

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

**IN THE MATTER OF APPLICATION No 1536580
BY INTERFACE INTERIOR FABRICS INC TO
REGISTER A TRADE MARK IN CLASS 24**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 41991 BY GUILFORD MILLS INC
AND GUILFORD EUROPE LTD**

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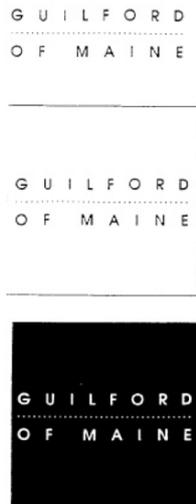
**IN THE MATTER OF Application No 1536580
by Interface Interior Fabrics Inc to register a
trade mark in Class 24**

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**IN THE MATTER OF Opposition thereto under
No 41991 by Guilford Mills Inc and Guilford
Europe Ltd**

BACKGROUND

1. On 24 May 1993 Guilford of Maine Inc (now Interface Interior Fabrics Inc) applied to register the following series of three trade marks in Class 24:



Registration of this mark shall give no right to the exclusive use, separately, of the words "Guilford" and "Maine".

for the following specification of goods:-

"Commercial interior decoration fabrics for wall hangings, covers and panels; fabrics for ceiling covers and panels; upholstery fabrics; fabrics for screens and curtaining; all included in Class 24."

2. The application was accepted by the Registrar in Part B and published in the Trade Marks

Journal. On 15 February 1995 McNeight & Lawrence filed a Notice of Opposition on behalf of Guilford Mills Inc and Guilford Europe Ltd. The Statement of Case accompanying the Notice of Opposition did not specify any section of the Trade Marks Act but may be summarised as follows:-

- (i) The first opponent, Guilford Mills Inc (GMI), is a large textile company based in Greensboro, Guilford County, North Carolina, USA producing knitted fabrics for a wide variety of markets. The second opponent, Guilford Europe Limited (GEL), is a wholly owned subsidiary of the first opponent.
- (ii) Guilford is a town in the State of Maine, United States of America that was established in 1803 and where textiles have been produced continuously since 1865. Two mills trading in Guilford, Maine came into common ownership in 1943 trading under the name "The Guilford Woolen Mills Company", which subsequently became Guilford Corporation then Guilford Industries Inc and in 1989 Guilford of Maine Inc.
- (iii) An "off the shelf" company was incorporated in the UK on 17 October 1989 under the name Guilford of Maine (UK) Limited. This was a subsidiary, together with Guilford Industries Limited, of Interface Inc. The assets of Guilford Industries Limited were transferred on 1 January 1990 to Guilford of Maine (UK) Limited.
- (iv) The opponents make fabrics for a wide range of end users but the supply of upholstery fabrics has been a significant part of their market. Most people in the business of buying upholstery fabrics would believe that GUILFORD OF MAINE was merely another trading style for the Opponents or either of them. Indeed, since Guilford of Maine began trading in the UK there have been instances of confusion.

3. On 20 April 1995 Phillips and Leigh on behalf of the applicants filed a counterstatement denying the grounds of opposition. Both sides have asked for an award of costs in their favour and have filed evidence. The matter came to be heard on 17 December 2001 when the applicants for registration were represented by Mr Farwell of Phillips & Leigh and the opponents by Mr McNeight of McNeight & Lawrence.

4. 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 reference in this decision are references to the provisions of the Trade Marks Act 1938 (as amended) unless otherwise stated.

Opponent's Evidence

5. This consists of a statutory declaration by Anthony Geoffrey Millington dated 19 August 1996. Mr Millington is the Operations and Finance Director and also the Company Secretary

of Guilford Europe Limited.

6. Mr Millington explains that in November 1997 he applied to register "Guilford & Logo" in respect of Textile piece goods in Class 24 under Application No 1326448 and at Exhibit AJM1 to his declaration, Mr Millington provides a copy of the mark applied for. He states that the application was accepted for advertisement subject to disclaiming the geographical words GUILFORD and acceptance was based upon evidence of substantial use since 1981. Mr Millington adds that the application was opposed by Guilford of Maine Inc and Guilford of Maine (UK) Limited on the grounds that GUILFORD is a geographical name. He then points out that as Guilford is in Maine, Guilford, Maine is also a geographical name.

7. Mr Millington goes on to claim that the opponent (GEL) under one or other of its names, which have all included the word Guilford since 1981, has a longer and more comprehensive reputation in the textile piece goods industry than could be claimed by the applicant. He adds that the evidence of Gerald L Harrison on behalf of Guilford of Maine Inc, declared 10 July 1991, in the opposition to application No 12326448 put the first use of by that company in the UK of any name including GUILFORD as four or five years before the date of the declaration ie no earlier than 1986. A copy of Mr Harrison's declaration is attached as Exhibit AJM2 to Mr Millington's declaration. Mr Millington concludes that as the applicants have failed to provide evidence of use in the UK before the Opponents use in 1981, this must itself be good evidence of the absence of any such use.

8. Mr Millington stated that the history between the two US Guilford companies goes back prior to 1981 but whatever the position in the USA, in the UK the opponent had established the GUILFORD TRADE MARK before the applicants first used their mark here. He adds that in the UK the relevant public would assume that goods sold under trade marks containing the name/word GUILFORD would emanate from the same business or undertaking. Mr Millington goes on to say that his company makes fabrics for a wide range end of uses and that a significant part of their market is and has been since 1981, the supply of upholstery fabrics and that they have an occasion supplied fabric to the same customers as the applicants. At Exhibit AJM3 to his declaration, Mr Millington draws attention to a copy of a fax sent by Herman Miller Limited to Guilford Industries in America in 1989 which was faxed to Guilford Mills Inc, together with a covering letter from his company returning it to Herman Miller pointing out that there is no connection between Guilford Mills and the opponents. He states that Herman Miller Limited are now customers "of both Guilfords" and if they have been confused, the public at large must be at major risk of confusion. He adds that there have been numerous instances of cheques intended for Guilford of Maine being sent to his company in error.

Applicant's Evidence

9. This consists of a statutory declaration by Donald A Sutcliffe, dated 23 May 2000. Mr Sutcliffe is Studio 2 Manager for Interface Fabrics Limited and was Customer Services Manager of Guilford of Maine (UK) Limited from 1991 to May 1998 when Guilford of Maine (UK) Limited was integrated with Interface Fabrics Limited, formerly Guilford of Maine Inc (GOM).

10. Mr Sutcliffe states that when the application in suit was filed, GOM's agents filed a covering letter drawing the Registrar's attention to the history of the trade mark GUILFORD with reference to an earlier withdrawn trade mark application number 1403714 for GUILFORD CONTRACT FABRICS, a copy of which is attached as Exhibit DS2 to Mr Sutcliffe's declaration. This letter sets out historical background in relation to GOM, recognises the geographical signification of the words Guilford and Maine and argues a case for registration of the mark in light of the size, and location of the town Guilford and the relationship of the applicant to the town.

11. Mr Sutcliffe refers to the statutory declaration of Mr Millington filed on behalf of the opponent in which reference is made to an earlier opposition filed by GOM against an application in the name of Guilford Mills Inc (No 1326448) to register the word Guilford & Logo. Mr Sutcliffe points out that this application was withdrawn and that the word "Guilford" was disclaimed in that abandoned application.

12. Mr Sutcliffe goes on to state that the opponent's have not filed evidence to demonstrate use of their trade mark GUILFORD & Logo from 1981. He adds that GOM started trading in the UK as Guilford of Maine (UK) Ltd in 1990 and adopted the trade mark GUILFORD OF MAINE in 1990. He then provides the following annual sales figures which relate to periods prior to the filing date for the application in suit:-

YEAR	£000's
1990	379
1991	439
1992	745
1993 (to May)	440

and adds that such sales have been in respect of panel fabrics (88% of sales) and seating fabrics and to major clients such as Preform GmbH, Herman Miller, Kudos Designs and Fabritrak. Exhibit DS6 to the declaration shows an example of the mark in use.

13. Next, Mr Sutcliffe turns to the similarity between the trade mark of the present application and that used by the opponents and states that this is solely due to the geographic origins of the two companies, GOM being named after the town of Guilford in the State of Maine and the opponents mark after the town of Guilford in North Carolina. He adds that the two corporations have long co-existed in the USA.

14. Mr Sutcliffe considers the respective products of the parties and he states that the products for which GOM use their GUILFORD OF MAINE trade mark are "textile fabrics and woven furniture fabrics and fabrics for office, commercial, institutional and residential uses such as wall coverings, wall dividers/partition coverings and upholstery and interior decorator fabrics and fabrics for the airline industry as well as in the polypropylene fibre field. I understand that the products for which Guilford Mills, Inc. use their GUILFORD trade mark are "knit textile fabrics and polyester and nylon yarns for various applications, such as: apparel; automotive; home furnishing and upholstery, including window treatments, mattress ticking, comforters, sheets and bedspreads; office furnishings; and numerous industrial

applications, including for example: component parts of shoes; protective covers; tents; liners and tarpaulins of all types (including pool covers, covers for vehicles); filtration products (eg water purification devices); abrasive products; medical and health care products; "hook and loop" fastenings systems; luggage and handbags; geotextiles; carpet backings; wall coverings; flags and banners; wiping clothes; and ceiling tiles for the residential market". He adds that in his experience as Customer Services Manager, no direct confusion between these two product areas and he states that there has been no instances of actual confusion between Guilford Mills' operations and Guilford of Maine's operations in the United Kingdom. The two Corporations are generally known as "Guilford of Maine" and "Guilford Mills" respectively.

15. This completes my summary of the evidence filed in this case.

16. Prior to the hearing it was agreed between the parties that Mr Robert Dale Weston, a trade mark attorney in the direct employ of the applicants, should give oral evidence to clarify the nature of the applicant's goods and business in the light of the evidence already filed. Mr Weston was duly sworn and in his evidence stated that the applicant's business was primarily in the contract furnishing industry, in particular the production and supply of fabrics and upholstery for office furniture. He also confirmed that the evidence of first use of the mark in suit related to 1990.

THE DECISION

17. At the hearing Mr McNeight, on behalf of the opponents, confirmed that the opponents' ground of opposition was based on Section 11 of the Act in that use of the mark in suit by the applicants would be likely to deceive or cause confusion because of the opponents' earlier reputation in the word GUILFORD or in their trade marks containing the word GUILFORD.

18. Section 11 of the Act reads as follows:-

“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.”

19. The established test for this section is set down in Smith Hayden and Company Ltd's application (Volume 63 1946 RPC 101) later adapted by Lord Upjohn in the BALI trade mark case (1969 RPC 496). Adapted to the matter in hand the test may be expressed as follows:-

Having regard to the user of the opponent's marks, is the tribunal satisfied that the mark applied for 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?

20. Under Section 11, I must take into account the actual user of the opponents' mark(s) and it is well established that to succeed under this Section an opponent must show use of their mark(s) prior to the relevant date this being the date of application for the mark in suit or

where the applicants have shown use of their earlier mark, use predating that of the applicant.
- see Section 7 of the Act.

21. At the hearing Mr Farwell submitted that the opponents' evidence did not show use or reputation in any trade marks bearing the word GUILFORD, adding that no sales, turnover or advertising figures have been provided, nor examples of use or details of customers. He contrasted this with the evidence provided by the applicants which details turnover and customers in relation to the mark in suit (since 1990) and provided examples of the mark in use.

22. In my view Mr Farewell's submissions on this point are well made. While the opponents claim use in the UK since 1981, these assertions (albeit sworn) are not substantiated by evidence or examples of any use whatsoever. Mr McNeight submitted that in light of the opponent's long presence in the UK, GUILFORD must at least have been used as a company name by the opponent in relation to the goods. However, it seems to me that the evidence does not show use of even a company name by the opponents in relation to the goods.

23. In my considerations on the evidence of use by the opponent I do not lose sight of the opponents' allegations of confusion in relation to the fax sent in 1989 by Herman Miller Limited to Guilford Industries (USA) in America - see paragraph 8 of this decision. The covering letter of 17 August 1989 returning the fax is sent on behalf of GUILFORD EUROPE LIMITED. However, it does not demonstrate use in relation to goods in the UK and merely points out that a fax had been sent to a wrong number. Furthermore, the fax sent by Hermon Miller Limited to Guilford Industries (USA) relates to fabric purchase orders but contains no reference to GUILFORD EUROPE LIMITED or any GUILFORD trade mark belonging to the opponents. While it could possibly be inferred that the fax was intended for GUILFORD EUROPE LIMITED and related to an order from that company and that the goods were being sold under a GUILFORD trade mark, this is far from obvious. Indeed, it could be inferred that as the fax was sent to the USA, Hermon Miller Limited had obtained goods directly from the USA as opposed to obtaining them from a UK based trader or business. Furthermore, there is no reference to a trade mark under which the goods were bought and sold. On the basis of this evidence I feel unable to find that the opponents have shown use of any trade marks bearing the word GUILFORD in relation to these proceedings.

24. To conclude, while the opponents may well have had a real presence in the UK market place before the relevant date, it seems to me that the opponents' evidence in relation to the use of GUILFORD as a trade mark amounts to little more than assertions, albeit sworn. There are no examples to show even use of the mark on or in relation to goods and the opponents have certainly not established anything resembling a reputation on the basis of the evidence. In view of this finding the opposition cannot get off the ground and Mr McNeight's persuasive submissions made at the hearing in relation to the similarity of marks and goods cannot assist the applicant.

25. The opposition having failed, the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of **£650**. This sum is 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 28 day of January 2002

**JOHN MacGILLIVRAY
for the Registrar
The Comptroller General**