

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

**IN THE MATTER OF APPLICATION No 1526232
BY DORGARD LIMITED TO REGISTER A MARK
IN CLASS 9**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 44987 BY SPS (HOLDINGS) LIMITED**

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by Dorgard Limited to register a mark in
Class 9**

10 **and**

**IN THE MATTER OF Opposition thereto under
No 44987 by SPS (Holdings) Limited**

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DECISION

20 On 8 February 1993 Dorgard Limited applied under Section 17 of the Trade Marks Act 1938
to register the following mark:



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for a specification of goods which reads:

35 "Safety and security equipment for use with doors; door retainers, door holders and
door closers, all operated by remote control; door retainers, door holders and door
40 closers, all being electro-magnetic and all being operated by remote control; apparatus
for the remote control of all the aforesaid goods; parts and fittings for all the aforesaid
goods; all being safety or security apparatus for use with doors; all included in
Class 9."

On 24 July 1996 SPS (Holdings) Ltd filed notice of opposition to this application. They say
that they are the proprietors of a later filed application for the mark DOORGUARD and have
been using this mark since July 1992 in connection with a "mechanical securing device for
45 preventing unauthorised access to a building". In view of the opponents' claimed use it is
possible to deduce that a Section 11 ground is intended though it is not specifically referred to.
The opponents go on to say:

5 "In view of the fact that the goods themselves of the two applications are of a totally different nature, although both are used to assist in securing doors, the opponents have suggested to the applicants that they might like to give a letter of consent but at the time of filing the opposition, no satisfactory response in this connection has been received.

10 The above set of grounds are the best particulars which are presently available to the opponents. However, the opponents reserve the rights to seek leave to augment such particulars, or make such amendments as may be advisable or necessary in the light of any further or other information which may arise pending resolution of this opposition."

15 The applicants filed a counterstatement which, inter alia, asked that the last paragraph above be struck out.

20 Both sides ask for an award of costs in their favour. Both sides filed evidence in these proceedings and the matter came to be heard on 26 May 1999 when the opponents were represented by Mr W G F Allen of J A Kemp & Co, Trade Mark Attorneys and the applicants by Mr R Davis of Counsel instructed by Mathys & Squire, Trade Mark Attorneys.

25 By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

Opponents' evidence

30 The opponents filed a statutory declaration dated 12 May 1997 by Alexander MacDonald Duffus their Managing Director, a position he has held since 1990. He holds the same position in SPS Doorguard Ltd, a company which he describes as being a trading partner of SPS (Holdings) Ltd.

35 He says:

40 "There is now produced and shown to me and marked AMD1 a bundle of copy invoices made out in the name SPS Doorguard Limited to several customers showing that rental of certain products commenced in early 1992 to several different customers. At the same time products were also sold to other customers. These products are in fact designed to fill doors and windows of void properties, that is to say properties in whom nobody is at present living or working, to prevent axis [sic] by criminals and vandals. SPS Doorguard Limited has been continuously renting and selling these products on an ever increasing scale.

Our records show products sold by SPS Doorguard Limited have the following turnover figures:-

5	1992	£286,094
	1993	£484,728
	1994	£1,714,026
	1995	£1,938,992
	1996	£3,524,755

10 While the bulk of these products are the void protection products, since September 1992 we have been selling a number of other products, and in particular a product which is actually sold under the trade mark DOORGUARD. There is now produced and shown to me and marked AMD2 a brochure illustrating our various products. The DOORGUARD appearing on the first inside page has been sold continuously since 15 September 1992 and the turnover figures for this product alone is:-

	1992	£9,880
	1993	£75,541
	1994	£84,080
20	1995	£105,743
	1996	£145,424

I consider that the trade mark Application No 1526232 by Dorgard Limited has a Specification of Goods which is unduly broad, because it appears to overlap with the 25 products manufactured, sold and rented by SPS Doorguard Limited, and its sister company SPS (Holdings) Ltd., insofar as the Specification of Goods of 1526232 includes the very broad expression "safety and security equipment for use with doors". Because the actual products sold by Dorgard Limited are in fact different, I would have no objection with remaining goods listed in the specification of 1526232 being 30 retained, because these goods are clearly distinct from those in which my company is interested."

Applicants' evidence

35 The applicants filed a statutory declaration dated 14 October 1997 by Neil Pursey, Chief Executive of Dragrod Ltd (formerly Dorgard Ltd), a position he has held since 1992.

In response to Mr Duffus' declaration he says that the invoices bear no references to DOORGUARD, each referring to 'SPS Void Protection Products' and 'SPS Doors'. He 40 exhibits (NP1) a brochure of SPS Void Protection Products and Doors and notes that it does not show use of DOORGUARD as a trade mark. He says that the opponents' evidence does not support the claim that goods were placed on the market in September 1992 and suggests that this in any case conflicts with the claim in the statement of grounds that the mark has been in use since July 1992.

45 In relation to his company's mark he says that this was chosen in April 1992 and the particular form in which the mark has been applied for was designed in July 1992 and used thereafter on

letterheads and promotional literature. In September 1992 the company attended the Fire 1992 Exhibition in Eastbourne. He goes on to say:

5 "In view of the importance of this product from a safety aspect, we did not launch immediately but spent a substantial amount of time developing the product. During this time we continued to promote the product under the trade mark DORGARD in all fields. There are now produced and shown to me marked Exhibit NP2 the front page from a Confidentiality Agreement dated 1992 with Hosiden Besson Limited and a DTI Enterprise Initiative document dated 5th August 1992 which I note on page 2, at point 10 3 refers to my product under the trade mark DORGARD.

15 In January 1993 (although inadvertently dated 1992) I had correspondence with the Loss Prevention Certification Board relating to testing and approval. Correspondence relating to this matter which refers to the product by the trade mark DORGARD is now produced and shown to me marked Exhibit NP3.

20 Since the date of application, I have continued to promote the trade mark and in this connection there is now produced and shown to me marked Exhibit NP4 correspondence with Paramount Publishing and Exhibition London relating to my product."

Opponents' evidence in reply

25 Mr Duffus filed a further statutory declaration dated 8 April 1998.

In summary he:

30 S makes further observations on the use of SPS DOORGUARD or SPS Doorguard Limited

S exhibits (AMD2) two further invoices which it is said show use of the mark

35 S corrects the 1992 sales figure of £9880 to £14000 by reference to one of the above mentioned invoices and the date of first sale from July 1992 to 27 August 1992

S makes a number of observations on the applicants' claims. I will deal with these issues so far as necessary in my decision.

40 That concludes my review of the evidence.

45 The opponents say they have an application of their own for the mark DOORGUARD but it has a later filing date than the mark under attack. However they claim that they have priority of user over this application. Objection, therefore, arises under Section 11. This Section reads:-

"11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design."

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The established test for an objection under this Section is set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand the test may be expressed as follows:-

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Having regard to the user of the mark DOORGUARD, is the tribunal satisfied that the mark applied for, DORGARD and device, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

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Both parties claim to have adopted and put their marks into use before the material date (8 February 1993).

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The question of priority, therefore, needs to be considered in the light of the evidence filed. I should preface what follows by saying that in general terms both sides adopted their marks at about the same time in 1992 and claim to have commenced use in the summer of that year. However the supporting evidence is thin and in some areas inconclusive and this has not aided the process of reaching a decision.

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The opponents were originally said to have been using their mark since July 1992 but this claim was later adjusted to August 1992. Turnover under the mark for 1992 was put at £9880 but subsequently said to be £14,000 plus VAT. As the latter is a single invoice it is not clear to me what the initial figure related to or how the discrepancy arose. The invoices at AMD1 are of no assistance to the applicants as they appear to relate to the rental of void protection devices sold under the house mark SPS. There is reference at the foot of the invoices to 'SPS Doorguard Limited' in small type and with the company address, telephone and fax numbers. However the nature of this use is not such that subsequent use of the applicants' mark is likely to cause confusion within the meaning of the test. Substantiation of any sales under the name or mark DOORGUARD must, therefore, rest on the other exhibits to Mr Duffus' declaration.

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AMD2 (exhibited to Mr Duffus' first declaration) is a product brochure showing representations of the goods on the front cover along with what I take to be a trade mark in the form of a grid device with the letters SPS running beneath. The inside of the single fold document contains information on the void protection products and the DOORGUARD product. As regards the latter the introductory paragraph refers to SPS DOORGUARD.

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Thereafter the remaining references are to DOORGUARD on its own. The document is not dated, though Mr Davis suggested, by reference to the telephone number, that it was produced after the relevant date. He also noted that the SPS Doorguard product was at that time said to be 'new' but given the promotional context I draw no particular conclusions from that. The only other exhibit is attached to Mr Duffus' second declaration and contains two copy

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invoices. One is dated 25 August 1993 which is after the material date and the other 27 August 1992. The latter invoice is, therefore, the only item that clearly carries a date prior to the filing date of the application in suit. The invoice refers to SPS Doorguard Units.

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The applicants' position is that they claim to have chosen their mark in April 1992 and to have used it since July 1992 in the normal course of business. In support of this claim Exhibit NP2 is the first page of a confidentiality agreement with Hosiden Besson Ltd dated 10 July 1992. So far as I can see the only relevant reference is to Dorgard Ltd which again is simply a
5 reference to the name of the company. Also included in this exhibit is a copy of a DTI Enterprise Initiative document dated 5 August 1992. It appears to relate to an application for assistance with a design consultancy relating to a DORGARD fire door safety device. That the product was still in its early design stages is further borne out by the fact that Exhibit NP3 (a letter from the Loss Prevention Certification Board dated 11 January 1993) relates to
10 <Testing and approval of DORGARD'.

The conclusions I draw from both sides' evidence is as follows:

15 S the applicants can point to use of DORGARD on 5 August 1992 but the nature of that use is as part of the 'internal' preparations for launch of a product. There is no evidence that the trade or potential customers were aware of the existence of the mark or the goods to be sold under the mark. Although the applicants attended the Fire 1992 Exhibition in September 1992 it is not clear whether this was as exhibitors or simply visitors
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S in terms of evidence of actual trade the opponents have established priority of date through their invoiced sale (the first sale in fact) on 27 August 1992 but
.....

25 S this use relates to either the mark SPS or, SPS Doorguard if I accept that the latter word is part of the mark

S whilst the distinctiveness of the mark or name DOORGUARD is not in issue before me I take the view that it is not the strongest of marks and when
30 combined with the letters SPS (in effect the house mark) it is the latter which is likely to be the dominant element. This is likely to impact on customer perception of the mark and the issue of confusion

S the use shown by the opponents is in respect of a single product, namely a key
35 operated security bar which is attached to the frame of a door to prevent access even if the door is forced

S it has not been clearly established that there would be a connection with
40 equivalent (eg electronic or remote controlled) items in Class 9 but I cannot entirely rule out the possibility that there will be.

The test of course requires me to come to a view as to whether there will be deception and confusion amongst a substantial number of persons. Taking all the above factors into account the opponents have not persuaded me that there is a real tangible risk of confusion. Their
45 claim to priority of use is at best marginal but combining the semi-descriptive word DOORGUARD with their house mark SPS points firmly away from rather than towards any risk of confusion. The impact of a single sale (or at least low volume of sales) under a

composite mark makes it difficult to assume that any meaningful customer impact was achieved by the relevant date for DOORGUARD as such. Moreover, although I do not primarily seek to decide the matter on the basis of the goods themselves it seems to me that the opponents have not clearly established that the goods (a very specific item in their case) are connected in the eyes of the trade or the relevant customer base such that confusion may arise. The opposition, therefore, fails.

As the applicants have been successful they are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £635.

Dated this 7 day of June 1999

M REYNOLDS
For the Registrar
the Comptroller General