

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

IN THE MATTER OF TRADE MARK APPLICATION **m** 1553108  
BY FLEXIFORM BUSINESS FURNITURE LTD  
TO REGISTER THE MARK **FLEXILINK**

AND

IN THE MATTER OF OPPOSITION  
THERE TO UNDER OPPOSITION **m** 42604  
BY WAGON STORAGE PRODUCTS LTD

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

IN THE MATTER of trade mark  
application **m** 1553108  
by Flexiform Business Furniture Ltd  
5 to register a mark in class 32

and

IN THE MATTER of opposition  
thereto under opposition **m** 42604  
by Wagon Storage Products Ltd

10 DECISION

Flexiform Business Furniture Ltd applied on 1991 under section 17(1) of the Trade Marks Act 1938 to register the mark FLEXILINK in Class 20 for:

15 “Office furniture, cabinets, filing cabinets, cupboards, lockers, storage furniture, desks, bureaux, bookcases, tables, chairs, stools, stands, screens; parts and fittings for all the aforesaid goods; all included in Class 20.”

The application was given the number 1553108, and was published for opposition purposes on 22 March 1995. On 16 June 1995 Wagon Storage Products Ltd formally opposed the application.

I summarise the grounds of opposition as follows:-

20 **M** Section 12(1) — The opponent claims that the mark in suit so nearly resembles a number of trade marks already on the Register (listed below) in respect of the same goods or the same description of goods as to be likely to deceive or cause confusion contrary to Section 12(1) of the Act.

25 **M** Section 11 — Use of the mark applied for in respect of the goods for which it is proposed to be registered would be deceptive or confusing and disentitled to protection in a Court of Justice in the terms of Section 11.

30 **M** Section 10 —The opponent contends that the mark applied for is not capable, in relation to the goods in respect of which it is proposed to be registered, of distinguishing goods with which the proprietor is connected in the course of trade from goods in the case of which no such connection subsists.

**M** Section 17(2) — The nature of the mark and its specification of goods are such that the Registrar should, in his discretion, refuse the application or accept it only with suitable limitations.

The prior registrations relied upon by the opponent are in Class 6 and Class 20; the relevant details are as follows:

	<b>Class 20 Marks</b>	<b>m</b>	<b>Date</b>	<b>Journal</b>	<b>Page</b>
	LINK	766,437	18.09.57	4143	1286
5	LINK	1,055,596	25.11.75	5522	1747
	LINK 51 STORMOR	1,216,521	10.04.84	5606	429
	LINK	1,218,262	09.05.84	5764	1315
	LINKSPAN	1,218,264	09.05.84	5646	2976
	LINK HANDY	1,222,078	04.07.84	5770	2127
10	LINK PLASTICS	1,386,549	31.05.89	5963	1060
	LINK 51 DRAWERSTOR	1,420,404	03.04.90	5912	1519
	LINK 51 STOREDRAWER	1,420,405	03.04.90	5912	1519
	LINK FIREFILE	1,428,959	26.05.90	5907	451
	LINKSAFE	1,428,961	26.05.90	5912	1519
15	LINK DISKETTE SAFE	1,428,963	26.05.90	5930	4904
	LINK DATASAFE	1,428,965	26.05.90	5913	1739
	GOLDLINK	1,436,398	25.07.90	5935	5757
	LINK 51 STORSECURE	1,440,381	17.09.90	5928	4640
	LINK STORMOST	1,477,585	21.09.91	5926	4313
20	LINK 51	1,543,208	29.07.93	5551	6041
	<b>Class 6 Marks</b>	<b>m</b>	<b>Date</b>	<b>Journal</b>	<b>Page</b>
	LINK	989,619	28.03.72	5267	1364
	LINKSTOR	1,078,787	20.05.77	5585	2468
	LINK 51 STORMOR	1,216,518	10.04.84	5606	398
25	LINK	1,218,259	09.05.84	5739	2597
	LINKSPAN	1,218,263	09.05.84	5646	2959
	LINK HANDY	1,222,076	04.07.84	5770	2104
	STORMOR LINK 51	1,254,871	20.11.85	5655	140

	<b>Class 6 Marks</b>	<b>m</b>	<b>Date</b>	<b>Journal</b>	<b>Page</b>
	LINK	1,425,734	03.05.90	5875	3147
	LINKSECURE	1,427,487	26.05.90	5873	2852
	SAFELINK	1,427,488	26.05.90	5873	2852
	LINK HOTEL SAFE	1,427,489	26.05.90	5922	3559
5	SECURPLINK	1,427,490	26.05.90	5875	3147
	LINK FIREFILE	1,428,958	26.05.90	5906	171
	LINKSAFE	1,428,960	26.05.90	5916	2325
	LINK DISKETTE SAFE	1,428,962	26.05.90	5932	5239
	LINK DATASAFE	1,428,964	26.05.90	5916	2325
10	GOLDLINK	1,436,397	25.07.90	5932	5239
	LINK 51 STORSECURE	1,440,380	17.09.90	5928	4585
	LINK 51	1,543,207	29.07.93	5506	6041

In response, the applicant filed a counterstatement admitting the existence of the opponent's prior registrations, but denying each of the grounds pleaded.

15 Both parties seek an award of costs in their favour.

The matter came to be heard on 6 January 1999. At the hearing, the applicant was represented by Mr Hugh Sherrard-Smith of Appleyard Lees. The opponent was represented by Mr Simon Walters of Trade Mark Consultants Co.

20 By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. Nevertheless, these proceedings having begun under the provisions of the Trade Marks Act 1938, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, and unless otherwise indicated, all references in the remainder of this decision are references to the provisions of the old law.

25 *The Evidence*

The applicant filed four statutory declarations in support of the application; one by each of: Hugh Sherrard-Smith of Appleyard Lees; Robert Speirs Nelmes, Marketing and Pre-sales Director of Flexiform Business Furniture Ltd; Ivan R Dunn, Managing Director of 1<sup>st</sup> Choice Stationery Ltd; and William James Ruddick White, Managing Director of Rotadex Systems Ltd.

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The opponent's evidence comprises two statutory declarations by George Myrants of Trade Mark Consultants Co.

I have carefully considered all these declarations, and their corresponding exhibits, before reaching my decision. At the hearing in this matter, Mr Walters conceded that he did not have sufficient evidence to succeed under section 11, and that consequently he would not be pursuing the opposition on that ground. There is therefore no need for me to review all the evidence in detail, since most of it is not relevant to my decision under section 12. Moreover, there is nothing in the evidence which has a bearing on the section 10 ground.

Later in this decision I will refer to the evidence of Messrs Dunn and White. The two declarations are short, and are expressed in almost identical words. For convenience I reproduce the text of Mr Dunn's declaration below:

"I am the Managing Director of 1st Choice Stationery Ltd and have worked in the furniture, storage and stationery industry for over 15 years.

I regularly attend furniture and equipment trade shows throughout the United Kingdom and Europe, including the recent Orgatec exhibition in Cologne.

During this time I have always known the company in question as Link 51 and it has never occurred to me to confuse their products with those of Flexiform and indeed would not confuse Flexilink with Link 51 or the singular use of the word Link. I normally would associate Link 51 with lockers and industrial storage. Flexilink I would associate with the office filing, storage and office furniture market."

Against this background, I now turn to consider the grounds of opposition.

### *Section 10*

This section of the Act is as follows:

**10** (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to the limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

In his submissions at the hearing, Mr Walters developed the opponent's case under section 10 by saying that the inclusion of the LINK element in the applicant's mark would cause the relevant public to associate the applicant's goods with the opponent, and that to this extent, the mark was incapable of distinguishing between these two companies. It does not appear to be a part of the opponent's case that the mark FLEXILINK is inherently incapable of distinguishing.

Kerly's Law of Trade Marks and Trade Names (twelfth edition) states at footnote 2 to Chapter 10-01 (page 143):- "Strictly, a mark that offends against Section 11 or Section 12(1) cannot be distinctive; but it is convenient to treat separately the objections under these sections and under Section 9 or Section 10."

The Registrar's hearing officer dealt with a similar situation in the *NUCLEUS* case<sup>1</sup>. At page 236 of the reported decision, the hearing officer says:-

"It is particularly convenient in cases such as this, of course, because here we have identical marks which have been used but which are in different proprietorship. The terms of Section 12(2) clearly envisage the possibility of identical marks in different proprietorship nonetheless being registrable, and it is therefore important to treat the essential or inherent qualities of the mark as a separate matter from issues of proprietorship since the outcome under Sections 11 or 12 could be that both are registrable. (An adverse finding under Section 11 or Section 12, of course, would make refusal mandatory. A retrospective finding that the mark was therefore not distinctive under Section 9 might be interesting, but it could have no practical effect other than perhaps to complicate an appeal against the Section 11 or Section 12 finding).

The Trade Marks Act 1994 employs the term "absolute grounds of refusal" in relation to Section 3 (equivalent to Sections 9 and 10 of the old Act), and "relative grounds of refusal" in relation to Section 5 (equivalent to Sections 11 and 12 of the old Act), and it seems clear enough that these provisions are to be applied separately from one another.

All this confirms me in my belief that even under the old Act, issues such as seniority or proprietorship are best dealt with under Sections 11, 12(3) and 17(1), and kept out of considerations under Sections 9 and 10. Accordingly, I propose to deal with the Section 11 ground as a separate matter from that under Section 9."

I see no reason why I should not follow the same course on this occasion. Consequently I find that the mark is acceptable under section 10, and the opposition on this ground fails.

### *Section 12(1)*

This section of the Act reads as follows:

"12(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- a. the same goods,

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<sup>1</sup>NUCLEUS TRADE MARK [1998] RPC 233

- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description.”

5 The reference in this section to a near resemblance is clarified by section 68(2B) of the Act which says that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

10 The opponent has referred to a large number of their LINK marks that are already on the register, but the evidence does not suggest that more than a few of these marks have actually been used in the last couple of decades. The opponent’s principle mark appears to be LINK or LINK 51. As I observed at the hearing, bearing in mind the *BECK KOLLER* case<sup>2</sup>, the opponent was not in a position to rely upon this ‘family-of-marks’ argument in the absence of evidence that a significant number of the marks were in use in the market. In the event, Mr Walters agreed that for the purposes of comparison under section 12(1) his most relevant mark is LINK solus; that is, registrations 766437, 1055596, 1218262, 989619 & 1218259. If 15 the opposition cannot succeed in relation to this mark, then in my opinion it cannot succeed in relation to any of the other marks.

The standard test for opposition under section 12 has been laid down in the *OVAX* case<sup>3</sup> by Mr Justice Evershed. Applied to the facts of the present case, the test may be expressed as follows:

20 Assuming use of the opponent’s mark LINK in a normal and fair manner for any of the goods covered by these registrations, is the tribunal satisfied that there will be no reasonable likelihood of deception or confusion amongst a substantial number of persons if the applicant uses the mark FLEXILINK normally and fairly in respect of any goods covered by the proposed registration?

25 So far as I am aware, the test advanced by Mr Justice Parker in the *PIANOTIST* case<sup>4</sup> remains the appropriate test for similarity of marks in proceedings under the 1938 Act.

30 “You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which

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<sup>2</sup> In the matter of an Application by Beck, Koller & Company (England) Limited for the Registration of a Trade Mark [1947] RPC 76; particularly at page 83 lines 26 to 56

<sup>3</sup>Smith Hayden & Co Ltd’s Application [1946] 63 RPC 97

<sup>4</sup>In the Matter of an Application by the Pianotist Company Ld for the Registration of a Mark [1906] 23 RPC at page 777

will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case.”

5 Mr Sherrard-Smith accepted on behalf of the applicant that the goods in respect of which the opponent’s marks are registered are the same as, or of the same description as, the goods contained in his application — eg office furniture.

I go on therefore to consider whether the trade marks LINK and FLEXILINK are similar. It is necessary to compare the trade marks as a whole when the question of the similarity of marks is in issue. In so comparing, I note that it is well established that the first syllable of a word is important for the purpose of distinction (see *TRIPCASTROID* [1925] RPC 264).  
10 Mr Sherrard-Smith directed my attention to the fact that there are a number of other ...LINK marks on the register for the same or similar goods, eg MODULINK, NIMLINK, ARLINK. However, there is no evidence of the extent to which these marks are being used, and therefore I think that this argument must fail for the same reasons as given in relation to the opponent’s ‘family-of-marks’ argument — (see *BECK KOLLER* above).

15 I put it to Mr Sherrard-Smith that the facts in this case were similar to those in *RUS/SANRUS*<sup>5</sup>. In that case, the plaintiffs, who were the registered proprietors of a trade mark consisting of the word RUS in respect of porcelain and earthenware, brought an action against the defendants for infringement of the mark and passing-off by the use in respect of bricks of the word SANRUS. In the matter of infringement, Mr Justice Simonds found that  
20 the plaintiffs had made out their case. At page 349 and line 12 he says:

“Now I think it is reasonably clear that no man seeing the words “Rus” and “Sanrus” written side by side on a piece of paper would be liable to any sort of confusion, nor I think is there any likelihood of confusion from the use of the words “Rus” or “Sanrus” in conversation, whether over the telephone or otherwise, but I am entitled, and bound, to take this into  
25 consideration, that a person accustomed to deal in this class of material, that is to say an architect, builder or purveyor of builders’ materials, hearing the word “Sanrus” used would at once think — for so the evidence leads me — “This is, or this may be, a name used to describe an article of the Plaintiffs’ manufacture.” If I come to that conclusion, as upon the evidence I think I must, then I must, upon the authorities, also hold that the use of a word liable to cause  
30 such confusion is an infringement of the Plaintiffs’ mark. Accordingly, upon the evidence which has been adduced in this case, I can come to no other conclusion than that the use of the word “Sanrus” is an infringement of the Plaintiffs’ mark “Rus”. ”

By analogy with the facts of this case, it would seem reasonable to suppose that FLEXILINK might be regarded as an infringement of LINK in the same way that SANRUS was found to be  
35 an infringement of RUS. If this is true, then it follows that there must be a reasonable likelihood of deception or confusion amongst a substantial number of persons if the two marks are used by different undertakings in respect of the same goods. On the other hand, I am conscious that LINK is not, in itself, a particularly distinctive mark in relation to office furniture. Modern office furniture often tends to be modular in construction with units of  
40 different shapes and sizes linking together to make the best use of the available space.

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<sup>5</sup>*Ravenhead Brick Co. Ld v Ruabon Brick & Terra Cotta Co. Ld* [1937] RPC 341

Mr Sherrard-Smith also reminded me that in reaching his decision in *RUS/SANRUS* Simonds J was influenced by the evidence of an expert in the field who confirmed that he would associate the two marks — in other words, he would assume that a SANRUS brick came from the same source as a RUS brick. The following paragraph is taken from page 348 of Simonds J’s judgment as reported in RPCs:

“Now the evidence before me is cogent to this effect. Witnesses of candour, experience and obvious integrity have come before me to tell me this, that if they saw the word “Sanrus” in connection with a brick they would come to the conclusion that it was a manufacture of the Plaintiff company, that it was a word invented by the Plaintiff company to describe some new manufacture of theirs and, no doubt, some new manufacture upon the lines of the “Rus” brick which was already very familiar to the trade. Necessarily their opinion was based upon that hypothesis, because except, I think, in the case of one of them, the word “Sanrus” had not, until they were invited to express an opinion in these proceedings, been brought to their notice. But there was one of them, a Mr Marshall, who had actually heard of the word “Sanrus” outside these proceedings. He was a gentleman of very large experience, a Fellow of the Royal Institute of British Architects, and a lecturer in Liverpool in the School of Architecture, and he was in charge of the Materials Gallery, so that he would be brought into close touch with and clearly would have intimate knowledge of, the materials used by builders. He had known the Plaintiff company for a large number of years and was familiar with the “Rus” brick which had long been manufactured by them, and he was asked one day, after a lecture, by a student who came to him, whether he knew the name “Sanrus” brick and where it came from. I am not giving his exact words, but he replied in effect that he did not know. But at once he associated it with the Plaintiff company. Now that is evidence which I am not entitled to disregard; indeed it is evidence which I must regard as of the greatest assistance in coming to a conclusion as to whether or not the use of the word “Sanrus” by the Defendant company in connection with an article manufactured by them is likely to cause confusion and to lead to the belief that the article bearing that name is an article manufactured not by the Defendant company but by the Plaintiff company. What Mr Marshall said out of his actual experience is corroborated by those other witnesses whom I have described, who expressed the view that they would have come to the same conclusion if the matter had been put before them for conclusion.”

Mr Sherrard-Smith drew my attention to the only evidence of a comparable nature in these proceedings — the statutory declarations of Mr Dunn and Mr White. Both of these gentlemen have been working in the furniture, storage and stationery industry for some time; fifteen years in the case of Mr Dunn, and six years in the case of Mr White. I have reproduced Mr Dunn’s declaration at page 4 of this decision. Mr White says precisely the same as Mr Dunn. Both gentleman say that they would not confuse FLEXILINK with LINK. Without the evidence of Messrs Dunn and White, the matter is finely balanced in my mind and could easily go either way. But with the assistance of the evidence of these two gentlemen, I conclude that there is not a significant risk of confusion in the mind of the public, and the opposition under section 12 fails accordingly.

#### *Registrar’s Discretion*

There remains the matter of the Registrar’s discretion. The opposition has failed on all the grounds on which it was brought, and I am not aware of any reason why this discretion should be exercised adversely to the interests of the applicant.

The applicant, having been successful in these proceedings, is entitled to a contribution towards the costs of defending the application. I therefore order the opponent to pay to the applicant the sum of **£635**.

**Dated this 16<sup>th</sup> day of February 1999**

5 **Mr S J Probert**  
**Principal Hearing Officer**  
**For the Registrar, the Comptroller-General**