

O-043-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION 2516512 IN THE NAME  
OF SAFELINCS LTD IN RESPECT OF THE FOLLOWING MARK IN CLASS 9:**



**AND**

**AN APPLICATION FOR INVALIDATION (NO 84157) BY  
ULTRA SUPPRESSION SYSTEMS LIMITED**

## **The background and the pleadings**

1) Trade mark registration 2516512 was filed by Safelincs Ltd (“Safelincs”) on 15 May 2009 and it completed its registration procedure on 4 September 2009. The mark and the class 9 goods for which it is registered are:



Fire extinguishers; fire extinguishing products.

2) Ultra Suppression Systems Limited (“USS”) applied on 31 August 2011 for a declaration of invalidity in respect of the above registration. Its grounds for doing so are based on sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b), USS relies on trade mark registration 2447290 which was filed on 20 February 2007 and which completed its registration procedure on 10 August 2007. The mark and the class 9 goods for which it is registered are:

## **ULTRA MIST**

Fire suppressing apparatus and instruments; fire extinguishing apparatus and instruments; sprinklers (water) for fire extinguishing.

3) The ULTRA MIST mark was filed by USS. The official records show that on 2 October 2012 USS requested that a change be made to its name to read “Ultra Surefire Limited” (“USF”). This was confirmed as a simple change of name not a change of legal entity. In view of this, the applicant for invalidation must also now be going by the name of USF. I will from this point forward refer to the applicant as USF regardless of the point in time being referred to. Given the respective filing dates, the ULTRA MIST mark constitutes an earlier mark as defined by section 6 of the Act. Furthermore, it had not completed its registration procedure more than five years prior to the date on which USF made its application for invalidation with the consequence that its earlier mark is not subject to the proof of use provisions set out in section 47(2A) of the Act. I will detail the sign(s) relied upon under section 5(4)(a) later in this decision, not least due to the fact that there is a pleadings dispute as to what may or may not be relied upon.

4) Safelincs filed a counterstatement denying the grounds of invalidation. It denies that the marks are “confusingly similar”. Both sides filed evidence. The matter then came to be heard before me on 30 November 2012 at which Safelincs was represented by Mr Simon Malynicz, of counsel, instructed by Marks & Clerk Solicitors LLP; USF was represented by Mr Stephen Kinsey of Wildbore & Gibbons.

## USF's evidence

5) This consists of a witness statement of Mr Peter Kemp, USF's managing director, a position he has held since 2004 when USF was incorporated. He says that since 2004 USF has been using the "trading style "Ultra"" in connection with high and low pressure water mist fire suppression systems and equipment. Its main supplier was Ultrafog in Sweden who wanted USF to use this name. Mr Kemp states that one of the main reasons for incorporating the company was to protect the trading name ULTRA SUPPRESSION SYSTEMS [which was in the company name when incorporated].

6) Mr Kemp states that the name ULTRA has been used since at least 2005. The website [www.ultrass.co.uk](http://www.ultrass.co.uk) is said to have been active since 2005. USF's main brochure is provided in Exhibit PK.1. It carries no date. The brochure makes reference to the ULTRA MIST system. The brochure features the words ULTRA SUPPRESSION SYSTEMS prominently throughout, albeit most often in the form:



There is a reference to "Ultra Suppression Systems Limited" on the back page of the brochure.

7) Mr Kemp states that customers for its ULTRA water mist system are located throughout the UK. Customers include Ministry of Justice Prisons in England and Scotland, Fitness First and David Lloyd Leisure clubs throughout the UK, Stirling Castle, Windsor Castle and the College of St George. Fire systems have also been purchased by food industry customers including Northern Food, Greencore Frozen Foods, pizza processing factories and Whately Manor. Annual turnover has ranged from £855,604 in 2007 to over £2 million in 2010.

8) Mr Kemp states that the Ultra brand is well known within the fire protection industry. He states that USF was the first company in the UK to apply marine based fire water mist extinguishing technology to land based situations. Mr Kemp then provides the following exhibits:

- Exhibit PK.2 – A newsletter from the British Automatic Fire Sprinkler Association ("BAFSA") dated March 2007. On page 7 there is a reference to Howard Tomlin of "Ultra Suppression Systems" who is a BAFSA

representative working on the BSI standards for water mist suppression systems.

- Exhibit PK.3 – A newsletter from the Fire Extinguishing Trades Association (“FETA”) dated January 2006. This contains an advertorial from USF which features the logo as depicted earlier. The advertorial is headed “ULTRA – THE MOVIE”, a reference to the availability of a promotional DVD from USF which highlights the benefits of water mist as an alternative to conventional fire suppression systems.
- Exhibit PK.4 – A newsletter from the British Fire Protection Systems Association (“BFPSA”) for winter 2006 which contains a similar article to the one above.
- Exhibit PK.5 – This is a copy of the aforementioned DVD together with a press release which contains similar information to the advertorials. The DVD itself features the logo as depicted earlier and also contains the name Ultra Suppression Systems Limited.
- Exhibit PK.6 – This is a photograph of a control panel for a water mist suppression system which Mr Kemp states USF installed in early 2009. I can see that the control panel carries the logo and words as above
- Exhibit PK.7 – This is a copy of the case details for the applied for mark. Mr Kemp states that whilst he is unfamiliar with what Safelincs actually use its mark for, he states that the general word “extinguishers” could be understood to mean any item for extinguishing fires, whether a hand operated stored pressure cylinder or a mist/water sprinkler installation. Mr Kemp believes that due to the goodwill USF has built up, the relevant public will understand the UltraFire mark as denoting a product of USF.

9) Mr Kemp concludes his evidence by stating that USF have been members of the Fire Industry Association (“FIA”) and of BAFSA and have sat on several of its committees. He also refers to a CEN committee in Europe but does not explain what this is. He refers to other Ultra brands it has developed such as Ultra Guard and Ultra Ensign.

### **Safelincs’ evidence**

10) This consists of a witness statement of Harry Dewick-Eisele, Safelincs managing director. Mr Dewick-Eisele states that he started Safelincs as a sole trader in 2001 and that the company was subsequently incorporated in 2003. He states that it is the UK’s largest online fire safety retailer with its headquarters in Alford, Lincolnshire. It offers fire safety products as well as services such as fire extinguisher maintenance and fire alarm panel installation. Its largest customers are the Church of England and the Catholic Church but it also supplies the

wholesale trade and retailers, and it provides a “drop-ship” platform for other fire safety businesses.

11) In relation to Safelincs use of its mark, the brand was “initially developed” in 2009, to be used on two fire extinguisher ranges to be sold in the UK. This has since been developed with a further range of ECO extinguishers. Mr Dewick-Eisele states that a significant reputation and goodwill has been built up but provides no details of turnover or sales figures, nor does he identify when the first sales were actually made. A picture of one of its products showing the mark in use is provided in Exhibit HDE.1. It is explained that various searches were conducted to ensure that the mark was not in conflict in the UK. He does not state whether USF’s mark was identified in these searches.

12) In relation to USF’s use, Mr Dewick-Eisele explains that the two parties are competitors. He highlights that USF have historically used its full name and not ULTRA alone, although this may have changed in 2010 when USF began to use ULTRA FIRE GROUP on its website. He provides at Exhibit HDE.3 archive prints from USF’s website between April 2005 and May 2010 which predominantly feature the logo as depicted earlier, or the words ULTRA SUPPRESSION SYSTEMS/LIMITED. Some of the prints from May 2008 onwards make use of ULTRA as, effectively, a short-hand for the company name.

13) Mr Dewick-Eisele refers to the meaning of the word ULTRA and that it is an adjective commonly used to describe goods and services. The following definitions are provided in Exhibit HDE.4

- Chambers Free English Dictionary: “adj 1 said of a person or party: holding extreme opinions, especially in political matters. 2 colloq extremely good; marvelous” and “noun ultras - someone who holds extreme opinions, especially in political or religious matters”.
- There is also a reference to the prefix ultra-, denoting “1 beyond in place range or limit. ultra-microscopic, 2. Extreme or extremely ultra. Ultra conservative, ultra modern.”

14) Reference is made to the use of the word ULTRA by other parties. Provided in Exhibit HDE.5 is a Google.co.uk search results page for the word ULTRA which brought back some 893 million hits. The first page of results is provided. Mr Dewick-Eisele states that it includes references to numerous company names and domain names under the name ULTRA. Exhibit HDE.6 contains examples of the use of the word ULTRA by third parties in relation to fire safety products and services, as follows:

- Ultrasafe Fire Solutions, who provide domestic, residential and engineered fire sprinkler solutions (the URL of the website features a UK designation);

- A product on the website of IKO Group called ULTRA PREVENT T-O which is a roofing membrane used for long-term waterproofing and fire protection (from its context, this appears to be a UK company);
- A product on the website of fireangel.co.uk called an “Ultra bright escape light ionization smoke alarm”;
- A website extract from the website of fomtec.com (there is nothing to suggest that this is a UK company) for a product called FORREX ULTRA which is a “blend of high activity hydrocarbon surfactants, solvents and stabilizers for use on class A fuel fire”;
- An extract from the website businessstandard.com (there is nothing to suggest that this is a UK website) relating to the Fire India 2011 EXPO at which were showcased “Ultra Light Weight Fire Extinguishers”;
- A print of a brochure from a company called Badger Fire Protection (based, apparently, in the US) about a product called Universal Ultra AR-AFFF Foam FIRE EXTINGUISHER. The document refers to: “Universal Ultra’s vapor” and “Universal Ultra Foam”;
- A print from amazon.co.uk relating to a product: “Ultra Max Photoelectric Fire Safety Alert Smoke Detector Alarm”. This was first available on Amazon.co.uk on 25 February 2012;
- A print from the website firesafety.com (there is nothing to suggest that this is a UK company) which, when referring to a heat detector, refers to “ultra fast fire detection”;
- A print from the website of bfpe.com (there is nothing to suggest that this is a UK company) which includes reference to a product called “Universal Ultra” from Badger.

15) Mr Dewick-Eisele provides in Exhibit HED.7 the details of 14 trade mark registrations for the word ULTRA including one by USF which was not registered until 2011. He is surprised that USF claim historic rights in the word ULTRA due to this and, also, because USF has generally been known by its full company name. He states that, in any event, Safelincs’ mark is a composite mark and does not conflict. As far as he is aware there has been no confusion in the marketplace.

## **USF's reply evidence**

### *Second witness statement of Mr Kemp*

16) Mr Kemp includes in his evidence a letter from 2007 issued by USF which contains the logo depicted earlier (as per paragraph 6) in its letterhead. Mr Kemp highlights that ULTRA is given prominence. The letter also refers to the ULTRA MIST product and to the company as ULTRA SUPPRESSION. A further letter from 2007 also contains references to ULTRA SUPPRESSION SYSTEMS and ULTRA FIRE SUPPRESSION SYSTEMS which he considers uses ULTRA to refer to USF. He states that these are typical of the sorts of letters issued by USF from 2007 and earlier.

### *Witness statement of Alexander Kidd*

17) Mr Kidd is the secretary general and a director of BAFSA. It is a trade body founded in 1974. He identifies Ultra Suppressions Systems Limited as a member. He explains that water mist systems are also referred to as fire suppression systems. He states that Ultra Suppression Systems Limited is naturally and normally referred to as ULTRA in this industry sector. No other BAFSA member has the word ULTRA in its name. Mr Kidd is aware of a contract that USF had with Historic Scotland in which he had some involvement. He states that at all times during this contract, USF were referred to as ULTRA both verbally and in meeting minutes and other communications. He referred to them as ULTRA in emails to the client, architects and other contractors.

### *Witness statement of Martin Duggan*

18) Mr Duggan is the general manager of FIA, another trade association. He also identifies USF as a member and he adds that no other members have ULTRA in their name.

## **Section 5(2)(b)**

19) Section 5(2)(b) of the Act reads:

“5.-(2) A trade mark shall not be registered if because –

(a) .....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

20) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

### **Comparison of goods**

21) Safelincs' mark is registered in respect of:

"Fire extinguishers; fire extinguishing products."

22) USF's earlier mark is registered in respect of:

"Fire suppressing apparatus and instruments; fire extinguishing apparatus and instruments; sprinklers (water) for fire extinguishing."

23) It is accepted by Safelincs that the goods it seeks to register are identical to the "fire extinguishing apparatus and instruments" covered by the earlier mark. The goods are identical.

### **The average consumer**

24) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

25) The goods are not run of the mill consumer items. To the extent that the goods include fire suppression systems and similar installations, they are unlikely to be fitted in the home and will, instead, be purchased by businesses and other organisations for the workplace or other large buildings. They will be selected with a great deal of care. To the extent that the goods are more basic, such as cylindrical fire extinguishers (or similar items), they could be purchased for the home or for large buildings. The home owner will adopt a slighter higher than the

normal degree of care and consideration as the purchase will be an infrequent one and the particular characteristics of the goods will be scrutinised. In terms of such goods selected for use in larger buildings, an above average level of consideration will be adopted (although perhaps not as high as that for the purchase of larger scale installations) in their selection as, again, the purchase will be infrequent, potentially costly, and issues such as health and safety compliance will need to be considered. Whilst for none of these types of goods will aural similarity be ignored, slightly more weight will be placed on the visual characteristics of the marks given that the goods will likely be selected following perusal of websites, brochures and the goods themselves.

### **The significance/meaning of the word ULTRA**

26) The significance/meaning of the word ULTRA in the respective marks has potential to impact upon a number of factors including how the marks are likely to be perceived by the average consumer, what the dominant and distinctive elements of the marks are, and, in terms of the earlier mark, what level of distinctiveness it has; all of this will need to be factored in when deciding whether there exists a likelihood of confusion. In forming such a view, I bear in mind both the dictionary meanings of the words and the examples of use put forward in Safelincs' evidence. Mr Malynicz was keen to stress what he felt was the laudatory nature of the word ULTRA meaning extreme, ultimate or good. Mr Kinsey argued that whilst the word ULTRA may have some descriptive qualities when used as an adjective, this was not the case with the marks at issue here. He also criticised the evidence for a number of reasons including the date on which it was obtained and the field and context of the examples provided.

27) I do not consider it appropriate to place too much weight on the evidence filed given that some are from overseas and some are from different fields; neither do they paint a compelling picture that the average consumer has been exposed to large amount of use of the word ULTRA in the relevant field. However, they at least demonstrate how the word ULTRA may potentially be used and perceived. I come to the view that the word ULTRA has potential to be perceived as a description. However, much depends on context. For example, the use of the word ULTRA as part of the expression "Ultra Light Weight Fire Extinguishers" or "Ultra bright escape light ionization smoke alarm" sends only a descriptive meaning, based on the dictionary meaning of beyond in range/extreme. In other words, in the examples I have given, the goods are extremely light or extremely bright. However, beyond such context, the potential to be seen simply as a description may be lost. To exemplify this, it is clear that some of the examples of the use in the evidence are examples of trade mark use, albeit often as secondary or sub marks. Whilst I bear in mind the additional dictionary meaning of being "colloq extremely good; marvelous", I do not consider that such use will be perceived as normal descriptive use. Whilst there may be some allusiveness in the word, and whilst the word may be a popular trade mark (or part of a trade mark), it may still be distinctness, even if not highly so.

## Comparison of the marks

28) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:



and

## ULTRA MIST

29) In terms of the dominant and distinctive elements of the marks, I bear in mind the comments I made above regarding the significance of the word ULTRA. As stated, a lot depends on context. In relation to the ULTRA FIRE mark, clearly, the word FIRE has a direct relationship with the goods. The combination ULTRA FIRE is somewhat meaningless. It is not on a par with an expression such as ULTRA BRIGHT or ULTRA LIGHT. This points towards the word ULTRA being the dominant aspect of the mark, a point which is further emphasised by the presentation of the mark, with the word ULTRA standing out more. Whilst the totality of the mark will be borne in mind, the dominant and distinctive element is the word ULTRA.

30) In terms of the ULTRA MIST mark, and being a plain word, there is nothing which emphasises the word ULTRA over the word MIST. Mr Malynicz argued that the dominant and distinctive element was the word MIST on account of such a word having no meaning in relation to the goods. On the other hand, Mr Kinsey argued that the word MIST did have a direct relationship with the goods and, therefore, the word ULTRA was the dominant and distinctive element. Whilst the evidence does not demonstrate that the word MIST is particularly well known in the relevant field, or indeed known at all for ordinary fire extinguishers, it seems to me that the word MIST will strongly suggest to the average consumer that the goods will use some form of mist in their fire extinguishing/suppression operation. Again, and despite Mr Malynicz suggesting that ULTRA MIST would be perceived as some form of “extreme mist” concept, I consider the combination ULTRA MIST to be somewhat meaningless, not on a par with expressions such as ULTRA BRIGHT or ULTRA LIGHT. Whilst the totality of the mark will be borne in mind, the dominant and distinctive element is the word ULTRA.

31) Bearing in mind what I consider to be the respective marks’ dominant and distinctive elements, I consider there to be a reasonable (neither high nor low)

degree of visual, aural and conceptual similarity. The differences have been noted (including the presentation of ULTRA FIRE), but they do not outweigh the similarities or indeed reduce the similarities to only a low level.

### **The distinctiveness of the earlier mark**

32) The degree of distinctiveness of the earlier mark(s) must be assessed. This is because the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In terms of inherent characteristics, I consider ULTRA MIST to be averagely distinctive. Given my comments in paragraphs 26-27 I cannot accord the mark with a high degree of distinctiveness, but, given the mark as a whole and the context of the word combination, it is certainly not low in distinctiveness.

33) I must also consider the use put forward. Whilst the mark has been referred to in various brochures etc, the primary form of use made by USF is of the logo as depicted earlier, and/or the company name and/or the name ULTRA SUPPRESSION SYSTEMS. On this basis, it is not established that the trade mark ULTRA MIST has been used to such an extent that it is entitled to an enhanced level of distinctive character.

### **Likelihood of confusion**

34) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

35) The goods are identical. There is a reasonable degree of similarity between the marks. I must of course bear in mind that the goods in question are not causal purchases. Even though imperfect recollection is borne in mind, the degree of care and attention used in the selection of the goods means that the average consumer is likely to notice the different endings of the marks MIST/FIRE. However, given my view that the word ULTRA is the dominant and distinctiveness component of the marks, and given that the endings will be perceived in a somewhat descriptive way, I consider that the common presence of the word ULTRA will indicate to the consumer of the identical goods in question that the goods are the responsibility of the same or an economically linked undertaking. There is a likelihood of confusion. **The invalidation succeeds under section 5(2)(b).**

### **Section 5(4)(a) of the Act**

36) Section 5(4)(a) of the Act prevents the registration of a mark the use of which is liable to be prevented:

“(a) by virtue of any rule of law (in particular, the law of passing-off) protecting an unregistered trade mark or other sign used in the course of trade..”

37) The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position quite succinctly when he stated:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly he must demonstrate that he suffers, or in a quia timet action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

38) The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom.”

39) I note from the relevant case-law that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature<sup>1</sup>. However,

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<sup>1</sup> *Hart v Relentless Records* [2002] EWHC 1984

being a small player does not necessarily prevent the law of passing-off from being relied upon<sup>2</sup>.

40) In terms of the material date, I note the judgment of the GC in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Joined Cases T-114/07 and T-115/07 where it was stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

41) Use of the mark the subject of this dispute before its date of application may be relevant. It could have established that Safelincs are the senior users, or that there had been common law acquiescence, or that the status quo should not be disturbed which, in turn, could mean that the use of the mark could not have been prevented under the law of passing-off at the material date<sup>3</sup>. However, as stated earlier, Safelincs’ use if not particularly clear in terms of the date of actual first use so, this is not an issue. The material date is 15 May 2009.

42) I mentioned earlier the pleadings issue under section 5(4)(a). USF’s pleading states that the earlier sign relied upon is “Ultra Suppression Systems Limited” but when explaining why passing-off would occur it goes on to say:

“At the time of application for registration of the proprietor’s mark the applicant, by virtue of trading under the name “Ultra Suppression Systems Limited” had a goodwill in the United Kingdom in the name ULTRA in relation to fire suppression and fire extinguishing systems such that use of the registered mark by the proprietor in relation to goods for extinguishing fires would have constituted a misrepresentation to the relevant public and thus damage to the applicant’s business or goodwill.”

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<sup>2</sup> See, for instance, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49

<sup>3</sup> See, for instance: *Croom’s Trade Mark Application* [2005] RPC 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] RPC 42.

43) Mr Malynicz argued that the way the pleaded case was put meant that USF could not rely on the sign ULTRA. Mr Kinsey felt the position was clear (although it could have been expressed better) and that if necessary he would amend the pleadings accordingly (an amendment which Mr Malynicz resisted). In my view the pleadings could have been clearer. However, when taken in the round, it is clear enough that USF wished to rely on goodwill in the word ULTRA generated through its use as part of the longer company name. It is also clear that Safelincs understood this to be the position given the comments in its evidence regarding USF's claimed goodwill in the word ULTRA. Given that it is clear enough, and given the stage the proceedings have now reached, it is not necessary to amend the pleadings.

44) It is clear from the evidence that in the field of fire suppression installations USF has a reasonable sized business and is likely to be known in the relevant trade. This area of trade is where its goodwill exists. The primarily used signs likely to be recognized and associated with the business are the logo depicted earlier in this decision and the full name ULTRA SUPPRESSION SYSTEMS/LIMITED. There is some evidence that the full name will be abbreviated to ULTRA in use, for example by third parties and, indeed, since May 2008 by USF on its website (as per Exhibit HDE. 3 of Mr Dewick-Eisele's evidence). Whilst the evidence itself is not particularly compelling (in the case of the third party use) or longstanding (as per USF's use), it reflects a fairly common sense view that because the rest of the name SUPPRESSION SYSTEMS/LIMITED is descriptive, more focus will be placed on the word ULTRA which, in turn, could lead to the company being referred to in short hand as ULTRA. Either way, it is clear that ULTRA is the most memorable part of the various signs that USF use and, thus, I think the word ULTRA will also be associated with it.

45) The above does not mean that I should simply compare the word ULTRA with ULTRA FIRE (stylized). The law of passing-off is not concerned with rewarding businesses with a monopoly in an unregistered mark. But I must nevertheless decide, on account of the actual use made by USF, whether ULTRA FIRE goods will be assumed to be those of USF. In relation to fire extinguishing products, which I consider a broad enough term to include installations of the type USF supply, then the question must be answered in the affirmative. Although I agree with Mr Malynicz that a good deal of care and consideration will be used by the consumers of such goods, this is an area of trade in which USF directly operate. The use of a trade mark containing as its dominant element the word ULTRA will, on account of USF's trading history, be assumed to be offered by USF. A misrepresentation will occur.

46) I must also deal with the term "fire extinguishers" which I consider more limited in nature covering, primarily, the cylindrical type devices seen primarily in office and other large buildings, but are also goods for use in domestic settings. The position is slightly different because USF have not sold such goods, focusing

instead on larger fire suppression systems. Misrepresentation occurs when the customers or potential customers of USF are deceived, or at least a substantial proportion of them are. For this reason, domestic purchasers will not be the subject of any misrepresentation because they will be unaware of USF's trading history. However, there is some overlap from the other perspective because those with responsibility for acquiring suppression systems in business premises may also be responsible for acquiring fire extinguishers. I must factor in the differences between fire extinguishers and large installations, however, whilst this is borne in mind, I still consider that a misrepresentation will occur. The relevant consumer (or at least a substantial proportion thereof) will put the presence of the word ULTRA in ULTRA FIRE (stylized) down to the fact that the goods come from the company they know whose trading styles have as their most memorable aspect the word ULTRA. The difference between the goods will be put down to an obvious expansion of trade.

47) The misrepresentation must lead to damage. The prospective use of the mark in relation to goods such as suppression systems leads to an obvious form of damage in terms of loss of sales. In relation to the other goods (such as fire extinguishers) then there is the damage that could be done to USF's business more generally, particularly given the nature (including safety implications) of the industry concerned. This can clearly be seen in *Ewing v Buttercup Margarine Co Ltd*, 34 RPC 232 where it was stated:

“To induce the belief that my business is a branch of another man's business may do that other man damage in all kinds of ways. The quality of goods I sell; the kind of business I do; the credit or otherwise which I might enjoy – all those things may immensely injure the other man who is assumed wrongly to be associated with me.”

48) The application for invalidation succeeds under section 5(4)(a).

### **Outcome**

49) The application for invalidation has succeeded under both pleaded grounds. Safelincs' registration is hereby declared invalid and deemed never to have been made.

### **Costs**

50) USF has been successful and is entitled to a contribution towards its costs. I hereby order Safelincs Ltd to pay Ultra Surefire Limited the sum of £1600. This sum is calculated as follows:

*Preparing a statement and considering the other side's statement*  
£300

*Considering and filing evidence*  
£800

*Attending the hearing*  
£500

***Total***  
**£1600**

51) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

**Dated this 28<sup>th</sup> day of January 2013**

**Oliver Morris**  
**For the Registrar,**  
**The Comptroller-General**