

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO 3079482
IN THE NAME OF
STEPHEN ROBIN MALLONEY**



IN CLASS 11

**AND THE OPPOSITION THERETO
UNDER NO. 403838**

BY

ROBERT DAVID FUREY

Background and pleadings

1. Stephen Robin Malloney applied for the trade mark shown below on 30 October 2014 for goods in Class 11:



Installation and apparatus, all for water filtering and purification; parts and fittings for all the aforesaid goods; all included in class 11.

2. The application was published in the Trade Marks Journal on 28 November 2014. It was subsequently opposed under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") by Robert David Furey. Mr Furey claims that there is a likelihood of confusion with his earlier mark, the details of which are:

2445159



Class 7: Filtration machines and machine tools for use in the catering industry.

Filing date: 31 January 2007; registration procedure completed: 19 October 2007.

3. Mr Malloney denies that there is a likelihood of confusion between the marks because the goods and services are different and are directed to different customer bases (respectively, catering and water purification). Some of the counterstatement is framed in terms of section 5(3) of the Act, but this was not pleaded.

4. Mr Furey made a statement in his notice of opposition that his mark has been used for all the goods for which it is registered. This is relevant because marks which have been registered for five years or more on the date of publication of the opposed mark are subject to proof of their use, provided that the applicant requests proof of use. In his defence and counterstatement, Mr Malloney requests Mr Furey to provide proof that the earlier mark has been used in respect of "Filtration machines and machine tools for use in the catering industry, and any other similar goods and/or services falling within Class 7 for which the Opponent claims relevant use of his mark." Proof of use can only be requested for those goods which are in the specification and for which a statement of use has been made. The counterstatement also says this:

“The Applicant puts the Opponent to proof of genuine use of this mark in the United Kingdom within the period of five years following the completion of registration of his mark.”

5. The Registry wrote to Mr Malloney’s trade mark representative on 21 March 2016, stating that this period has no part to play in an opposition; the relevant period, under section 6A(3)(a) of the Act, is the five years ending on the date of publication of the opposed application. Mr Furey’s evidence supporting his statement of use did, in fact, address the correct five year period. Mr Malloney’s attorney confirmed, in a letter dated 1 April 2016, that this was an error and that, in ticking the proof of use request box, it was the section 6A(3)(a) period which was meant.

6. Both parties are professionally represented (Mr Furey by D.W. & S.W. Gee; Mr Malloney by Marker Law). Both parties filed evidence. Neither elected to be heard. Only Mr Malloney filed written submissions in lieu of a hearing. I make this decision after careful consideration of all the papers filed.

Relevant dates

7. The relevant dates for proof of use are 29 November 2009 to 28 November 2014. The relevant date for consideration of the section 5(2)(b) ground is the date of application, 30 October 2014.

Evidence

8. Robert Furey has filed a witness statement and exhibits. The covering letter accompanying Mr Furey’s evidence contains the following paragraph:

“Proof of use is being submitted in relation to “filtration machines for use in the catering industry”. No proof of use is specifically being submitted in relation to “machine tools for use in the catering industry”. In the event that the attached proof of use is deemed to be insufficient to maintain the registration in respect of “machine tools”, those goods are to be abandoned.”

9. Mr Furey’s witness statement is dated 16 August 2015. He states that he is the managing director of Florigo UK Limited and Frying Solutions Limited.

10. Exhibit A is described as a copy of a design plan for an installation including filtration machines for use in the catering industry, undertaken by Mr Furey’s companies. The plan is dated 16 March 2011, updated on 4 April 2011. It says it is a concept drawing and not drawn to scale. The mark appears as registered underneath the drawing. The design was produced for a Mr Whitehead of Hornsea (Yorkshire) and appears to relate to a fish and chips installation. The specification includes the mention of a filtration system.

11. Exhibit B is described as four further design plans for installations including filtration machines for use in the catering industry, undertaken by Mr Furey’s companies before the relevant period. Mr Furey states that they show that the design plan in Exhibit A is not an isolated design plan, but is one of a series of design plans. The plain words “Filterlogic Filtration” appear in the middle of the first

page underneath the drawing, which is dated 19 August 2008, updated on 24 November 2008. This design was produced for Mr Pagani, in Annan (Dumfries and Galloway) and appears to relate to a fish and chips installation. The second design plan shows the mark as registered and mentions a filtration system in the specification and "Filterlogic filtration." The design was produced for a Mr Lee of Spennymoor (County Durham). It appears to relate to a fish and chips installation and is dated 25 February 2009. The third design plan is dated 19 March 2009 and shows the mark as registered and the words "Filterlogic filtration" in the specification. It was produced for The Swan Restaurant in Southport (Merseyside) and appears to relate to a fish and chip installation. The fourth design plan is dated 20 April 2009 and shows the mark as registered and the words "Filterlogic filtration" in the specification. It was produced for Mr Nicolaou of Bloxham (Oxfordshire) and appears to relate to a fish and chip installation. All these design plans include the disclaimer that they are concept drawings and are not drawn to scale.

12. Mr Furey states that his companies are in negotiation with US corporations which supply filtration machines to catering facilities, ranging from public houses to fish and chip shops. Mr Furey states that he is "seeking to license the technology to US corporations primarily because they provide economies of scale which can make the new filtration machines more cost-effective". Mr Furey states that his companies have been in discussions with one US corporation for about one year. He states that the US corporation supplies around 50,000 fryers per year, compared to the largest UK supplier, which supplies about 2,000 fryers per year.

13. Mr Furey states:

"11. The installations to which the design plans of Exhibits A and B relate are therefore trial installations for the purposes of proving the technology, intended to allow my companies to demonstrate the effectiveness of the new filtration machines over a number of years. Whilst these installations are all for the fryers of fish and chip shops, we will supply filtration machines under the trade mark to the whole of the catering industry."

14. Exhibit C is described as a copy of an advertisement placed in the periodical "Fish and Chips and Fast Food, published in July/August 2010. The exhibit shows a photocopied full page advertisement, the mark as registered, the mark Florigo, and the words "The only fully automated filtration system available in a frying range today".

15. Exhibit D is described as a copy of an advertisement placed in the periodical "Fry" published in October 2010. The advertisement consists of a photocopied two-page spread. One page refers to the companies Florigo and Frying Solutions Limited and also shows the mark in its registered form with these words next to it:

"The only fully automated built in filtration system that enables you to filter whilst you fry."

16. The other page consists of a testimonial from a Mr Michael, the owner of a fish and chip shop which opened in Leeds in March 2010, with an installation featuring the Filterlogic filtration system.

17. Exhibit E is described as a copy of an A5 publicity brochure printed for Mr Furey's company. Mr Furey states that 500 copies of the brochure were printed, "the vast majority of which were distributed to customers and potential customers during the relevant period". The penultimate page features the trade mark as registered and an explanation of the product.

18. Exhibit F is described as a copy of an A4 folder printed for Mr Furey's company. There were 1,000 copies printed and, again, Mr Furey states that the vast majority of them were distributed to customers and potential customers during the relevant period. Mr Furey states that the brochure was distributed at exhibitions which his company attended between 2010 and 2013, and also directly to customers and potential customers. The folder contained any quotations or company correspondence sent out by hand or by post. The exhibited folder is empty. The front cover shows the company name and logo (Frying Solutions), which is repeated on the back page, together with smaller trade marks underneath, represented as sub-brands, including Florigo and the Filterlogic mark in its registered form.

19. Mr Malloney has filed a witness statement and exhibits, the primary purpose of which appears to be to differentiate between the parties' respective trades (catering and water purification). In summary:

- Mr Malloney's company is called Pozzani which makes and sells products for water purification and filtration. Pozzani has never and never will be involved in oil or fat filtration.
- Pozzani occasionally sells water filtration equipment to the catering industry, but this is a minor part of its present business. Mr Malloney intends to expand the Filter Logic range including for treating cooking and drinking water, and other business contexts, including catering.
- Mr Malloney came up with the name Filter Logic in 2009, for a new range of water filters for domestic applications. He commissioned a designer to design a logo to make it more 'distinguished'.
- Mr Malloney had never heard of Mr Furey or his companies until his application was opposed. He states that this is because the water treatment industry and the oil/fat filtration industry are entirely separate and independent of one another.
- The Filter Logic branded filters have been sold since 2009 in the UK and abroad.
- Mr Malloney believes that Filter Logic is one of the top ten water filter brands in the UK. He has sold over one million Filter Logic water filter products between 1 December 2013 and 30 November 2014 (although it is not clear if all of these sales were within the UK).
- Mr Malloney is willing, if it would be of assistance to Mr Furey, to make a formal undertaking not to use his mark in relation to oil or fat filtration.

Decision

20. Section 6A of the Act provides:

- “(1) This section applies where—
- (a) an application for registration of a trade mark has been published,
 - (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
 - (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if—
- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes—
- (a) 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
 - (b) 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.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects—

- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or
- (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration)."

21. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks:

"217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

[218] ...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) 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 to distinguish the goods or services

from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

22. The onus is on the proprietor to show use because Section 100 of the Act states:

“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.”

23. The relevant period for proving use is 29 November 2009 to 28 November 2014. The evidence supplied by Mr Furey which falls within this period comprises:

- Exhibit A, the copy of a concept drawing/design plan for a fish and chip shop in Yorkshire, dated 16 March 2011 and updated 4 April 2011, which shows the mark in its registered form for a filtration system.
- Exhibit C, the full page advertisement from July/August 2010, showing the mark as registered for a filtration system for use in frying ranges.
- Exhibit D, the double page advertisement from October 2010 showing the mark as registered and a customer testimonial (a fish and chip shop in Leeds).
- Exhibit E, the A5 publicity brochure (500 copies), the vast majority distributed during the relevant period, to customers, potential customers and at exhibitions.
- Exhibit F, the empty folder which contained quotations and correspondence. 1000 of these were printed, the vast majority distributed from 2010 to 2013. The folder bears the mark as registered.

24. On the face of it, this is not a great deal of evidence to show for five years. There are no turnover figures, no customer correspondence, no invoices, no pricing, no quotations, no exhibition details and no photographs of actual installations containing the filtration component which bears the mark. Although the concept drawing was updated within three weeks, suggesting customer involvement, there is no evidence about whether the installation went ahead. It is assumed it did because Mr Furey states that this installation and those in Exhibit B, before the relevant period, were trial installations to prove the technology.

25. Although use of a mark need not be quantitatively significant for it to be deemed genuine, it must use which is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods, bearing in mind the characteristics of the market concerned. Mr Furey states that the trial installations were all for fish and chip shops. He also states that the largest UK supplier supplies about 2,000 fryers a year. It is not shown in the evidence how many suppliers there are in the UK, but it is clearly not a large market. It is also not a consumer market; the items are likely to be expensive and not purchased frequently. That said, compared to 2,000 for the largest supplier, Mr Furey's evidence from the five year period in question amounts to a single design plan for a single customer, and a hearsay testimonial in an advertisement in 2010. Despite the existence of advertising (brochures), this does not appear to be even a toe-hold in the market for oil/fat catering filtration systems.

26. Genuine use can include a launch phase (*MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* Case T-334/01 General Court) and goods which have not yet been sold, but the marketing of which has already happened or is imminent and for which preparations to secure customers are underway, particularly in the form of advertising campaigns. There are no details about the exhibitions at which the

brochures and folders were handed out. The trail goes cold in terms of individual customers after 2011 (Exhibit A) and this was only a trial. Mr Furey states that he is seeking to license the technology (he does not mention the mark) to US corporations. The gaps in the evidence suggest that the UK side of the business, which has amounted to no more than one or two customers in the relevant five year period, one of which was a trial, and four trials prior to the relevant period, has been put on ice to pursue greater economies of scale in the US. If the five trial installations (Exhibits A and B combined) had all been in the relevant five year period, it might have added to the picture of goods for which marketing was imminent. However, four of the five trials are before the relevant period and there are only two advertisements, both in 2010.

27. In *Plymouth Life Centre, O/236/13* Mr Daniel Alexander QC, sitting as the appointed person, observed that:

“20. Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time to review the material that it has to prove use of it.

...

The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

28. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and

purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

29. In criticising the individual pieces of evidence, I have not lost sign of the potential for a picture to emerge which shows genuine use when they are all viewed together. Although they are individually less than compelling, the various parts might corroborate each other. However, the individual pieces of evidence, analysed above, do not present me with a picture of genuine use when I put them together. Mr Furey has not shown genuine use in the relevant period for any of the registered goods.

30. The consequence is that Mr Furey may not rely upon his earlier mark for the section 5(2)(b) ground of opposition, which means that the opposition fails.

Outcome

31. The opposition fails. The application may proceed to registration.

32. Mr Malloney has been successful and is entitled to a contribution to his costs, based on the published scale (see Tribunal Practice Notice 4/2007). I award Mr Malloney costs on the following basis:

Considering the opposition and filing a counterstatement	£200
Evidence	£500
Written submissions in lieu of a hearing	£300
Total	£1000

33. I order Robert David Furey to pay Stephen Robin Malloney the sum of £1000 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 13th day of April 2016

**Judi Pike
For the Registrar,
the Comptroller-General**