

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 1437155 BY MARREL
TO REGISTER THE MARK MARREL IN CLASS 7**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 38630
BY MARRILL ENGINEERING CO LTD**

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**IN THE MATTER OF Application No 1437155 by Marrel
to register the mark MARREL in Class 7**

and

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**IN THE MATTER OF Opposition thereto under No 38630
by Marrill Engineering Co Ltd**

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DECISION

20 On 7 August 1990 Marrel of France applied under Section 17 of the Act to register the mark
MARREL for a specification of goods which reads:

25 “Handling, tipping and conveying apparatus, all for use in agriculture, construction,
civil engineering, refuse and waste collection; apparatus, all for handling and conveying
containers; concrete mixers; gravel spreaders; apparatus, all for collecting, compacting,
storing and transporting refuse and waste; aerial and lighting platforms; parts and
fittings for all the aforesaid goods; all included in Class 7.”

The application is numbered 1437155.

30 On 26 February 1994 Marrill Engineering Co Ltd filed notice of opposition to this application.
The grounds of opposition are in summary:

(i) under Section 12(1) by virtue of the opponents’ registration of the mark
MARRILL (see below for details)

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(ii) under Section 11 by reason of the opponents’ use of their mark.

40 The opponents note that the mark at issue proceeded to advertisement on the basis of
evidence of use for the purposes of Section 12(2). They say that they have no knowledge of
the use referred to and that the applicant is not entitled to benefit from the provision. They
also ask the Registrar to refuse the application in the exercise of his discretion. Details of the
registration referred to above are as follows:

NO	MARK	CLASS	JOURNAL	SPECIFICATION
1338983	Marrill	7	5814/1402	Metal processing machines; machine tools, press tools, jigs; transfer conveying and control apparatus, all being parts of machines; parts and fittings for all the aforesaid goods; all included in Class 7; but not including hydraulic lift platforms or any goods of the same description as hydraulic lift platforms.

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The applicant filed a counterstatement denying the above grounds. Both sides ask for an award of costs in their favour. Both sides filed evidence. The matter came to be heard on 22 January 1999 when the opponents were represented by Mr M Vanhegan of Counsel instructed by Lewis & Taylor, Trade Mark Attorneys and the applicant by Mr A Ashton of Counsel instructed by Wildbore & Gibbons, Trade Mark Attorneys.

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By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

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Opponents' evidence (Rule 49)

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The opponents filed a Statutory Declaration dated 23 December 1994 by John Phillips, their Managing Director. He says his company was established in 1964 and has a current turnover of £7 million. He exhibits (JP1) material showing use of the mark MARRILL. He describes his company's activities in more detail as follows:

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“Many of my company's customers are in the automotive industry which is a very international industry. Further, many of these customers are in specialised parts of the automotive industry, for example waste disposal and excavators. Automotive customers include Rover and Rolls Royce Motors, Ford and LDV (Leyland Daf); excavators, refuse equipment and similar heavy automotive products are made by our customers Komatsu, JCB, Caterpillar, Case and Taylor (formerly Midland Containers).

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Marrill Engineering Co. Ltd. design and make, refurbish and upgrade many forms of machine tools and carry out a considerable amount of work for automotive and specialist automotive companies. These companies know of the broad ranging service available from my company which not only designs and makes jigs and tools but also conveying and control apparatus for use in manufacture and indeed finished pressings for the automotive industry. Our products are technologically sophisticated precision engineering products which are designed and made to the highest international standards”.

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He goes on to give his views on the overlap between the parties' goods and the marks themselves. I bear these comments in mind in reaching my decision. Finally he explains why he is concerned that certain aspects of the proposed registration may damage his company's business.

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"Firstly, my company sells products to Government departments such as the Ministry of Defence. Since the company Marrel is a French company, any possible confusion could lead to loss of orders to my company in the defence, aerospace and other politically sensitive industries. Similar factors may apply to my company's export sales to certain countries. Since it appears that the French company Marrel actually makes refuse vehicles, lorry bodies, tippers, containers and so on, they are in direct competition with many of my customers, for example those listed above under paragraph number 6. My customers, who have been buying for example press tooling from my company under the trade mark MARRILL might, if they became confused by the use of the trade mark MARREL, believe that my company was setting up as competitors in the field of automotive or specialised automotive manufacture and would obviously not want to buy tooling from a potential competitor."

Applicant's evidence (Rule 50)

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The applicant filed a declaration dated 21 August 1995 by Jean-Pierre Jeunet who describes himself as Directeur Général Adjoint of Marrel. He has been associated with the company since 1991. He confirms that he has a good knowledge of the English language.

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He firstly asks that evidence filed at the examination stage in connection with his company's application (and by virtue of which the honest concurrent use provisions were invoked) be admitted into this opposition action. He exhibits this material at J-PJ1. I will return to this material below. He too comments on the respective goods and says that to the best of his knowledge and belief there have been no instances of confusion in over thirty years of concurrent use. He provides more recent turnover figures and also exhibits (J-PJ2) documents from the French Ministère de Budget and an extract from the Encyclopédie Douanière identifying the goods exported into the United Kingdom.

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Exhibit J-PJ1 referred to above consists of a Statutory Declaration by Pierre Martinet, the Chairman of Marrel. Mr Martinet says that the mark MARREL was first used in 1956 in relation to the goods covered by the above specification. Turnover is given as

<u>Year</u>	<u>Turnover in £'s</u>
To April '88	1,941,987
April '89	2,459,913
April '90	2,653,902
April '91	1,802,315
April '92	1,230,859

Goods are said to have been sold throughout the United Kingdom and on average £15,000 per year is spent on advertising with advertisements appearing for example in Commercial Motor, Municipal Journal, Reclamation Weekly and NAWDC News. Goods have been exhibited at the ISWM Show in various locations annually in June for the past 33 years and also at SED and other shows since 1975. The company also publishes brochures, leaflets, and other promotional literature. Specimens of such material are shown at exhibit PM1.

Opponents' evidence in reply (Rule 51)

The opponents filed two Statutory Declarations. The first is from Arnold Vincent Hallam and is dated 29 May 1996 and the second dated 22 May 1996 is from Roy Lane.

I will take Mr Lane's declaration first. He is Research Manager of Carratu International Group Ltd, a commercial investigation company. The purpose of his declaration is to exhibit (RL1) a copy of a report prepared for Lewis & Taylor into use of the name MARREL in this country. The report records the results of enquiries made into the activities of Marrel S.A., Marrel United Kingdom plc and Edbro plc, the latter being a UK company said to be jointly owned by the two Marrel companies following a successful bid in 1991. Much of this material seems to me to be of doubtful relevance as it relates to events occurring in the main after the material date. Mr Lane says Jeff Whitworth, a member of Edbro's sales staff, said that his company no longer markets any products under the Marrel or Bennes Marrel name but did sell a Marrel Rolatip some three years previously. Since then Rolatip machines have been marketed under the Edbro name. A visit to the Edbro offices did not reveal any use of the names MARREL or BENNES MARREL. Finally he refers to a Marrel hydraulic hook lift system used on an Ampliroll product manufactured by another UK company Boughton Ltd.

Mr Hallam is a partner in Lewis & Taylor, the opponents' professional representatives in this matter. In summary he makes the following points:

- Mr Lane's enquiries failed to find any substantial use of MARREL in this country. Sales in this country have been through Edbro plc and Boughton Ltd. These companies appear to use other brand names
- Mr Jeunet's declaration is open to criticism as dealing with matters after the material date
- it is noted that Mr Martinet's declaration was originally drafted for Thomas Trafford Boughton (this is evident from initialled amendments on the face of the document). Mr Boughton, it is said, is Chairman of Boughton Ltd, one of the UK distributors of the applicant's goods
- it is further noted that the single exhibit to Mr Martinet's declaration appears to have been used originally in support of an application to register the mark AMPLIROLL (the hook lift system of Bennes Marrel marketed by Boughton). As a result it is suggested that this casts doubt on the relevance of the use figures given by Mr Martinet

- enquiries were instituted into the journals referred to by Mr Martinet in relation to advertising activity. No record was found of two of the journals and no advertisements using the MARREL name were found in Commercial Motor and NAWDC News. Mr Hallam draws the conclusion that any goods sold in the United Kingdom have been marketed by Boughton under trade marks other than MARREL
- the opponents have no knowledge of the ISWM Show and SED (referred to by Mr Martinet) and assume they are not UK exhibitions
- the documents exhibited as PM1 do not show use of MARREL in this country. Much of the documentation is in French and, although there is also English language text, English is an international language. The “flash service” map on page 27 of this document is of France only
- the mark used in the document is BENNES MARREL and geometric device
- further detailed criticism is offered of what is described as the Boughton documentation in exhibit PM1
- no order letters, invoices or the like have been supplied.

Applicant’s further evidence (Rule 52)

This further evidence comes in the form of a Declaration dated 27 January 1997 by Jean Delpont, the new Administrative and Financial Manager of Marrel. He confirms he has a reasonable understanding of the English language.

In summary

- he confirms that he has rechecked the company’s sales records between 1956 and 1988. Whilst these records are not extensive or detailed he is able to confirm that goods bearing the mark MARREL have been sold in the UK since 1959
- he says that Mr Martinet’s reference to the Municipal Journal was incorrect and should have been Municipal Engineering. He exhibits (JD1) copies of advertisements placed in the magazine dated 25 April 1978 and 20 June 1978
- he explains that ISWM and SED stand for Institute of Solid Wastes Management and Site Equipment Display. He exhibits (JD2) a copy of a catalogue entry for the former. He suggests that neither show would be of interest to the opponents given the nature of their goods

- in relation to Mr Phillip's statement that his company sells to Government Departments such as the Ministry of Defence he says such business is done by tender and confusion is unlikely given the sophisticated nature of the goods

5 - he clarifies certain aspects of exhibit J-PJ2 to Mr Jeunet's declaration.

That completes my review of the evidence.

10 The respective specifications are set out at the start of this decision. I suspect that a casual observer considering those specifications would not think that the parties are in the same line of business. Such a view is largely borne out by the evidence filed and the submissions at the hearing. Nevertheless it is in the nature of trade mark specifications that they are rarely framed with absolute precision and, for sometimes understandable reasons, employ generalised terminology. On occasions this practice will bring into conflict parties who might not expect to encounter one another in the normal course of trade. In my view that is largely what has happened here. I was asked at the hearing to defer issuing my decision so that the parties, who at that stage were in belated discussions, could try and reach an agreement of some form that would dispose of the opposition proceedings. In the event, it seems that no such agreement has been reached and I have had to come to my own view of the matter as set out below.

The opposition is based on Sections 11 and 12 of the Act which read:

25 "11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

30 12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- a. the same goods
- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description."

40 The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

45 The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted, in the case of

Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

5 **(Under Section 11)** Having regard to the user of the mark Marrill, is the tribunal satisfied that the mark applied for MARREL, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

10 **(Under Section 12)** Assuming user by the opponents of their mark Marrill in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark MARREL, normally and fairly in respect of any goods covered by their proposed registration.

15 The main issues between the parties arise under Section 12 and I will, therefore, take that ground first.

20 Mr Ashton, for the applicants, quite properly conceded that the marks themselves are very close. Whilst the problem of confusing similarity may not be quite so acute in relation to industrial goods as it might be with inexpensive consumer items it is a problem none the less. Not surprisingly, therefore, the main area of discussion at the hearing was the respective sets of goods.

25 The opponents' specification covers the machines, presses and tooling that are used to produce component parts. Their customers are spread across a wide range of industries - automotive, agricultural, defence, domestic equipment manufacturers etc. The applicants; main area of activity on the other hand appears to be the provision of hydraulic systems used for a variety of purposes (typically tipping or lifting) on lorries, trucks, or semi-trailers and specialist vehicles. The product literature supplied suggests that the construction industry and
30 waste transport and collection industry would be prime users.

35 Whilst there is in my view some distance between what I will call the parties' respective core activities there is an area of overlap in the specifications which was highlighted at the hearing. This arises principally from the "transfer conveying and control apparatus" in the opponents' specification and the handling and conveying apparatus in the first half of the applicants' specification.

40 As matters stand I cannot rule out the possibility of conflict between these goods having regard to the terms used and the established tests for comparison of goods (notably the criteria in the JELLINEK case (1946 RPC 59) . The question arises as to whether they are the same goods or goods of the same description. The point is not simply an academic one because it is part of the applicants' case that if I hold that the same goods are involved the opponents are nevertheless not entitled to object to their mark going on the register by virtue of the fact that
45 Section 7 of the Act (saving for vested rights) will come into play based on the applicants' antecedent use. In the alternative the applicants make a claim under Section 12(2) on the basis of honest concurrent use and special circumstances.

The opponents' conveying apparatus is qualified in two respects. Firstly it is said to be 'transfer' conveying apparatus and secondly it is restricted to 'all being parts of machines'. There has been no attempt to further explain the significance of the full description thus involved but it seems to me that without unreasonably stretching the normal meaning of words it is very doubtful that the term should be construed as covering the sort of application specific purposes associated with the applicants' goods.

Mr Jeunet says in his declaration that "it is in the sense of transportation that the word 'conveying' in my company's specification of goods should be understood". Even Mr Phillips in his declaration for the opponent does not go so far as to say that the respective goods are the same but rather argues that they are of the same description. Moreover he refers to his company's goods as being "conveying and control apparatus for use in manufacture". That seems to me to be consistent with the reference in the opponents' specification to their transfer conveying apparatus being parts of machines. I note also that their brochure shows a cooker production line with the goods under manufacture progressing along what I take to be a conveyer line (presumably to the next stage of manufacture or assembly). It seems likely, therefore, that transfer conveying is being used as a term to describe a factory or production line process. Based on what I can actually establish about the respective activities I am not entirely persuaded that even goods of the same description are involved. But I must bear in mind that the test under Section 12 is a notional one and I must consider the potential scope of the opponents' specification. Bearing in mind also the generalised terminology used I have come to the view that the respective specifications do not cover the same goods but can be construed as covering goods of the same description. The opposition thus succeeds under Section 12(1) in respect of that part of the applicants' specification that covers handling and conveying apparatus but not the very specific items from the words 'concrete mixers' onwards.

Before considering the applicants' counterclaim under the honest concurrent use provisions of Section 12(2) I will deal briefly with the opponents' case under Section 11 based on their actual use. Mr Vanhegan took the view that his clients' use goes wider than the goods for which they are registered and covers not just the supply of machines tools, press tools, jigs etc. but also a related design service for the production of parts to customers' specifications. Beyond this it is said that the company will also use the tooling etc. they have designed to produce the parts for the customer. Thus it seems the opponents will either provide the customer with the means by which the parts can be produced or, if for instance the customer lacks the production facilities, Marrill will manufacture the parts for them. As already indicated these various functions are performed for a wide variety of end user industries including the automotive and specialist automotive industries. On this basis it is said that the customers of the two companies may overlap with resulting risk of confusion.

Even allowing for all normal and fair use of the applicants' mark I am not persuaded that there is or is likely to be any conflict between the parties in a trading context. As indicated the opponents' main activity is the provision of the means (tooling etc) whereby their customers can produce for themselves particular parts and components. With the possible exception of the transfer conveying apparatus on which little specific information exists the opponents do not appear to be offering completed apparatus or systems. Even when they are manufacturing parts for the customer (and the scale of this business is not clear) instead of just supplying the tooling, the customer would have approached the opponents because of their acknowledged

5 expertise in the design and manufacture of machine tools and associated press tools, jigs etc.
Given the nature of the opponents' trade I do not think it is likely that there will be confusion
within the meaning of the BALI test if the applicants use their mark in a normal and fair
manner. In the absence of evidence I am not prepared to assume that the sort of problems
10 postulated by Mr Phillips are likely to arise. In particular I find it difficult to believe that the
opponents' customers, if they encountered the MARREL mark, would necessarily conclude
that the opponents were now operating in a different field and as a result would see the
opponents as a competitor and would not want to buy tooling from them. That seems to me
require a series of assumptions that go beyond a reasonable and businesslike approach to the
15 issues before me. Making the best I can of it, therefore, the opponents' case under
Section 11 does not in my view raise any wider considerations than the position reached under
Section 12.

I now turn to the applicants' claim under Section 12(2). This Section reads:

15 "12(2) In case of honest concurrent use, or of other special circumstances which in the
opinion of the Court or the Registrar make it proper so to do, the Court or the
Registrar may permit the registration by more than one proprietor in respect of:-

- 20 (a) the same goods
- (b) the same description of goods or
- 25 (c) goods and services or descriptions of goods and services which are
associated with each other

of marks that are identical or nearly resemble each other, subject to such conditions
and limitations, if any, as the Court or Registrar, as the case may be, may think it right
to impose."

30 The main matters for consideration under Section 12(2) were laid down by Lord Tomlin in the
PIRIE case 1933 RPC 147. They are:

- 35 (i) the extent of use in time and quantity and the area of trade;
- (ii) the degree of confusion likely to ensue from the resemblance of the marks,
which is, to a large extent, indicative of the measure of public inconvenience;
- 40 (iii) the honesty of the concurrent use;
- (iv) whether any instances of confusion have been proved;
- 45 (v) the relative inconvenience which would be caused if the mark in suit was
registered, subject if necessary to any conditions and limitations.

The evidence of use which underpins the claim is contained in Mr Martinet's declaration as
later confirmed and clarified by Mr Delpont. The evidence presents a number of difficulties

and was heavily criticised by Mr Vanhegan at the hearing. As indicated earlier Mr Martinet's declaration was originally filed during the course of processing the application but has been adopted into these opposition proceedings. It seems that the declaration was originally intended to be sworn by Thomas Trafford Boughton but was subsequently adapted for Mr
5 Martinet. However the exhibit to the declaration was originally headed in respect of an application to register AMPLIROLL, a mark used in relation to another Marrel product and for which, it seems, Mr Boughton's company was distributor in this country. The word AMPLIROLL has been deleted from the heading and MARREL inserted in manuscript. This raises a number of questions about the evidence. Mr Ashton's response was that this did not
10 matter - if the facts are the same and applicable to use of both marks then it should not matter who has sworn the information. It is not so much the latter point that concerns me as the difficulty of knowing quite what the evidence establishes. Are the two marks, MARREL and AMPLIROLL, used as separate marks on or in relation to the same goods? Or as a composite mark? If as seems to be the case AMPLIROLL is used in relation to a particular type of
15 product¹ in the Marrel range then the same evidence may also serve to show use of MARREL on that same type of product but I cannot see how it establishes use across the broad specification claimed by the applicants. Alternatively if, as Mr Ashton suggested, it did not rule out the possibility of MARREL being used on other goods then at the very least there needed to be some disaggregation of the information to show which marks were being used in
20 relation to which goods. Despite Mr Ashton's best efforts to deal with these points I regard the evidence as being fundamentally flawed in terms of achieving its intended purpose. That is not to cast doubt on the sales information provided but for the above reasons I cannot be certain of the marks used or the goods to which they relate.

25 The problem with the evidence is further compounded by the fact the main brochure exhibited (PM1) to Mr Martinet's declaration shows very little use of the mark applied. Rather the dominant and most obvious trade mark used is a composite one consisting of the words BENNES MARREL (albeit with BENNES in smaller type) and a device mark. It is by no means clear from when and to what extent MARREL has been used on its own. The
30 remaining items in Exhibit PM1 show a plate, presumably used on vehicles or equipment, with the words Hearncrest - Boughton/Marrel and a Hearncrest Boughton brochure headed Twenty One Years of Marrel Boughton Multi Buckets depicting various vehicles incorporating lifting devices. The exhibits to Mr Delpont's declaration do not greatly assist other than to clarify advertising usage. The advertisements concerned are under the heading
35 Boughton International Refuse Disposal Equipment and show a 'Hearncrest Boughton Marrel Skip Loader', a 'Marrel Ampliroll and Trailer' and a 'Marrel 8 Wheel Skip Loader'.

40 Making the best I can of the material it does not establish use in this country beyond a rather restricted product range. I bear in mind also that the main brochure relied on is in French and English and refers also to an international distribution network. This suggests that the use position in any given market needed to be established with some care. Moreover the assertion that MARREL has been used on its own is not convincingly established by the exhibits. In these circumstances I am not persuaded that the applicants' claimed use has been sufficiently well explained or documented to get them to the starting line in terms of the PIRIE test and

¹ A vehicle-mounted hook lift system for the handling and tipping of large containers.

certainly not for the generality of the first part of their specification. Accordingly I do not intend to undertake an evaluation of their case against the criteria set out above.

5 I nevertheless return to my starting point which is that these parties are not in my view in any real commercial sense in conflict. Nor is there any suggestion that there has been any confusion in the marketplace, though I must, of course, have regard to what the applicants will notionally be able to do if registered. I have come to the view that the application is not open to objection in respect of a specification of goods which more precisely describes what seems to me to be their core area of trade (and reflecting also those goods in respect of which objection does not arise). The application will, therefore, be allowed to proceed to registration if, within one month of the end of the appeal period for this decision the applicants file a Form TM21 amending their specification as follows:

15 "Vehicle-mounted hydraulic and mechanical lifting and handling systems, all for use in agriculture, construction, civil engineering, refuse and waste collection; concrete mixers; gravel spreaders; apparatus, all for collecting, compacting, storing and transporting refuse and waste; aerial and lighting platforms; parts and fittings for all the aforesaid goods; all included in Class 7."

20 If the applicants do not file a TM21 restricting the specification as set out above the application will be refused in its entirety.

25 In the circumstances the opposition having been partly successful I order the applicants to pay the opponents the sum of £400. If the applicants do not amend their specification the opposition will have succeeded in its entirety and I will order the applicants to pay the opponents the sum of £800.

30 Dated this 26 day of April 1999

35 M REYNOLDS
For the Registrar
the Comptroller General