

O-159-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2296334
IN THE NAME OF ROLSON TOOLS LIMITED
TO REGISTER THE TRADE MARK ROLCRAFT IN CLASSES 7 AND 8**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 91083 IN THE NAME OF
RODCRAFT PNEUMATIC TOOLS GMBH & CO., KG**

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BACKGROUND

1. On 25 March 2002, Rolson Tools Limited applied to register the trade mark ROLCRAFT in Classes 7 and 8 in relation to the following specifications of goods:

Class 07: Machine hand tools; light electrical hand tools; planes; screwdrivers; saws; chisels; spanners; sanders; drills; routers; staple guns; nail guns; crimping tools; all the aforesaid being machine operated hand tools; all operated by electric motors or compressed air; and parts and fittings for all the aforementioned goods.

Class 08: Hand tools; hammers; awls; files; planes; screwdrivers; saws; chisels; spanners; sanders; drills; hand drills; routers; staple guns; nail guns; pliers; wrenches; drill bits; hacksaw blades and frames; screwdriver bits; bevels; clamps; vices; wire brushes and wheels; trowels; trimming knives; axes; crimping tools; pincers; carving tools; gouges; socket sets; mitre boxes and blocks; all the aforesaid being hand tools; none being electrically or pneumatically operated; and parts and fittings for all the aforementioned goods.

2. On 12 September 2002, Rodcraft Pneumatic Tools GmbH & Co., KG filed notice of opposition to the application, the grounds of opposition being as follows:

1. Under Section 5(2)(b) because the mark the subject of the application is similar and the goods for which the applicants seek registration are either identical or similar to the opponents= earlier marks.

2. Under Section 5(4)(a) by virtue of the law of passing off.

Details of the earlier marks relied upon by the opponents can be found as an annex to this decision.

3. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based.

4. Both sides ask that an award of costs be made in their favour.

5. Both sides filed evidence in these proceedings. Neither side took up the offer of an oral hearing, instead electing to have a decision from the papers. After a careful study of the evidence and the written submissions provided, I go on to make my decision.

OPPONENTS= EVIDENCE

6. This consists of two Witness Statements. The first is dated 20 November 2003 and comes from Stephen Clement Samms, President of Rodcraft Pneumatic Tools GmbH & Co., KG, a position he has held since 1998.

7. Mr Samms says that in 1986 his company started using and registered the trade mark RODCRAFT in Germany. The first use in the UK was in 1987. He gives details of his company's UK sales under the RODCRAFT mark for the years 1995 to 2001, which ranges from a base of just over , 400,000 to a peak of around , 562,000. Mr Samms says that the goods are manufactured in Germany and sold in the UK via a subsidiary, Rodcraft UK Limited. Figures for expenditure on advertising and attendance at trade shows in the UK in the years 1996 to 2001 show expenditure at between , 8,940 and , 25,018. Mr Samms says that his company promotes its goods through the Internet, and owns two websites.

8. The remainder of the Witness Statement consists of submissions on the opponents= case, and whilst I do not consider it to be appropriate or necessary to summarise these here, I will take them fully into account in my decision.

9. The second Witness Statement is dated 29 November 2003 and comes from Victoria Jane Martin, a Trade Mark Attorney and Partner in Brookes Batchellor LLP, the opponents= legal representatives in these proceedings.

10. Ms Martin confirms that the opponents= goods are manufactured in Germany, saying that from 1994 the goods were sold in the UK by AB Pneumatic Products Limited as sole distributor and agent. Exhibit VJM1 consists of a memorandum dated 20 June 1994 relating to a visit that took place on 13/14 June 1994, which confirms that AB Pneumatic Products Limited were to be sole agents and distributor of RODCRAFT products in the UK.

11. Exhibit VJM2 consists of two letters dated 20 and 21 June 1994 respectively, from the opponents to AB Pneumatic Products Limited , the first referring to an enclosed price list and trading terms, the second letter setting out terms for a warranty agreement to be signed (but as yet unsigned) by the parties.

12. Exhibit VJM3 consists of two RODCRAFT product brochures, one headed 'WORKSHOP= 94@ the other, RODCRAFT Power Tools, and a footer '94 OUTILS PNEUMATIQUE. These brochures are in French, the first giving a contact address in France, there being nothing to indicate that it was available in the UK. Ms Martin relies upon this evidence only insofar as it provides details of RODCRAFT products that she says were sold in the UK by their distributor.

13. Ms Martin says that AB Pneumatic Products Limited was subsequently acquired by

Rodcraft UK Limited, the latter company continuing to act as sole distributor and agents in the UK for the sale of RODCRAFT products. Exhibit VJM4 consists of a compliment slip, and the business card of Robert Birtles, the Managing Director of Rodcraft UK Limited.

14. Ms Martin relates that on 30 December 2002, Rodcraft UK Limited was acquired by new shareholders who obtained the right from the opponent to continue using the name Rodcraft UK Limited and set up a sole distributorship agreement with the opponent for the sale of RODCRAFT products in the UK.

15. Exhibit VJM5 consists of extracts from the October 2003 edition of a magazine entitled **FACTS**. The pages include an advertisement for RODCRAFT power tools, and a company profile confirming that that company has been supplying the automotive aftermarket industry with pneumatic tools and workshop equipment (although not specifically RODCRAFT branded) for some 25 years. The exhibit also includes an extract from another magazine which provides no information prior to the relevant date.

16. Exhibit VJM6 consists of various product brochures, only one of which, headed **RODCRAFT WORKSHOP 2000** appears to originate from prior to the relevant date. The brochure bears a sticker giving Rodcraft UK Limited as the contact. The brochure depicts various items of automotive workshop equipment. Although dated after the relevant date, the cover of one brochure bears the legend **1975 - 2002 YEARS OF QUALITY**.

Applicants- evidence

17. This consists of a Witness Statement dated 8 June 2004 from Surinder Kumar Rajput, Managing Director and owner of Rolson Tools Limited since its establishment in 1979.

18. Mr Rajput says that the trade mark **ROLCRAFT** relates to a line of hand tools, power tools and accessories that his company has been producing since about 1979. He says his main product line is branded **ROLSON**, which is a mark that appears on all of his company's products. Mr Rajput states that his company carries a line of about 5,000 items, the mark **ROLCRAFT** relating to those he would categorise as being for the **tradesman** sector.

19. Mr Rajput says that the **ROLSON** brand has a considerable reputation and market share in the tools business. To take advantage of this, in 2000 his company launched a new range under the name **ROLCRAFT**, the **ROL** prefix being a link to **ROLSON**.

20. He sets out the turnover for business under the **ROLSON** name for the years 1997 to 2003, which ranges from , 4.7 million in 1997, rising to , 8 million in 2001, the last full year prior to the relevant date. Mr Rajput says that although his company does not keep records in a manner that will allow straightforward separation of the **ROLCRAFT** and **ROLSON** business, to his knowledge approximately 40% of turnover relates to **ROLCRAFT**. He says that sales are to general and specialist hardware, DIY and tool retailers, some of which he names. He suggests that to obtain a total value of the goods sold at retail would involve a mark-up of 25%.

21. In relation to the promotion/advertising of the mark, Mr Rajput says that his company spends in the region of , 25,000 per annum, mainly at exhibitions and the like. He says that they also use a network of sales agents who visit potential customers and make commission sales.

22. To illustrate the way in which his company uses the ROLCRAFT mark, Mr Rajput refers to exhibit SKR1. This consists of a series of undated photographs of tools, the ROLCRAFT name being shown with the letters ROL in white lettering on a blue background, and the word CRAFT in black lettering on an orange background. Exhibit SKR2 consists of extracts from the applicants=2004 stock list. Mr Rajput concludes his declaration by commenting on the lack of any confusion.

Opponents= evidence in reply

23. This consists of a Witness Statement dated 8 September 2004 from Victoria Jane Martin. The Statement consists of no more than submissions on the evidence filed by the applicants, and the substantive issues in this case. Whilst I do not consider it to be appropriate or necessary to summarise these submissions, I will take them fully into account in my determination of this case. Two exhibits are referred to. Exhibit VJM1 consists of details of other ROL prefixed marks registered in respect of goods in Classes 7 and 8. Exhibit VJM2 consists of an Aexecutive summary of the 2003 DIY and Hardware Retailers in UK market analysis@, Ms Martin highlighting that during 2003 the market size was , 4.8 billion.

24. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

25. I turn first to consider the ground under Section 5(2)(b). The relevant part of the statute reads:

A5.-(2) A trade mark shall not be registered if because -

(a) YYYYYYYY.

(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.@

26. An earlier trade mark is defined in Section 6 of the Act as follows:

A6.- (1) In this Act an Aearlier trade mark@means**B**

(a) 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,@

27. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen*

Handel B.V. [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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 B.V.* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) 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*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

28. In any analysis it is inevitable that reference will be made to the individual elements of which a mark is composed, and rightly so, for the case law requires consideration to be given to the distinctiveness and dominance of the component parts. However, it must not be forgotten that the consumer does not embark on a forensic analysis of trade marks and it is the marks as a whole that must be compared.

29. The opponents rely on two earlier registrations for the word RODCRAFT. The mark applied

for is the word ROLCRAFT. The respective marks are composed of the same number of letters and syllables, share the same ARO@prefix and ACRAFT@suffix, the only difference being that the third letter in the opponents= earlier mark is a letter AD@whereas in the mark applied for it is a letter AL@. Whilst these letters affect the pronunciation and sound, because of their positioning in the body of the word this has a minimal impact on their sound. The same must be said for the visual impact that the letters have on the respective marks.

30. Whilst I do not go so far as to say that the word CRAFT is dominant or distinctive in the mark, it is an ordinary and well-known English word and as such is likely to be fixed as a point of reference when recalling the marks. The combining of this word with the meaningless prefixes creates the impression of an invented word. Given these facts and similarities I take the view that the marks are visually, orally and conceptually similar.

31. Whilst the word ACRAFT@cannot be regarded as distinctive for machines and hand tools for use in crafts or craft-work, the prefixes have no relevance, and as a whole the respective marks are invented words that possess a distinctive character.

32. Turning to the respective goods. The opponents= earlier marks cover two classes, the same two classes for which the applicants seek to register their mark. The opponents= registration in Class 7 covers machines in general, electric machines for specific purposes or for use in particular industries, and parts and fittings for such goods. The mark applied for also covers machines in general, hand tools and parts and fittings for these goods. Collins English Dictionary gives one of the meanings of Amachines@as being a Amechanical or electrical device that automatically performs tasks or assists in performing tasks@. In my view this means that the term would cover machines that are floor standing or hand-held, and therefore the specifications of the respective marks cover identical goods.

33. The opponents= earlier mark registered in Class 8 covers hand tools and hand operated implements in general. The mark applied for is for hand tools at large, and specific hand tools. Self-evidently the specification of the opponents= registration in Class 8 encompasses the same goods for which the applicants seek to register their mark.

34. There is nothing in the wording of the specifications that would separate them; they are not limited or restricted in any way. Accordingly, I must notionally assume that they operate in the same market and share the same channels of trade, from manufacture to retail. Whilst the Anotional@average consumer will depend upon the type of goods, I see no reason why the consumer of the opponents= goods should be any different to those that would buy the applicants= goods.

35. The goods notionally range from the cheap and simple that will be selected with minimal attention to the brand and where the notional average consumer is likely to be more concerned with the functionality of the tool, to expensive and sophisticated machines where the purchaser will be well informed and circumspect in all aspects of the selection. There will be a greater potential for confusion in the former rather than the latter case.

36. The opponents say that they began using the RODCRAFT mark in the UK in 1987. The figures for sales are not insignificant, but given the overall size of the market are hardly impressive. Advertising and promotion appears to have primarily been directed at the trade, the expenditure

being minimal. Based on the information provided I would not say that the mark has become any more distinctive by virtue of the use made of it, and certainly does not warrant it being afforded a wider degree of protection.

37. Taking all of the above into account and adopting the Aglobal@approach advocated, I find that taking into account the similarities, and particularly the potential for imperfect recollection, that if the applicants were to use their mark in a trade in the goods for which they seek registration, that this would cause the public to wrongly believe that the goods come from the opponents or some economically linked undertaking. There is a likelihood of confusion and the opposition under Section 5(2)(b) succeeds.

38. My decision in respect of the ground under Section 5(2)(b) effectively decides the matter, but for completeness I will go on to give my decision in respect of the ground under Section 5(4)(a). That section of the Act reads as follows:

5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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. @

39. In order to determine the issue under Section 5(4)(a) of the Act, I shall adopt the guidance provided by the Appointed Person, Mr Geoffrey Hobbs Q.C in the *Wild Child* case [1998] 14 RPC 455. In that decision Mr Hobbs states that:

- (1) that the plaintiff-s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

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

40. The opponents say that they first started using the name RODCRAFT in the UK in 1987, some 15 years prior to the date on which the application was made, and potentially some 13 years before the applicants first used their mark. Whilst there is no evidence that clearly establishes this date, the brochure at exhibit VJM6 bears the legend A1975 - 2002 YEARS OF QUALITY@ suggests that this is, in fact the case. I do, of course acknowledge that this could relate to use in markets other than in the UK. There is evidence that the opponents were using the mark, in the UK in 1994 and I have no difficulty in accepting that at the date, that the applicants say they first used the mark ROLCRAFT, and also the date on which they made their application to register that name, the opponents had already established a reputation and goodwill in the UK.

41. I have already stated my view that the respective marks are similar, and given that the opponents have a reputation and goodwill in their mark, in relation to identical and similar goods, should the applicants use their mark this would amount to a misrepresentation that would lead to damage. In my view the opposition under Section 5(4)(a) should succeed.

42. The opposition having been successful, I order the applicants to pay the opponents the sum of , 1,250 as a contribution towards their costs. This sum 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 15th day of June 2005

**Mike Foley
for the Registrar
the Comptroller-General**