

0/002/21

IN THE MATTER OF THE TRADE MARKS ACT 1994

-and-

IN THE MATTER OF TRADE MARK APPLICATION No. 3318253

in the name of AGRIHAUL ENGINEERING LIMITED

to register the trade mark



in class 12

-and-

OPPOSITION No. 413887

by TOTAL STEEL SOLUTIONS LIMITED

**APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF BEVERLEY
HEDLEY, HEARING OFFICER, ACTING ON BEHALF OF THE REGISTRAR OF
TRADE MARKS DATED 5 DECEMBER 2019**

DECISION OF THE APPOINTED PERSON

1. This is an Appeal by the Opponent against the Decision of the Hearing Officer rejecting an Opposition brought under s5(2) of the Trade Marks Act 1994 on the basis that there was no likelihood of confusion between the Mark applied for and the earlier marks relied on by the Opponent.
2. The Applicant and the Opponent are rival companies engaged in steel fabrication services.

3. The mark applied for is as set out below ('the Mark').



It is applied for in 3 classes: 6, 37 and 40. The class 6 specification is for steel, steel beams, steel buildings and steel fabrications. The class 40 specification is for steel cutting. And the class 37 specification is for various services connected with building construction.

4. The Opponent relies on its EU registration 837070 which is for the mark set out below:



The Opposition also relied on another mark, STEEL CENTRE 4, but the case based on this mark was plainly weaker than the case based on the mark above, and the arguments in this Appeal were entirely founded on the stylized SC4 mark shown above.

5. Then Opponent's mark is also registered in classes 6 and 40 for very similar items and services. It is not registered in class 37.
6. For the purpose of the Opposition, the Opponent was required to prove use under s6A of the 1994 Act. The Hearing Officer found that use had

been shown only in relation to steel and steel fabrications in class 6, and steel processing and fabrication services in class 40. No challenge was made on appeal to that finding.

7. The Hearing Officer carried out a thorough analysis of the issues pertinent to the likelihood of confusion between the two marks when used in relation to the goods and services for which they were registered and (in the case of the Opponent) use had been shown.
8. She first carried out a comparison of these goods and services, concluding that the goods and services in classes 6 and 40 of the Application were identical or essentially identical to the class 6 and 40 goods and services of the Opponent's mark, and that the services in class 37 of the Application were similar to a low to medium degree to the class 40 services of the Opponent's mark.
9. She then reviewed the average consumer and the purchasing process, concluding that the average consumer was a construction industry professional and that the level of attention would be between above average and high.
10. She went on to compare the Mark with the Opponents mark, finding low and very low levels of visual and aural similarity and that the conceptual position was neutral since the marks would simply be viewed as combinations of letters.
11. Turning to the distinctive character of the Opponent's mark, she concluded that its level of inherent distinctiveness was at a normal level and no acquired distinctiveness through use had been proved.
12. I have not set out the reasoning of the Hearing Officer on these points in any detail since none of these conclusions was challenged at the hearing before me. The approach taken on this appeal by Mr Edenborough QC, acting for the Opponent, was in essence as follows. Despite these findings of low or very low levels of similarity, and no enhanced distinctiveness,

which would on their own have entitled the Hearing Officer to reach the conclusion she did, the Hearing Officer would and should have reached a different conclusion if she had taken proper account of the evidence which was alleged to demonstrate actual confusion between the marks. Moreover, further evidence of confusion had been discovered since the hearing which I should take into account on this Appeal.

13. I therefore turn to consider the alleged instances of confusion, starting with the one which was considered by the Hearing Officer.
14. This consisted of a witness statement of Ms Karen Eddy, Director of the Opponent, dated 2 September 2019, which was long after the submissions in relation to the Opposition had been filed, and very shortly before the hearing. The statement exhibited 2 emails from someone called Sharon at ArcelorMittal, a steel company also based in Scunthorpe.
15. The first email is dated 14 August 2019. It is addressed to wes.smith@sc4.co.uk. Apparently, this is a genuine email address of the Technical Manager of the Opponent, although Mr Smith has not provided any evidence. The subject line is *2978 ADDED SHAUN*. It reads *'Good morning...Test certificates for: Your Order Ref: 2978 ADDED SHAUN...Our Delivery Note No. 428453...Kind regards Sharon'*. The attachment appears to be a test certificate from a Spanish company for some steel beams.
16. The second email is dated 23 August 2019. This is also addressed to Mr Smith's email address. The content of the email is essentially the same save that this time the subject line reads *2978 PORSCHE L5* (rather than *2978 ADDED SHAUN*), as does the Order Ref, and the Delivery Note is 428450 (rather than 428453). Unlike the previous email, the attachment is not a Test Certificate, but a Delivery Note. It relates to the *PORSCHE L5* reference and the beams are not the same as those on the test certificate for the previous email. The Delivery Note refers to an Invoice to *STEEL 4 STRUCTURES LTD* and records delivery as taking place to *STEEL 4 STRUCTURES LTD*.

17. The evidence about these emails from the Opponent is thin and not very illuminating. What it does say is not particularly reliable. For example Ms Eddy asserts that the first email attaches a delivery note when it plainly does not – it attaches a test certificate.
18. There can be no real doubt that the latter email of 23 August concerned an order placed by the Applicant, not by the Opponent, since the delivery note relates to an order from STEEL 4 STRUCTURES. It is therefore a reasonable conclusion that the email of 14 August attaching the test certificate also concerned an order placed by Steel 4 Structures. There is plainly some relationship between the two orders, since they have the same number, though a different name attached.
19. Oddly, there is no evidence from Mr Smith or anyone else at the Opponent about his response to the first email. Since there is no indication in that email of the intended recipient of the steel beams which are the subject of the test certificate, one would have expected him to contact Sharon and ask what was going on. Possibly he did so, and possibly this is what produced the second email, though this seems to relate to a different part of the same order. This however is pure speculation.
20. It remains a mystery how these emails came to be sent to Mr Smith. On the face of it, the error could have resulted from an unnoticed autofill error when typing in the name of the intended recipient into the address line (Arcelormittal are apparently suppliers of both parties). Or from some other administrative error which caused Sharon to believe that this particular order had actually been placed by the Opponent rather than the Applicant.
21. Mr Edenborough submitted however that that Hearing Officer ought to have found that these emails arose out of confusion on Sharon's part between the Opponent's mark SC4 and the Applicant's mark S4S. As he put it at the hearing:

'She clearly thought that Wes Smith was the correct recipient, but she clearly thought that Wes Smith worked for Steel 4 Structures. The fact that when the email address turns up [by autofill] and shows that it is not an S4S email address but an SC4 email address, that difference does not strike her and therefore she completes the mistake. The mistake is predicated upon a direct confusion between those two three-alphanumeric trade marks. That is the way I am putting it. It has to be a mistake that has arisen that way. There is no other explanation.'

22. I do not see how this argument works. If one assumes that Sharon knew who Wes Smith was and thought he was the correct recipient, then (since he worked for SC4), she must surely also have believed that SC4 were the correct recipient of the documentation. So the fact that an SC4 email address popped up by autofill would have been exactly as expected. The only question is why she thought that SC4 were the correct recipient, which may have come about by any number of administrative errors, nothing to do with the trade marks.
23. Mr Edenborough's reasoning however is predicated on the assumption that Sharon believed (contrary to the fact) that Wes Smith worked for Steel 4 Structures. Only by making that assumption could he attach any significance to the fact that she sent the email to the SC4 email address. But I can see no reason to make such an assumption. If Sharon knew who Wes Smith was at all, then one would have thought this could only have been in the context of his position as technical manager of SC4.
24. It is worth making one further point. There is nothing in the evidence to suggest that Sharon was familiar with the Mark applied for (essentially the S4S logo) at all. The only reference in the Sharon documentation to the Applicant is by their full name Steel 4 Structures, used in the delivery note. So it is hard to see how this incident could ever be used to establish *'direct confusion between those two three-alphanumeric trade marks'* as submitted by Mr Edenborough, and thus be relevant to the issue in this case.

25. I therefore conclude that the Sharon emails provide no evidence of confusion arising out of the similarity of the trade marks in issue. They are perfectly consistent with either a typographical error or a simple administrative error which had allocated this particular order number to the wrong customer.
26. The Hearing Officer was right to place no reliance on this evidence, for precisely the reasons she gave at [58] of her Decision.
27. I turn now to the evidence which was not before the Hearing Officer. An Application was made before me to adduce new evidence in the form of 3 more witness statements, all dated 30 September 2020.
28. The first of these was from Karen Eddy (I shall call it 'Eddy 2', since she had already filed a witness statement), and concerned the way in which the Opponent does business. Mr Edenborough explained that the relevance of the evidence went to the issue of degree of care taken by customers in differentiating between suppliers. The point seemed to be that the customers have a technical specification already and are more interested in the price being charged for steel to that specification than they are in the company providing the steel. I could see no reason why such evidence could not have been advanced before the Hearing Officer. Furthermore, the evidence did not actually establish the point which Mr Edenborough was seeking to get from it. I therefore rejected the application in relation to this evidence at the hearing.
29. The second witness statement was also from Karen Eddy ('Eddy 3'). This exhibited another email from ArcelorMittal (though a different division from the source of the previous emails, this time the distribution division in Birkenhead). This email was dated 29 May 2020 (after the date of the hearing before the Hearing Officer). It was from one Julie Brown, addressed to accounts@sc4.co.uk and attaching an invoice for some steel beams. The invoice was addressed to Steel 4 Structures Ltd. Ms Eddy said

she processed the invoice on 11 June 2020 and realized that it did not relate to one of their orders.

30. Paragraph 8 of Eddy 3 said as follows:

'I then contacted AMDS UK Ltd to ask why they had sent an invoice intended for Steel 4 Structures to SC4. I received a response from Darrell Burnett at SMDS UK Ltd apologizing for the mistake and concluding that the reason for the mistake was the similarity between the trading names of Steel 4 Structures and SC4.'

31. The response from Mr Burnett was attached. However, it was plainly not a response to a query about the May 2020 invoice to which Ms Eddy was referring in this statement. First of all, his response was dated 14 September, more than 3 months after Ms Eddy said she had processed the invoice and realized the mistake. Secondly, Mr Burnett is from the Scunthorpe division of ArcelorMittal, not the distribution division in Birkenhead which had been responsible for the mistake.

32. Thirdly the email from Mr Burnett said this:

'Hi Karen, I can only apologise for us sending you test certificates which should been sent to Steel for Structures...'

Obviously this was not in response to a query about sending an invoice. Mr Edenborough was unable to explain this discrepancy.

33. The only logical conclusion from the facts is that, contrary to Ms Eddy's evidence, Mr Burnett's email was an attempt to obtain evidence to bolster the case in relation to the original email from Sharon attaching the test certificates back in August 2019. It therefore could plainly have been obtained in time for the hearing before the Hearing Officer.

34. Given the unsatisfactory and misleading nature of paragraph 8 of Eddy 3 about Mr Burnett's email, and the fact that it could have been obtained in time for the original hearing, I refused the application to advance paragraph 8 and Mr Burnett's email. However, I allowed the rest of Eddy 3 (concerning the receipt of the Julie Brown email) to be admitted.

35. The third witness statement was from Mr Shay Eddy. Paragraphs 1-5 were essentially identical to the same paragraphs in Eddy 3. Paragraph 6 dealt with his involvement in processing the invoice. He apparently did not notice that the invoice was addressed to Steel 4 Structures since he was expecting a similar invoice from ArcelorMittal anyway. Paragraphs 7 and 8 stated as follows:

'7. AMDS UK Ltd have confused Steel 4 Structures with SC4 (UK) Limited, sending the invoice relating to an order placed by Steel 4 Structures to SC4 (UK) Limited in error.

8. I myself have confused Steel 4 Structures with SC4 (UK) Limited, by approving the invoice addressed to Steel 4 Structures in error.'

36. I admitted paragraphs 1-6 of this statement, since they were purely factual and related to the new incident dealt with in 1-7 of Eddy 3 which I also admitted. I did not admit paragraphs 7 and 8. Paragraph 7 is an expression of opinion by Mr Eddy on matters about which he knows nothing since he cannot know why the erroneous invoice was sent. Paragraph 8 is an assertion which is not justified by the evidence. The fact that Mr Eddy approved the invoice in error does not mean that he was confused between the companies. As he said, he had simply assumed when the invoice arrived that it related to an existing order which he had placed. His role in the processing of the invoice is said to have been to check that it related to goods which he was expecting to be delivered. Plainly he can have given it no more than a cursory glance, since it is not suggested that the goods were identical either in terms of their nature or their quantity to the goods which he was expecting. In the circumstances

there is no reason to believe that he even looked at the name of the customer or the invoice address.

37. Mr Edenborough submitted that the mistaken sending of the email and attached invoice by Julie Brown was more evidence of confusion which I should take into account when reviewing the decision of the Hearing Officer. For similar reasons to those I have expressed in relation to the Sharon emails, I disagree. Once again, we have no idea how this mistake was made, but there is no reason to believe that Julie Brown was confused as a result of the similarity of the trade marks in issue. Once again, the mistake could have occurred as a result of any number of administrative errors in the office which had nothing to do with the names of the companies. Or it could have resulted from a momentary distraction when typing in the address line, particularly if an autofill process was involved. Furthermore, there is no reason to believe that Ms Brown was familiar with the mark S4S at all.

38. In all the circumstances, I am not satisfied that the Hearing Officer made any error in the weight she was prepared to give to the alleged evidence of confusion, and I do not believe that the new evidence advances the Opponent's case.

39. I therefore reject the Opponent's appeal.

40. I shall award the Applicant £1,000 towards its costs of the Appeal to take into account the hearing itself and the submissions necessary in relation to the application to adduce further evidence.

**IAIN PURVIS QC
THE APPOINTED PERSON**

4 January 2021

