

O-044-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS 2295265 AND 2345225  
BY BEACONS BUSINESS INTERIORS LIMITED  
TO REGISTER THE TRADE MARK:**

The image shows the trade mark 'Bbi' in a stylized, handwritten font. The letters are black and have a slightly rough, ink-like texture. A vertical line is positioned to the right of the letters, extending from the top of the 'i' down to the bottom of the 'B'. The 'B' is the largest and most prominent letter, followed by the 'b' and then the 'i'.

**AND**

**THE CONSOLIDATED OPPOSITIONS THERETO  
UNDER NOS 91405 AND 92148  
BY  
BBI BUSINESS INTERIORS LIMITED**

## Trade Marks Act 1994

**In the matter of application nos 2295265 and 2345225  
by Beacons Business Interiors Limited  
to register the trade mark:**



**and the consolidated oppositions thereto  
under nos 91405 and 92148  
by BBI Business Interiors Limited**

### BACKGROUND

1) This case concerns two applications made by Beacons Business Interiors Limited, which I will refer to as Beacons, to register the above trade mark. The first application was made on 13 March 2002. The application was published for opposition purposes in the "Trade Marks Journal" on 16 October 2002 with the following specification:

*metal decorations, metal wall tiles, metal building materials, metal ducting, metal building structures and metal signs; none being parts and fittings in respect of furniture;*

*electric fittings, electric switches, electric power points, electric cabling, cabling for computer networks and cabling for telephone networks;*

*lighting fittings, lighting installations, air heating, air filtering and air conditioning equipment, and heating systems;*

*ceilings for buildings, partitions, floors and flooring materials, wall tiles, walls and decorations for buildings;*

*paperhangings, carpets, carpet tiles, linoleum, wall hangings and wall paper.*

The above goods are in classes 6, 9, 11, 19 and 27 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

The second application was filed on 8 October 2003. The application was published for opposition purposes in the "Trade Marks Journal" on 21 November 2003 with the following specification:

*installation, repair and maintenance services for offices, shops and buildings; information and advisory services relating to furniture and office equipment; interior and exterior painting and decorating services; refurbishment of shops, offices and buildings;*

*design and planning of buildings, offices and shops; industrial design; information and advisory services relating to the aforesaid.*

The above services are in classes 37 and 42 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) BBI Business Interiors Limited, which I will refer to as Business, has filed oppositions against the two applications. Business is the owner of two United Kingdom trade mark registrations:

- No 2268372 for the following trade marks (a series of two):

**BBI** |

and

**bbi** |

It is registered for the following goods:

*furniture and parts and fittings therefor.*

The above goods are in class 20 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- No 2270928 for the following trade marks (a series of two):

**bbi**  
BUSINESS  
INTERIORS

and



It is registered for the following services:

*installation, arrangement and maintenance of furniture and office equipment;  
information and advisory services relating to furniture and office equipment;*

*furniture design and planning; interior design and planning; office design and  
planning; information and advisory services relating to the aforesaid services.*

The above services are in classes 37 and 42 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

Business claims that the trade marks of Beacons are similar to its trade marks and the respective goods and services are either identical or similar. Consequently, there is a likelihood of confusion and registration of the applications would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) In relation to application no 2295265 Business claims that it has made extensive and substantial use of its trade marks in the United Kingdom since 1985 and has consequently acquired a goodwill and reputation in them. Consequently, use of Beacons' trade mark is liable to be prevented by virtue of the law of passing-off and registration of the application would be contrary to section 5(4)(a) of the Act.

4) Business requests that the applications are refused and seeks an award of costs.

5) Beacons filed counterstatements. It denies that there are grounds for refusal of the applications. However, Beacons admits that the services and goods of Business's earlier trade marks are identical or similar to those of its application no 2345225. In relation to application no 2295265, Beacons denies that the respective goods and services are sufficiently similar for section 5(2)(b) of the Act to apply. Beacons claims that it owns prior rights in the trade mark owing to use by itself and its predecessor in business. It claims that Business has acquiesced in the use of Beacons' trade mark for many years, thereby disabling it from bringing a case in passing-off.

6) Beacons seeks the dismissal of the oppositions and an award of costs.

7) Both sides filed evidence.

8) The case was heard on 15 February 2005. Beacons was represented by Mr Morcom QC, instructed by Wynne-Jones, Lainé & James. Business was represented by Ms May of counsel, instructed by Withers & Rogers.

## **EVIDENCE**

### **Evidence of Business**

9) This is furnished by way of a witness statement from David Roderick Bee. Mr Bee has been the managing director of Business since 5 November 1991. Business is the successor in title to Baileys Business Interiors Limited which was formed in 1989. Baileys Business Interiors Limited went into receivership, as part of the 'Baileys' Group, in October 1991 and was purchased by Business from the receivers. Mr Bee states that the trade name Baileys Business Interiors Limited, the bbi logo and the goodwill therein were purchased and a shelf company, Furnishfine Limited, was used to facilitate this. Beacons has challenged the evidence of Mr Bee in relation to this matter. I deal with this in my finding of facts. Mr Bee states that from 5 November 1991 Business traded as BBI and Baileys Business Interiors was removed from its trading name. I find this latter statement somewhat confusing in light of matter exhibited at DRB3. There are copies of various press articles from 1993 and 1994 referring to Baileys Business Interiors, the last one being dated 23 February 1994. BBI Business Interiors was adopted in 1994 and the company name changed in 1996. Mr Bee exhibits a change of name certificate, showing the change of name from Furnishfine Limited to BBI Business Interiors Limited. Mr Bee states the Business's bbi logo trade mark was first used in the United Kingdom in March 1989. He exhibits various materials spanning the period 1989 to 2002 to show this use. The material initially shows use of bbi and Baileys Business Interiors. The first evidence of use of BBI Business Interiors is from a page from "Business West Midlands" of June 1994. In the material, use of BBI is shown on its own and with the name of the company. In articles and promotional material invariably both BBI or bbi are used as well as Business Interiors Ltd or Baileys Business Interiors. All of the material identifies Business by these names and by reference to Warwickshire, where its headquarters is. The material shows that Business's business is that of designing and fitting-out offices, this encompasses such things as space planning, interior design, supply of furniture, lighting, carpets, curtains and blinds. A promotional newsletter for spring 1990 has a piece by Mr Bee, who is identified as the managing director. Other articles refer to the management buy-out of the business.

10) Mr Bee states that Business first became aware of Beacons in February 2001 when it was sent an article from "Business Equipment Digest" of February 2001. This article identifies Beacons as Beacons Business Interiors initially and finally, in the rest of the article it is referred to as BBI. Business contacted Beacons and eventually, on 19 February 2002, a meeting took place between representatives of the two companies, including Mr Bee and Mr Oldroyd, who gives evidence for Beacons. On 13 March 2002 Mr Bee wrote to Mr Oldroyd. A copy of the letter is exhibited. At the core of the letter are the following two paragraphs:

"We will not be actively looking for new business in Wales and if any opportunities are given to us through Senator/Haworth we would contact you before proceeding. As far as your company is concerned we would expect that you would not be actively seeking work within say a 25 mile radius of our

premises in Stareton. We realise that any work generated from your existing client base within this area would not be included in this proviso.

If you were to acquire any business within the Midland area and want to use the BBI name this obviously would be totally unacceptable to ourselves.”

A copy of the response, dated 26 March 2002, is exhibited. It was written by Mr Oldroyd and states, inter alia:

“Your proposal seems a sensible way of addressing the problem and we are happy to give agreement to it. I would hope that no problems will arise between us in the future.”

Mr Bee points out that the application form for application no 2295265 was filed on 12 March 2002 (in fact it was signed on 12 March but actually filed on 13 March 2002),

11) The sales figures for goods and services sold under the bbi logo trade marks by Business are as follows:

<b>Year</b>	<b>Approximate turnover (£ million)</b>
1998	1.3
1999	1.6
2000	3.2
2001	2.2
2002 (to 13 March 2002)	2

The following figures are given for advertising and promotion:

<b>Year</b>	<b>Approximate advertising expenditure</b>
1999	£13,000
2000	£28,000
2001	£24,000
2002 (to 13 March 2002)	£31,000

Mr Bee states that the bbi logo trade mark has been used throughout the United Kingdom. He lists a large number of specific locations in England and several in Scotland, Wales and Northern Ireland.

12) Mr Bee exhibits a brochure from Beacons and pages from its website. Both show the trade mark but also the name of the business as Beacons Business Interiors. From the brochure it is clear that Beacons and Business are in exactly the same line of business.

### **Evidence of Beacons**

13) This was furnished by way of a witness statement from Simon Peter Oldroyd, who is the sales and marketing director of Beacons. He states that Beacons was incorporated on

9 May 1995 but first began trading in 1989 under the name Beacons Business Interiors; the latter was a partnership. He states that since 1991 it has used the stylised acronym Bbi, although this was initially without the underlining, which was introduced in mid 1991. Mr Oldroyd states that Beacons is in the business interiors business. It fits out the interiors of offices, supplying all the internal construction elements, as listed in trade mark application no 2295265, as well as furniture. Beacons has forty five employees, including designers, surveyors, project managers, tradesmen and installers. He states that this is a common business sector and that there are many businesses throughout the United Kingdom which include the “business interiors” in their names. He exhibits two pages from a Google search for the words “business interiors” to support this. (The first reference on the page is to Business.)

14) Mr Oldroyd gives the turnover figures for Beacons from its audited accounts:

<b>Year (end May)</b>	<b>Turnover</b>
1998	£3,540,489
1999	£4,344,027
2000	£6,054,932
2001	£5,889,686
2002	£6,779,856

Mr Oldroyd exhibits records of projects carried out by Beacons throughout the United Kingdom between 1992 and 2001. He also exhibits copies of purchase orders from between 1990 and 1992 and correspondence relating to a refurbishment of the premises of Philips & Buck in Cardiff. A copy of an article from “Partitioning” (the journal of the Partitioning Industry Association) of Spring 1993 is exhibited. This relates to Beacons’ contract at Evershed. (From a copy of an advertisement for Beacons, from what appears to be a page from “Yellow Pages” of 1991/92, it appears that Beacons is a member of the Partitioning Industry Association.) Mr Oldroyd exhibits various materials relating to the promotion of Beacons’ business. All of them, bar one advertisement from “Yellow Pages”, make reference to Beacons Business Interiors, most also show BBI. The advertisement from “Yellow Pages” is from the office furniture section. It shows the trade mark, under which is the address of Beacons in Brecon. From the 0222 telephone codes that appear on the page, this must emanate from some time ago as this code changed to 0122 and then 029. Most of the material exhibited relates to Welsh publications eg “Yellow Pages” for part of South Wales and the “Western Mail”. The latest date on the material is 2 August 1994, and that is a letter specifically addressed to Beacons Business Interiors from the “Western Mail” giving advertising rates. All of the copies from pages from “Yellow Pages” show 0222 telephone numbers and so emanate from some time ago.

15) Mr Oldroyd gives the following figures for advertising and promotional expenditure:

<b>Year</b>	<b>Expenditure</b>
2000	£64,170
2001	£41,500

A copy of a photograph showing the official opening of new premises of Business on 14 July 1993 is exhibited. The trade mark can be seen on a plaque commemorating the opening, underneath the trade mark are the words BEACONS BUSINESS INTERIORS.

16) Mr Oldroyd states that he is personally aware of the history surrounding the old Baileys Business Interiors Limited business since he knew a number of the parties concerned. He states that it began with a family run department store in Leamington Spa called "The Baileys" which opened a contracts division during the 1980s, run from an upper storey of the building and headed by Messrs Ron Balmer and Malcolm Adams. Mr Oldroyd states that at this time it was selling mainly office furniture, with any fitting-out work sub-contracted out. He states that sometime in 1989 this division moved to Heathcote Industrial Estate in Warwick. Mr Oldroyd then goes on to dispute various points made by Mr Bee in his witness statement, rather than giving evidence of fact. Mr Oldroyd exhibits a letter from Mr Bee dated 14 November 2001 which states that Beacons' business and use of BBI in connection with it has come to the attention of Business. Mr Oldroyd comments that the letter states that Business owns a registered trade mark whilst at the time there was only a pending trade mark application.

#### **Evidence in reply by Business**

17) This is in the form of a further witness statement by Mr Bee. Mr Bee states that he was aware of Beacons prior to 2001 but as Beacon (sic) Business Interiors and not as BBI. He states that Business never traded under the name Furnishfine Limited. Mr Bee exhibits documentation to show Business's business in various parts of the United Kingdom. He also exhibits a brochure for Baileys Business Interiors from April 1993, this shows use of the bbi logo. Mr Bee exhibits a letter received by Business from Carleton Furniture Group Limited. The letter is dated 13 February 2004 and is addressed to BBI Ltd in Brecon. The letter is intended for Beacons. Mr Bee states that this is proof of confusion.

#### **Evidence by Beacons in relation to application no 2345225**

18) This is by way of a witness statement from Mr Oldroyd. Most of the statement is submission rather than evidence of fact. Mr Oldroyd states that there has been no confusion. In relation to the letter from Carleton, which Mr Oldroyd refers to as an invoice, he states that the address details show that the person preparing it knew where it was supposed to be going and had no intention of sending it to Business. He goes on to make various comments as to why he considers that confusion has not occurred.

#### **Evidence in reply by Business in relation to application no 2345225**

19) This is in the form of witness statement by Mr Bee. Mr Bee states that between the original Baileys' business being in receivership and its purchase by Business, there was a period of between two and three weeks at the most whilst there was a cessation in use.

## **Findings of fact upon the evidence**

20) Beacons disputes that Business has established that it took over the goodwill of the Baileys Business Interiors business. However, Mr Bee states on two occasions that this was the case. He explains why the documentation is no longer available. Beacons has not called for him to be cross-examined. The evidence shows that Baileys Business Interiors was the subject of a management buy-out in November 1991. This is not just the evidence of Mr Bee. Exhibited is a copy of Burgis & Bullock's "Business Brief" of Spring 1992:

"BBI directors took control of the company on 5<sup>th</sup> November 1991. Rescued from the hands of the receiver, the company was originally forced into insolvency in early October 1991..."

For some time the company continued to trade under the bbi Baileys Business Interiors name. Consistently, it has traded using bbi. It would seem odd that it could trade using the name and goodwill of Baileys Business Interiors without having purchased it. On the basis of the evidence presented, including the absence of any contradictory evidence from Beacons, I find that Business did purchase the goodwill in the business of Baileys Business Interiors when it took over that business. Ms May noted that Beacons had made no statement and furnished no evidence to show that it had taken over the goodwill of the original partnership when it was incorporated in 1995. I note that two of the partners, Andy Graham and Steven Hughes appear respectively as managing director and director in a flow chart of staff exhibited at SPO2. However, this is not evidence of transfer of the goodwill of the partnership. I accept Ms May's submission that there is no evidence of the transfer of goodwill. Taking into account that Beacons has disputed the evidence of Business in relation to the transfer of goodwill, Beacons' approach does appear to amount to the pot calling the kettle black.

21) From the evidence before me I come to the conclusion that both sides have been using the letters bbi/Bbi in relation to their businesses for a good number of years, probably from 1989 in both cases. In the case of Business it used these letters in combination firstly with Baileys Business Interiors and latterly with Business Interiors. In the case of Beacons it has used these letters in combination with Beacons Business Interiors. The businesses of both is basically the same, the fitting-out of office premises – business interiors. At the time of the filing of the applications both businesses had concurrent goodwill in their businesses. In the context of this case I do not consider that it matters who was first in the field or the absence of evidence in relation to the transfer of goodwill to Beacons in 1995. The period from 1995 is certainly long enough to establish a concurrent goodwill.

22) One of the trade mark applications and one of the trade mark registrations is for goods. I have looked through the evidence in relation to goods. I can find nothing to suggest that either side does anything other than supply or use the goods of others. I give a few illustrations in the evidence which in my view support this conclusion:

From exhibit DRB4:

“Marketing director Simon Oldroyd explains that BBI is not a furniture dealer nor an interiors design agency but really a facility partner....”

“BBI major on two well established principal suppliers, Farrell UK and Samas Office Furniture”.

From exhibit DRB8:

letter from Carleton Furniture Group Limited which relates to the supply of workstations, pedestals, screens, power outlets, cable baskets, finishes, MFC tops and screen fabric to Beacons.

From exhibit DRB9:

“Our installation teams have considerable experience in decorating, carpet fitting, cabling, erecting partitioning, arranging furnishings, and delivering even to the most awkward sites.”

“As a company, Baileys Business Interiors is totally independent of any manufacturing company, enabling us to recommend products to suit your needs and ensure you obtain high quality goods and value for money.”

“K&N System oak furniture with grey frames was chosen for the main offices....”

“..we carefully timetabled the procurement, transport and installation of the furniture and equipment concerned.”

From exhibit DRB3:

bbinteriors of spring 1990:

“And in pride of place is the very latest furniture system, Pulsar by Alan Cooper, which we highlight on the back cover of this issue.”

Newspaper advertisement feature from May 1992 has advertisements from Senator, Buroflex, Cooper Dauphin and Konig & Neurath K + N International – all manufactures of office furniture.

CPR 1111 press release from July 1992:

“BBI both designs offices and supplies furniture, suspended ceilings, partitions, carpets and fabrics”.

Advertisements stating that Business is the main distributor of Haworth UK and Senator International.

“OTN” of September 1996:

“The company will install 130 workstations of Senator’s Network desking, with Mainstream seating..... managing director David Bee says it is crucial that he deals with reliable suppliers.”

Exhibit SPO1:

“As a totally independent contractor, BBI can design and install any type of ceiling using systems from all reputable manufacturers...”

“BBI offers a design and installation service for office furniture. Using top quality products from an internationally known and nationally known suppliers.”

Philips & Buck refurbishment in Cardiff – Komfort’s Komfire System, Pioneer System, external vertical blinds – “material from the grade ‘B’ selection – see catalogue”; replacement tiles – Armstrong’s Minatone Cortega Tegular

“Partitioning” for Spring 1993: “BBI installed *Logika 2000* with full-height double glazing with venetian blinds in the cavity, taped and filled joints and *Murek* Lancaster wallcovering from Muraspec.”

“Welsh Industry and Commerce” July/August 1993:

“It has recently won the Welsh dealership for Samas Roneo office furniture...”

The goodwill, on the basis of the evidence, is for the services that the two sides conduct; services relating to the fitting out of offices, the business interiors business. I cannot see that there is any goodwill for goods in relation to either side. They supply services which uses the goods of others.

## **DECISION**

### **Likelihood of confusion – section 5(2)(b) of the Act**

23) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

The trade marks of Business are earlier trade marks within the meaning of section 6(1)(a) of the Act.

24) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723.

### Comparison of trade marks

25) The trade marks to be compared are:

**Application:**



**Earlier trade marks:**



26) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public” (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

27) Beacons has put in evidence to show that the words “business interiors” are commonly used and devoid of distinctive character. I accept this. The dominant and distinctive element of the trade marks of Business is the letters bbi, in the case of three of the trade marks in the same script. Phonetically this element is identical to the trade mark of Beacons. Ms May submitted that the respective trade marks are conceptually the same. There is no indication that the letters bbi have any meaning or conceptual association. I have difficulty in understanding how the letters have a conceptual association. She compared this case to that of the bounding feline in *Sabel BV v Puma AG*. However, in that case the image had a conceptual association, that of a bounding feline. It is not necessary for a trade mark to be a word to have a conceptual association. However, it must, in my view have some concept that can be concretised. I am not convinced that three letters, with no meaning per se, can be classified as having any conceptual association. Although, I note that Ms May’s view of letter marks having a conceptual association is supported by the Court of First Instance (CFI) in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03. Mr Morcom submitted that the distinctiveness of the respective trade marks lay in their get-up rather than the letters themselves. Such a submission, it seems to me, is essentially based upon the predication that three letter trade marks are inherently non-distinctive. I see no reason for such an assumption. The basis for the objection to three letter trade marks under the 1938 Act was very much based on the refusing of monopolies that might affect others rather than the inherent distinctiveness of the trade marks. Such a position has also been held in relation to surnames and was dealt with by the ECJ in *Nichols plc v Registrar of Trade Marks* Case C-404/02. In that case that position was repudiated by the ECJ:

“31 The registration of a trade mark constituted by a surname cannot be refused in order to ensure that no advantage is afforded to the first applicant since Directive 89/104 contains no provision to that effect, regardless, moreover, of the category to which the trade mark whose registration is sought belongs.”

Mr Morcom’s submission runs completely contrary to the judgment of the CFI in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)*, which placed emphasis on the common occurrence of the letters. In that case, it is to be noted, that the respective trade marks were two letter trade marks and that there was a good deal of stylisation and the goods, clothing, it was accepted, are mainly bought by the eye.

28) I am of the view that the key point of the respective trade marks is the letters bbi, their stylisation is noted but is not key to the recognition or distinctiveness of the

respective trade marks. None of them are in the form of intricate monograms. I note the presence of the words “business interiors” in two of the trade marks, taking into account the nature of the goods and services I think that this has little effect upon the outcome (see *Alejandro v OHIM – Anheuser-Busch (BUDMEN)* Case T-129/01, paragraph 53; *Koubi v OHIM – Flabesa (CONFORFLEX)* Case T-10/03, paragraph 60; *Grupo El Prado Cervera v OHIM – Debuschewitz (CHUFAFIT)* Case T-117/02, paragraph 51).

29) Mr Hobbs QC, sitting as the appointed person, in *Torremar* [2003] RPC 4 stated:

“At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example, *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713) or origin neutral (see, for example, *The European Ltd v The Economist Newspaper Ltd* [1988] FSR 283).”

30) In considering the respective trade marks one has to consider the similarities and the differences. Mr Geoffrey Hobbs QC, sitting as the appointed person in *Croom’s Trade Mark Application* [2005] RPC2 stated:

“The differences and the similarities had to be given as much or as little significance as the average consumer would have attached to them at the date of the opposed application for registration.”

and

“My difficulty is that in these passages of his decision the Hearing Officer has concentrated on the similarities to the exclusion of the differences between the marks in question. That might not have mattered if the marks differed only in respect of elements to which the average consumer would have attached little, if any, significance.”

31) I take into account that, at least for the services, the relevant public will be making a careful purchasing decision. The nature of the services are such that the public is likely to have several contacts with the suppliers of the services. However, I am of the view that the common presence, despite the stylisations, of the letters bbi means that the respective trade marks are distinctively similar. Despite, Mr Morcom’s submissions, owing to the nature of the trade marks I consider that they are distinctive to a high degree. Rather than seeing the distinctiveness laying in the get-up of the letters, I consider the relevant public will be far more likely to simply see one set of letters as being a simple image makeover of the other.

### Comparison of goods and services

32) In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

33) In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* the European Court of Justice held in relation to the assessment of the similarity of goods and services that the following factors, inter alia, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary. I do not consider that there is any dissonance between the two tests. However, taking into account the judgment of the European Court of Justice, I may need to consider whether the goods and services are complementary.

34) Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I also bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* where he stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

I take on board the class in which the goods or services are placed is relevant in determining the nature of the goods and services (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). Although it dealt with a non-use issue, I consider that the words of Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 are also useful to bear in mind:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

35) Beacons has accepted that the respective services are similar. The services of the application are:

*installation, repair and maintenance services for offices, shops and buildings; information and advisory services relating to furniture and office equipment; interior and exterior painting and decorating services; refurbishment of shops, offices and buildings;*

*design and planning of buildings, offices and shops; industrial design; information and advisory services relating to the aforesaid.*

The services of the earlier registration are:

*installation, arrangement and maintenance of furniture and office equipment; information and advisory services relating to furniture and office equipment;*

*furniture design and planning; interior design and planning; office design and planning; information and advisory services relating to the aforesaid services.*

I do not consider that in relation to the respective services an exhaustive analysis is required as they are clearly identical in some areas and highly similar in the remaining areas and, of course, Beacons has admitted this.

36) The goods of the application are:

*metal decorations, metal wall tiles, metal building materials, metal ducting, metal building structures and metal signs; none being parts and fittings in respect of furniture;*

*electric fittings, electric switches, electric power points, electric cabling, cabling for computer networks and cabling for telephone networks;*

*lighting fittings, lighting installations, air heating, air filtering and air conditioning equipment, and heating systems;*

*ceilings for buildings, partitions, floors and flooring materials, wall tiles, walls and decorations for buildings;*

*paperhangings, carpets, carpet tiles, linoleum, wall hangings and wall paper.*

The goods of the earlier registration are:

*furniture and parts and fittings therefor.*

I have rehearsed the services in paragraph 35 above. I can see no way that the goods of the earlier registration coincide, in any meaningful way, with the goods of the application. Ms May concentrated her submissions upon the basis of the similarity of the services of Business to the goods of Beacons.

37) In making the comparison it is necessary to keep a view of the actual specification of the earlier registration; not to have one's view distorted by what Business might have actually done. One is comparing specification with specification, not actual business with specification. The class 37 specification is limited to services relating to furniture and office equipment. It does not relate eg to services for maintaining air conditioning apparatus, heating apparatus, plastering or painting. The class 42 specification is for design and planning. In considering the cover of the services I bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Ms May submitted, if I understand her correctly, that because Business use the goods in its services they are similar. Are nails similar to carpentry services because a carpenter uses them? There is no evidence that is common in trade for, eg, an interior design company to produce such goods as ceilings, partitions, carpets or wall papers. The only indication of this is the application itself, by making which, Beacons states that it does intend to use its trade mark in relation to the goods of the application. However, the evidence certainly does not show this is what the average consumer expects and the services that Beacons supplies cannot be conflated with the specifications of Business's registration. Ms May picked up a comment by Mr Morcom about the relationship between cars and the servicing of cars. This seems to me to be actually in favour of Beacons. The relationship between car manufacturers and their servicing is long established, it is reinforced by the requirements of warrantees, specialist equipment and specialist knowledge. It has for a long time been part and parcel of the package of buying a car. In so far as the services of the two specifications coincide with the evidence relating to the businesses of the sides, there is no relationship between the goods and the

services, other than their being possibly used. In my view the nature of the services is the very opposite, in its effecting in trade and how it relates to goods, to the car trade. Ms May was arguing that the respective goods and services are complementary. What is meant by the term complementary is somewhat vague, the CFI has taken what appear to be two different views in *Pedro Díaz, SA v OHIM (CASTILLO)* Case T-85/02 [2004] ETMR 42 and *El Corte Inglés, SA v OHIM (EMILIO PUCCI)* Case T-8/03.). I have tended to the view that to have any significance in terms of similarity of goods and/or services, it relates to a symbiotic relationship or a mutual dependency. Otherwise the pen could be considered similar to the poem. It certainly, in my view, requires something more than a relationship in use; I do not see the nail and the carpenter's service as being complementary just because the carpenter hits the nail. In the case of cars and their servicing there is a mutually dependent and a symbiotic relationship both by nature and by the conventions of trade.

38) Ms May tried to give a very wide definition to office equipment, to include for instant, under my direct questioning, air conditioning apparatus. I do not share Ms May's view of what this term means. I consider that, based upon *Thomson Holidays Ltd v Norwegian Cruise Line Ltd, Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* and *British Sugar Plc v James Robertson & Sons Ltd*, that the term would cover such things as photocopiers, printers, fax machines. I certainly do not envisage it encompassing such things as *air conditioning equipment, heating systems* and *lighting fittings*. These might all be in offices but it does not make them goods which would normally be described as office equipment.

39) It might be that if there was a fault in a piece of office equipment, a service provider could change the plug – if this was the cause of the fault – I do not see that this makes a plug similar to the *maintenance of office equipment*. The user of the services of the earlier registration is someone seeking a general and complete service. It is not the same person, in my view, as someone purchasing a particular electrical fitting, a carpet or wall paper or a ceiling. Many of the services covered by the earlier registration do not even cover the supply of goods eg the class 42 services. The other services are strictly limited – to furniture and office equipment.

40) Mr Morcom submitted that this was the sort of case where it was necessary to furnish evidence of the similarity of the goods and services. The following comments of the ECJ in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* have more often been honoured in the breach than the commission:

“It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered.”

In the vast majority of cases there is no need for evidence in the comparison of goods and services, such a requirement would be over-burdensome. However, in relation to the comparison of certain goods and services there is a need so to do. In this case, I agree

with Mr Morcom. This is a matter that requires evidence. The onus is upon Business, the opponent, to prove its case (see *React Trade Mark* [2000] RPC 285). I am not convinced by the arguments of Ms May as to the similarity between the goods of Beacons application and the services of Business's registrations. I do not find the argument that certain of the services would involve the supply of certain of the goods in itself a basis for finding that the goods of the application are similar to the services of the registration. **I find that the goods of application no 2295265 are not similar to either the goods or the services of the registrations of Business.**

## Conclusion

41) To succeed under section 5(2)(b) of the Act the goods and/or services have to be similar; that is what the Directive states, it is what the Act states. It is what is pointed out in *Sabel BV v Puma AG* [1998] RPC 199:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

Consequently, as I have not found the goods of the application to be similar there cannot be a likelihood of confusion in relation to these.

42) In considering the services of the application I need to take into account a variety of factors:

- the distinctiveness of the earlier trade mark;
- the degree of similarity between the trade marks;
- the degree of similarity between the respective services;
- the nature of the respective services and the subsequent purchasing decision;
- the average consumer for the services involved;
- that trade marks are seldom compared directly and the potential purchaser may be prey to imperfect recollection;
- any claim to reputation.

I have dealt with, to some extent, the issue of the distinctiveness of the earlier trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). The trade marks of Business which encompass services include the words “business interiors”, the distinctiveness of which I have already dealt with. For the services I cannot see that bbi is any way descriptive or even allusive. It stands together as a whole, its key identifier is the letters. I do not see that the average consumer is going to muse upon whether the bi means business interiors, especially as these words follow the letters. Many undertakings use letters as trade marks. They work successfully. I consider that the trade mark of

Business enjoys a reasonable degree of inherent distinctiveness as the public are used to abbreviations to indicate trade origin and there is no relationship between the services and the letters. There is no evidence that the letters bbi are commonly used for the services under consideration. A three letter trade mark can enjoy a good deal of inherent distinctiveness, however, despite this the nature of the trade mark means, in my view, that the scope of its protection is narrow. As I have indicated it is common for letter marks to be used in trade and for the public to be aware of them. This in turn means that the public are used to discriminating between various letter trade marks; a small difference in the trade mark can give rise to a large difference in perception. However, these differences relate to where, for one instance, one letter is different. It does not, in my view, occur where the essential difference relates to get-up. The differences in get-up in this case do not give rise to a major difference in perception. I consider the respective trade marks enjoy a high degree of similarity as do the respective services. The nature of the services is such that it is likely that the purchaser will be involved in a number of communications/meetings with the provider; requirements will be obtained, estimates/quotations supplied, advice and consultation supplied. However, where the trade marks are essentially so similar and the services also, I do not consider that the nature of the purchasing process, and the sophistication of the purchaser, will militate against confusion. All there is, effectively, to differentiate between the two trade marks is a degree of stylisation. No claim to reputation has been made, in the terms of section 5(2)(b) of the Act.

43) Beacons has commented upon the lack of confusion in the market place. There is the communication from Carleton Furniture Group Limited. However, I consider that Beacons is correct in submitting that this does not represent trade mark confusion but a misdialling, the communication is clearly directed to Beacons. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

(Also see *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41.) I consider that this is the case here. All the evidence shows that the sides have used the letters bbi/Bbi with other indications to show the origin of the goods. This is not only the company names but also the location of the companies. The nature of the services is such that there will be communication with the undertakings and consequently an identification of one company with Brecon and another with Kenilworth. The nature of the services also shows that brochures are used which further make it clear from the other indicia and the different geographical locations that these are not the same undertakings. I have to consider the respective trade marks on the basis of normal and fair use. I have to consider them without any other extraneous matter.

**44) Taking into account all the above I find that there is a likelihood of confusion in relation to trade mark application no 2345225 and that this application should be**

**refused as per section 5(2)(b) of the Act. I find that there is not a likelihood of confusion in respect of trade mark application no 2295265.**

**Passing-off section 5(4) of the Act**

45) Section 5(4)(a) of the Act states:

“4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom 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,”

46) I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case* [1998] 14 RPC 455. In that decision Mr Hobbs stated that:

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

.....Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that; “To establish a likelihood of deception or confusion in an action for passing-off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact. In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.””

47) The first matter that I have to decide is the material date. It is well established that the material date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] RPC 8 and 9). Section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998 which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark”.

Mr Morcom was looking for a material date back when the two sides started concurrently trading. This presupposes that one can conflate the trade mark of the application with the usage relating to the goodwill of Beacons. I do not believe that such a conflation can be made. The evidence shows that though the trade mark has been used for a good number of years, it has been used with other indicia. Indicia that have allowed the two sides to trade seemingly without confusion. A further flaw in Mr Morcom's argument, in my view, is that it does not address the fact that the passing-off claim relates to goods and the evidence indicates that Beacons has no goodwill in relation to the goods at issue. I consider, therefore, that the material date in this case is the date of application, 13 March 2002.

48) Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 stated:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

Professor Annand, sitting as the appointed person, in *Loaded* BL0/191/02, accepted that proof of goodwill could be accomplished by other means. I have already concluded that Business has established a goodwill in relation to the business interiors business, which is related to use of bbi in conjunction with various other indicia, whether by the name of the undertaking or by its location. The comparison I have to make is with the trade mark as applied for, with no other indicia, and not with the use made by Beacons which would put the issue in a very different light.

### **Acquiescence**

49) Mr Morcom argued that Business had acquiesced in the use of the trade mark of Beacons. Not in the use of the trade mark with other matter but its use upon its own. He based his argument upon the correspondence exhibited at DRB5 and when Mr Bee first knew about Beacon's business. In his first statement Mr Bee states that he first became aware of Beacons in February 2001, in his second statement he seems to state, it is not completely clear, that he was aware of Beacons in 1998. However, what is clear from his statement is that he was not aware of Beacons' use of Bbi until February 2001, which is the germane issue. Mr Morcom interprets Mr Bee's letter of 13 March 2002 as indicating that he was content with the use of the letters BBI. I do not find the letter that clear. There is reference to the BBI name. However, he states:

"What we would hope to do is carry on very much as we have for the last ten years, when we not seem to have had too many problems or confusion."

This could mean carrying on with the use of other indicia. In Mr Oldroyd's letter of 26 March 2002, he refers to "respective uses of versions of the name "BBI"". This indicates, in my view, that Mr Oldroyd is talking about the letters without other matter. However, this is not certain. To build anything upon this exchange of correspondence it would, in my view, be necessary to have a copy of any notes taken at the meeting and/or

cross examination of the two writers. In the absence of either it is very difficult to come to any conclusion. However, I note the following from Mr Bee's letter:

"If you were to acquire any business within the Midland area and want to use the BBI name this obviously would be totally unacceptable to ourselves."

Mr Morcom submitted that business in this context did not mean custom but actual purchase of another undertaking. Ms May submitted that it simply meant custom. I am of the view that Ms May's interpretation is the more natural, it is certainly how I read the sentence. This sentence then torpedoed Mr Morcom's claim to acquiescence. The application has been made with no clause limiting the rights to any particular geographical area. The application is a national one, one which covers the Midlands and so I have to consider the issue of Beacons' use of the trade mark in the Midlands, in Kenilworth perhaps. Business makes it clear that such use is not acceptable to it. Further to this, if there had been any agreement the evidence indicates it relates to the current trade practices of the two sides. There is nothing to indicate that it relates to goods of any kind.

50) Mr Morcom referred to the judgment of Oliver LJ in *Habib Bank Limited v Habib Bank AG Zurich* [1982] RPC 1, where he stated:

"We have been referred at length to a recent judgment of my own in a case of *Taylor Fashions Ltd. v. Liverpool Victoria Friendly Society* in which I ventured to collect and review the authorities. Perhaps fortunately for those gifted with neither patience nor perseverance it remains unreported, but I there said this (page 39, Tab. 16):

"Furthermore the more recent cases indicate, in my judgment, that the application of the *Ramsden v. Dyson* principle--whether you call it proprietary estoppel, estoppel by acquiescence or estoppel by encouragement is really immaterial--requires a very much broader approach which is directed rather at ascertaining whether, in particular individual circumstances, it would be unconscionable for a party to be permitted to deny that which, knowingly or unknowingly, he has allowed or encouraged another to assume to his detriment than to inquiring whether the circumstances can be fitted within the confines of some preconceived formula serving as a universal yardstick for every form of unconscionable behaviour."

Even ignoring my findings in paragraph 49, I cannot see that, on the basis of the severely limited and not particularly clear evidence before me, that an action for passing-off in relation to the goods of the application could be considered to represent unconscionable behaviour.

**51) I do not consider that Beacons has established acquiescence by Business in relation to the trade mark for the goods.**

52) Again the argument has been run that there has been no confusion in the marketplace. However, again this tells me nothing. In the market place the two sides have used various indicia and other indications of origin with their trade marks. Beacons has not applied for the trade mark with its name, it has removed one of the indicium that distinguished its business from that of Business. I consider that this has strong parallels with *Sir Robert McAlpine Limited v Alfred McAlpine Plc* [2004] RPC 36, where the removal of a forename meant that the distinguishing feature between the two undertakings was removed. In that case there was also a long concurrent goodwill and sophisticated customers. Mr Morcom submitted that *Sir Robert McAlpine Limited v Alfred McAlpine Plc* was not on a par with this case as the indicium which was removed was a forename. This is, of course, the case. However, I think that the principle still holds good, that the removal of the distinguishing indicium can give rise to passing-off and length of concurrent use and sophistication of the customer, are not going to militate against this.

53) In considering the issue of passing-off, in this context, I have to consider the trade mark as filed and the actual use of the signs of Business. Passing-off does not require goods or services to be similar. In *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501 Slade LJ said:

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.”

Millet LJ in *Harrods Ltd v Harrodian School* also stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

I have already considered the respective goods and services in relation to the likelihood of confusion and decided that they are not similar. However, here I have to consider the services as actually provided by business and not the services as registered; services which cover a wider spectrum in relation to supplying business interiors. However, despite this the same fundamental issue arises. Would the person concerned, knowing the business of Business and the signs used in relation to it and how they have been used, believe, seeing the trade mark, that it was responsible for the goods of the application sold under that trade mark? All the same issues arise as to an absence of any evidence as to this being the norm in trade. Business supplies a complete service, it is not in the business of supplying for instance discreet electrical services and certainly there is no indication of any responsibility for the actual goods it installs. To take an example, if I saw the trade mark of the application on flooring material would I consider knowing of

the business of Business that it was responsible for the material? There is no evidence that undertakings that perform the business of Business are also responsible for the goods, the evidence such as it is is against this, as is my experience. Taking into account the goods of the application, the services that Business has furnished, the signs that it has used in relation to those services, I do not consider that Business has established that use of the trade mark for the goods is liable to be prevented by the law of passing-off. Owing to the nature of the goods and the business of Business, at the best the public concerned, which from the evidence of Business is a sophisticated and educated public, might note the coincidence in the letters bbi. I do not think that it will go any further than that.

**54) Consequent upon the above I dismiss the grounds of opposition under section 5(4)(a) of the Act.**

### **OVERALL CONCLUSION**

**55) As a result of the findings in relation to section 5(2)(b) and 5(4)(a), application no 2345225 is to be refused in its entirety. The opposition to application no 2295265 is dismissed in its entirety.**

56) Ms May also submitted that the class 6 specification included a negative exclusion, which was contrary to the judgment of the ECJ in *Koninklijke KPN Nederland NV v Benelux Merkenbureau* Case C-363/99 [2004] ETMR 57. There is no ground of opposition on the basis that the class 6 specification included an exclusion by characteristic. If Business wished to run this as a ground, it should have requested an amendment to its grounds; allowing Beacons to consider it and, if it considered it appropriate, possibly amending its specification. As this was not a ground, it is not something of which I am prepared to take any cognisance.

### **COSTS**

**57) Each side has been successful to some extent. Consequently, I consider that each side should bear its own costs in relation to the work involved in the cases. However, Business should receive compensation for the opposition fee that it paid in relation to its successful opposition. I, therefore, order Beacons Business Interiors Limited to pay BBI Business Interiors Limited the sum of £200. This sum is to 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 21st day of February 2005**

**David Landau  
For the Registrar  
the Comptroller-General**