

O-349-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No. 2515703
BY SUMITOMO RUBBER INDUSTRIES LIMITED
TO REGISTER THE TRADE MARK
DUNLOP
IN CLASSES 35 & 37**

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No.99615 BY
BTR INDUSTRIES LIMITED and
DUNLOP INTERNATIONAL LIMITED**

BACKGROUND

1) On 12 May 2009 Sumitomo Rubber Industries Limited (hereinafter the applicant), applied to register the trade mark DUNLOP for the following:

In Class 35: Retail services relating to tires; business consultation, information and advisory services relating to tires and repair of vehicles; but none of the aforesaid services relating to aircraft tires, aircraft applications or industrial applications.

In Class 37: Tire retreading, repair of tires, fitting of tires, consultancy, advisory and information services relating to the above services; consultancy, information and advisory services relating to tires and repair of vehicles; but none of the aforesaid services relating to aircraft tires, aircraft applications or industrial applications.

2) The application was examined and accepted, and subsequently published for opposition purposes on 10 July 2009 in Trade Marks Journal No.6793.

3) On 9 October 2009 BTR Industries Limited (hereinafter the opponent) filed a notice of opposition, subsequently amended on more than one occasion. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Number	Mark	Date of filing /registration	Class	Relevant Specification
CTM 2831188	DUNLOP	30.08.2002 / 16.09.2004	6	Hose and flexible hose; pipes and flexible pipes; tubing and flexible tubing; couplings; hose and pipe fittings; parts and fittings for all the aforesaid goods; all goods made wholly or predominantly of metal.
			17	Non-metallic hose; pipes and tubing; flexible and high pressure hose, pipes and tubing; hose, pipes and tubing made of rubber and rubber substitutes; couplings and hose fittings; parts and fittings for all the aforesaid goods.
			37	Installation, maintenance, repair, servicing and re-furbishing of hose, pipes, tubes and related parts and fittings.
312332C	DUNLOP	17.04.1909 / 17.04.1909	12	Industrial tyres for vehicle wheels and tubes and repair outfits therefor.
1044430C	DUNLOP	03.04.1975 / 03.04.1975	12	Industrial tyres for vehicle wheels and tubes and repair outfits therefor.gears.

- b) The opponent contends that the mark in suit is similar to its marks above. It also contends that the goods of the two parties are identical or similar. The mark in suit therefore offend against Section 5(2)(a) of the Act.
- c) The opponent contends that the mark in suit was applied for in bad faith, contrary to section 3(6) of the Act, in that it was filed in breach of a license agreement dated 2 January 1985, and contrary to the provisions of a Partial Assignment of trade marks agreement from 2006.
- d) The opponent also contends that the mark in suit offends against section 5(4)(b) of the Act because in the agreements mentioned at (c) above the applicant agreed to refrain from registering or using the trade mark in connection with goods or services other than:

“tyres for vehicle wheels; inner tubes for vehicle tyres and repair outfits therefor but not including industrial or aircraft applications of any such products.”

4) On 26 April 2011, the applicant filed a counterstatement, subsequently amended. They denied all the grounds and put the opponent to strict proof of use regarding trade marks 312332C and 1044430C. They also point out that the 5(4)(b) ground is unsustainable as it only refers to rights to a name, personal portrayal, copyright and industrial property right. It does not cover contractual rights. The applicant claims that as a result of agreements between the parties the opponent has effectively given consent to use and is therefore estopped from taking action.

5) On 15 November 2012 the prior registrations relied upon in the instant case were acquired by Dunlop International Limited. On 24 January a request was submitted to allow Dunlop International Limited to be substituted as the opponent in respect of the grounds of opposition under Section 5(2)(b) and 3(6), with the original opponent BTR Industries Ltd remaining as the opponent under Section 5(4)(b). This letter also requested the applicant to confirm that it accepted that the evidence filed fulfilled the proof of use requirement. In the absence of such assurances the new opponent sought leave to file additional evidence and also sought permission to cross examine the applicant’s witnesses. This was subsequently amended to a request for cross examination of one witness which was granted. The new opponent provided the assurances required under paragraph 4.17 of the Registry Work Manual in a letter dated 28 January 2013.

6) Both sides filed evidence and both sides request costs. As a lot of the evidence was the subject to confidentiality orders, and as the decision relies heavily upon these confidential documents, large parts of the decision are redacted and not open for public inspection. The matter was heard on 31 January 2013. However, because of the issue of the cross examination the hearing was adjourned and reconvened on 14 March 2014. At the hearing, BTR Industries Limited and Dunlop International Limited were represented by Mr Moody-Stuart of Counsel instructed by Messrs Isaac & Co.; the

applicant was represented by Mr Simon Malynicz of Counsel instructed by Messrs Clifford Chance LLP.

CONCLUSION

50) Given my findings the opposition under Section 3(6), 5(2)(b) and 5(4)(b) must all fail.

COSTS

51) At the hearing it was agreed that the parties would have the opportunity to comment on the issue of costs after the interim decision was issued. As such the parties are given fourteen working days from the date of this interim decision to provide such submissions. The appeal period will not commence until the supplementary decision on costs is issued.

Dated this 6th day of August 2014

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

