

O-201-16

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3064148

BY GUY WEAVER TO REGISTER THE TRADE MARK DURASTONE IN CLASS 21

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 403193

BY WARIMEX WAREN-IMPORT EXPORT HANDELS GMBH

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF

MR GEORGE SALTHOUSE DATED 21 OCTOBER 2015

DECISION

1. This is an appeal from a decision of Mr George Salthouse, the Hearing Officer for the Registrar, in the opposition by Warimex Waren-Import Export Handels Gmbh (“the Opponent”) to the registration of the mark DURASTONE. Mr Salthouse decided that the opposition failed and the Opponent appeals that decision.

Background

2. On 14 July 2014 Mr Weaver (“the Applicant”) applied to register a mark consisting of the word DURASTONE for frying pans and pans in Class 21.
3. The Opponent opposed the application on the basis of sub-sections 5(2)(b), s 5(4)(a) and s 3(6) of the 1994 Act. The three earlier marks relied upon for s 5(2)(b) were all were registered as Community Trade Marks (now EUTMs). The three marks were as follows:

Mark	Number	Date of application / registration	Class & Specification
	7016041	25.06.08 29.01.09	21 Pans and pots, all being predominantly of metal.
STONE	8945719	11.03.10 20.09.10	21 Pots and pans, both of metal or metal alloys
STONELINE	11411063	10.12.12 29.04.13	21 Household or kitchen utensils and containers

			(not of precious metal and polished); Pots, pans, roasters, all of the aforesaid goods being made in particular from aluminium, stainless steel or cast aluminium, however not including earthenware; Baking dishes; Glass tableware, Porcelain ware, [and many other items]
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4. The stylised "Stoneline" mark, No. 7016041, had been registered early enough to be liable to be put to proof of use. The Hearing Officer considered that the Opponent did prove use of it, a fact which is not in dispute on this appeal.

5. There is no appeal against the Hearing Officer's conclusions as to the nature of the average consumer and of the purchasing decision. He concluded at paragraphs 32 and 33 of his decision that all three of the earlier marks had a low level of inherent distinctiveness and had not been sufficiently used to benefit from enhanced distinctiveness. He said:

"32) Two of the opponent's marks (CTM 7016041 & CTM 11411063) consist of the words "STONE" and "LINE" conjoined. Both are well known English words. It is clear from the opponent's website that the pans sold under this mark have particles of stone within them which are said to improve the cooking as it is like cooking on a hot stone and also make the pan scratch resistant. The word "LINE" has no significance to the goods but will, in my opinion, be viewed as a reference to the range of pans which have this particular coating. In my opinion as neither word is dominant, both being allusive terms, the distinctiveness lies within the whole of the mark. **Overall the opponent's marks (CTM7016041 & CTM11411063) have a low level of inherent distinctiveness. Whilst the opponent has filed evidence of use of its marks in the UK it has not provided evidence of market share, and the evidence shows only a small amount of sales. Taken overall, the evidence is not enough for the opponent to benefit from enhanced distinctiveness.**

33) I now turn to the opponent's mark CTM 8945719 which is for the word "STONE". The same contentions apply in that the mark is a well known English word which has an obvious meaning as demonstrated by the opponent's own website. It is clearly allusive of the item. However, as a registered mark there is a presumption of validity. No evidence of use of this mark has been provided and

so I regard this mark as having a low level of inherent distinctiveness and which cannot benefit from enhanced distinctiveness through use.”

6. The Hearing Officer then compared the parties' respective marks and in particular considered at paragraph 36 the impact of the “dura” element of the Applicant’s mark:

“36) The opponent contended in its submissions that the term DURA would be seen by the average consumer as a reference to the word “durable”. It supplies the following meaning of dura mater “the outermost and toughest of the three membranes covering the brain and spinal cord often shortened to dura”. The origin is said to be from medieval Latin for “hard mother”. It also claims that the Italian phrase “pietra dura” means “hard stone” and would be taken to indicate durability. There is no evidence that the term “dura” is a well known shorthand for the word durable; and no evidence of the average consumers [*sic*] knowledge of medieval Latin or even modern Italian. Given comments often made regarding the lack of ability in modern languages of the average UK citizen I doubt that many members of the UK population would recognise the term “dura”. Nor do I believe that the term “dura” would be seen as allusive of the words durability or durable. **Whilst there is a degree of visual and aural similarity between the mark STONELINE and DURASTONE these are far outweighed by the differences. A similar result occurs when comparing the opponent’s mark STONE to the mark in suit. Conceptually both marks suggest that they have stone within the product, although it is not clear what the average consumer would make of the term “DURA” and so there is a medium to high degree of conceptual similarity between the mark in suit and both of the opponent’s marks.”**

7. Mr Salthouse concluded that the opposition under section 5(2)(b) failed, and rather similarly decided that there would be no misrepresentation sufficient to found an objection under section 5(4)(a). Lastly, he rejected the opposition based on s 3(6), finding that there was no proof of bad faith.

Grounds of the appeal

8. The appeal pursued only the objection under sub-section 5(2)(b). The Grounds of Appeal can be summarised as follows – the Hearing Officer wrongly:
- a. concentrated on "pots and pans" and ignored the lengthy description of goods covered by CTM 11411063,

- b. assessed the distinctive character of the word STONE in the earlier marks - he found it to be allusive of pots and pans featuring scratch-resistant coatings containing particles of stone; and
- c. assessed how the public in the UK would perceive the prefix to the applicant's mark "DURA..."

The Opponent did not pursue point (a) as a stand-alone point at the appeal, but only to aid its submissions in relation to point (b).

- 9. A Respondent's Notice was filed on behalf of Mr Weaver, but it simply sought to support the reasoning of the Hearing Officer, and did not raise any additional basis upon which the decision should be upheld.

Approach to the appeal

- 10. This appeal is a review not a rehearing. *Reef Trade Mark* [2003] RPC 5 ("*Reef*") and *BUD Trade Mark* [2003] RPC 25 ("*BUD*") show that neither surprise at a Hearing Officer's conclusion, nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal. Instead, I need to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong, as Robert Walker LJ (as he then was) said at [28] in *Reef*:

"...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle."

- 11. The applicable principles have since been summarised in the light of the more recent authorities from the Court of Appeal and the Supreme Court by Arnold J in *Shanks v Unilever Plc* [2014] EWHC 1647, [2014] R.P.C. 29 at [27]-[28]. I have slightly shortened the passage for present purposes:

"27. The role of the appeal court was recently reviewed by Lewison L.J. in *Fine & Country Ltd v Okotoks Ltd* [2013] EWCA Civ 672, [2014] F.S.R. 11, where he said:

"50. The Court of Appeal is not here to retry the case. Our function is to review the judgment and order of the trial judge to see if it is wrong. If the judge has

applied the wrong legal test, then it is our duty to say so. But in many cases the appellant's complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test. [...] Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge's decisions of this kind. There are many examples of statements to this effect. I take as representative Lord Hoffmann's statement in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] 1 WLR 2416, 2423:

'Secondly, because the decision involves the application of a not altogether precise legal standard to a combination of features of varying importance, I think that this falls within the class of case in which an appellate court should not reverse a judge's decision unless he has erred in principle.'

51. Where the appeal is (or involves) an appeal against a finding of fact, the role of an appeal court is as stated by Lord Mance in *Datec Electronics Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23, [2007] 1 WLR 1325 at [46] [...] as follows:

'14. The approach of the court to any particular case will depend upon the nature of the issues kind of case determined by the judge. [...] In some cases the trial judge will have reached conclusions of primary fact based almost entirely upon the view which he formed of the oral evidence of the witnesses. In most cases, however, the position is more complex. In many such cases the judge will have reached his conclusions of primary fact as a result partly of the view he formed of the oral evidence and partly from an analysis of the documents. In other such cases, the judge will have made findings of primary fact based entirely or almost entirely on the documents. Some findings of primary fact will be the result of direct evidence, whereas others will depend upon inference from direct evidence of such facts.

15. In appeals against conclusions of primary fact the approach of an appellate court will depend upon the weight to be attached to the findings of the judge and that weight will depend upon the extent to which, as the trial judge, the judge has an advantage over the appellate court; the greater that advantage the more reluctant the appellate court should be to interfere. As I see it, that was the approach of the Court of Appeal on a 'rehearing' under the RSC and should be its approach on a 'review' under the CPR 1998.

16. Some conclusions of fact are, however, not conclusions of primary fact of the kind to which I have just referred. They involve an assessment of a number of different factors which have to be weighed against each other. This is sometimes called an evaluation of the facts and is often a matter of degree upon which different judges can legitimately differ. Such cases may be closely analogous to the exercise of a discretion and, in my opinion, appellate courts should approach them in a similar way.'

52. I would add to that citation the statement of Lord Steyn in *Smith New Court Securities Ltd v Citibank NA* [1997] AC 254, 274:

‘The principle is well settled that where there has been no misdirection on an issue of fact by the trial judge the presumption is that his conclusion on issues of fact is correct. The Court of Appeal will only reverse the trial judge on an issue of fact when it is convinced that his view is wrong. In such a case, if the Court of Appeal is left in doubt as to the correctness of the conclusion, it will not disturb it.’

[...]

28. I would add that the Comptroller-General of Patents is a specialist tribunal, and therefore the warning given by Baroness Hale of Richmond in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49, [2008] 1 AC 678 at [30], [...] is apposite in this context:

‘ ... This is an expert tribunal charged with administering a complex area of law in challenging circumstances. To paraphrase a view I have expressed about such expert tribunals in another context, the ordinary courts should approach appeals from them with an appropriate degree of caution; it is probable that in understanding and applying the law in their specialised field the tribunal will have got it right: see *Cooke v Secretary of State for Social Security* [2002] 3 All ER 279, para 16. They and they alone are the judges of the facts. It is not enough that their decision on those facts may seem harsh to people who have not heard and read the evidence and arguments which they have heard and read. Their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts or expressed themselves differently ... ’

12. It is also helpful to bear in mind the comments of Mr Alexander QC in *Digipos* [2008] R.P.C. 24, where he said:

“6 ... appellate review of nuanced assessments requires an appellate court to be very cautious in differing from a judge's evaluation. In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference.”

Merits of the appeal

13. The strongest aspect of the Opponent's case under s 5(2)(b) was in its reliance on the earlier STONE mark, No 8945719, which is registered for “pots and pans, both of metal or metal alloys.” Such goods plainly are identical to the frying pans and pans in the

Applicant's specification. If the opposition could not succeed on that basis, it would not succeed on the basis of the less similar STONELINE marks, still less relying upon the non-identical goods in the specification of the later STONELINE mark.

14. The main point raised by the Opponent was that the Hearing Officer erred in principle in suggesting that the STONE mark was of low distinctiveness because (he thought) it was descriptive or allusive of the goods for which it is registered. The Hearing Officer concluded that the mark had an "obvious meaning" as a well-known English word. Plainly, that was correct. However, the Hearing Officer also concluded that the word would be seen as descriptive or allusive of the nature of the pots and pans sold under the STONE mark, a conclusion which he said that he had reached in the light of the evidence before him of the goods sold by the Opponent.
15. The Hearing Officer was correct to say that the evidence before him showed that the Opponent had sold pans with a non-stick surface containing particles of real stone. My concern with his conclusions in paragraph 32 and especially paragraph 33 is that the evidence of such use was not very substantial. The Hearing Officer had rightly pointed out that only a small number of sales were shown and there was no evidence of the Opponent's market share. In particular, the evidence barely showed any use of the STONE mark, perhaps because the Opponent had been required to prove genuine use only of the STONELINE mark. Indeed, the Hearing Officer went as far as to find, in paragraph 33, that there was *no* evidence of use of the STONE mark. That was not quite accurate, since there was in the evidence a single page from the Opponent's website advertising STONE pans, rather than STONELINE pans. That page is poorly reproduced in the documents, but it does not seem to me to mention that the non-stick coating on the pans contains particles of stone, although the documents relating to the STONELINE pans did refer to that aspect of the goods, as the Hearing Officer found.
16. In my judgment, the question which the Hearing Officer should have considered was whether the word 'stone' would be seen by the average consumer as descriptive or allusive of the Opponent's pots and pans, in particular because the mark is registered

for “pots and pans, both *of metal or metal alloys*” (my emphasis). On the face of it, I consider that the Opponent is right to say that goods of that specific description could not be made of stone, so the Hearing Officer needed to decide whether the average consumer would expect such goods, when made of metal or metal alloys, to contain stone elements such as a stone-based non-stick surface. It seems to me that the average consumer would not expect such pots and pans to be made from or incorporate elements of stone, without having been educated to do so. The limited evidence filed by the parties did not, in my view, prove that there would be any such expectation. Absent evidence that metal or metal alloy pans with stone elements were well-known or established on the market at the relevant date, I do not consider that the Hearing Officer was justified in concluding that the mark STONE would be seen as descriptive or allusive of the goods, let alone as “clearly allusive” to their character or properties.

17. The Opponent submitted that the Hearing Officer could be shown to have erred in his assessment of the inherent distinctiveness of its marks by his failure to consider how they would be viewed in relation to its goods which are not pots and pans. I agree that the word stone is less likely (and in some case not at all likely) to be seen as descriptive of a number of the goods within the specification of EUTM 11411063, which covers e.g. goods like cocktail shakers and garlic presses, but I am not convinced that this indicates an error on the Hearing Officer’s part. I consider that he was concentrating upon pots and pans as those were the identical goods to the Applicant’s goods.
18. Nevertheless, in the light of the paucity of evidence as to how the word stone would be seen by the relevant public, it seems to me that the Opponent is right to say that the Hearing Officer attributed too low a level of inherent distinctiveness to the STONE mark. In my judgment the mark does not have only the minimum level of distinctiveness required to achieve registration, but has an average level of inherent distinctiveness.
19. The second substantive point on the appeal was whether the Hearing Officer made an error of principle in his assessment of the similarity of the marks in paragraph 36 of

the decision, in particular in his assessment of how the "DURA" element of the Applicant's mark would be seen by the average consumer. The Opponent had argued that the term would be seen as descriptive or allusive, as having some reference to the word "durable" and had relied specifically in its written submissions on the various (rather more rarefied) definitions mentioned in paragraph 36. The Hearing Officer considered that the average consumer would not know of the Latin or Italian usages relied on, nor would he connect "dura" with the property of durability.

20. In my view, there are no grounds to criticise the Hearing Officer's views of the chances of the average consumer in the UK understanding "dura" from the Latin or Italian definitions supplied by Opponent. The only real question, in my judgment, is whether he can be said to have erred in principle in reaching his view that "dura" would not even be seen as allusive of the common English words "durability" or "durable." The Opponent had not provided evidence of use of "dura" as a prefix in common use, nor of its use in the descriptive or allusive manner claimed. After careful consideration, I have concluded that this is a matter on which reasonable people could disagree, rather than a point which has a clear answer which the Hearing Officer got wrong. Again in the absence of evidence of how the term would be seen by the average consumer, I do not think that I am in a position to say that the Hearing Officer erred in the conclusion that he reached.

21. I do not consider, therefore, that it would be right to interfere with the Hearing Officer's conclusions that the visual and aural similarity between Stone/Stoneline and Durastone is outweighed by the differences in those respects. My conclusion at paragraph 19 above however has an impact upon the final sentence of the Hearing Officer's paragraph 36, where he dealt with conceptual similarity. I find the sentence difficult to follow, because the first phrase suggests that the Hearing Officer is comparing Durastone to Stone, but the last phrase suggests that he was comparing Durastone to both Stone and Stoneline. In any event, I think that the Hearing Officer was right to consider that the average consumer would recognise the word "stone" in all of the marks, which would have led to some conceptual similarity between them, most particularly in the comparison of Stone to Durastone.

22. I move on to consider the global assessment of the likelihood of confusion, in the light of the Hearing Officer's findings amended by my view that STONE has an average level of inherent distinctiveness for pots and pans made of metal or metal alloys. The Hearing Officer summarised the approach to take to this task in paragraphs 38-39 of the decision, and found essentially that the identity of the goods, and the average degree of care that would be used in purchasing the goods, were outweighed by the differences between the marks.
23. The Opponent argued on the appeal that the fact that DURASTONE incorporates STONE, taken with the identity of the goods, inexorably leads to a likelihood of confusion. I do not agree; such an analysis fails to take account of the interdependency principle, and risks ignoring the differences between the marks. The consumer should not be expected to ignore part of the DURASTONE mark, or artificially dissect it, but it is necessary to compare marks as a whole. In my judgment, even accepting that the STONE mark has an average level of distinctiveness, the differences between the marks preclude a likelihood of confusion.
24. For these reasons, the appeal is dismissed.
25. Although the Opponent succeeded in the first limb of its appeal, I think that it should make a contribution to the Applicant's costs of the appeal, but I also factor in the time which will have been taken by the Opponent in considering the unnecessary Respondent's Notice. I will order the Opponent to pay the Applicant £750 towards its costs of the appeal, to be paid by 3 May 2016, in addition to the costs awarded below, which shall be paid by the same date.

Amanda Michaels
The Appointed Person
18 April 2016

MR. DAVID TATE of Maguire Boss appeared for the Appellant.

MS. KATHERINE McCORMICK of Trade Mark Direct appeared for the Respondent.