

O-177-08

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2363603
IN THE NAME OF TIMOTHY BENSON
OF THE TRADE MARK:**

Trussloft

IN CLASS 37

AND

**THE APPLICATION FOR A DECLARATION
OF INVALIDITY THERETO
UNDER NO 82804
BY TOP-STOREY LOFT CONVERSIONS (NE) LTD**

Trade Marks Act 1994

**In the matter of registration no 2363603
in the name of Timothy Benson
of the trade mark:
Trussloft
in class 37
and the application for a declaration of invalidity
thereto under no 82804
by Top-Storey Loft Conversions (NE) Ltd**

Background and evidence

1) The trade mark **Trussloft** (the trade mark) is registered for *repair of roofs, roof installation services, roof repair, roofing services, roof restoration*. The application for registration was made on 19 May 2004 and the registration process was completed on 15 October 2004. The application was made in the name of Mr Timothy Benson, and still stands in his name. On 8 March 2007 Top-Storey Loft Conversions (NE) Ltd, which I will refer to as Top-Storey, was sent a letter by Mr Terry Banham of Truss Loft Conversions Limited, which I will refer to as TLC. Mr Banham states in his letter that, despite previous verbal assurances, an advertisement by Top-Storey in the 2007/8 *Yellow Pages* for York, Harrogate and Scarborough contains the expression Truss Loft. The letter advises that the majority shareholder of TLC owns the above trade mark and that TLC has the exclusive right to use the trade mark as of 19 May 2004. Mr Banham states that he has been advised by TLC's solicitors that use of Truss Loft is contrary to section 10(1) of the Trade Marks Act 1994 (the Act) or, in the alternative section 10(2) of the Act. Mr Banham requires that Top-Storey and Mr Birch, of Top-Storey, give written undertakings to cease and desist from using the term Truss Loft and deliver up various documents and material. Mr Banham states that if these undertakings are not made the matter will be placed in the hands of the solicitors of TLC. Top-Storey was given until 16.00 on 16 March 2007 to respond. On 16 March 2007 Top-Storey filed an application for the invalidation of the registration.

2) Mr Birch, on behalf of Top-Storey, claims that Trussloft is a generic term. He states that all loft conversion companies nowadays carry out conversions to truss lofts in modern houses. Mr Birch states:

“We wish to invalidate the above Trade Mark as it is not unique to the proprietor; it is a generic term used in the loft conversion trade and should therefore be free for everyone in the loft conversion trade to use.

We believe we have absolute grounds to invalidate the above Trade Mark under Section 3 (section 1) (subsection b) of the Trade Marks Act 1994, as it is devoid of any distinctive character.”

Mr Birch states that he has been advised that ‘Truss Loft Specialists’, which appears in Top-Storey’s advertisements, is an “absolute description” of Top-Storey’s trade. (Top-Storey has not had professional legal representation in this case.)

3) Mr Benson denies that the trade mark was registered in breach of section 3(1)(b) of the Act. In the alternative, if it was so registered, he claims that owing to the substantial use of the trade mark, by him or with his consent, that it has acquired a distinctive character in relation to the services for which it is registered.

4) Mr Banham’s letter might be read as intimating that legal proceedings for infringement were to be commenced if Top-Storey and Mr Birch failed to give the undertakings demanded. There is no indication that any legal proceedings have been commenced either by Mr Benson or TLC against Top-Storey or Mr Birch. If any such proceedings had commenced this case would have to be dealt with by the court, as per section 47(3)(a) of the Act.

5) Applications for the invalidation of a trade mark registration are governed by section 47 of the Act¹. Mr Brandreth in his skeleton argument noted that Mr Birch was a litigant in person (someone without legal representation) and that the grounds for invalidation related to sections 3(1)(c) and (d) of the Act. I agree with Mr Brandreth that the grounds of invalidation primarily relate to sections 3(1)(c) and (d) of the Act. Mr Birch also claims that the trade mark is devoid of any distinctive character and so the grounds for invalidation are born of sections 3(1)(b), (c) and (d) of the Act. Section 47(1) of the Act allows an application for invalidation to be based upon sections 3(1)(b), (c) and (d) of the Act. Section 3(1) of the Act reads:

“3.-(1) The following shall not be registered -

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Section 47(1) of the Act reads:

“47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

Consequently, the use of a trade mark after registration which might lead to it having acquired a distinctive character has to be considered.

6) This part of the Act is derived from Article 3(3) of First Council Directive 89/104 of December 21, 1988 (the Directive) which states:

“3. A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. Any Member State may in addition provide that this provision shall apply where the distinctive character was acquired after the date of application for registration or after the date of registration.”

(One of the principle aims of the introduction of the Act was to implement the Directive. It is necessary to interpret those parts of the Act derived from the Directive on the basis of what the Directive states. Interpretations of law are based upon judgments of domestic courts, the European Court of Justice (the ECJ) and the Court of First Instance (CFI). The ECJ is the final arbiter on interpretation of the meaning of the Directive. (All judgments of the ECJ and the CFI can be accessed at the url: <http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en>)

7) In *Premier Luggage and Bags Ltd v. Premier Co (UK) Ltd & Another* [2002] ETMR 69 Chadwick LJ stated:

“51 The relevant question, therefore, is whether the trade mark had acquired a distinctive character through use in connection with products supplied by Premier Luggage either by the date of application, or (if not) by the date of the trial. The judge did not differentiate between those dates -because, as he said at paragraph 21 of his judgment:

"Although the proviso [to section 3(1) of the Act] refers to the mark acquiring distinctiveness prior to the date of the application for registration, section 47 of the 1994 Act provides that, if it is sought to obtain a declaration of invalidity where a mark has already been

registered, it is sufficient if a distinctive character has been acquired since registration."

52 There is, I think, a danger in that approach, because it fails to recognise where the burden of proof lies in the two cases. The position was explained by Jacob J. in the *British Sugar* case, at page 302 (lines 7-12). After pointing out that section 72 of the Act provided that registration of a person as proprietor was prima facie evidence of the validity of the original registration, Jacob J. went on to say this:

"This clearly casts the onus on he who wishes to attack the validity of the original registration. But once the attacker can show the registration was wrongly made (particularly for non-compliance with section 3(1)(b)-(d)) and the proprietor wishes to rely on the proviso to section 47(1) it is for the proprietor to show that is [sic] mark is distinctive."

Consequently, the material dates for this case are the date of application, 19 May 2004 and the date of the hearing, 4 June 2008. If it is decided that at the date of application that the trade mark was not capable of distinguishing then use of the trade mark up to 4 June 2008 can be taken into account when considering if the trade mark has acquired distinctive character.

8) As per the judgment of Chadwick LJ, the burden of proof in showing that the trade mark at the date of application fell foul of any part of section 3(1) of the Act lies with Mr Birch. However, if Mr Birch succeeds in establishing that the trade mark fell foul of any part of section 3(1) of the Act, then the burden of proof of establishing distinctiveness lies with Mr Benson.

9) It is Mr Birch's case for Top-Storey that the term Trussloft is both generic for the services provided and an absolute description. Mr Benson's response is that he coined the term. This in itself, if it is the case, is not a defence if the term is descriptive. A neologism is not registrable simply because it is a neologismⁱⁱ.

10) A good deal of the evidence, from both sides, emanates from after the date of the application for registration. However, I am not going to shut it out as it is still instructive in that it shows how Trussloft is viewed. The ECJ in *Alcon Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-192/03 P* held that use after the date of the application could be used to draw conclusions as to the position at the date of applicationⁱⁱⁱ. In *Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-322/03* the CFI took into account documents emanating from four years after the date of application^{iv}. Use after the date of application can also go to the issue of foreseeability in relation to the use of the term^v.

11) The conversion of lofts is a relatively modern phenomenon. In many modern houses it is more difficult to convert the lofts than in older houses; this is because of the prevalence of fink roof trusses. Fink roof trusses are used when the roofs are not built on

site. Fink truss roofs are not easily converted because the integrity of the roof depends on the truss loadings being left in tact and loadings typically run from wall plate to wall plate across the house. It is estimated that around 98% of house roofs built between 1970 and 2000 use fink trusses. It is no surprise, therefore, that ways of converting such roof spaces have been developed and that the conversion of such spaces is now a part of the work of many businesses.

12) Mr Birch has exhibited at MB1, MB2 and MB3 copies of advertisements for undertakings in the loft conversion business. Walton Building & Restoration, AARK Loft Conversions, AJR Joinery, Premier Loft Conversions Ltd and Room Maker Loft Conversions in their promotion material all refer to Truss Lofts. Creative Loft Conversions and Upper Deck Conversions refer to truss roofs or truss roofed houses. At exhibit MB4 the banner for TLC's website is exhibited, "The UK's Only National Truss Loft Company" is written underneath the words Truss Loft Conversions (this page was downloaded on 14 June 2007). Advertisements from *Yellow Pages* for TLC are exhibited at MB5. The advertisements include, inter alia, the following: "NATIONWIDE TRUSS LOFT SPECIALISTS", "Modern truss rafter lofts can be converted", "Unique system to convert your truss lofts". A copy of the advertisement can be seen below:



13) Exhibited at MB6 is an e-mail from Acorn Carpentry & Building Services advising that they are "speachalists in truss roof conversions". Exhibited at MB7 to MB11 are E-mails from Ms Kate Birch and Mr Jonny Smee to various undertakings re conversion of a truss loft. In the responses three refer to truss roofs, two to roof space and one to a truss loft. It is the contention of Mr Birch that the responses to these e-mails show that there is no confusion as to what is meant by a truss loft. It is clear from the responses that what was meant by truss loft was understood, even if the term itself was not used.

14) Mr Birch states that he has carried out truss loft conversions since 1985 and intends to continue carrying out such conversions. (This, of course, is not the same as stating that he has used the term truss loft since 1985.) He states that he and Mr Benson agreed that there would be no confusion between the advertisements for Top-Storey and those for TLC. Mr Birch states that there has never been an enquiry from a third party asking if Top-Storey is the company TLC.

15) Mr Birch states that Gayle Urquhart, the head of *Yellow Pages* legal department, has confirmed that the expression truss loft is a recognised description used in the loft conversion trade. *Yellow Pages* area representative and major accounts manager, Norman Clifford, has also advised that truss loft is a generic term. Mr Clifford, it is stated, advises loft conversion companies to advertise that they convert truss lofts. Mr Clifford had input in the structure of the advertisement to which TLC objects. Ms Urquhart has advised Mr Birch not to remove the wording “truss loft specialists” from any of Top-Storey’s advertisements as this is an “absolute description” of its trade. The advertisement to which TLC has objected was designed and prepared solely by the *Yellow Pages* art department. Top-Storey had no input in the wording or layout, although the advertisement was approved by Mr Birch when he received the art work.

16) Mr Benson is the managing director of TLC. He states that Trussloft has been used under an exclusive licence by Truss Loft Conversions since 1995. Truss Loft Conversions was incorporated in 1997 as TLC. Exhibited at TB1 are copies of pages from TLC’s website, downloaded on 7 September 2007; it is stated therein that Trust Loft Conversions has been established in the north of England since 1995. Mr Benson comments that it can be seen from the pages that TLC no longer uses Truss Loft in the way identified by Mr Birch and as shown at exhibit MB4 to the statement of Mr Birch. I cannot see what bearing this change has upon the case before me. (Exhibit MBa32 to the second witness statement of Mr Birch shows that website was re-launched on 7 September 2007.) The business of TLC is loft conversion, as part and parcel of this business it also repairs, restores and installs roofs. Exhibited at TB2 is a list of the locations from where enquiries about loft conversions have been made to TLC. These enquiries emanate from all over the United Kingdom. Mr Benson states that customers, when referring to the services offered by TLC, use the term loft conversion. He states that Trussloft has no technical meaning. Exhibited at TB2 are copies of letters and e-mails in which TLC’s customers refer to loft conversions or conversions rather than truss loft conversions. There are also references to Truss Loft and Truss Loft Conversions in the correspondence. It is difficult to see how the customers could refer to the undertaking in any other way as it describes itself as Truss Lost and Truss Loft Conversions. The absence of any reference to truss lofts in the correspondence cannot indicate that the term is not generic or descriptive.

17) The turnover for TLC is as follows:

| | |
|-------------------|------------|
| 2002 | £1,337,595 |
| 2003 | £1,822,453 |
| 2004 | £2,726,979 |
| 2005 | £3,469,703 |
| 2006 – April 2007 | £3,909,376 |

Mr Benson states that it is difficult to give an indication of the market share that TLC has as he is not aware of any database which provides information relating to the size of the loft conversion market in the United Kingdom. The providers of these services range from sole traders through to incorporated companies and so, Mr Benson states, the market

share of any single organisation will be relatively small. Mr Benson states that TLC advertises throughout the United Kingdom in *Yellow Pages*, the *BT Phone Book* and a selection of national magazines. The advertising expenditure of TLC is as follows:

| | |
|------|---------|
| 2002 | £18,470 |
| 2003 | £19,647 |
| 2004 | £25,835 |
| 2005 | £73,257 |
| 2006 | £40,070 |
| 2007 | £45,000 |

18) The *Yellow Pages* advertising for 2002/2003 was in Middlesbrough, Sunderland, Reading & Newbury, York, Cambridge, Oxford & Banbury and Leeds. In 2003/2004 it was in Middlesbrough, Sunderland, Norwich, Reading & Newbury, Slough, York and Cambridge. In 2004/ 2005 it was in Northampton, Oxford & Banbury, High Wycombe & Aylesbury, Leeds, Middlesbrough, Sunderland, Durham, Norwich, Reading & Newbury, Slough, York, Cambridge, Hull & East Yorkshire. In 2005/ 2006 it was in Northampton, Oxford & Banbury, Manchester South, Wakefield & Huddersfield, Leeds, Durham, Middlesbrough, Sunderland, Barnsley, Doncaster and Rotherham, Sheffield, Chesterfield & Manchester, Hull & East Yorkshire, York, Harrogate & Scarborough. In 2006 -2007 it was in Blackburn, Wakefield & Huddersfield, Leeds, Nottingham, Derby, Wirral & Chester, Durham, Middlesbrough, Barnsley, Doncaster and Rotherham, Sheffield, York, Harrogate & Scarborough. In 2005/06 TLC appeared in the following *BT Phone Books*: Huddersfield, Oxford, Wakefield, Slough, Windsor and Maidenhead, Newbury, Reading, Nottingham, London South West, London South East, Ealing, Bracknell and Ascot, Darlington and the Dales, Leeds, Northumberland, Bradford, Bury St Edmunds, Watford, Durham and Wearside, Halifax, St Albans, Peterborough and Huntingdon, Luton, Sheffield South, Sheffield North, High Wycombe, Northampton, Sutton, Basingstoke, Alton and Farnborough, York, Enfield and Waltham Cross, Barnsley, Wakefield, Slough, Windsor and Maidenhead, Kettering, Nottingham. (Presence in *Yellow Pages* is certainly a form of advertising. It would take a very broad and generous interpretation of the term to consider that a mere entry in a telephone directory can be described as advertising.) A list of “magazines/others” is included in the exhibit in relation to advertising. The details are as follows:

| | |
|--------------------------------|-----------------------------|
| Homebuilding & Renovation Show | May 2006 |
| Ideal Home Show Cheque Book | March 2005 |
| Northside Magazine | February 2006 |
| Northside Magazine | March 2006 |
| Northside Magazine | April 2006 |
| Home Building & Renovation HB | June 2006 |
| Guide to Property Development | 8 June (year not indicated) |
| Homebuilding & Renovation | 11 May (year not indicated) |
| At Home with Kirsty and Phil | March 2007. |

19) Copies of pages from *Yellow Pages* with advertisements for TLC are exhibited at TB4. The pages come from the following editions of *Yellow Pages*:

2007/ 2008

Sheffield
Barnsley, Doncaster & Rotherham
Hull & East Yorkshire

2006/2007

Middlesbrough
Blackburn
Chesterfield & Mansfield
Leeds
Nottingham
Manchester South
York, Harrogate & Scarborough
Sheffield
Barnsley, Doncaster & Rotherham
Hull & East Yorkshire
Derby
Durham
Wirral & Chester
Wakefield & Huddersfield
Sunderland

2005/2006

Reading & Newbury
Manchester South
Cambridge
Oxford & Banbury
Norwich
Slough, Bracknell, Windsor & Maidenhead
Northampton

2004/2005

Cambridge

20) In the earlier advertisements TLC describes its business as being the conversion of modern truss rafter lofts or of modern trussed rafter lofts. In the latest advertisements it describes itself as: "The UK's leading Truss Rafter Loft conversion specialist".

21) The 2004/2005, 2005/2006 and two of the 2006/2007 advertisements follow a similar pattern of printing Truss Loft Conversions Limited, Truss Loft Conversions Ltd, www.trussloft.co.uk and a TLC monogram. In the majority of the 2006/2007 advertisements and in all of the 2007/2008 advertisements, the sign¹ “space” appears, there are references to Truss Loft® Conversions Limited, Truss Loft Conversions, the TLC monogram and the website address. In three of the 2006/2007 advertisements there is reference to Truss Loft® Conversions Limited, Truss Loft Conversions Ltd, the TLC monogram and the website address.

22) Use of truss loft can be seen in various of the advertisements exhibited:

Reading & Newbury 2005/2006 – advertisement from Loft View – “modern truss lofts converted”.

York, Harrogate & Scarborough 2006/2007 - AJR Joinery – Truss Loft Conversion Specialists,

Alpine – truss loft specialists

Sheffield 2006/2007 – Another Level – “timber truss loft conversions”.

Barnsley, Doncaster & Rotherham 2006/2007 – Another Level – “timber truss loft conversions”.

Durham 2006/2007 AARK – “truss loft conversions”

Sheffield 2007/2008 Another level – “specialists in timber truss loft conversions”

Barnsley, Doncaster & Rotherham 2007/2008 – Another Level – “timber truss loft conversions”.

23) Top-Storey advertisements also appear in some of the pages, wherein Top-Storey describes itself as a “truss loft specialist”. In the various advertisements for other loft conversion undertakings that can be seen on the pages there are references to: truss roofs, trussed roofs and truss rafter roofs.

24) TLC’s website was registered in 1999 and has operated since 2000. Mr Benson states that the website receives over 200 on-line estimate and literature requests per month. An article from the website Finance Markets, exhibited at TB6, states that in 2006 126,000 loft conversions were allowed under permitted development in the United Kingdom. The article also states that a one room loft conversion costs in the region of £16,000 whereas two bedrooms and a bathroom will costs around £40,000. If one takes the turnover figure for 2006 – April 2007 of TLC, a period of sixteen months, and looks at the lower end of the cost figure at £20,000, this would give rise to approx 195 conversions over a sixteen month period, or on a pro rata basis 147 conversions in the year 2006, or 1.17% of the market share. I note from exhibit MBa9 to the evidence of Mr Birch that it is estimated that TLC undertakes about 150 conversions a year.

25) Mr Benson states that TLC specialises in the conversion of loft space in buildings with trussed rafter roofs. He states that his company created an innovative design (sic) to remove the trusses and convert the loft space into extra room space. He states that it has provided these services under the sign Trussloft. Mr Benson states that prior to 1995 the

¹ Others might use the term “trade mark” rather than sign.

term trussloft had not been used and that he created the term. Exhibited at TB7 are definitions of truss and loft from the *Oxford Advanced Learner's Dictionary*. In the context of this case the most pertinent definition of truss is: “a frame made of pieces of wood or metal used to support a roof, bridge etc.” In the context of this case the most pertinent definition of loft is: “a space just below the roof of a house, often used for storing things and sometimes made into a room: a loft conversion (= one that has been made into a room or rooms for living in) – compare ATTIC, GARRET.”

26) Mr Benson states that Trussloft is not and never has been an industry recognised term. Exhibited at TB8 and TB9 are pages from the TRADA website. TRADA describes itself as; “The Timber Research and Development Association (TRADA) –is an internationally recognised centre of excellence on the specification and use of timber and wood products”. A search on the TRADA database found no hits for the term Trussloft, however, hits are displayed for the term “trussed rafter”. Exhibited at TB11 and 12 are pages from the TRA (Trussed Rafter Association) website and a copy of a data sheet produced by the organisation. The objective of the TRA is to encourage the use of trussed rafters. The data sheet gives information about loft conversions with trussed rafter roofs. There is no reference to Trussloft in the data sheet. Exhibited at TB13 and TB14 is a page from the website of the NHBC (National House Building Council) and an extract from the roofs section of the NHBC *Good Craftsmanship Guide – Carpentry and Joinery – Carcassing*. The NHBC describes itself as “the standard setting body and leading warranty provider for new and newly converted homes in the UK”. In the guide there are references to trussed rafter roofs and trussed rafter bracing; there are no references to trusslofts. Exhibited at TB15 are extracts from the website of the British Standards Institution (BSI) which refers to a number of publications produced by the BSI which relate to trussed rafter roofs. Mr Benson states that a search for trussloft and truss loft found no hits. Exhibited at TB17 and TB18 are copies of a loft conversion guide and leaflet entitled *Making the Most of Your Loft*, both produced by Velux. Mr Benson states that Velux is the largest manufacturer in the world of roof windows used in new buildings and loft conversions. In the publications there are references to trussed rafter roof construction.

27) Mr Benson exhibits pages from the websites above-it-all.co.uk and restyleloft.co.uk at TB22. He states that a summary of Truss Roofs and loft conversions can be found on these websites and states that there is no reference to Trussloft in a descriptive sense. The pages from the first website are headed Truss Roofs and Lofts, it seems to me that the natural reading of this heading is that the adjective truss is applied to lofts as well as roofs and so this is effectively use of truss lofts. The pages go onto to refer to “trussed loft conversions” and state “[w]e are experienced truss attic and loft conversion specialists”. Unlike Mr Benson I can only read the last statement as use of truss loft as a descriptive term.

28) Mr Benson states that TLC actively seeks to prevent the use of Trussloft by others and states that it has taken successful actions against third party use of Trussloft by Upper Deck Conversions Limited, Top Flight and AJR Joinery Ltd. Documentation in relation to this is exhibited at TB23. From the material it appears that TLC threatened legal

action but that no proceedings were brought in relation to trade mark infringement. The undertaking from Upper Deck Conversions Limited includes the following:

“In consideration of the Company refraining from issuing proceedings against US and applying to the High Court of Justice for an injunction to restrain US from infringing the Company’s common law rights in the “Truss Loft Conversions” and “Truss Loft” trade marks, but acknowledging Our entitlement to use the words: *truss* and/or *trussed loft conversions*, to describe the services offered by Upper Deck Conversions Limited.....”

Taking into account the undertaking as a whole I consider that Upper Deck undertakes not to use truss loft conversion and truss loft as indications of origin but can use these terms to describe the services offered. The undertaking was finalised on 14 April 2004 ie before the date of application for registration of the trade mark.

29) The undertaking from Top Flight includes the agreement to refrain from using truss loft, trussloft, truss lofts, trusslofts, truss rafter loft and any similar signs. However, Top Flight can use the terms trussed rafter roof, truss rafter roof and trussed rafter loft. The undertaking includes reference to an infringement of copyright of a work; this is clearly not relevant to this case.

30) A letter from AJR Joinery, dated 26 April 2007, agrees not to use the term truss loft in future advertising. The writer states:

“Converting this type of loft is very rare for my company accounting for perhaps 5% of all lofts converted.”

So the writer considers truss loft describes a type of loft.

31) Mr Benson responded to the evidence of Mr Birch. Exhibited at MBa3 is a search conducted on yell.com for “truss loft conversions” in the United Kingdom. The search gave rise to 100 hits; it is not indicated if this is because the number of hits to be retrieved was limited to this number. It would appear from the results that a hit would arise not only for truss loft but also for trussed loft, trussed roofs and as the result of other occurrences of the terms. From the printout before me, truss loft appears in the hits for Ray Thorpe & Son, Aztech Building, AARK Loft Conversions and W&M Building Services. Trussed loft appears in two other hits. Only a sample of printouts appear to have been exhibited, only 12 hits being displayed.

32) Mr Birch states:

“For the benefit of someone who is unfamiliar with Loft Conversions, a Loft Conversion to a ‘Rafter and Purlin Roof Construction’ is called a ‘Traditional Loft conversion’ whereas a Loft Conversion to a ‘Trussed Rafter Roof Construction’ is called a ‘Truss Loft Conversion’; therefore resulting in advertising expressions such as ‘Truss Loft Specialists’ or ‘Truss Loft Conversion

Company’, both of which have been used as an advertising description by Mr Benson of Truss Loft Conversions Ltd.”

33) A search was conducted using Google on 16 October 2007 using the search term What is a TRUSS LOFT?. The search was not limited to the United Kingdom. The search term, as with the search term used for interrogating yell.com, suggests that Mr Birch is not au fait with the use of Boolean operators. 191,000 hits are recorded, 10 of these are displayed; 2 of these emanate from TLC’s website and one refers back to TLC, 2 of the hits are from the above-it-all website (see above). The two last hits refer, inter alia, to truss roof loft conversions, trussed loft conversions and truss roof attic conversions. A hit from room-maker.co.uk refers to truss loft conversion.

34) Exhibited at MBa5 are pages from the website of The Construction Centre, downloaded on 8 October 2007. There is a reference to TLC on this website, which is described as “specialists in truss loft conversions”. Pages downloaded from the website of Room Maker Loft Conversions on 8 October 2007 are exhibited at MBa7 and MBa8; these show that the undertaking is offering a truss loft conversion service. Pages from the website show how the undertaking goes about effecting a truss loft conversion. At exhibit MBa11 there is a page downloaded from the website of TeleBeam, who supply a loft conversion and flooring system, primarily designed for modern roof trusses. The headline on the page is “Think a truss loft can’t be converted easily?”. A page from the website of T E Robson, downloaded on 8 October 2007, is exhibited at MBa12; this refers to “traditional and truss lofts”. Pages from the website of Walton Building & Restoration, downloaded on 8 October 2007, are exhibited at MBa13; these refer to truss loft conversions. Exhibited at MBa14 are pages from the website of Building Alternatives Inc, downloaded on 8 October 2007; the pages are a form of questionnaire, one of the boxes to be ticked is to identify whether the property has a “truss loft roof”. From the terminology used in the pages of the website this would appear to be of United States origin.

35) Exhibited at MBa15 – MBa21 are pages downloaded from various United States websites in October 2007 where there are references to truss lofts or trusslofts. Several of these pages relate to dealing with fires in truss lofts. In the pages downloaded from firechief.com the following appears:

“In the older frame buildings that use conventional lumber, fire that runs into the void spaces is usually contained between the floor joists or wall studs at first. A room-and-contents fire that extends through the ceiling and into a floor bay will burn horizontally along that bay but be contained between the two floor joists. In newer lightweight-truss buildings, however, there’s nothing in the truss loft to limit horizontal fire spread except the outside walls. A fire that gets above or through the sheetrock protective envelope will spread unchecked throughout the loft.”

At exhibits MBa20 and MBa21, pictures of a truss loft (trussloft) or truss void can be seen. Exhibited at MBa22 are quotations from various publications relating to fire

fighting. There is no provenance given to the publications but they would appear to emanate from the United States, owing to the Americanisms and spelling. In these quotations there are various references to truss loft and trussloft.

36) Mr Birch states that he has used the term truss loft since the mid 1980s and that he has sub-contracted with various loft conversion companies including Elite Econoloft, which he describes as the biggest and longest established national loft conversion company. A letter is exhibited at MBa24 from Mr J McKay, who was contracts manager with Elite Econoloft in the late 1970s and early 1980s. He is now the company director of Design A Loft, which was established in 1991. In his letter Mr McKay writes:

“In the early 80’s as the first loft conversion businesses became established, a loft conversion in a modern house was referred to and still is referred to as a truss loft in both sales and construction departments.”

Mr McKay goes on to state:

“This is a clear general term used throughout the country and has been recognised in the loft conversion industry over this period.

In my opinion this descriptive reference should never have been issued as a company name by the Trade Mark Office.

If the company *Truss Loft Conversions Ltd* ever attempts to enforce trading restrictions on our business when converting any type of loft whether it be a truss loft or traditional loft we will immediately file for deregistration of the Trade Mark. If I am made aware that this company is trading in Greater Manchester or Cheshire and informs customers that they invented the construction system or the truss loft term I will proceed with deregistration of the Trade Mark.

Please feel free to pass on my credentials to the Trade Mark Office as I feel strongly that this Trade Mark should never have been issued.”

Exhibited at MBa26 is a letter from the company secretary of Elite Econoloft. The following is written in the letter:

“Econoloft is the longest established loft conversion specialist in the UK (established 1986) and are the national market leaders trading at this time. Econoloft convert more lofts than any other company in the UK.

We have specialised in truss loft conversions throughout our trading history in addition to traditional loft conversions.

Econoloft refer to a loft conversion in a truss rafter roof as a truss loft conversion.”

(There is a disparity between the letters of Mr McKay and that of the company secretary of Elite Econoloft, as the latter states that the company was established in 1986.)

37) Emails were sent to Skyline Loft Conversions, Cleveland Fire Brigade, London Building Control Ltd and OnSite Building Control asking them to state what they understood the term truss loft to mean and if they regard it as a common and generic description of a type of loft construction. The responses are exhibited at MBa28. In its response Skyline states:

“It is possible to do a conversion on a standard trussed roof by removing the central web (a truss loft).”

The Cleveland Fire Brigade wrote back to state that it was only known as a type of loft conversion. London Building Control Ltd stated that:

“a truss loft may be a manufactured truss roof designed so there is a loft space (i.e. without joists within the central area).”

OnSite Building Control simply confirmed that truss and loft are both commonly used construction terms.

38) The material exhibited at MBa24, MBa26 and MBa28, having been solicited for these proceedings, should have been in the form of witness statements (or affidavit or statutory declaration.) As Top-Storey does not have legal representation this failing is not surprising; indeed, it occurs where there has been legal representation. However, in the form that it is presented I must consider it on the basis that it is hearsay evidence and attribute to it the weight that I consider appropriate, taking into account the nature of the responses and the respondents and considering it in the context of other evidence in the case.

39) Mr Birch was cross-examined. I found Mr Birch an honest, straightforward and intelligent witness.

40) Mr Brandreth commented upon the cluster of use of the term truss loft, being around the area served by TLC. He submitted that the undertakings were trying to take advantage of the goodwill and reputation of TLC rather than use the term truss loft as a generic or descriptive term. In the advertisements the term truss loft is clearly used as a description of a type of work, it cannot be seen as indicating the services of one undertaking^{vi}. The alternative to Mr Brandreth’s parasitism argument is that the term is simply one that the trade uses and has used for some time. This is a position that is supported by the nature of the advertisements.

41) Mr Brandreth appeared to see some significance in the fact that the extracts from *Yellow Pages* that Mr Birch submitted emanated from the North East of England. Mr Birch gave a simple explanation for the provenance of the extracts; they came from the *Yellow Pages* that were in the office of Top-Storey; as Top-Storey is based in Stockton-

on-Tees it is without surprise that copies of *Yellow Pages* from the North East would be in the office. In Mr Benson's evidence based upon *Yellow Pages*, as per TB3, he has relied upon the volumes within which TLC has advertised, not all the *Yellow Pages* of the United Kingdom. So his system of accrual of information is effectively the same as that of Mr Benson.

42) The clustering/parasitism argument also has the flaw that even in the limited evidence there are examples of undertakings from outside the area using the term truss loft. Loft View of Reading advertises "Modern Truss Lofts Converted". Room Maker Loft Conversions has a Bournemouth telephone code and a recommendation from a customer in Dorset. The pages from the Internet exhibited at MBa6 show that the undertaking works in Dorset and surrounding counties. The pages exhibited at MBa7 and MBa8 from the website of Room Maker Loft Conversions show that it devotes a section of its website specifically to truss loft conversions. There is no doubt that this term is used descriptively/generically and the undertaking is well outside of the orbit of TLC's advertising. It is difficult to see how the page exhibited at MBa11 can be an example of parasitism as TeleBeam is not in the loft conversion business but supplies the products to convert lofts.

43) Mr Brandreth commented upon the advertisement exhibited at TB24 . He considered that this showed the parasitism of Top-Storey. To Mr Brandreth it was significant that truss loft was prominent in the advertisement rather than the name of the company. Mr Birch explained that the advertisement was withdrawn by Top-Storey, effectively, because it did not want the hassle that it was getting from Mr Benson. He explained that in advertising in *Yellow Pages* it was of primary importance to show the nature of the work that an undertaking did rather than the name of the undertaking. I cannot see that Mr Birch can be faulted in his logic. After all *Yellow Pages* is divided up by trade, not by name. My own experience confirms what Mr Birch said. If I am looking for a tradesman I look in the appropriate section of *Yellow Pages*; I then identify the tradesmen that I will contact for estimates/quotations by reference to the type of work that it is indicated that they do. The name of the tradesman is important only as an identifier of whom I have contacted. If I am satisfied with the work of a tradesman and would like him to do further work then I will identify him by name using the ordinary telephone directory, not *Yellow Pages*. The various pages exhibited from *Yellow Pages* show that in many advertisements the name of the undertaking has very much a subsidiary role. Mr Birch also stated under oath that until Mr Benson contacted him about the advertisement the former did not know of the latter's business.

44) Mr Brandreth attempted to equate the advertising on Yell.com with advertising in *Yellow Pages*. It is my understanding that although both means of advertising are owned by the same undertaking their businesses are separate and an advertisement in *Yellow Pages* does not give rise to an advertisement in Yell.com. Consequently, a search on Yell.com does not tell one what can be found in *Yellow Pages*, of course, an undertaking may wish to advertise using both media. It is difficult to draw sound conclusions from the evidence exhibited, one way or the other, from Yell.com at MBa3 as it appears that

the search has been limited to the first 100 results and only twelve hits from the search have been exhibited.

45) Mr Brandreth raised the issue as to Mr Benson commenting in his evidence that there was no indication of the number of emails that were sent by Top-Storey and the geographical spread of those e-mails. In the evidence in reply, at paragraph 18, Mr Birch specifically identified the persons to whom he had sent e-mails which he exhibits at MBa28 and so at least the full gamut of the e-mails filed in the evidence in reply is displayed. Mr Brandreth submitted that some of the responses to the e-mails did not support the case of Top-Storey. As Mr Birch reasonably pointed out it seemed odd to suggest at one instance that some of the e-mails had been suppressed and that at the next that some of them did not support the case of Top-Storey. Surely if e-mails were to be suppressed they would be the ones that did not support the case of Top-Storey? In his evidence in reply Mr Birch explains that the recipients of the e-mails were chosen to give a geographical spread to answer the comment of Mr Benson in his evidence that there was no indication of the geographical location of the recipients of the e-mails. Of itself the responses to the e-mails would certainly not be damning but they are part of the warp and weave of the material that Mr Birch has produced. It is clear that the majority of the recipients knew what was meant by the term truss loft, it neither bemused nor befuddled them. The majority of the respondents referred to truss roofs, Ms Cuthbert stated that Coastal Conversions could convert truss lofts.

46) In his evidence Mr Benson made reference to Econoloft as the country's leading national loft experts and that they had been in the industry for over thirty years. Pages from the website were exhibited, at TB21, which show use of truss rafter lofts rather than the phrase truss loft. In response to this Mr Birch contacted Econoloft and Mr McKay who had been the contracts manager of Elite Econoloft. Under cross-examination Mr Birch stated that he had specifically sought someone from Econoloft who could advise what the position was in earlier days. Mr McKay made a clear statement in his letter:

“In the early 80's as the first loft conversion businesses became established, a loft conversion in a modern house was referred to and still is referred to as a truss loft in both sales and construction departments.”

The company secretary of Elite Econoloft stated:

“Econoloft is the longest established loft conversion specialist in the UK (established 1986) and are the national market leaders trading at this time. Econoloft convert more lofts than any other company in the UK.

We have specialised in truss loft conversions throughout our trading history in addition to traditional loft conversions.

Econoloft refer to a loft conversion in a truss rafter roof as a truss loft conversion.”

Mr Brandreth attacked these letters. He considered that the contents of Mr McKay's letter are very convenient for Top-Storey; the contents are certainly inconvenient for Mr Benson. Mr Brandreth suggested that there had been conversations with Mr McKay between the letter of enquiry from Mr Birch of 15 October 2007 and the reply of Mr McKay of 18 October 2007. Mr Birch did not know of any such conversations. Mr Brandreth considered that the letter was suspicious as it was headed "to whom it may concern" rather than to Mr Birch. I can see nothing suspicious in this heading, especially as in his letter Mr Birch stated that he was compiling evidence to verify that truss loft was a commonly used term for a lengthy period of time. Mr McKay made it clear in his letter that for the purposes of his own business he considers that the term truss loft needs to be kept free. I cannot see that the contents of the letter are less believable because of the frank and open comments of Mr McKay. Mr Brandreth referred to the letter from the company secretary of Econoloft as being purportedly from Econoloft. I can see nothing purported about it. Of course, the two letters in relation to the Econoloft business represent hearsay evidence, not being witness statements. I consider that they are useful in considering the matters before me within the context of the evidence as a whole. Mr Benson referred to Econoloft. Mr Birch reacted by seeking the views of a previous employee of the undertaking and a current officer of the undertaking. This seems to me to be an eminently reasonable and sensible way to behave; that the individuals did not give evidence by way of witness statement is likely to have arisen from Mr Birch not having legal representation rather than any cunning plan. I would emphasise that I found Mr Birch a straightforward, honest and intelligent witness. Mr Benson could have countered the matter by contacting Econoloft; he had the benefit of legal representation; it would have been a simple enough exercise to undertake and such evidence would have demanded admission into the proceedings.

47) Mr Birch clearly stated under cross-examination that at the date of the filing of the application for registration of the trade mark the term truss loft was commonly used in the loft conversion trade.

48) Mr Brandreth attacked the evidence of Mr Birch for what was not there. Mr Birch commented that he considered that the evidence that he had furnished was so damning that he did not consider that it was necessary to file anything more. Indeed, TLC's own use of the term in question was damning in itself. If one was looking for absences in the evidence one could also take note of what was absent from the evidence of Mr Benson ie actual statements from the trade (although, of course, the burden is upon the applicant and not the registered proprietor).

49) Mr Brandreth in his skeleton argument states that there is no example of the trade mark being used in a descriptive fashion and that the registered proprietor has never done so. The only basis of this claim that I can see is if Mr Brandreth is splitting the finest of hairs with an electron microscope by making an effective distinction between the use of the trade mark Trussloft and the words truss loft. He referred to whether TLC had used the term in an "arguably" descriptive manner, in the face of the evidence I cannot see that these positions of Mr Brandreth have any substance. No explanation has been given to why truss loft has been used in a descriptive/generic manner by TLC if the term is not

descriptive/generic. Nothing that Mr Brandreth said gainsaid the fact of the nature of the usage by TLC, as shown at exhibits MB4 and MB5. The banner of TLC's website describes Trust Loft Conversions as the "The UK's Only National Truss Loft Company". The description of the nature of TLC can only have meaning if truss loft is a term that has meaning. Mr Brandreth argued that this was used in relation to other matter and the banner was changed; apparently on 7 September 2007 after the evidence of Mr Birch identified the use. In the advertisements exhibited at MB5 TLC advises that it has a "unique system to convert your truss lofts". Yet Mr Brandreth states that truss loft is not a term that has meaning and the use by other undertakings is parasitic behaviour. These advertisements refer to TLC as being nationwide truss loft specialists. One is left with the question as to how one advertises a service, in which one describes oneself as a specialist, if the wording has no meaning. In relation to the pages from the Internet, downloaded on 8 October 2007, exhibited at MBa5, Mr Brandreth stated that the reference to TLC was a form of advertisement. I cannot see how this benefits Mr Benson's case as the logical sequitur of this is that TLC decided to advertise themselves as being "[s]pecialists in truss loft conversions". So TLC specifically describes its business by reference to the term truss loft; if this term does not have meaning the purpose of the advertisement is nullified. It is reasonable to assume that TLC was responsible for the copy of the advertisement.

50) Exhibited at TB22, by Mr Benson, are pages from the above-it-all.co.uk website. This is exhibited to show that truss loft is not a term that is descriptive/generic. As I have indicated above, it seems to me that in the ordinary reading of the heading to the pages "Truss Roofs and Lofts" the truss describes the lofts as well as the roofs. The pages state "[w]e are experienced truss attic and loft conversion specialists"; I find it difficult to see how truss cannot be seen as describing both an attic and a loft; especially when further on the following is written "[m]aking the most of your truss loft or attic". I consider that the meaning is clear, if not convenient to the case of Mr Benson.

51) I consider that it is instructive to read the undertakings that Mr Benson has required of other undertakings. The undertaking exhibited at TB23 is from Upper Deck Conversions Limited. The undertaking specifically refers to desisting from the use of Truss Loft Conversion and Truss Loft as a "name, mark or brand", not from use as a term to describe the services of the undertaking. In particular the undertaking states:

"In consideration of the Company refraining from issuing proceedings against US and applying to the High Court of Justice for an injunction to restrain US from infringing the Company's common law rights in the "Truss Loft Conversions" and "Truss Loft" trade marks, but acknowledging Our entitlement to use the words: *truss* and/or *trussed loft conversions*, to describe the services offered by Upper Deck Conversions Limited...."

I consider that a normal reading of the above is that Upper Deck can use the terms truss loft conversions or trussed loft conversions to describe its services, taking both the wording in the paragraph above and the rest of the undertaking I do not see that the undertaking can be read in another fashion. So TLC accepts that Upper Deck can use the

terms *truss* and/or *trussed loft conversions* to describe its services. **It is to be noted that this undertaking emanates from 14 April 2004 ie before the date of application.** Mr Brandreth made much of the absence of contemporaneous documentation supporting the case of Mr Birch; I consider that in any fair reading of the undertaking that this is documentation emanating from prior to the date of application which shows that truss loft is a descriptive/generic term.

52) The undertaking from Top Flight requires it to refrain from using the term truss rafter loft. However, this is the term that TLC regularly uses to describe its business in a descriptive/generic term. Mr Benson in his evidence shows a reference to the term truss rafter loft from the Econoloft website, TB21. Restyle (see below) also use this term. So in the case of Top Flight, TLC required an undertaking to refrain from using a term that it uses descriptively/generically and which Econoloft and Restyle also use in such a manner. This behaviour is not in any way determinative of the issues before me but does indicate that in another area TLC has blurred the divisions between the descriptive/generic and that which indicates origin.

53) The websites of TRADA, TRA, NHBC, BSI, Velux and Econoloft were interrogated. It was considered of significance that no reference was found on the websites to the word Trussloft. I cannot see that the absence of hits for Trussloft necessarily tells one anything other than this is not a term on the website. It is not argued by Top-Storey that everyone uses the term truss loft. In relation to the business of Velux I cannot see that it is relevant whether the loft was of a modern or a traditional format. The further enquiries of Mr Birch have given rise to letters from a past employee and a present officer of Econoloft stating that truss loft is a term that Econoloft use. (Mr Brandreth considers that I should give no weight to these letters.) The one thing that Mr Benson has not done is to go directly to trade bodies and directly ask if truss loft or Trussloft are terms in use; so the interrogations of the websites of TRADA, TRA, NHBC and BSI just tell me what is on the website, not what is in the knowledge of these organisations. I would also note that none of these bodies is actually in the business of loft conversion although two of them are associations for undertakings which supply goods to the trade. (Of course, TeleBeam who supply goods to the trade do use the term truss loft.)

54) Mr Benson exhibits copies of letters from home owners and considers that conclusions should be drawn from the use of Truss Loft to identify TLC and the work carried out is identified by reference to loft conversion or conversion. Owing to the company name of TLC it is hardly surprising that the customers describe TLC as Trust Loft or Trust Loft Conversions. (If the company name was Loft Conversions Ltd, it is likely that a customer would refer to it as Loft Conversions.) By referring to the work completed as a loft conversion the customer is using an easy form of reference. I do not consider that the usage in the letters, taking into account the other evidence of the case, can be in anyway determinative of whether trust loft is a descriptive/generic term. It certainly does not indicate what the trade would know.

55) The majority of the advertisements from *Yellow Pages* exhibited at TB4 do not distinguish between conventional and modern loft construction so in those advertisements

no terminology can be used in relation to modern loft conversion and so the fact that only a small number of the advertisements refer to truss lofts is inevitable. In the advertisements TLC advises that part of its work is the conversion of modern truss rafter lofts. The advertisements that do identify the different type of loft/roof construction are identified below:

Loft View of Reading advertises “Modern Truss Lofts Converted”

Loft-Tec refers to modern trussed roof conversion.

Cavendish Conversions refer to modern and traditional roofs.

Econoloft states trussed roofs are converted and gang nailed trusses.

Classic Lofts refers to specialising in truss roofs.

Xtraroom advertise that it is an expert in truss roof conversions.

The Loft Conversion Company advises that it undertakes conversions of cut and trussed roofs.

Acorn advises that it deals with trussed roof conversions.

Loftstyle advises that it undertakes trussed roof conversions.

Another Level in one advertisement advises that it undertakes work on “[m]odern truss lofts and older traditional lofts” and in another that it is a specialist in timber truss loft conversions.

Loft Conversions North East refer to Velux, Dormer and Truss roofs.

Top-Storey describes itself as a truss loft specialist.

Lofts Direct advertises that it is a truss roof specialist.

Loft Wizard states that it is a truss roof design specialist.

Through The Roof describes itself as being a truss roof specialist.

Roof Rooms advertises that it undertakes truss roof conversions.

The Loft Exchange refers to being a specialist in truss roofs.

Attica states that it converts traditional and truss roofs.

Air Joinery states that it is a specialist in traditional and truss loft conversions.

Alpine describes itself as a truss loft specialist.

Restyle refers to modern truss rafter roofs and traditional style rafter roofs and to modern truss rafter lofts.

G Foulstone refers to modern and traditional roofs.

RJH state that are experts in truss roofs.

AARK advertises that it undertakes truss loft conversions.

A Charlton advises that it undertakes conversion of new truss rafter and old traditional roofs.

Creative Loft Conversions advises that it undertakes work in new homes with truss roofs.

P Denison advises that it undertakes loft conversions in truss roofs.

Mick McAllister undertakes modern roof truss work.

Cedar Lofts describes itself as an expert in truss roof conversions.

Excluding the protagonists in this case there are advertisements from 29 undertakings who refer to conversion work of lofts in modern roofs; 5 of these use the term truss loft, I cannot see how any of the usage can be viewed other than as descriptive/generic. So in 17.24% of cases where the advertisement does make a reference to this type of conversion the term truss loft is used. (Of course, the selection of extracts from *Yellow*

Pages is not of itself statistically valid, representing where TLC advertises. There are, of course, examples of other use of truss loft as shown in the evidence of Top-Storey.) (Econoloft does not use truss loft in its advertisement but there is further evidence from both sides re Econoloft usage.) The following terms are used in the advertisements: modern trussed roof, modern roof, trussed roofs, gang nailed trusses, truss roof, truss rafter roofs and modern roof truss work. Truss roof is the most popular description used. In this type of advertisement there is only one example of a description of a loft rather than a roof, that of Restyle. So one does not get a picture of how the actual loft is described in these advertisements. If one takes only the examples of where there is a reference to a loft and modern roof construction in five examples out of six the term truss loft is used, or 83% of the time. So I cannot see that the advertisements in *Yellow Pages* substantiate the claims of Mr Benson in relation to the use of truss loft; the facts are against him when one actually looks for a description of a loft conversion in a modern roof.

56) Mr Brandreth questioned Mr Birch about one of the advertisements of Top-Story that appeared in *Yellow Pages* for Sunderland in 2004/2005. The tack of the questions was that owing to the prominence of Truss Loft Conversions in the advertisement that this was trying to trade off the reputation of TLC. Mr Birch explained that the advertisement was primarily to advertise the nature of the business and give the contact details. It is to be noted from the various copies of advertisements that this is a common practice in the advertisements in this publication, the name of the business being subservient to the details of what service is being offered. This is, of course, the purpose of *Yellow Pages*, to advise the potential customer of the services that are being offered and to give contact details. I certainly see nothing in the advertisement, or in the replies of Mr Birch, to suggest that truss loft was intended to be seen as anything other than a descriptive/generic term. Top-Storey's name and website address are given to identify the business. That particular advertisement was not continued with and from the evidence of later advertisements Top-Storey added the wording "TRUSS LOFT SPECIALIST" to its existing advertisements, which were of a different format. However, I can see, owing to the nature of the signs used by TLC, why it could have been concerned by the advertisement. From the replies of Mr Birch it was clear that the advertisement was not persisted with as he did not want the hassle arising from it.

Decision

57) The elephant in the room in this case is the use by TLC of the term truss loft in *Yellow Pages* and on its website in a descriptive/generic fashion. TLC has used truss loft to describe a type of loft that it converts; it has not been explained as to how this descriptive/generic use can be squared with the claim that the term is not descriptive/generic. Mr Benson makes no statement as to when TLC began using truss loft in a descriptive/generic fashion, he is silent as to how if truss loft is not a descriptive/generic term it can serve any purpose in the advertisements and web banner of TLC where it is clearly being used in this fashion. The burden of proof is on Top-Storey, however, once the nature of the use by TLC was shown it is reasonable to expect an explanation in relation to the use. Stating that the use was with other origin indicative

material or that a particular use was withdrawn, well into the proceedings and after having been exposed by Mr Birch, tells one nothing. The only salvation that Mr Benson can look for in relation to this point is if it is decided that it is not established that the term was descriptive/generic at the date of application, or that there is a significant difference between truss loft and Trussloft or that the term is not descriptive/generic in respect of the particular services of the registration.

58) Mr Brandreth accepted that if the term was descriptive/generic for a type of loft conversion it would catch the services of TLC. In relation to section 3(1)(c) of the Act this must be the case, as the services are clearly directly ancillary to the conversion of lofts. The ECJ in *Koninklijke KPN Nederland NV v Benelux Merkenbureau* Case C-363/99 stated:

“102. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 3(1)(c) of the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially.”

(Article 3(1)(c) of the Directive is the equivalent of section 3(1)(c) of the Act.) It seems to me that the same logic must equally apply, at least in this case where the services are directly linked and essential to loft conversion, in relation to section 3(1)(d) of the Act.

59) Mr Brandreth asked Mr Birch if the trade mark had any meaning, ie the words truss and loft conjoined rather than separate. Mr Birch responded that it did not. This is a simple statement that the trade does not use the two words in a conjoined form; Mr Birch was not abrogating the basis of the grounds of invalidation made by Top-Storey and it is for me to decide if this conjoining has an effect upon the grounds of opposition. In *Koninklijke KPN Nederland NV v Benelux Merkenbureau* the ECJ stated:

“98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.”

In this case the argument of Top-Storey is not that each of the elements is descriptive of the services but that the whole is a term used in the trade. The joining of the two words has not led to the two elements losing their combined meaning, if they have such a meaning; the conjoining of the two words has not created a new whole which differs in

effect. On the same basis I cannot see that the objection under section 3(1)(d) can fall simply because of the conjoining of the words; otherwise the argument would be that by conjoining words that are used in the trade one could per se create a registrable trade mark. (There may be circumstances when such a conjoining would have an effect, this is not the case here.) So the conjoining of the two words does not have an effect.

60) Mr Brandreth argued that there is no contemporaneous documentary evidence to show that truss loft was a generic/descriptive term at the date of application. In my view this is wrong; there is the undertaking from Upper Deck Conversions Limited, which was furnished by Mr Benson. Mr Brandreth disagreed with my understanding of the undertaking but taking the undertaking as a whole I cannot see that his view is correct. However, outside of this there is other evidence from after the date of application; evidence that can be taken into account (see paragraph 10). There is the use by TLC of the term truss loft in a clearly descriptive/generic form; a use for which there has been no explanation. Was there some date when the term took on a descriptive/generic characteristic? Mr Benson has not argued this, he has not put any evidence in relation to this, instead he has chosen to effectively ignore TLC's own use of truss loft in a generic/descriptive fashion. Mr Birch stated, under oath that at the time of the application, truss loft was a generic term. There are the letters from Mr McKay and Econoloft to this effect. Mr Brandreth submitted that no weight should be given to this hearsay evidence but he gave no persuasive reasons for adopting such an approach. There is the evidence of others who, after the material date, were using the term truss loft in a clearly descriptive manner. Mr Brandreth argued that this use formed a parasitic cluster. However, his argument was based on not taking into account the nature of the use and the use in Reading and Dorset. To add to this pot, if only as light seasoning, is the attitude of TLC to use of the term truss rafter loft; a term that the evidence indicates is descriptive/generic but which it insisted that Top Flight should refrain from using. Mr Brandreth considered that it was significant that there was no use of truss loft on the TRADA, TRA NHBC and Velux websites. I have dealt with this matter above. However, it is also necessary to take into account that the interrogation of these websites was well after the date of application; at a time when a number of other undertakings were clearly using truss loft in a descriptive/generic manner. So there is co-contemporaneous evidence of the use of the term in a descriptive/generic manner at the same time as the negative results from these websites were obtained and so what little potential relevance arises from the negative results is further dissipated. **Taking into account all these factors, I find that at the date of application truss loft was a generic term that described a type of loft.**

Relevant public

61) Mr Birch stated in his evidence that some loft conversions were put out to sub-contracting. This evidence was not challenged. So one group of relevant consumers will be others involved in the loft conversion trade. I consider that the average, relevant consumer in the loft conversion business will be aware of the term truss loft. Another group of relevant consumers will be the public at large who purchase the services of a loft conversion company. I think it unlikely that this relevant public would, prior to the

consideration of converting a loft, be aware if their property had a truss loft or not. However, as Mr Birch stated under cross-examination this public will become aware of the term when it makes enquiries about the conversion of a loft. It is normal in relation to such services as loft conversion that several quotations are requested so, assuming that the person seeking the conversion has a truss loft, this relevant public will be educated in the process of seeking a quotation as to the existence and meaning of the term truss loft. Consequently, I consider that both relevant publics will be aware of the term, one from the beginning, the other by the education of the quotation process.

Section 3(1)(d) of the Act

62) In *Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-322/03 the CFI stated:

“49 Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50 With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51 Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52 Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

(Article 7(1)(d) is the equivalent of section 3(1)(d) of the Act.) **I consider that the term truss loft is customary in the current language of the trade and was so at the date of application and so registration of the trade mark was contrary to section 3(1)(d) of the Act.**

Section 3(1)(c) of the Act

63) In *MacLean-Fogg Co v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-339/05 the CFI stated:

“26 Article 7(1)(c) of Regulation No 40/94 provides that ‘trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’ are not to be registered. Furthermore, Article 7(2) of Regulation No 40/94 provides that Article 7(1) ‘shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.

27 According to case-law, Article 7(1)(c) of Regulation No 40/94 prevents the signs or indications referred to therein from being reserved to one undertaking alone because they have been registered as trade marks. That provision thus pursues an aim in the public interest, which requires that such signs or indications may be freely used by all (Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 31; Case T-219/00 *Ellos v OHIM (ELLOS)* [2002] ECR II-753, paragraph 27; Case T-348/02 *Quick v OHIM (Quick)* [2003] ECR II-5071, paragraph 27; and Case T-316/03 *Münchener Rückversicherungs-Gesellschaft v OHIM (MunichFinancialServices)* [2005] ECR II-1951, paragraph 25; see also, by analogy, *Windsurfing Chiemsee*, cited in paragraph 13 above, paragraph 25; *Koninklijke KPN Nederland*, cited in paragraph 13 above, paragraphs 54 and 95; and *Campina Melkunie*, cited in paragraph 13 above, paragraph 35).

28 Furthermore, signs or indications which may serve, in trade, to designate characteristics of the goods or service in respect of which registration is sought are, by virtue of Article 7(1)(c) of Regulation No 40/94, regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or service, thus enabling the consumer who acquired the goods or service designated by the mark to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (*OHIM v Wrigley*, cited in paragraph 27 above, paragraph 30, and *ELLOS*, cited in paragraph 27 above, paragraph 28).

29 Consequently, for a sign to fall within the scope of the prohibition in that provision, it must suggest a sufficiently direct and concrete link to the goods or services in question to enable the public concerned immediately, and without further thought, to perceive a description of the goods and services in question or

of one of their characteristics (Case T-106/00 *Streamserve v OHIM (STREAMSERVE)* [2002] ECR II-723, paragraph 40, upheld on appeal by order of 5 February 2004 in Case C-150/02 P *Streamserve v OHIM* [2004] ECR I-1461; and *PAPERLAB*, cited in paragraph 25 above, paragraph 25).

30 For a trade mark which consists of a neologism or a word produced by a combination of elements to be regarded as descriptive within the meaning of Article 7(1)(c) of Regulation No 40/94, it is not sufficient that each of its components may be found to be descriptive. The word or neologism itself must be found to be so (*SnTEM*, *SnPUR*, *SnMIX*, cited in paragraph 18 above, paragraph 31, and *PAPERLAB*, cited in paragraph 25 above, paragraph 26; see also, by analogy, *KoninklijkeKPN Nederland*, cited in paragraph 13 above, paragraph 96, and *Campina Melkunie*, cited in paragraph 13 above, paragraph 37).

31 A trade mark consisting of a neologism or a word composed of elements each of which is descriptive of characteristics of the goods or services in respect of which registration is sought is itself descriptive of the characteristics of those goods or services for the purposes of Article 7(1)(c) of Regulation No 40/94, unless there is a perceptible difference between the neologism or the word and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the neologism or word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts (*SnTEM*, *SnPUR*, *SnMIX*, cited in paragraph 18 above, paragraph 32, and *PAPERLAB*, cited in paragraph 25 above, paragraph 27; see also, by analogy, *KoninklijkeKPN Nederland*, cited in paragraph 13 above, paragraph 100, and *Campina Melkunie*, cited in paragraph 13 above, paragraph 41). In that connection, an analysis of the term in question in the light of the relevant lexical and grammatical rules is also useful (see *PAPERLAB*, cited in paragraph 25 above, paragraph 27, and the case-law cited).

32 The assessment of the descriptiveness of a sign may only be assessed, first, in relation to the understanding of the sign by the relevant public and, second, in relation to the goods or services concerned (*EUROCOOL*, cited in paragraph 13 above, paragraph 38, and *MunichFinancialServices*, cited in paragraph 27 above, paragraph 26).”

64) It is inevitable from my findings under section 3(1)(d) of the Act that the trade mark will be seen by the relevant publics, in relation to the services of the registration, as descriptive of such services in relation to truss lofts. **Consequently, registration of the trade mark was contrary to section 3(1)(c) of the Act.**

Need to leave free

65) This is a case where both the customs of the trade and the actions of TLC demonstrate that there is an overriding requirement to leave the sign Trussloft free.

Clearly the registration of the trade mark has fettered and hampered honest traders in legitimate descriptions of their trade. This is an example where registration has enclosed part of the great common of the English language and there is a clear need to declare the enclosure illegitimate.

Section 3(1)(b) of the Act

66) In *Koninklijke KPN Nederland NV v Benelux Merkenbureau* the ECJ stated:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

(Article 3(1)(b) of the Directive is the equivalent of section 3(1)(b) of the Act.) As I have found that registration of the trade mark was contrary to section 3(1)(c) of the Act I must find that it was also contrary to section 3(1)(b) of the Act.

Alternative considerations under sections 3(1)(c) of the Act

67) In the event that I am wrong in relation to my finding that the term truss loft was generic at the date of the application I will consider if the trade mark was still incorrectly registered.

68) The evidence shows a variety of terms used in relation to the modern type of roof construction and the lofts in such a roof: truss rafter lofts, trussed roofs, truss roofs, truss roof houses, trussed rafter lofts. The common element is truss and trussed. In the responses to the e-mails sent by Top-Storey it is clear that what was meant by truss loft was understood. The evidence from the United States has very little weight as American English often uses terms that are not used or understood in the United Kingdom and also the type of loft being described is different to the modern loft in the United Kingdom. However, this United States use of truss loft does show that it is a term that readily lends itself to being created.

69) A trade mark can have an evocative effect that can preclude it from registration; in *Eurohypo AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-439/04 the CFI stated.

“In that connection, the applicant’s argument, that the word most frequently used to designate a charge *in rem* encumbering real property is ‘Grundschuld’, is irrelevant, as it does not prevent ‘hypo’ from evoking a ‘hypothek’ for the average German-speaking consumer.”

(In this case, on appeal, the ECJ held that the CFI had applied the incorrect criteria in relation to Article 7(1)(b) but still decided that registration would be contrary to that part of the regulation. In its decision, *Eurohypo AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-304/06 P, the ECJ stated:

“69 As OHIM correctly stated in the contested decision, the relevant public, in the field covered by the trade mark application, understand the word sign EUROHYPO as referring, as a whole and in general, to financial services requiring real securities and, in particular, to mortgage loans paid in the currency of the European Economic and Monetary Union. Furthermore, there is no additional element which would allow the view to be reached that the combination, created by the current and usual components EURO and HYPO, is unusual or might have its own meaning which, in the perception of the relevant public, distinguishes the services offered by the appellant from those of a different commercial origin. Therefore, the relevant public perceives the trade mark in question as providing details of the type of services which it designates and not as indicating the origin of those services.”)

70) In his submissions Mr Brandreth sought succour from *Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) v Celltech R&D Ltd* Case C-273/05 P. He referred to paragraph the ECJ stated:

“76 In order for a mark consisting of a word produced by a combination of elements, such as the mark applied for, to be regarded as descriptive for the purposes of Article 7(1)(c) of Regulation No 40/94, it is not sufficient that each of its components may be found to be descriptive. The word itself must be found to be descriptive (see, in respect of Article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), a provision identical, in essence, to Article 7(1)(c) of Regulation No 40/94, *Koninklijke KPN Nederland*, paragraph 96, and Case C-265/00 *Campina Melkunie* [2004] ECR I-1699, paragraph 37).

77 As OHIM pointed out, it follows from the Court’s case-law that, as a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 7(1)(c) of Regulation 40/94 (*Koninklijke KPN Nederland*, paragraph 98, and *Campina Melkunie*, paragraph 39).

78 However, the Court added that such a combination may not be descriptive, within the meaning of that provision, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements (*Koninklijke KPN Nederland*, paragraph 99, and *Campina Melkunie*, paragraph 40).

79 Accordingly, whilst, as regards a trade mark comprising words, its distinctive character may be assessed, in part, in relation to each of its elements, taken separately, it must, in any event, depend on an appraisal of the whole which they comprise (see, by analogy, concerning Article 7(1)(b) of Regulation No 40/94, *SAT.1 v OHIM*, paragraph 28, and *BioID v OHIM*, paragraph 29).”

He did not refer to paragraph 78, the requirement that the descriptiveness be **sufficiently far removed** from the impression produced by the simple combination of the elements.

71) In this case the word truss is commonly used in relation to the modern type of roof construction, loft is clearly descriptive of the space in a roof. There is also use of the terms truss rafter loft and trussed rafter lofts. The evidence shows that a number of people in the trade, including TLC, considered that truss loft could be used in advertisements in relation to a description of a particular type of loft. I consider that in relation to at least one set of relevant consumers, the loft conversion trade, that Trussloft will be seen as a term that describes the type of loft that is found in most modern houses; this is the likely evocative effect of the term, the combination of the two words is not sufficiently far removed from the impression produced by the combination of the two elements. Moreover, the combination of truss and loft suggests a sufficiently direct and concrete link to the services in question to enable the public concerned immediately, and without further thought, to perceive a description of the services in question (see *MacLean-Fogg Co v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-339/05*). The CFI established in *Biofarma SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-154/03* that there can be more than one relevant public for a product and it is necessary to consider matters in relation to each of these relevant publics. In this case a contractor, seeking a sub-contractor, seeing an undertaking advertising truss loft conversion services would be in doubt what particular service could be provided. **The services of the registration are directly ancillary to the conversion of such lofts and, consequently, even if the term truss loft was not generic at the date of application it was descriptive and so the registration of the trade mark was contrary to section 3(1)(c) of the Act.**

Alternative considerations under sections 3(1)(b) of the Act

72) As stated above a finding under section 3(1)(c) of the Act gives rise to a finding under section 3(1)(b) of the Act. However, in the event that I am wrong in respect of my other findings I will consider this ground of invalidation on a stand-alone basis.

73) In *Develey Holding GmbH & Co Beteiligungs KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-238/06 P* the ECJ stated:

“79. According to consistent case-law, the distinctive character of a trade mark within the meaning of Article 7(1)(b) of Regulation No 40/94 means that the mark in question makes it possible to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to

distinguish that product from those of other undertakings (Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* [2004] ECR I-5173, paragraph 32, and Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 42). That distinctive character must be assessed, first, by reference to the products or services in respect of which registration has been applied for and, second, by reference to the perception of the relevant public (*Procter & Gamble v OHIM*, paragraph 33, and Case C-24/05 P *Storck v OHIM* [2006] ECR I-5677, paragraph 23).”

The CFI in *Rewe Zentral AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-79/00 described the issue in a clear and practical manner:

“26. The signs referred to in Article 7(1)(b) of Regulation No 40/94 are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition.”

74) I consider that both types of relevant consumer will see the two words that are conjoined, both types will know full well what a loft is. The relevant consumer in the trade will be aware of what a truss rafter, truss roof etc is. Mr Benson has furnished dictionary definitions of truss, upon which he relies, inter alia these include a frame made of pieces of wood to support a roof. I consider that even if the average house owner does not know this specifics of this definition of truss, he or she will identify the word truss with some form of support. Consequently, for the trade, I consider that the trade mark will give an idea of a loft that uses a truss rafter construction and not an indication of origin. For the average house owner I consider that the trade mark will give the idea of a particular type of loft or loft conversion and will not see Trussloft as an indicator of origin. **Consequently, the registration of the trade mark was contrary to section 3(1)(b) of the Act.**

Distinctiveness acquired through use

75) A claim has been made that if it is found that the trade mark is not distinctive of itself it has acquired distinctiveness through use. If I am correct in that the term truss loft is generic I cannot see that Trussloft can ever be distinctive through the use made of it. There may be instances where use can overcome an objection under section 3(1)(d) but I cannot see that these instances could arise in relation to a term that is generic and descriptive. I consider that this view is in keeping with the judgment of the Court of Appeal *Bach and Bach Flower Remedies Trade Marks* [2000] RPC 513. In paragraph 45 Morrit LJ stated:

“If to a real or hypothetical individual a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the

requirements of the Act for it will not provide the necessary distinction or guarantee. It is in that sense that a common or descriptive meaning must be displaced. It is also in that sense that I accept the second submission made by counsel for HHL before Neuberger J.”

76) In the event that I am wrong in relation to section 3(1)(d) of the Act I will go on to consider the evidence in relation to the acquiring of distinctiveness. In *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* Joined Cases C-108/97 and C-109/97 the ECJ stated:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

The judgment of the ECJ in *Bovemij Verzekeringen NV v Benelux-Merkenbureau* Case C-108/05 has established that a reputation in one area will not be enough to establish distinctiveness.

77) Mr Brandreth considered that the list of areas from which enquiries had been received, exhibited at TB2, establish a national reputation. I note that Mr Benson states that TLC operates nationally but does not actually give an indication of where work has been commissioned and carried out. The advertisements in *Yellow Pages* exclude a large area of the United Kingdom: Scotland, Wales, Northern Ireland, London, Kent, Sussex, Surrey, West Midlands, the Marches, Lake District & Cumbria, South West. The advertising shown is primarily in *Yellow Pages* and so, in the absence of evidence to the contrary, it is reasonable to infer that the enquiries exhibited at TB2 were to a large extent emanated from the TLC’s website. The banner for TLC’s website described, it has since been changed, the company as “The UK’s Only National Truss Loft Company”, above this “Truss Loft Conversions” appears, to the left is a monogram of the letters TLC. So when the website was visited the visitor would be educated into seeing truss loft as a descriptive/generic term. Consequently, the website, would militate against the public from seeing Trussloft as being distinctive of TLC. It is also to be noted that in its publicity TLC invariably uses Truss Loft and not Trussloft; the use of Trussloft tends to

only occur in relation to the website address. The *Yellow Pages* advertisements refer to the website; so those who visit the website after reading the advertisement in the *Yellow Pages* will have been educated into seeing truss loft as a descriptive/generic term. Of course, at least one of TLC's print advertisements also clearly uses truss loft in a descriptive/generic fashion:



As can be seen from the above there is use of the TLC monogram. Later advertisements give prominence to the sign “space” and they, of course, direct the reader to the website.

78) In *Bach and Bach Flower Remedies Trade Marks* Morrit LJ stated at paragraph 49

“First, use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”

In the same judgment Chadwick LJ stated on page 535 at line 11 et seq:

“As Morrit L.J. has pointed out, a reasonably well informed and reasonably observant and circumspect consumer would know, if it be the case, that the words or word are widely used in a generic or descriptive sense-even if he is, himself, aware that they are also used in a distinctive sense. With that knowledge, it seems to me impossible for him to say that the words identify, for him, the goods as originating from a particular undertaking. Knowing, as he does, that the use of words may be intended as descriptive, he cannot assert that he understands them as necessarily distinctive.”

I consider that part of the use shown is in a manner that actively undermines the establishment of distinctiveness. It does have materiality but in the opposite sense to that which Mr Benson claims, it educates the public to see truss loft as a descriptive/generic term.

79) Mr Benson states that he cannot give an indication of market share but refers to the number of loft conversions which were allowed under permitted development in 2006, 126,000. It is surprising that Mr Benson does not give the number of conversions

effected by TLC; which would be put into a context, even if not all 126,000 went forth to construction. From the evidence before me, as referred to in paragraph 24, that in 2006 TLC effected about 150 conversions. This does not seem a significant number to me.

80) To sum up:

- There is use that educates the public to see truss loft as a descriptive generic term.
- The use in advertising is in a limited area in the United Kingdom.
- The number of conversions in relation to the number of permissions granted is small.
- There is use with other signs.

I do not consider that the claim to acquired distinctiveness stands up to scrutiny. (The case of Mr Benson is further weakened by the concurrent use of Truss Loft by a variety of other undertakings in a descriptive/generic manner, so educating the public to see the term in this manner rather than as an indicator of origin.)

Conclusion.

81) The trade mark was registered in contravention of sections 3(1)(b), (c) and (d) of the Act and is to be invalidated in its entirety. In accordance with section 47(6) of the Act the registration is deemed never to have been made.

Costs

82) Top-Storey having been successful is entitled to a contribution towards its costs. As the applicant is a litigant in person I have to bear in mind the actual costs that were incurred; as per the decision of Mr Richard Arnold QC in BL/O/160/08 at paragraph 36. In order that I can make an assessment as to the costs, Top-Storey should advise me of the following:

- A statement of the time spent by Top-Storey in dealing with the proceedings, this should include the time spent in considering the evidence of Mr Benson and the time spent in travelling to and from London and at the hearing (as Mr Benson required the cross-examination of Mr Birch).
- Any additional costs eg travel costs to London (if Mr Birch travelled to London by car the mileage should be given).
- Any other financial losses incurred by Top-Storey in dealing with the proceedings.

Top-Storey should advise me of these costs within four weeks of the date of the issue of this decision. A supplementary decision, in relation to costs, will then be issued.

83) The appeal period in relation to the substantive decision will run in parallel with the appeal period in relation to the decision on costs; when that has been issued.

Dated this 26th day of June 2008

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

A hearing took place on 4 June 2008.

Mr Benet Brandreth, instructed by Walker Morris, appeared as counsel for Mr Benson.

Mr Michael Birch, a director of Top-Storey, represented the company.

i “47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground -

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless -

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if -

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that -

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

ⁱⁱ See *Koninklijke KPN Nederland NV v Benelux Merkenbureau* Case C-363/99.

ⁱⁱⁱ “41. Moreover, the Court of First Instance could without inconsistency in its reasoning or error of law take account of material which, although subsequent to the date of filing the application, enabled the drawing of conclusions on the situation as it was on that date (see, by analogy, the order in Case C-259/02 *La Mer Technology* [2004] E.C.R. I-0000 , [31]).”

^{iv} “62 Even though those documents were gathered four years after the application for registration of the mark WEISSE SEITEN had been lodged, they confirm the linguistic development which took place and the conclusions which result from the documents concerning the period prior to the lodging of the application.”

^v *Wm Wrigley Jr Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*
Case C-191/01 P:

“32 In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

^{vi} For example:

Walton Building & Restoration of York - the advertisements list the type of work that the undertaking does: truss loft conversions, attic dormers, Velux conversions, garage conversions, extensions.

Aark Ltd of Durham lists the type of work that it does: bedrooms, en-suites, studies playrooms, dormer roof windows, Velux roof windows, truss loft conversions.

AJR Joinery of York lists the type of work that it does: traditional and truss loft conversion specialists, design and construction of bespoke staircases.

Premier Loft Conversions Ltd describes itself as a truss loft specialist.

T E Robson of Stockton-on-Tees on its website states that it deals with “traditional and truss lofts”.