

O-065-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2478665

BY DOORMAC (UK) LTD

TO REGISTER IN CLASS 9 THE TRADE MARK:



AND

IN THE MATTER OF OPPOSITION NO 97321 BY

DORMA GMBH & CO KG

TRADE MARKS ACT 1994

In the matter of application No 2478665
by Doormac (UK) Ltd
to register a trade mark in class 9

and

In the matter of opposition No 97321 by
Dorma GmbH & Co KG

Background

1. On 2 February 2008 Doormac (UK) Ltd (“the applicant”) applied to register the following trade mark for the following goods:



Class 09: Electric and electronic locks, Electromagnetic locks, Electric bolt locks, Electric strike locks, key pad switches, remote controls, power supply units used for electric and electronic locks, apparatus used for the operation of electric and electronic locks, electric strike locks, key pads switches and release buttons, electric motors and gate operators.

2. On 9 June 2008 opposition to the registration of the applicant’s trade mark was made by Dorma GmbH & Co KG (“the opponent”) under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b) the opponent relies on three of its trade marks for the word DORMA (one of them also contains a device element) and, under section 5(4)(a), it relies on the use of signs corresponding to its registered trade marks which, it says, have been used since 1978. The full details of the opponent’s trade marks are set out in the annex to this decision.

3. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use of its trade marks. Both sides filed evidence, a summary of this is provided later. Neither side requested a hearing, both opting instead to make written submissions.

The opponent's earlier trade marks

4. All three of the opponent's trade marks have dates of filing prior to that of the applicant's mark¹. The applicant does not have the benefit of an international priority date. In view of this, all three of the opponent's marks constitute earlier trade marks as defined by section 6(1) of the Act.

5. Two of the earlier marks (2201691 & 2201690) relied upon by the opponent completed their registration procedures before the beginning of the five year period ending on the date of publication of the applicant's mark². The proof of use provisions contained in section 6A³ of the Act, therefore, apply. However, the opponent's third mark, Community Trade Mark ("CTM") 6523377, did not complete its registration procedure until October 2009 which is after the date of publication of the applicant's mark. This means that the proof of use provisions do not apply to that mark and it can, therefore, be considered for its specification as registered. CTM 6523377 can also be taken to represent the opponent's best case given that its registered specification is no narrower (at least in terms of the most relevant goods) than its other earlier marks and the mark itself is for the plain word DORMA (I do not see how its word and device mark would put it in a better position). Given all this, I do not consider it necessary to deal with the proof of use provisions in relation to those marks for which proof of use is required. The opposition will be determined on the basis of CTM 6523377.

The opponent's evidence

Witness statement of James Justin Ratcliffe

6. Mr Ratcliffe has been the Chief Executive of the Council for Aluminum in Building ("CAB") since 2006. Between 2001 and 2006 he was one of its directors. Prior to his roles with CAB he was a Marketing Manager for the Aluminum Federation and a Business Development Executive at Indalex (part of Rio Tinto Zinc) and a Commercial Planner at Metal Box. He has a number of qualifications in marketing and business studies.

7. Mr Ratcliffe states that the name and brand DORMA have been known to him since 2000 and that DORMA UK are members of CAB (and have been since 1994); a membership certificate is shown in Exhibit 1. He states that DORMA UK frequently attend meetings and AGMs organised by CAB. He states that Mr Bob Ramage (a former Managing Director of DORMA UK) was a CAB board member

¹ The applicant's mark was filed on 2 February 2008 and the opponent's marks were filed on 30 June 1999 (2201691 & 2201690) and 3 December 2007 (CTM 6523377).

² The applicant's mark was published on 28 March 2008 whereas the two earlier marks completed their respective registration procedures on 8 May 2002 & 1 March 2002 respectively.

³ Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

from 1994 to 2004. He states that DORMA are active exhibitors in the UK and on the continent.

Witness statement of Gary Denis Amer

8. Mr Amer is Chief Executive of The Guild of Architectural Ironmongers (“GAI”). He has held this position for one year, prior to which he was director of another trade association, namely, The National Federation of Builders (“NFB”), a position he held for 10 years. Prior to all this, Mr Amer spent 21 years in the financial services sector.

9. Mr Amer became aware of the DORMA brand through his time at the NFB. He states that the name and advertisements for it could be found in industry publications. He states that they are reliable suppliers to main contractors in the supply chain. He states that they are a well-established and respected manufacturer of door closures etc., with a well-known and respected service and maintenance arm. He estimates that his knowledge of DORMA started 10 years ago (when he became involved in the construction industry).

10. Mr Amer states that DORMA is an active member of GAI and, therefore, that he has regular dealings with them. He states that he sees references to them all the time. He states that DORMA advertise a great deal in GAI publications and are keen sponsors of their business events. The DORMA mark has been used on many GAI pieces of literature. He states that DORMA are major players in its unique marketplace.

Witness statement of Paul Lennard Watson

11. Mr Watson is the Head of Regional Division, UK Automatics (Direction) of DORMA UK Limited, a subsidiary of the opponent. He has worked in this subsidiary for 17 years. He has worked in the automatic door industry for 21 years, prior to this he served in the Royal Air Force (Engineering). He has a City & Guilds qualification in engineering and has been chairman or a representative in a number of trade associations or working groups/committees.

12. Mr Watson states that the DORMA brand originated in Germany. Its roots go back to 1908 and relates to the manufacture of double action door hinges and miller screws. The DORMA name was created in 1927 as an acronym of the founders of the company (Messrs Dorken & Mankal). DORMA was established in the UK in 1978 with the formation of DORMA Door Controls Limited. This was followed by a number of related companies (e.g. DORMA Glass in 1986, DORMA Entrance Systems in 1991, DORMA Access Control & Maintenance in 1992); all these companies were amalgamated in July 2003 to form DORMA UK.

13. He states that DORMA offer a package of products and services relating to doors, the fitting thereof, and also glass and movable walls. Reference is made to some supporting exhibits, namely:

PLW1 - A file of documents from the Door Controls Division. It contains a large amount of promotional and technical information focusing on door closures, floors springs (for doors), magnets and co-ordinates (for doors), panic hardware (for doors), mortise locks (for doors) and aluminum hinges (for doors). The brochure is not aimed at the general public. The goods are not really for domestic dwellings, but more to do with the doors in public places and buildings.

PLW2 – A file of documents from the Automatics division. This is similar in style to that above but focuses on sliding, swing, folding, space-saving and revolving doors, subsequent servicing and, also, movable wall systems.

PLW3 – A smaller folder to those described above, but, again, similar in style. It features door access control systems and other door fittings that have a security element.

In all of the above, the word DORMA (with and without the logo) is heavily featured.

14. Mr Watson states that it has 12000 customers in the UK from both the private and public sectors. Its customers range from hotel chains, to football clubs, to hospitals, to universities and schools, to police forces. At Exhibit PLW4 there is a range of documents (DORMA branded) supporting this diverse range of customer. Mr Watson states that all the projects referred to in these documents were completed prior to 2008. Various press releases (taken from the opponent's website) are shown in Exhibit PLW5 showing a variety of projects. The earliest is from February 2004, the latest from July 2006.

15. Reference is made to what Mr Watson describes as DORMA's aim to supply products of the highest standard and its innovativeness in introducing new products and improved processes. He states that it has a reputation for meeting UK and EU legislation (for example on fire safety and disability access). Some of its "innovations" are shown in material in Exhibit PLW6.

16. UK turnover figures are then provided. It is sufficient to record that in the period July 2003 to June 2007 turnover ranged between £43million and £47million per annum. A similar figure (£45million) is given for the period between 1 July 2007 and 30 June 2008. Promotional expenditure in the same four year period identified above ranged between £742k and £972k. It was £725k between 1 July 2007 and 30 June 2008. The advertising and promotional costs cover things such as brochures, catalogues, price lists, media advertising,

directory listings, promotional gifts, exhibitions, public relations, photography etc. Some of these promotional materials are shown in PLW6 and others in PLW1-3.

The applicant's evidence

Witness statement of Tarsem Singh Bains

17. Mr Bains is a director of the applicant. He has been involved in the installation and manufacturing of shop fronts and shutters since 1996. He was initially employed by London Shopfitters Ltd, a company which specialises in the supply and installation of shop fronts and roller shutters.

18. In 2003 Mr Bains set up his own business called Emperor Shopfitters Limited ("Emperor") which manufactures and installs full glass shop fronts with patch fittings and automatic door systems. Components were initially sourced from different manufacturers which led to excess volumes. To become more competitive, the applicant company was set up to supply various items (patch fittings, architectural hardware, automatic door systems, electronic-magnetic lock systems and remote control access systems) under the DOORMAC brand.

19. Mr Bains states that the name DOORMAC is an acronym for "door mechanisms". The applicant's brand was called DOORMAC ARCHITECTURAL HARDWARE as its business principally involves the sale of patch fittings and automatic door systems. He states that there was no intention for any correlation with DORMA. He refers to another of the applicant's trade marks for DOORMAC ARCHITECTURAL HARDWARE⁴ in classes 6 & 17 which he notes the opponent did not object to.

20. It is stated that the applicant's business has grown steadily and that it now has 1100 customers (his evidence is given on 1 May 2009). Mr Bains states that this includes individuals, businesses and industry specialists who would be aware of the co-existence of DORMA and DORMAC ARCHITECTURAL HARDWARE.

21. In terms of promotion, Mr Bains says that this is done through Emperor's customer database. Reference is made to the applicant's brochure (Exhibit TSB2) which shows a range of goods (door patch fittings, locks, handles, sliding door kits etc.). The applied for mark is prominently shown on the front and rear cover of this brochure and it also features as a watermark throughout the document. The mark is also shown on letterheads, compliments slips and business cards (Exhibit TSB3) and on a poster featuring its products (Exhibit TSB4). Mr Bains states that significant sums of money are spent on advertising and promotion. A copy of the DOORMAC website is shown in Exhibit TSB5. Photographs of its boxed-up stock in its warehouse are shown in Exhibit TSB6 (the mark is clearly shown on the boxed-up goods). Reference is also made to the cost of creating a mould (\$20,000), the cost of creating metal plates

⁴ UK Registration 2438046 – details of it are in Exhibit TSB1.

containing its name and logo, and also legal fees associated with registering its other trade mark and defending an unrelated opposition.

22. Turnover figures for the applicant are given as £5,785 in 2007, £59,350 in 2008 and £67,678 in 2009. In terms of promotional costs (including tooling) this was 2007-2008 \$23,680 and in 2008 £16,170.

23. Separate figures are given for Emperor, this was £515,432 in 2006, £792,780 in 2007 & £1,113,736 in 2008. Promotional spend in 2006-2008 was £37,524.

24. Mr Bains highlights the applicant's (and Emperor's) year on year growth. He states that the applicant now offers full install and maintenance services to clients including Chiltern Hotels, McDonalds, Shell, Sutton Lane Post Office, Sports World, Cost Cutter and major supermarkets and retailers. Customer statements are provided in Exhibit TSB7. They are not in evidential form. All are identically worded with the names, addresses and signatures of the customer filled in by hand (the substantive text is typed). They all state that the respective marks would not be confused, that they have co-existed in the marketplace with each other and that the customer is familiar with both and, furthermore, that there are other marks that also co-exist with them (Dormeyer, Dorman, Doortech, Doortech 2000, Dortex, Doorma, Doormaker, Doorman, Doormaster).

25. Mr Bains makes reference to the preliminary indication issued in these proceedings. This has no bearing on my decision so I will say no more about it⁵.

26. Mr Bains refers to various marks beginning with the word DOOR or the letters DOR (as per the customer statements) and states that to his knowledge these are already in use without confusion with DORMA and, so, the applied for mark will similarly not be confused. He states that he can see no detriment that could be caused to DORMA but, on the other hand, if the opponent was successful then the applicant would suffer significant financial loss and expense.

Witness statement of Ozlem Ipek

27. Mr Ipek is a partner in Archipek Architecture and Interiors Ltd. He has a career of 12 years in the architectural business. He states that he has designed and installed various pieces of DORMA product. He states that during the construction of his office in Stoke Newington he had a reference from a building company which led to DOORMAC installing his shop front. He never found himself to be confused between the two.

⁵ See Lindsay J in *esure Insurance Limited v Direct Line Insurance Plc* [2007] EWHC 1557 (Ch)

Witness statement of Duanne Law

28. Mr Law is the managing director of Volt Design Interiors Limited and Volt Design Limited. He has been in the procurement industry for over 20 years. Volt Design Limited is linked to the construction industry and facilitates the design and build of shops. He first became aware of Doormac when specifying complete shop fronts several years ago. He found them to be reliable vendors in the supply chain. He has been able to clearly identify Doormac products from other suppliers including DORMA. He has never been confused, and due to the distinct name does not believe there would be confusion in the marketplace.

Witness statement of Mumin Yildiz

29. Mr Yildiz is a structural engineer. He currently works freelance and has a career total of 16 years in engineering design. He is currently responsible for designing and specifying material for building projects and he has used various types of automatic doors, door fittings, hinges and other similar systems. He says that he is familiar with many different trade company products and it is clear to him that the DORMA brand is different to DOORMAC and he has never been confused between the two.

Witness statement of Boota Singh Nijjer

30. Mr Nijjer is a partner in Bains and Nijjer a property investment company with a portfolio of residential and commercial properties. He is also managing director of Freetown Ltd, a company involved in development and construction of residential and commercial property since 1997. He is responsible for managing and buying all kinds of materials for building projects. He has used various types of automatic doors, door fittings, hinges and other similar systems.

31. Mr Nijjer is aware of both DORMA and DOORMAC. DOORMAC has been known to him for two years. He has, though, never been confused as the DOORMAC logo is distinguishable to him and in no way similar in visual appearance or phonetics.

Witness statement of Iqubal Hussain

32. Mr Hussain has been involved in the shopfitting industry for 11 years. He is now the managing director of Contrast Interiors Ltd involved in shopfitting, interior design and construction. He states that Dorma and Doormac are two of the companies in the field who manufacture relevant goods. He states that the companies he has dealt with do not use Dorma due to cost. He finds it inconceivable that there would ever be confusion due to distinctive products, different look, different logos and costing structures. He also refers to marketing through different channels.

The section 5(2)(b) ground of opposition

33. Section 5(2)(b) states:

“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.”

34. When reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments germane to this issue, notably: *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, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). The above judgments set out the primary principles to be applied in matters such as these; I will refer to them, to the extent relevant, in more detail later in this decision.

The average consumer and the purchasing act

35. As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) I will begin with an assessment of who this is.

36. The goods sought by the applicant cover electric and electronic locks, key pads and other apparatus for controlling the same, and motors and openers for gates. Whilst it is possible for a member of the public to purchase and install such goods, it seems to me that the technical nature and the specialist job of fitting such goods means that they will, most often, be purchased by a specialist tradesman with the appropriate technical knowledge and skill or by an architect or other property development professional who is required to buy in such goods for the projects on which they are working. Furthermore, it seems to me uncommon for houses to make use of electric locks (mechanical locks being order of the day) and these goods are more likely to be found in larger complexes such as offices, hospitals, retail establishments, large apartment complexes etc. This re-enforces the fact that it is a specialist that will be the average consumer.

37. The average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). This general presumption can, however, change (or at least the degree of care and attention that they utilise) depending on the particular goods in question (see, for example, the decision of the General Court⁶ in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). This is a case in point. The average consumer will possess technical knowledge that he will utilise when purchasing the goods. He or she will have to ensure that the goods chosen perform the desired function, will be an appropriate fit for the particular job and issues of interoperability with other items will be important. Although little information is provided on pricing, the goods are unlikely to be cheap, casually purchased items. The applicant argues that the average consumer will be discerning, I agree with this argument because the factors analysed so far are indicative of a higher degree of care and attention being used than the norm when purchases are being considered/made. This may, to some extent, mitigate against the concept of imperfect recollection.

38. In terms of the manner of purchase/use, both sides evidence refers to brochures and other printed matter that is made available to would be purchasers. There is though, no evidence as to how this is followed through into purchases. Purchases could be made in a number of ways such as website sales, sales in a trade store, both of which suggest that visual considerations are important. However, in the context of trade purchases, there is no reason to discount telephone ordering or over the counter requests at a trade store with goods kept in a store room behind the scenes. Overall, I consider the aural and visual considerations to have equal significance.

Comparison of goods

39. In terms of approach, if a term falls within the ambit of another term, either way, then it must be regarded as identical⁷. The applied for mark covers:

- 1) Various electric/electronic locks;
- 2) Apparatus related to locks (key pad switches, remote controls, power supply units for locks);
- 3) Apparatus used for the operation of electric/electronic locks, switches and release buttons;
- 4) Electric motors and gate openers.

⁶ Previously known as the Court of First Instance of the European Communities – a court of binding precedent.

⁷ See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-133/05

40. The opponent's earlier mark (CTM 6523377) covers various goods including:

- 1) Electric locks. Goods covered by item 1 of the applicant's specification (as I set out in the preceding paragraph) are, therefore, identical.
- 2) Switching, control, monitoring and checking apparatus for locks and also apparatus related to controlling and conducting electricity. Goods covered by items 2 and 3 of the applicant's specification (as I set out in the preceding paragraph) fall within this description and are, therefore, identical.
- 3) Regulating and control apparatus for items including gates. Goods covered by item 4 of the applicant's specification (as I set out in the preceding paragraph) are, therefore, identical.

41. Taking the above into account, all of the respective goods are identical. Even if I am wrong on that and there is not exact identity with some of the goods, then they are, nevertheless, highly similar having regard to their nature, intended purpose and methods of use etc⁸.

Comparison of the marks

42. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). Neither side dispute this nor that it is a whole mark comparison that must be made. I highlight, though, that the applicant's comparison in its written submissions focuses on the applied for mark compared to the device and word mark of the opponent. However, as I stated earlier, the opponent's best case lies with its word only mark. I will make the comparison accordingly and, for ease of reference, the respective marks are detailed below:

<u>Applicant's mark</u>	<u>Opponent's mark</u>
 The applicant's mark consists of the word "DOORMAC" in a blue, sans-serif font. Below the word is a stylized, curved line representing a door handle, with two small circular details. Underneath the handle is the text "Architectural Hardware" in a smaller, blue, sans-serif font.	 The opponent's mark is the word "DORMA" in a large, black, sans-serif font.

43. In terms of the dominant and distinctive elements, the opponent's mark consists of only one element so that, self-evidently, is its dominant and distinctive element. The applicant's mark, on the other hand, has three elements, namely,

⁸ See *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, paragraph 23 of the ECJ's judgment

the word DOORMAC, a device element and the words “Architectural Hardware”. The most prominent element is the word DOORMAC, it is also distinctive. The other textual element consists of the words “Architectural Hardware”, but this is not only less significant in terms of impact, but it is also descriptive and, therefore, lacking in distinctiveness. There is also the device element to consider, but this is likely to be regarded by the average consumer as a representation of a piece of architectural hardware (even if it is not detailed enough to know exactly what it is) and it is also less prominent than the word DOORMAC. The opponent argues that DOORMAC is the dominant and distinctive element. Taking all the factors into account, the word DOORMAC not only consists of one of the dominant and distinctive elements in the mark, it is also the most dominant and distinctive element. Despite this, it is still a whole mark comparison that must be made because I do not consider the other elements of the applicant’s mark to be negligible in the overall impression that it creates (see *Shaker di L. Laudato & Co. Sas*).

44. In terms of submissions on similarity, the opponent argues that both DORMA and DOORMAC have no meaning and are virtually identical on a visual, phonetic and conceptual level. It argues that the beginning of the respective words DORMA and DOORMAC will be focused upon more than the endings which will have less attention paid to them and which could tail off in pronunciation. The applicant highlights that it is a whole mark comparison that must be made, it highlights the differences between DORMA and DOORMAC on a visual and phonetic level (and the differences created by the additional elements in the DOORMAC mark) and highlights a difference in concept as one has a device of a door handle whereas the other has a crown (although the crown does not appear in the opponent’s mark being considered here).

45. In terms of a visual comparison, the applicant highlights the presence of colour in its mark, however, given that the opponent’s mark is registered without regard to colour, the presence of colour in the applied for mark cannot create a significant difference – the matter must be assessed on the basis of any similarity between the respective marks’ words and configurations without regard to colour⁹. The dominant and distinctive elements of the respective marks do, though, share the letters DO and RMA. However, DOORMAC has an additional O (between the DO and RMA) and an additional letter C at the end of the mark. It is also likely to strike the eye that DOORMAC is longer than DORMA and that it is also made up of two distinct component (DOOR and MAC) as opposed to one (DORMA). The other aspects of the applicant’s mark, particularly the device element, also create a visual and noticeable difference. In my view, the differences outweigh the similarities to a large extent so meaning that any visual similarity between the marks must be regarded as low.

⁹ See the decision of Mr Hobbs QC (sitting as the Appointed Person) in BL O-246-08 *MARY QUANT COSMETICS JAPAN LTD V ABLE C&C Co LTD*

46. In terms of an aural comparison, the applied for mark is likely to be pronounced on the basis of its dominant and distinctive element DOORMAC, and it will be spoken/heard as two distinct components DOOR and MAC. The opponent's mark, although not regarded as being of two separate components, nevertheless has two syllables and will be pronounced as either DOR-MA or DORM-A. Either way, the beginnings of the respective marks have a strong degree of similarity (or even identity) but the ends less so. The endings are less similar because the applicant's mark has a hard K sound at the end of it and the A produces a harder "AH" sound rather than the softer "UH" sound produced at the end of DORMA. I am not persuaded that the pronunciations will tail off as the opponent suggests. There is though, in my view, a reasonable but not high degree of aural similarity.

47. Conceptual similarity and its importance has been dealt with in the jurisprudence on a number of occasions. In *Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR the General Court stated:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above.

The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

48. In terms of concept, the opponent says that neither mark has a conceptual meaning. Whilst the word DORMA has no meaning¹⁰, it is the phonetic equivalent of a word, namely, the word “dormer”, which relates to a construction with a

¹⁰ At least according to Collins English Dictionary.

window that projects from a sloping roof¹¹. I must, though, be conscious to not accept too readily the degree of knowledge that the average consumer may or may not possess¹². However, the average consumer of the goods in question (as I assessed earlier) strikes me as the very type of person likely to know of this word and its meaning. Although the word is not spelt correctly (and that this may also be noticed by the average consumer) it nevertheless creates a suggestive or evocative reference. A trade mark may still create a concept in the mind of the average consumer on the basis of evocation or suggestion¹³.

49. The word DOORMAC has no real meaning as a whole. The applicant states that it is an acronym for the words “DOOR MECHANISMS”, however, I agree with the opponent that this is not an obvious acronym (I do not see how you get to DOORMAC from DOOR MECHANISMS) that will be noticed by the average consumer. It is likely, though, that the average consumer will, at least, notice that the word DOORMAC is based on the word DOOR. This is likely to strike him or her due to the nature of the relevant goods and the fact that they will often be used in relation to doors. Whilst this does not give the word (or mark) as a whole a conceptual meaning in totality, it does give it a suggestive or evocative reference point which may form part of the average consumer’s recall process. Either way, the word DOORMAC does not have the same meaning (as I have assessed) as DORMA and, therefore, there is a conceptual difference that will, in my view, create some degree of counteraction in relation to the other aspects of similarity so that, overall, the degree of similarity between the marks is at the lower end of the spectrum.

Distinctive character of the earlier trade mark

50. The distinctiveness of the earlier mark is another factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). Although the earlier mark is a misspelling of the word DORMER (and it is possible for the goods in question, or at least some of them, to be fitted to a dormer) I consider the mark to have a reasonable degree of inherent distinctive character. However, it is clear from the evidence that the use of the earlier mark has been long standing and its turnover figures are significant. The opponent is clearly a leading player in its field and the name DORMA is its primary trade mark which identifies its goods to the average consumer. Much of the use focuses on doors and door mechanisms, but it is clear that locks and access devices etc. are a clear adjunct to this. There is evidence from the trade

¹¹ According to the Collins English Dictionary

¹² See the decision of Anna Carboni (sitting as the Appointed Person) in *Cherokee* BL-O-198-08

¹³ See, for example, the decision of the CFI in *Usinor SA v OHIM* (Case T-189/05).

as to the reputation of DORMA and, indeed, the applicant's own evidence highlights that DORMA is known in the relevant trade. The net effect of all this is that the opponent's earlier mark should be regarded as possessing a high degree of distinctiveness.

Likelihood of confusion

51. It is clear that the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that 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.

52. In terms of the factors assessed so far, I have found that the respective goods are identical but that the degree of similarity between the marks is at the lower end of the spectrum caused, to some degree, by a conceptual difference. I bear in mind, though, that a low degree of similarity between the marks can be off-set by a high degree of similarity between the goods.

53. In terms of the other factors, the earlier mark is highly distinctive. However, I have also found that the average consumer will pay a higher degree of care and attention than the norm. Whilst the concept of imperfect recollection is an important consideration, the higher degree of care and attention likely to be used by the average consumer will mitigate against the significance of this. Taking this into account, and despite the relevant goods being identical and the earlier mark highly distinctive, I do not consider that the degree of similarity that I have found will result in the average consumer being confused be it directly or indirectly. I believe the care and attention that will be applied, whether the goods are selected by the eye or whether orally requested, means that the average consumer will be able to distinguish between them and, furthermore, that any similarity he or she sees (which I have assessed as being at the lower end of the spectrum) will be put down to co-incidence rather than an assumption that the same or an economically linked undertaking is responsible for both.

54. In coming to the above conclusion I have not placed any real weight on the applicant's evidence regarding parallel trading and the evidence of consumers saying that they would not confuse the two marks. This is because the degree to which the applicant has used its mark does not strike me as being particularly significant and the degree of parallel trade is, therefore, limited. Whilst Emperor's turnover figures are reasonably significant, the applicant's are less so and it is the applicant's sales that relate to DOORMAC rather than Emperor's sales. The length of use is also relatively limited, it is certainly not long-standing so as to seriously test the capacity of the marks to be used confusion free. Furthermore,

there appears to be a difference in terms of the precise area of trade each specialize in, and whilst there may be a degree of overlap in trade and consumer, this, again, limits the parallel trading activity. The case-law advocates that a cautionary approach be adopted when considering confusion free parallel trade claims¹⁴, this is certainly the case here. That being said, the evidence from actual consumers (particularly those contained in actual witness statements as opposed to the pro-forma customer statements¹⁵) at least supports my conclusion set out above even if it is possible to criticize them (as the opponent does in its submissions) as containing other factors that contribute to the distinguishing process (such as cost, market etc). I also note that reference is made in the applicant's evidence to co-existence with other marks that begin with DOOR or DOR, but as no detailed information is provided about the actual use of any of these marks then this can have no bearing.

55. The ground of opposition under section 5(2)(b) fails.

The section 5(4)(a) ground of opposition

56. Section 5(4)(a) of the Act reads:

“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, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

57. 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:

¹⁴ Whilst Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the marketplace, a number of decision express caution about the circumstances in which it is appropriate to give these factors weight (see the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v. Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v. Phone 4u. co. Uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45.)

¹⁵ Although, they are not ignored completely for being pro-forma non-evidential statements (see, by analogy, *DUCCIO Trade Mark* BL O343-09)

“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.”

58. I will deal with this ground briefly. This is because I have already found under section 5(2)(b) that despite the earlier mark having a highly distinctive character, part of which was associated with its use (which would also have given the opponent a protectable goodwill associated with its sign DORMA), I found that there was no likelihood of confusion on the part of the average consumer. If that is the case, I cannot see how the opponent can be in any better position to argue that goods sold under the applicant's mark will be taken by a substantial number of persons as being its (the opponent's) goods. This ground of opposition would fail due to lack of misrepresentation.

Costs

59. Both grounds of opposition have failed. The applicant says that the opponent's conduct is an abuse of process due to it proceeding in the face of the preliminary indication. As mentioned in paragraph 25, the preliminary indication is irrelevant as must be the claim to abuse of process. Nevertheless, as the applicant has been successful it is entitled to a contribution towards its costs¹⁶. I hereby order Dorma GmbH & Co KG to pay Doormac (UK) Ltd the sum of £1600. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£400

Filing evidence and considering the other side's evidence
£800

¹⁶ Costs have been assessed from the Registrar's published scale set out in TPN 6/2008

Written submissions
£400

60. The above sum is to be paid with 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 22 day of February 2010

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

Annex – opponent’s earlier marks

Trade mark details	Goods and services
<p>UK Registration 2201691 for the mark:</p> <p>DORMA</p> <p>Filing date: 30 June 1999</p> <p>Registration date: 05 April 2002</p>	<p>Class 06: Mechanical locks and keys for these locks; buildings' hardware including hinges, handles, locks and strike boxes, lever handles, fittings for toughened glass doors and glass panes, accessories for toughened glass assemblies, namely locks and lock cases, striking plates, handles, door knobs, cross bars, screw-on fittings, clamping fittings, connectors, protective fittings; manually operated single-panel or multiple-panel doors and gates, namely sliding doors, swing doors, revolving doors, curved sliding doors, telescopic sliding doors, wing gates, folding gates, sliding gates, sliding gates, horizontal sliding walls: all the aforesaid goods being made of metal and/or combined materials, consisting of different kinds of laminated material or pressed material; revolving doors of metal or glass, the leaves of which are designed as swing doors; door closers.</p> <p>Class 07: Mechanical, pneumatic and hydraulic devices for moving single-panel or multi-panel doors or gates, namely single doors, swing doors, revolving doors, curved sliding doors, telescopic sliding doors, folding doors, wing gates, folding gates, sliding gates; all of metal and power operated; electrical mechanical and pneumatic drives, controls and automatic-control for sliding doors, swing doors, secure swinging doors, revolving doors, curved sliding doors, telescopic sliding doors, folding doors, wing gates, folding gates and sliding gates; motorized garage-gates drives.</p> <p>Class 09: Automatic lock devices and lock systems transferred into the locking and/or unlocking position by means of electronic switches for respectively single panel or multiple-panel doors or gates; electronic switch, control, monitoring and checking devices for the mentioned lock devices and lock systems; access-control installations; code-cards; code cards as data storage units; devices and installations for the identification of persons; alarm circuit; devices for heavy current engineering for the change, storage and control; computer programs in machine-readable media, including cards and chips; video-monitoring systems, consisting of video cameras which transmit pictures on control-systems without any wire or via cable, transmitter and receiver for the transmission of data; distributing boxes, junction boxes, electrical door opener; talk-back circuits; electrical control for locks, windows and door drives; electrical locks and keys for these locks.</p>

	<p>Class 16: Documentation, operating and user manuals; all relating to mechanical locks and keys for these locks, buildings' hardware including hinges, handles, locks and strike boxes, lever handles, fittings for toughened glass doors and glass panes, accessories for toughened glass assemblies, namely locks and lock cases, striking plates, handles, door knobs, cross bars, screw-on fittings, clamping fittings, connectors, protective fittings, manually operated single-panel or multiple-panel doors and gates, namely sliding doors, swing doors, revolving doors, curved sliding doors, telescopic sliding doors, wing gates, folding gates, sliding gates, horizontal sliding walls, revolving doors of metal or glass, the leaves of which are designed as swing doors, door closers, mechanical, pneumatic and hydraulic devices for moving single-panel or multi-panel doors or gates, namely sliding doors swing doors, revolving doors, curved sliding doors, telescopic sliding doors, folding doors, wing gates, folding gates, sliding gates, all of metal and power operated, electrical, mechanical and pneumatic drives, controls and automatic-control for sliding doors, swing doors, secure swinging doors, revolving doors, curved sliding doors, telescopic sliding doors, folding doors, wing gates, folding gates, sliding gates, motorized garage-gates drives, automatic lock devices and lock systems transferred into the locking and/or unlocking position by means of electronic switches for respectively single panel or multiple-panel doors or gates, electronic switch, control, monitoring and checking devices for the mentioned lock devices and lock systems, access-control installations, code-cards, code cards as data storage units, devices and installations for the identification of persons, alarm circuit, devices for heavy current engineering for the change, storage and control, computer programs in machine-readable media, including cards and chips, video-monitoring systems, consisting of video cameras which transmit pictures on control-systems without any wire or via cable, transmitter and receiver for the transmission of data, distributing boxes, junction boxes, electrical door opener, talk-back circuits, electrical control for locks, window and door drives, electrical locks and keys for these locks, glass doors of all kinds, separation walls of glass, automatically and manually operated.</p> <p>Class 19: Glass doors of all kinds; separation walls of glass, automatically and manually operated; manually operated single-panel or multiple-panel doors and gates, namely sliding doors, swing doors, revolving doors, curved sliding doors, telescopic sliding doors, wing gates, folding gates, sliding gates, horizontal sliding walls, all goods being not made of metal.</p>
UK registration 2201690 for the mark:	Class 06: Mechanical locks and keys for these locks; builders' hardware including hinges, handles, locks and strike boxes, lever



Filing date:

30 June 1999

Registration date:

01 March 2002

handles, fittings for toughened glass doors and glass panes, accessories for toughened glass assemblies, namely locks and lock cases, striking plates, handles, door knobs, cross bars, screw-on fittings, clamping fittings, connectors, protective fittings; manually operated single-panel or multiple-panel doors and gates, namely sliding doors, swing doors, revolving doors, curved sliding doors, telescopic sliding doors, wing gates, folding gates, sliding gates, horizontal sliding walls, all the aforesaid goods being made of metal and/or combined materials, consisting of different kinds of laminated material or pressed material; revolving doors of metal or glass, the leaves of which are designed as swing doors; door closers.

Class 07: Mechanical, pneumatic and hydraulic devices for moving single-panel or multi-panel doors or gates, namely sliding doors, swing doors, revolving doors, curved sliding doors, telescopic sliding doors, folding doors, wing gates, folding gates, sliding gates; all of metal and power operated; electrical mechanical and pneumatic drives, controls and automatic-control for sliding doors, swing doors, secure swinging doors, revolving doors, curved sliding doors, telescopic sliding doors, folding doors, wing gates, folding gates and sliding gates; motorized garage-gates drives.

Class 09: Automatic lock devices and lock systems transferred into the locking and/or unlocking position by means of electronic switches for respectively single panel or multiple-panel doors or gates; electronic switch, control, monitoring and checking devices for the mentioned lock devices and lock systems; access-control installations; code-cards; code cards as data storage units; devices and installations for the identification of persons; alarm circuit; devices for heavy current engineering for the change, storage and control; computer programs in machine-readable media, including cards and chips; video-monitoring systems, consisting of video cameras which transmit pictures on control-systems without any wire or via cable, transmitter and receiver for the transmission of data; distributing boxes, junction boxes, electrical door opener; talk-back circuits; electrical control for locks, windows and door drives; electrical locks and keys for these locks.

Class 16: Documentation, operating and user manuals; all relating to mechanical locks and keys for these locks; buildings' hardware including hinges, handles, locks and strike boxes, lever handles, fittings for toughened glass doors and glass panes, accessories for toughened glass assemblies, namely locks and lock cases, striking plates, handles, door knobs, cross bars, screw-on fittings, clamping fittings, connectors, protective fittings; manually operated single-

	<p>panel or multiple-panel doors and gates, namely sliding doors, swing doors, revolving doors, curved sliding doors, telescopic sliding doors, wing gates, folding gates, sliding gates, horizontal sliding walls; revolving doors of metal or glass, the leaves of which are designed as swing doors; door closers; mechanical, pneumatic and hydraulic devices for moving single-panel or multi-panel doors or gates, namely sliding doors, swing doors, revolving doors, curved sliding doors, telescopic sliding doors, folding doors, wing gates, folding gates, sliding gates; all of metal and power operated; electrical, mechanical and pneumatic drives, controls and automatic-control for sliding doors, swing doors, secure swinging doors, revolving doors, curved sliding doors, telescopic sliding doors, folding doors, wing gates, folding gates and sliding gates; motorized garage-gates drives; automatic lock devices and lock systems transferred into the locking and/or unlocking position by means of electronic switches for respectively single panel or multiple-panel doors or gates; electronic switch, control, monitoring and checking devices for the mentioned lock devices and lock systems; access-control installations; code-cards; code cards as data storage units; devices and installations for the identification of persons; alarm circuit; devices for heavy current engineering for the change, storage and control; computer programs in machine-readable media, including cards and chips; video-monitoring systems, consisting of video cameras which transmit pictures on control-systems without any wire or via cable, transmitter and receiver for the transmission of data; distributing boxes, junction boxes, electrical door opener; talk-back circuits; electrical control for locks, windows and door drives; electrical locks and keys for these locks; glass doors of all kinds; separation walls of glass, automatically and manually operated.</p> <p>Class 19: Glass doors of all kinds; separation walls of glass, automatically and manually operated; manually operated single-panel or multiple-panel doors and gates, namely sliding doors, swing doors, revolving doors, curved sliding doors, telescopic sliding doors, wing gates, folding gates, sliding gates, horizontal sliding walls; all being goods not made of metal.</p>
<p>CTM¹⁷ registration 6523377 for the mark:</p> <p>DORMA Filing date: 03 December 2007</p>	<p>Class 06: Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores; mechanical locks of metal; keys; fittings of metal for buildings, namely door hinges, latchkeys, locks and counter casings, fittings</p>

¹⁷ Community Trade Mark

Registration date:
22 October 2009

for latchkeys, fittings for all-glass doors and glass panes; fittings of metal for all-glass installations, namely locks and lock casings, strikes, handles, door knobs, grab bars, screw mountings, clamp fittings, connecting fittings, protective fittings; doors; all the aforesaid goods mainly of metal; partitions, in particular with stationery and mobile individual elements, sliding doors, sliding revolving doors, folding doors; all the aforesaid goods mainly of metal; horizontal sliding walls, adjustable walls and partitions, in particular moving partitions, and folding walls and doors, all the aforesaid goods mainly of metal; revolving double doors of metal, with panels that act as swing doors; door closers, non-electric; door stops of metal.

Class 07: Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; mechanical, pneumatic and hydraulic drives and control apparatus for moving single-component or multi-component doors and gates, in particular sliding doors, revolving doors, revolving double doors, curved sliding doors, telescopic sliding doors, folding doors, double wing doors, folding gates, sliding gates and/or partitions, all of metal and power-operated; electric drives for sliding doors, revolving doors, revolving double doors, curved sliding doors, telescopic sliding doors, folding doors, double wing doors, folding gates, sliding gates and/or partitions; motorised garage door drives; fittings for apparatus and drives for moving single-component or multi-component doors and gates, namely linkages, operating levers, slide rails, mounting plates, cover plates, included in class 7.

Class 09: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; electric regulating and control apparatus for sliding doors, double wing doors, revolving security doors, revolving double doors, curved sliding doors, telescopic sliding doors, partitions, folding doors, double wing doors, folding gates and sliding gates; electric locks; electronic switching, control, monitoring and checking (supervision) apparatus for locks, windows and door drives; electric door openers; encoded

cards, encoded identity cards and magnetic identity cards; access control devices, and apparatus and devices for personal identification, namely readers (data processing), central processing units (for data processing) and time recording apparatus; alarm apparatus; smoke detecting apparatus; apparatus for heavy-current engineering, namely for conversion, storage and control; video monitoring installations, consisting of video cameras transmitting images to control screens wirelessly or via cables, senders and receivers for transmitting data; distribution boxes (electricity); interphones.

Class 16: Stickers (stationery); packaging containers and packaging material of paper, cardboard and corrugated cardboard; printed matter, namely documentation, operating and user instructions; plastic materials for packaging, included in Class 16; all the aforesaid goods for and in connection with products and systems for doors.

Class 19: Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal; doors of all kinds (not of metal); partitions (not of metal), in particular with stationery and mobile individual elements, sliding doors, sliding revolving doors, folding doors; all the aforesaid goods mainly of glass, wood, plastic or composite materials; revolving double doors with panels that act as swing doors.

Class 35: Advertising; business management services; business administration; office functions; development of advertising and marketing concepts; planning, arranging and conducting of advertising events; business management and organisation consultancy, in particular in the field of distribution; wholesale and retail services in relation to doors and products for opening, closing and security doors; planning, arranging and conducting of product training courses.

Class 37: Building construction; repair; installation services; installation, commissioning, maintenance and repair of manual and automatic doors, gates, partition systems and windows; installation, commissioning, maintenance and repair of fire alarm installations, burglar alarm installations, time recording systems, access control installations.

Class 42: Development of software for controlling machines, terminals, and for access control and time monitoring apparatus; development of hardware, namely microcomputers, high-frequency

	circuits, optoelectronic apparatus, power supplies, with reference to customer requirements; technical planning of control apparatus and installations, access control, time and access monitoring installations and diagnosis equipment.
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