008**

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