

O-068-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2293227
BY CEMENT BRITANNIA LTD
TO REGISTER THE TRADE MARK:**



IN CLASS 19

AND

**THE OPPOSITION THERETO
UNDER NO 90965
BY B&Q PLC
BASED UPON THE EARLIER TRADE MARK:**

KING

Trade Marks Act 1994

**In the matter of application no 2293227
by Cement Britannia Ltd
to register the trade mark:**



**and the opposition thereto
under no 90965
by B&Q Plc**

1) On 18 February 2002 Cement Britannia Ltd, which I will refer to as CBL, applied to register the above trade mark (the trade mark). The application was published for opposition purposes in the “Trade Marks Journal” on 15 May 2002 with the following specification of goods:

cement.

The above goods are in class 19 of the “International Classification of Goods and Services”.

2) On 15 August 2002 B&Q Plc, which I will refer to as B&Q, filed a notice of opposition to the application. B&Q is the owner of United Kingdom trade mark registration no 2288411 for the trade mark **KING** which is registered, inter alia, for *cement (other than adhesives)*. The aforesaid goods are in class 19 of the “International Classification of Goods and Services”.

3) B&Q claims that the respective trade marks and goods are identical. Consequently, registration of the trade mark would be contrary to section 5(1) of the Trade Marks Act 1994 (the Act).

4) In the alternative, B&Q claims that the respective trade marks are similar and are for similar or identical goods. Consequently, there is a likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(b) of the Act.

5) B&Q states that it sells and promotes its products, particularly cement products, under the KING trade mark and has done so since the end of 2001. Consequently, use of the trade mark is liable to be prevented by the law of passing-off and its registration would be contrary to section 5(4)(a) of the Act.

6) B&Q seeks the refusal of the application and an award of costs.

7) CBL filed a counterstatement in which it denies the grounds of opposition. CBL requests that the opposition is dismissed and seeks an award of costs.

8) Only B&Q filed evidence.

9) After the completion of the evidence rounds both sides were advised that it was believed that a decision could be made without recourse to a hearing. They were also advised at this time that the hearing officer considered the grounds of opposition under sections 5(1) and 5(4) untenable. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing. No written submissions were received.

EVIDENCE OF B&Q

10) This is in the form of a witness statement by Andrew McLaren who is a building products buyer for B&Q. There is little in Mr McLaren's evidence that relates to the grounds of opposition. There are no turnover or advertising figures for use of the trade mark KING. A copy of an advertisement from "The Mirror" for 22 January 2002 is exhibited. The advertisement is for B&Q warehouse and shows a pack of cement using the trade mark the subject of the application. There is no indication that B&Q is responsible for the product, just that it sells it. A copy of the packaging for the cement is also shown. There is no indication that B&Q is responsible for the cement. Indeed, the very opposite is the case. The pack states that the cement was imported by CBL and gives its address.

11) There is no way that Mr McLaren's evidence can establish a protectable goodwill for the purposes of passing-off.

DECISION

Grounds of opposition under sections 5(1) and 5(2)(b) of the Act.

12) Sections 5(1) and (2) of the Act read:

"5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because -

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

- (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.”

13) 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”

14) B&Q’s registration is an earlier trade mark within the terms of section 6(1)(a) of the Act.

15) The European Court of Justice (ECJ) in *LTJ Diffusion SA v Sadas Vertbaudet SA* (Case C-291/00) [2003] FSR 34 stated:

“Article 5(1)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

There are clear and obvious differences between the respective trade marks which the average consumer will notice. B&Q cannot seek aid in a claim to oral use either, as Jacob LJ said in *Reed Executive plc and Reed Solutions plc v Reed Business Information Ltd and Reed Elsevier (UK) Ltd, totaljobs.com Ltd* [2004] EWCA Civ 159:

“You can only have "identity" if there is both aural and visual identity.”

16) The ground of opposition under section 5(1)(a) of the Act is dismissed.

17) In determining the question under section 5(2)(b), I take into account the guidance provided by the 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.

18) Both trade marks are for cement. I cannot see that anything turns upon the fact that the B&Q specification excludes adhesives. **The respective goods are identical.**

19) The trade marks to be compared are:

B&Q's trade mark:

KING

CBL's trade mark:



The application was filed in colour but colour is not claimed as an element of the trade mark. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* page 224). 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* page 224). I take into account the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v Puma AG* page 224) who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* page 84, paragraph 27).

20) The area of coincidence between the trade marks is, obviously, the word KING. The CBL trade mark contains a large letter K and the word KING as the main matter. Part of the representation of the trade mark shows parts of the side panels of the packaging, in which the word KING is far more dominant than the letter K. I am of the view that there are two dominant components in the trade mark: the letter K and the word KING. The letter K is not divorced from the word KING, it is the first letter of KING. As such it acts, as well as a simple representation of a letter, as a reference to the word KING.

21) 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).”

I am of the view, owing to the common and identical KING element, that the respective trade marks are distinctively similar.

22) In deciding if there is a likelihood of confusion I have to take into account various factors. The distinctiveness or otherwise of the earlier trade mark is of importance as

there is a greater likelihood of confusion where the earlier trade mark has a particularly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*). 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)*). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, *Windsurfing Chiemsee Produktions und Vertriebs GmbH (WSC) v Boots und Segelzubehör Walter Huber, Franz Attenberger* (Joined Cases C-108/97 and C-109/97) [1999] ETMR 585). KING is both a type of royal personage and a surname. There is no evidence that it describes any characteristic of the goods. Whether a surname is distinctive will depend on its use in the relevant trade. If numerous undertakings use it, then it will not have a capacity to distinguish the goods or services of one undertaking from those of another. In this case there is no evidence that the surname KING is widely used in relation to cement. Consequently, I am of the view that it must be accorded a reasonable degree of inherent distinctiveness. The ECJ has held that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case identical goods are involved. I also take into account that the distinctively similar element is identical, not just similar. I also bear in mind that the average consumer does not normally compare trade marks directly and has to rely on the vagaries of his or her recollection, that could be imperfect. Cement is not a particularly expensive item and I doubt that the average consumer will make a particularly educated or careful purchasing decision. Although I acknowledge that it is possible that the tradesman might take more care and will be more aware than the DIYer.

23) Taking all the above into account I have concluded that there is a likelihood of confusion and the application should be refused under section 5(2)(b) of the Act.

Grounds of opposition under section 5(4)(a) of the Act – passing-off

24) To succeed under this ground B&Q have to satisfy the classic trinity: goodwill, deception and damage. I have already decided above that B&Q has not established a protectable goodwill in relation to its business and the sign KING. **Consequently, this ground of opposition is dismissed.**

COSTS

25) In its grounds of opposition B&Q states that it asked CBL to withdraw its application. As it did not do so, it filed the opposition. It wants this to be taken into account in the award of costs. I do not see why its request to CBL should affect the amount of costs to be awarded. It made its request, CBL declined. That is CBL's right. The logic of B&Q's argument is that applicants should be penalised for defending their

applications if the opponent asks them to withdraw their application. I intend to award costs upon the normal scale.

26) B&Q Plc has been successful in this opposition and so is entitled to a contribution towards its costs. I order Cement Britannia Ltd to pay B&Q Plc the sum of £900. 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 16th day March of 2004

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