

O-092-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No.83758
BY ELECTRICAL WASTE RECYCLING GROUP LIMITED
FOR REVOCATION OF TRADE MARK No. 2353021
STANDING IN THE NAME OF
SILVER LINING INDUSTRIES LIMITED**

BACKGROUND

1) The following trade mark is registered in the name of Silver Lining Industries Limited (hereinafter SL).

Mark	Number	Registered Date	Class	Specification
LAMPCARE	2353021	09.07.2004	39	Collection of waste fluorescent tubes, discharge lamps, VDUs and associated electrical equipment.
			40	Treatment and recovery of waste fluorescent tubes, discharge lamps, VDUs and associated electrical equipment by granulation and processing to recover glass, aluminium, mercury and all other constituent parts and materials.

2) By an application dated 29 April 2010 Electrical Waste Recycling Group Limited (hereinafter EWR) applied for the revocation of the registration under the provisions of Section 46(1)(a) & 46(1)(b) claiming there has been no use of the trade marks on the goods and services for which they are registered in the five year period post registration or in the period 29 April 2005 – 28 April 2010. Revocation dates of 10 July 2009 under Section 46 (1) (a) & 29 April 2010 under Section 46 (1) (b) were sought.

3) On 2 July 2010 SL filed a counterstatement denying EWR's claims stating that the marks had been used or that there were proper reasons for non-use.

4) Both sides filed evidence. The matter came to be heard on 20 February 2013 when EWR was represented by Ms Jamal of Counsel instructed by Messrs Marks and Clerk; and SL was represented by Ms Reed of Counsel instructed by Messrs Appleyard Lees.

SL'S EVIDENCE

5) SL filed a witness statement, dated 7 November 2010, by Peter Hunt the Managing Director of SL based in Leeds. He states that his company has used the mark LAMPCARE since 15 March 2004 in relation to the services of the collection of fluorescent tubes, lamps, VDU's and associated electrical equipment and for the treatment of the above by granulation and processing to recover the constituent parts and materials. He states that the mark has been used throughout the UK. Mr Hunt states that the annual turnover for services under the mark in suit is approximately £650,000 and that his company services around 4000 clients in the UK under the mark in suit including Asda, Morrisons and local authorities and hospitals. He also provides the following exhibits:

- Exhibit PH2: this consists of a copy of a letter, dated 25 August 2010, by Martin Fortune a director of Key Waste Solutions Ltd based in Birmingham. He states that he has been doing business with SL under the mark LAMPCARE, in respect of collecting/disposing/treat/recycle FLT's, lamps, VDUs and CRT's; and that during the last six years there have been dozens of collections and deliveries with the business being worth over £60,000 in this period.
- Exhibit PH3: this consists of a copy of a letter, dated 3 September 2010, by John Robinson the Managing Director of John Robinson Commercials based in Leeds. He states:

—My business involves having to dispose of a considerable number of waste lamps from vehicles and fluorescent tubes from my different sites. I use the Lampcare service for these, they are collected from my premises and taken for disposal and treatment as required.

I have used the Lampcare service since about 2004 when I think it was a new service. We now do about £4000 a year in business and have at least one collection every month.”

- Exhibit PH4: this consists of a copy of a letter, dated 30 August 2010, by David Gardham the owner of David Gardham Builders based in York. He states:

—We find all sorts of things abandoned in buildings including fluorescent tubes, lamps of just about any type, broken visual display units, televisions etc. Because of all the regulations I decided to start using the Lampcare service which now collects and disposes or if possible and recycles such items on our behalf. We have around 20 collections a year from different sites. It costs us less now than it did but we spend about £600 per year. Sometimes we get money back for recovered waste.”

- Exhibit PH5: This would appear to be an example of a leaflet which carries the mark in suit. It is not dated as such but does refer to the regulations that “came” into force in August 2004. Mr Hunt states that this was distributed during the period 1 April 2005 to 31 January 2009. It was mostly distributed by post, and at talks and exhibitions. He states that approximately 500 leaflets were distributed. He states that other leaflets were also distributed to promote the LAMPCARE mark.

EWR’S EVIDENCE

6) EWR filed a witness statement, dated 31 May 2011, by Rebecca Tew, EWR’s Trade Mark Attorney. She states that EWR was incorporated on 27 June 2000 as Lampsafe Recycling Ltd. On 20 June 2001 it changed its name to Lampcare (UK) Recycling Ltd, and on 9 February 2008 to its current name. Details of these changes are provided at exhibit RT1 which is an extract from Companies House records. She states that EWR registered the domain name lampcare.co.uk on 19 June 2001. This is confirmed by exhibit RT2. She states that EWR has been trading under the name LAMPCARE in relation to electrical waste recycling services of fluorescent tubes and lamps and has established a significant business and reputation. She states that EWR has never come across the mark being used by any competition. Given that the two parties are dealing in the same business with the same clients she suggests that they would have been aware of SL’s use of an identical mark. She states that since around 2007 she has periodically searched the website of SL in relation to use of LAMPCARE. She states that at no stage did she locate a reference to SL when searching under LAMPCARE. Only in 2011 after the instant proceedings started did a search turn up SL listed as LAMPCARE/WASTECARE. She notes that SL’s home page lists its marks at the bottom as WEEE CARE, PACK CARE, BATTERY BACK and ECO CARE. She states that there is no mention of LAMPCARE. The service of recycling fluorescent tubes and lamps is under the WASTECARE mark and there is no mention of the mark in suit. Regarding the evidence of SL, Ms Tew states that it is not clear how the letters were collected but comments “it seems coincidental that they all contain the same information”. She also contends “There is nothing to confirm a clear recognition of the

LAMPCARE mark or that the collection of this evidence did not involve leading questions.” Ms Tew also provides the following exhibit:

- Exhibit RT4: Extracts of the website of SL obtained via the online *Wayback Machine* archive service. These are mostly dated 2004 which tallies with the fact that they refer to legislation due in that year. There are 4 pages from 2005 and one from 2006. Whilst no mention of LAMPCARE can be seen large parts of the pages are missing or cannot be read as they are so poorly photocopied.

7) That concludes my review of the evidence. I now turn to the decision.

DECISION

8) As a preliminary point, SL sought to file a colour replacement of exhibit PH5. EWR opposed its introduction as their copy of the exhibit did not show the mark in suit. However, the original copy filed with the Registry did show the mark and as such I was content to allow the new exhibit into proceedings as, in my view, it did not fundamentally alter the evidence but simply made it easier to view. The revocation action is based upon Section 46(1)(a) & (b) of the Trade Marks Act 1994, the relevant parts of which read as follows:

-46.-(1) The registration of a trade mark may be revoked on any of the following grounds -

- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (c)
- (d)

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or

resumption began before the proprietor became aware that the application might be made.”

9) EWR alleges that the mark has not been used in the five years subsequent to its registration or in the five years prior to the date of the application for revocation. The periods in question are, therefore, 10 July 2004 - 09 July 2009 for Section 46(1)(a) and 29 April 2005 - 28 April 2010 for the Section 46(1)(b) ground. These were agreed by both parties at the hearing.

10) Where SL claims that there has been use of the trade mark, the provisions of Section 100 of the Act make it clear that the onus of showing use rests with it. It reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

11) In *Laboratories Goemar SA's Trade Mark (No. 1)* [2002] F.S.R. 51 Jacob J (as he was then) said:

—Those concerned with proof of use should read their proposed evidence with a critical eye — to ensure that use is actually proved — and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

12) In determining the issue of whether there has been genuine use of the mark in suit I look to case O-371/09 (*AMBROEUS*) where Ms Anna Carboni acting as the Appointed Person set out the following summary:

—a) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(b) The use must be more than merely —toen”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(c) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(d) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(i) Examples that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(ii) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(e) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(f) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

13) Section 46(6) states:

—46(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

- (a) The date of the application for revocation, or
- (b) If the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.

14) In the instant case the periods governing the revocation actions under Section 46(1)(a) and 46(1)(b) overlap (see paragraph 9 above). The evidence of use crosses both periods. It is very sparse and consists of the assertions made by Mr Hunt in his witness statement, a single undated leaflet and three letters from customers of the business which because of their format must be regarded as hearsay. EWR have commented upon the letters stating that —“coincidentally” they contain the same information. To my mind, I find the fact that three independent witnesses agree around a basic set of facts reassuring. Inevitably, when witnesses are contacted to provide such evidence, trade mark attorneys will give a rough outline of what they hope the witness can confirm. The fact that the witnesses are willing to confirm these facts is of far more importance than the —“coincidence” that their statements all centre on a given theme. These are not pro forma statements, where all the witness has to do is fill in their name, sign and date the document. All three identify themselves and their companies very clearly, and whilst they are obviously aware that SL trades under a number of different, albeit themed around the word CARE, trade marks they state confidently that they have been dealt with for a particular service under the mark in suit. Notwithstanding these statements, I have the assertion of Mr Hunt himself. I note that EWR have not sought to cross examine Mr Hunt, but have instead filed their own evidence that they could not locate his trade mark on Google. Having made the charge EWR do not provide readable copies of their searches. However, even if I accept that their searches did not find any mention of SL under the mark LAMPCARE, I was not aware that a Google listing was a requirement of the Registry. I fully accept that EWR were in a position of trying to prove a negative, that SL had not used the mark. However, the evidence they have provided is not sufficient to overturn the evidence of use, despite its flaws, provided by SL. Mr Hunt states very clearly that he has used the mark upon all of

the goods and services for which it is listed. He has provided details such as when the use began, the amount of trade carried out under the mark and even provided information on his other marks. These basic facts are corroborated by the independent witnesses. I therefore see no reason to doubt the account provided by SL. **The revocation application under Section 46(1)(a) and 46(1)(b) fails.**

CONCLUSION

15) The revocation fails under both grounds.

COSTS

16) SL has been successful and it is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering and commenting on the other side's evidence	£900
Preparing for and attending a hearing	£1000
TOTAL	£2200

17) I order Electrical Waste Recycling Group Limited to pay Silver Lining Industries Limited the sum of £2200. 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 27th day of February 2013

**George W Salthouse
For the Registrar,
the Comptroller-General**