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TRADE MARKS ACT 1938 ( AS AMENDED)  
AND TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 1385672  
BY THAUMATURGY (UK) LIMITED  
TO REGISTER A TRADE MARK  
**DAMBUSTER**  
IN CLASS 1

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AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 45085  
BY ALAN WISEMAN ADHESIVES LTD.

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15 BACKGROUND

15 On 31 May 1989, Thaumaturgy (UK) Ltd of PO Box 37, Harwood Street, Blackburn, Lancashire,  
BB1 3BU applied under the Trade Marks Act 1938 for registration of the trade mark  
DAMBUSTER in respect of "Chemical preparations for clearing or cleaning drains; all included  
20 in Class 1." The application was granted on the basis of honest concurrent use from 1980 with  
Registration No B1257067.

On 8 August 1996, Alan Wiseman Adhesives Limited, filed notice of opposition to the application.  
The grounds of opposition are in summary:

25 1) The mark applied for is not capable of distinguishing the goods of the applicant and  
registration thereof would be contrary to the provisions of Section 10 of the Trade marks  
Act 1938 (as amended).

30 2) The opponent is the registered proprietor of UK trade mark number B1257067  
DAMBUSTER dated 23 December 1985 in Class1 in respect of "Chemical products  
included in Class 1 for cleaning and clearing drains".

35 3) As the trade mark in suit is identical to that of the opponent and for identical goods it  
is liable to deceive or cause confusion and so offends against Section 12 of the Trade  
Marks Act 1938. Furthermore, the applicant is not in a position to claim the benefit of  
Section 12(2) of the Act.

40 4) By virtue of the opponent's substantial use of the trade mark DAMBUSTER in the UK  
use of the mark applied for is likely to deceive or cause confusion and would be contrary  
to the provisions of Section 11 of the Trade Marks Act 1938

45 5) The applicants are not entitled to claim to be the proprietors of the mark applied for,  
and registration of the mark applied for would offend against the provisions of Section  
17(1) of the Trade Marks Act 1938 (as amended).

6) The application should be refused in accordance with the Registrar's discretion under  
Section 17(2) of the Trade Marks Act 1938.

The applicant filed a counterstatement denying all the grounds of opposition. The applicant also

claims to have continually used the trade mark on goods in the UK since 24 June 1983. Further that the opponent has on oath in the High Court, given evidence that its DAMBUSTER product was only developed in 1984. As such both the development date and the date of the opponent's own trade mark registration post date the first use by the applicant. The applicant also asks the Registrar to exercise her discretion in their favour and both sides seek an award of costs in their favour. Both sides filed evidence in these proceedings and the matter came to be heard on 10 January 2000, when the applicant was represented by Mr Neill of Appleyard Lees, Trade Mark agents. The opponent was represented by Ms McFarland of Counsel instructed by Wildbore & Gibbons.

By the time this matter came to be decided 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 this decision are references to the provisions of the Trade Marks Act 1938 ( as amended) unless otherwise indicated.

#### OPPONENT'S EVIDENCE

This consists of a statutory declaration, dated 20 May 1997, by Alan Leonard Wiseman the Managing Director of Alan Wiseman Adhesives Limited.

Mr Wiseman states that:

“In the High Court proceedings commenced in March 1990 and alluded to in the applicants' counter-statement, I confirm that I gave evidence that in 1984 I developed the liquid drain cleaning product which my company sells under the trade mark DAMBUSTER. In the course of further investigation of my company's records, however, I have since that time discovered that my company actually first used the trade mark DAMBUSTER in 1975. This information was not available at the time that the High Court proceedings were commenced. In those proceedings, which are currently in abeyance, my company has sought to restrain the applicants from infringement of my company's registered trade mark No 1257067 DAMBUSTER dated 23 December 1985.”

Mr Wiseman produces at exhibit ALW1 copies of price lists issued by his company dated 1 May 1977 and 1 March 1980. Both show that the company offered a drain cleaning product called DAMBUSTER, with the word being stylised in two different fonts for the word “DAM” and “BUSTER” with an explosion in the background.

At exhibit ALW2 copies of invoices, dated 6, 10 & 12 October 1977, showing sales of products under the DAMBUSTER trade mark are provided. The orders were placed by companies in Hertfordshire, Kent and Middlesex. These sales amounted to £60.

Mr Wiseman states that:

“Since 1975 my company has sold many thousands of 1 litre bottles of DAMBUSTER drain cleaning agent. The product is sold principally through chains of builders merchants and there is now produced and shown to me an exhibit marked ALW3 copies of my company's sales literature illustrating the product. My company's DAMBUSTER drain

cleaning agent has been sold through builders merchants throughout the whole of the United Kingdom.”

Exhibit ALW3 shows a range of products including a drain cleaner with the DAMBUSTER trade mark, albeit in the stylised form mentioned above. The literature is not dated.

Mr Wiseman states that “The following quantities of DAMBUSTER drain cleaning agent have been sold since 1977.”

Year	No of 1 litre bottles	Sales value £
1986 - 1990	211,613	846,452
1990 - 1996	684,187	3,420,935

Mr Wiseman comments adversely on the quality of the applicant’s product and states that the use by the applicant of their trade mark “in the first years of use was either only token use or not genuine commercial use because the quantities involved were too small. “

He concludes:

“There is now produced and shown to me marked ALW4 copies of invoices which originally formed part of the applicants’ evidence in the above mentioned High Court proceedings and on which the applicants have sought to rely as part of their defence. It will be seen that the stated cost value of the products supplied are very small. The applicants’ application for registration as published in the trade mark’s journal includes a claim to honest concurrent use of the trade mark DAMBUSTER since 1980; however, it would appear that their total business under the mark three years later amounted to no more than a few hundred pounds. The applicants ought not to be allowed to rely on such insignificant levels of sales to undermine my company’s exclusive registered rights in the trade mark DAMBUSTER.”

Exhibit ALW4 comprises of invoices from the applicant and show sales from 24 June 1983 to 7 February 1990. The sums involved are all relatively small, most invoices being for less than £100.

#### APPLICANT’S EVIDENCE

This consists of a statutory declaration, dated 13 November 1997 by Mr David McCartney, the Managing Director of the applicant company.

Mr McCartney states that:

“The applicants have equities in the trade mark DAMBUSTER in relation to the goods of the application going back to 1980. A DAMBUSTER product was sold at the time by a company Melpass Ltd. The applicants acquired the business of Melpass Ltd, including the business in the DAMBUSTER product in 1983. Goods have been sold by the applicants under the trade mark DAMBUSTER continuously since 1983.”

At exhibit DM5 is a copy of an affidavit, dated 11 April 1990, sworn by Emanuel Tod Benjamin

5 who was the Managing Director of Thaumaturgy (UK) Ltd. Mr Benjamin confirms that the applicant acquired the business of Melpass Ltd and states that the applicant has sold the product DAMBUSTER continuously since 1983. He claims that: “Since 1983, we have sold about 13,000 one-litre bottles, and about 7,000 two-litre bottles. We are now selling about 5,000 two-litre bottles per year.”

10 Attached to Mr Benjamin’s affidavit is the same bundle of invoices as is attached to the declaration of Mr Wiseman. Mr Benjamin describes these invoices as “a bundle of typical invoices which include DAMBUSTER, covering the period from 1983 to date.” The exhibit has invoices to a range of different clients with approximately four invoices for each year during the period June 1983 - February 1990.

15 Mr McCartney also provides at exhibit DM6 a copy of the statutory declaration, dated 9 November 1995, that he provided during the earlier trade mark proceedings.

In this declaration he provides annual turnover figures for sales under the DAMBUSTER mark as follows:

Year	Amount £
1990	42,465
1991	40,817
1992	39,497
1993	50,067
1994	52,053
1995	95,047

20 In other exhibits to this previous declaration Mr McCartney provides a list of towns throughout the UK where the applicants’ product is sold, price lists and a selection of sales literature which show use of the trade mark in suit (in plain script) and specimen invoices for the period 1990 - 1995 which show sales of product under the mark in suit.

30 Lastly Mr McCartney provides at exhibit DM7 a copy of an affidavit by Alan Leonard Wiseman “In which he states, on oath, that the opponents’ product was only invented in 1984.”

35 The exhibit is dated 28 March 1990 and refers to proceedings in the High Court. At paragraph two of the affidavit by Mr Wiseman he states:

40 “2. During 1984 I in the course of business invented a formula for the provision of a liquid drain cleaning agent and on perfecting such formulation made application to the Trade Marks Registry for registration of the name ‘DAMBUSTER’ which was a name I invented for the name of the product. There is now produced and shown to me marked ALW1 a true copy of the order of the Trade Marks Registry dated the 13<sup>th</sup> February 1987 which records the certificate of registration of the name DAMBUSTER in favour of the plaintiffs registered as at the 23<sup>rd</sup> December 1985.”

“3. Since that date the plaintiffs have manufactured and sold considerable quantities running into many thousands of one litre bottles of DAMBUSTER.”

#### OPPONENTS’ EVIDENCE IN REPLY

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This consists of another statutory declaration by Mr Leonard, dated 18 May 1998. He states at paragraph two:

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“Mr McCartney draws attention in paragraph six of his declaration to my affidavit in the High Court proceedings. I have dealt briefly with the issue of the date of invention of my company’s current DAMBUSTER product in my first statutory declaration at paragraph three. I would point out however that my said affidavit does not say that I invented the name DAMBUSTER in 1984. In fact, as I have explained, my company first used the mark in 1975, a fact that I had not recalled when swearing my affidavit. My affidavit says that I applied for registration of the trade mark DAMBUSTER after having perfected a formula for the product in 1984. My company’s use of the name prior to that date was in respect of a different formulation, although the chief constituent of the product has always been sulphuric acid, as is Thaumaturgy’s.”

15

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“I should reiterate that my company’s use of DAMBUSTER has been continuous and on a nationwide basis. I have exhibited to my earlier statutory declaration copy invoices from 1977 for the Kent, Middlesex and Essex regions; however my company’s DAMBUSTER product is sold through chains of builders’ merchants such as Graham’s and Jewson’s which have several hundred branches throughout the UK. Thaumaturgy ought reasonably to have been aware of my company’s use of DAMBUSTER by 1983 when they say they first used the mark.”

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“I have no knowledge of the alleged use of the name DAMBUSTER by Melpass Ltd since 1980 referred to by Mr McCartney at paragraph two of his declaration. My colleagues have no knowledge of it either. I conclude that any use by Melpass of the mark must have been very limited. I note that Mr McCartney does not refer to or exhibit any documentation showing that the goodwill in the business of that company or the trade mark DAMBUSTER was formally assigned to Thaumaturgy.”

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That completes my review of the evidence.

#### DECISION

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At the hearing Ms McFarland withdrew the grounds of opposition under Section 10.

The first ground of opposition is under Section 12(1) of the 1938 Act. This reads as follows:

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*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.”*

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The reference in Section 12 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.

10

It is accepted by both parties that the trade marks are identical and that the goods, drain cleaners are also identical. Both parties claim to have been selling throughout the UK and so there would appear to be no geographical limitations which could separate them. The opposition under Section 12(1) therefore succeeds, subject to the application of Section 12(2).

15

The applicant has sought relief from Sections 7 and 12(2) of the Act, these read:

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*7. - Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior -*

*(a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his; or*

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*(b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his;*

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*whichever is the earlier; or to object ( on such use being proved) to that person being put on the register for that identical or nearly resembling trade mark in respect of those goods under subsection (2) of section twelve of this Act.*

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*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: -*

*(a) the same goods*

*(b) the same description of goods, or*

40

*( c) goods and services or descriptions of goods and services which are associated with each other,*

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

With regard to Section 7, the applicant's first use was in 1983. Examples of invoices have been

provided for each year from 1983 - 1990, but not total sales figures. The only such figures provided by the applicant relate to the period 1990 - 1995 and are after the relevant date. The applicant states that it purchased the business of a company called Melpass Ltd, which it is claimed, had sold a drain cleaner under the mark DAMBUSTER since 1980. However the applicant has not provided evidence of having acquired the goodwill in the business previously conducted by Melpass Ltd. Consequently, the applicant's established first user dates from 1983.

The opponent has claimed that sales of a drain cleaner under the mark in suit began in 1975. Price lists and three invoices from 1977 are provided as corroboration. An explanation is provided as to why the claims made in the High Court under oath that the mark was first adopted in 1984 were incorrect. Despite the paucity of the supporting evidence I accept that the opponent first used the mark in 1977. The opposition is not therefore excluded by Section 7.

With regard to section 12(2), the main matters for consideration under this section were laid down by Lord Tomlin in the *PIRIE* case [1933] RPC 147. They are:

- (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;
- (iii) the honesty of the concurrent use;
- (iv) whether any instances of confusion have been proved;
- (v) the relative inconvenience which would be caused if the mark in suit was registered, subject if necessary to any conditions and limitations.

So far as the extent of use is concerned the applicant has, as already indicated, been using their mark since 1983 and thus had some six years use by the filing date. The sales invoices show sales to most areas of the UK. However, no turnover figures prior to the filing date are provided. The extent of the applicant's use is referred to in the affidavit, dated 11 April 1990, by Mr Emmanuel Benjamin (exhibit DM5). He states that between 1983 and the date of his affidavit the applicant had sold 13,000 one litre bottles of "DAMBUSTER" and 7,000 two litre bottles. The invoices indicate that the goods are usually sold in twelve litre cases.

When considering the degree of confusion likely to ensue from the resemblance of the marks [point (ii)] I must, I believe bear in mind that the marks and goods are identical. Therefore the obstacle that the applicant must overcome in terms of the measure of public inconvenience is considerable.

In terms of the relative inconvenience to the parties [point (v)], it is the position at the filing date that I must consider. The paucity of information as to the extent of the applicant's business at this time makes it difficult if not impossible to measure the impact on them. What is clear is that given the identical nature of the goods and marks that there would be likely to be an adverse effect on the opponent, through loss of business.

In reaching a decision under Section 12(2) a balanced view generally needs to be taken having



regard to what might be potentially conflicting results arising from the application of the *PIRIE* criteria. I have come to the view that the applicant's case based on honest concurrent use is not sufficiently strong.

5 There is a further point. Although the opponent has demonstrated first use in 1977, the evidence does not suggest that the use at that time was on a substantial scale. Further, it seems doubtful whether that use continued up until the date of the application in 1985. The opponent has only provided sales figures under the mark from 1986. In his affidavit dated 28 March 1990 Mr Wiseman, the opponent's Managing Director, had apparently forgotten that his company had used the mark before the date of their own Trade Mark application in December 1995. That points away from continuous use.

15 The only evidence of earlier use consists of three invoices totalling £60 and a price list dated 1977, and a further price list dated March 1980. It therefore appears that, although the opponent first used the mark, such use was on a small scale and ceased sometime after March 1980. Use then appears to have recommenced in 1986 - some three years after the applicant had commenced use under the mark.

20 Although, the applicant's case based upon its claim to honest concurrent use is not, by itself, sufficiently strong to justify registration of an identical mark for identical goods. I have considered whether the circumstances described above amount to "special circumstances" justifying registration under Section 12(2).

25 I have concluded that it does not. In assessing a claim for registration under Section 12(2) I am required to assume - in the absence of a counter application for invalidation - that the opponent's mark is validly registered. The issue, at this stage, is not therefore who has the best claim to registration, but (assuming that the opponent's mark is validly registered) whether the applicant has a good enough case for a second (in this case identical) registration. I do not believe the applicant's case is strong enough to offset the measure of public inconvenience involved in the registration of identical marks for identical goods by different proprietors.

30 As a result of above the opposition under Section 12 is successful.

35 Given my findings above I do not need to consider the other grounds of opposition.

As the opposition has succeeded, the opponents are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £835.

40 This sum to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10 Day of April 2000

45 George W Salthouse  
For the Registrar  
The Comptroller General

