

O/212/19

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO. 3148463 BY  
UK FIRE DOORS LTD  
IN RESPECT OF THE SERIES OF TWO TRADE MARKS:

**ENDURODOOR**

**enduroDOOR**

IN CLASS 19

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY  
THEREOF UNDER NO. 501954 BY  
INTEGRATED DOORSET SOLUTIONS LIMITED

## Background and pleadings

1. The series of two trade marks – ENDURODOOR and **ENDURODOOR** – was applied for on 8 February 2016 and entered onto the register on 6 May 2016. It stands in the name of UK Fire Doors Ltd (the registered proprietor).
2. The mark is registered in respect of the following goods:

### Class 19

*Doors made of wood for buildings; Doors, not of metal.*

3. On 30 January 2018, Integrated Doorset Solutions Limited (the applicant) applied under section 47 of the Trade Marks Act 1994 (the Act) for the trade mark registration to be declared invalid. The application is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Act. The section 5(3) and 5(4)(a) grounds were withdrawn in the applicant's written submissions on 28 August 2018.
4. The applicant is relying upon its UK trade mark number 2524781: **ENDURACOR**. The mark was filed on 27 August 2009 and was registered on 4 December 2009 in respect of the following goods:

### Class 19

*Non-metallic building materials; semi-worked woods; chipboard; doors, door panels and door frames; parts and fittings for the aforesaid goods.*

In its written submissions dated 28 August 2018, the applicant stated that it was relying only on *doors* and *door frames*.

5. The applicant claims that the marks are similar and that the goods are identical and similar to the goods specified in the earlier registration, and that, because of this similarity, there exists a likelihood of confusion which includes a likelihood of association.

6. The registered proprietor filed a counterstatement denying the claims made, and putting the applicant to proof of use in relation to all the goods relied upon. It denies that the marks are similar and accepts in part the applicant's claim that the goods are identical or similar, although it does not specify what it accepts and what it does not.
7. The applicant filed evidence in these proceedings. This will be summarised to the extent that is considered necessary.
8. The applicant also filed written submissions, including written submissions in lieu of a hearing, on 28 August 2018 and 28 February 2019. These will not be summarised but will be referred to as and where appropriate during this decision, which is taken following a careful perusal of the papers.
9. In these proceedings, the applicant is represented by Freeths LLP and the registered proprietor was represented by Brabners LLP but is now representing itself.

### **Preliminary issue**

10. The registered proprietor in its counterstatement alleges that the applicant has behaved unreasonably, in connection with its claims particularly under section 5(4)(a), specifically that it knowingly made a false statement that it had an earlier right protectable under the law of passing off. The applicant has reiterated its belief that it is the proprietor of protectable goodwill that existed at the relevant date, but as it has withdrawn the section 5(4)(a) and section 5(3) claims, and the registered proprietor has made no further submission on this subject, I shall disregard this section of the counterstatement.

### **Evidence**

11. The applicant's evidence comes in the form of two witness statements. The first is from Mr Stephen Hutsby, Head of Marketing and Product Development at Integrated Doorset Solutions Limited (IDSL) since January 2016. It is dated

28 August 2018. The second, attached to which are 24 exhibits, is from Mr Nigel Richmond, Managing Director and shareholder of IDSL since 2015. Mr Richmond states that he has over 25 years' experience in the door and building products industry. His witness statement is also dated 28 August 2018.

12. ENDURACOR is described in the product literature as:

“solid particleboard core with softwood framing to all 4 edges. Subfacing material both sides with concealed hardwood tipplings in both vertical edges or all 4 edges. Used in pairs of doors or where a more robust core is needed for high use areas such as schools and hospitals”.<sup>1</sup>

13. Mr Richmond states that the product was created in or around 2008 by a member of the Leaderflush Shapland group of companies (LS). It is mainly sold as a doorset. He adds that:

“A doorset refers to a complete door assembly and comprises a door frame, door sill, door, a weather bar (if applicable) and all the relevant hardware, including handles, panels, plates etc.”

14. LS went into administration on 18 December 2015. IDSL acquired all the intellectual property assets in the business, through a special purpose vehicle, Fire Door Inspection Solutions Limited (FDIS). The sale to FDIS took place on 13 January 2016 and the intellectual property was assigned to IDSL on 11 March 2016.

15. IDSL was founded in 2015 and Mr Richmond describes it as being

“engaged in the manufacture and supply of performance doorsets and architectural ironmongery solutions. We provide products for the construction and refurbishment markets, ideally suited to the health,

---

<sup>1</sup> Exhibit NR7, page 25.

education, commercial, leisure, office fit-out and high-end residential sectors.”

16. The applicant sold £356,873 worth of doorsets under the ENDURACOR trade mark in the last 9 months of 2016, £1,970,678 in 2017 and £902,247 in the first 5 months of 2018. Mr Richmond states that the total turnover of the applicant in 2017 was approximately £16 million and that ENDURACOR products accounted for about 12% of this total. He says that he does not have the figures for sales achieved by LS.
17. Mr Hutsby, who had previously been employed at LS for over 30 years, states that the group was turning over approximately £30 to £40 million per year between 2013 and 2015, and that around 70% of this turnover was attributable to goods sold under the ENDURACOR brand. He believes that at that time the UK market for “performance doorsets” was in the region of £240 million per year and calculates that LS’s market share was in the order of 8% to 12%. These appear to be rather rough figures and the source of the market data is not clear, but the registered proprietor has not challenged them.
18. The exhibits show that ENDURACOR was referred to in product literature and websites both before and after LS went into administration.<sup>2</sup> They also contain news articles dating from 2013 and 2014, highlighting the following projects:
  - the supply of 170 doorsets, incorporating ENDURACOR, to a new £9m pathology centre at New Cross Hospital in Wolverhampton (*Door Industry Journal*, 5 September 2013);
  - the supply of 5,131 doorsets and 7,330 doors to Southmead Hospital in Bristol. ENDURACOR was used in areas of heavy traffic, such as corridors and bedrooms (*Door Industry Journal*, 25 August 2014);

---

<sup>2</sup> See screenshots of the website from the Internet Archive “Wayback Machine” in Exhibits NR7 and NR14, and product literature in Exhibits NR3-4 and NR17-19.

- the supply of 328 doorsets, incorporating ENDURACOR, in the new Microsoft Research building in Cambridge (*Door Industry Journal* 22 July 2013); and
- the supply of 133 doorsets, incorporating ENDURACOR, in the £17m Michael Woods Sports and Leisure Centre development in Glenrothes, Kirkcaldy (*Public Sector Build Journal* 23 October 2014).<sup>3</sup>

19. The mark is shown as a word, with no stylisation and a variety of approaches to capitalisation, which are used inconsistently on websites and product brochures.<sup>4</sup>

## Legislation

20. Section 47 of the Act states that:

“(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) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

---

<sup>3</sup> Exhibits NR5 and NR6.

<sup>4</sup> EnduraCor (see, for example, Exhibit NR4), enduracor (see Exhibit NR7 page 2), Enduracor (see Exhibit NR7 page 25)

- (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 European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

...

(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.”

### **Relevant dates**

21. The earlier mark had been registered for more than five years on the date on which the contested mark was published. It is, therefore, subject to proof of use provisions under sections 47(2A)-(2E) of the Act, and the registered proprietor has requested such proof for all the goods upon which the applicant is relying. The applicant has made a statement that it has made genuine use of the mark in the UK, in the relevant period for all the goods upon which it is relying. The relevant period for these purposes is the five years ending with the date of application for the declaration of invalidity: 31 January 2013 to 30 January 2018.

### **Proof of Use**

22. The case law on genuine use was summarised by Arnold J in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

“114. *The law with respect to genuine use.* The CJEU has considered what amounts to ‘genuine use’ of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as

a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].
- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38]

and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [132].”

23. The onus is on the proprietor of the earlier mark to show use. Section 100 of the Act states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

24. The evidence I have summarised shows that the applicant has used the earlier mark. It is the registered proprietor and its account of how it acquired the ownership of the mark is unchallenged. In paragraph 19 above, I noted that the mark is used throughout the evidence as a word mark, with no stylisation and different capitalisation. The General Court stated in *Present-Service Ullrich GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, T-66/11, that:

“... The protection offered by the registration of a word mark applies to the word stated in the application for registration and not to the individual

graphic or stylistic characteristics which that mark might possess (Judgment of 22 May 2008 in Case T-254/06 *Radio Regenbogen Hörfunk in Baden v OHIM (RadioCom)*, not published in the ECR, paragraph 43).<sup>5</sup>

25. While the data on turnover and market share are not as precise as one might have wished, again the registered proprietor of the contested mark has not challenged these figures. Taking this evidence with the examples of individual projects in the UK mentioned in paragraph 18 above, I am satisfied that more than token use has been made of the mark.
26. The question I must now address is to what goods this use relates. The earlier mark is registered in respect of the following goods in Class 19: *Non-metallic building materials; semi-worked woods; chipboard; doors, door panels and door frames; parts and fittings for the aforesaid goods*. However, I remind myself that the applicant is relying solely on *doors* and *door frames*, and it is these goods alone that I must consider.
27. In paragraph 12 above, I have quoted the description of ENDURACOR from the applicant's own product literature. The product is characterised as a "core", around which the rest of the door is constructed. On its own, it cannot be described as a door, yet the evidence shows that the core is an integral part of the doorsets sold first by LS and then by the applicant. It does not appear to be sold separately. Different types of doors were available during the relevant period with this core: the Designer Range, the Sentinel and Plasform, for example.<sup>6</sup>
28. There is little case law dealing with the question of whether use of a mark for a component of a product constitutes genuine use of a trade mark in relation to that product. As has already been seen, *Ansul* establishes general principles. The facts of that particular case concerned the sale of spare parts and provision of after-sale services for goods in respect of which the mark was registered that were once

---

<sup>5</sup> Paragraph 57.

<sup>6</sup> See Exhibits NR7 page 25, page 28 and NR 10 respectively.

sold, but were no longer available. The General Court considered the application of *Ansul* in *Polytetra GmbH v OHIM*, T-660/11 (in particular, in paragraph 89), and concluded that in this case the use of a trade mark in connection with a third party's final product did not show genuine use of the mark in relation to that final product, as the nature and intended purpose of the goods (non-stick materials and goods coated with those materials) were different, and the consumer would not assume that the materials and the finished product shared the same commercial origin.

29. The UK or EU courts have not directly addressed the question of whether the use of a trade mark associated with a component or ingredient constitutes genuine use of the mark for the finished good. However, the Irish Supreme Court considered this issue in *Compagnie Gervais Danone v Glanbia Foods Society Ltd* [2010] ETMR 46. Decisions of the courts of other EU Member States are not binding on this tribunal, but may be of persuasive value in determining the meaning of the Directive-based provisions of the Act.<sup>7</sup>
30. The court found that the mark ESSENSIS, which was registered in respect of *yoghurt* in Class 29 and was used only in the context of a particular active ingredient of the yoghurt (a strain of bacterial culture), was genuinely used for the final product. The CJEU's decision in *Ansul* was analysed in detail, and the court commented that it could

“find little or no distinction between use of a trade mark in respect of spare parts of a product and use in respect of a specific integral ingredient.”<sup>8</sup>

Central to its conclusions was the fact that the mark was never used in respect of a culture product sold separately, and instead was used

“extensively, according to the findings of fact of the learned High Court judge, in advertising and promotional materials, all in respect of the

---

<sup>7</sup> See *Trade Marks Practice Manual, Tribunal Section*, section 1.4.

<sup>8</sup> Paragraph 46.

appellant's yoghurt products and, as she found, 'to distinguish' those goods from those of other manufacturers."<sup>9</sup>

31. This case was considered in a decision of this tribunal: *Egger Retail Products GmbH v Hunton Fiber AS (SILENZIO)*, BL O/131/12. The mark SILENZIO was registered for *laminated chip board panels* in Class 19 and *materials for covering existing floors, walls and ceilings, made from laminated chip boards* in Class 27. It was actually used in connection with an underlay that was integrated into flooring materials. The Hearing Officer reminded himself that he needed to look at the nature of the use and decide whether that use was aimed at creating or preserving an outlet for the goods in respect of which the mark was registered. He said that:

“... SILENZIO is performing, effectively, a dual role. Whilst it refers specifically on the one hand to the underlay component, it does so in a way that links that component with the complete product. ... The consumer may want the SILENZIO version of the product as opposed to the non-SILENZIO version. Such a role is aimed at maintaining a market for the finished product.”<sup>10</sup>

32. Looking at the evidence, it seems to me that ENDURACOR is a key component of the doorsets, in the same way as SILENZIO was found to be a key component of the flooring. There is nothing that suggests that it is available separately, and it cannot be removed from the doors without completely destroying them. The way that the mark is used in promotional materials suggests that it performs a dual role. Although generally described in terms of a core, ENDURACOR was defined on LS's website as “a cost effective engineered door providing outstanding performance”.<sup>11</sup> It also appeared on the list of door types.<sup>12</sup> In my view, use of the mark is aimed at maintaining a market for the applicant's doors, and in distinguishing those doors from ones produced by other manufacturers.

---

<sup>9</sup> Paragraph 45

<sup>10</sup> Paragraph 25.

<sup>11</sup> Exhibit NR15, a screenshot dated 9 March 2016, retrieved via the Internet Archive Wayback Machine.

<sup>12</sup> See Exhibit NR7, pages 1, 3, 7, 9, 11, 19, 20, 22 and 23.

33. The evidence shows that the applicant, and its predecessor in title, were trading in doorsets for commercial or public buildings. They do not appear to have been selling doors for residential properties. The high acoustic and fire-retardant specifications of ENDURACOR reinforce this view. However, it seems to me that to limit the goods that the applicant may rely on to doors for use in particular types of buildings would be overly fussy and not reflect how average consumers would perceive the goods. High-specification doors may be used in, say, apartment buildings which would not necessarily fall within the description of “commercial or public buildings”. In coming to this view, I take account of the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

34. This leads me to find that use has been shown for *doors*. The evidence does not explicitly state that ENDURACOR is used for door frames. However, as I have already noted “doorsets” include frames, and ENDURACOR is used as mark in the product brochures in the context of the whole doorset.<sup>13</sup> Consequently, I accept that the applicant can rely on *doors* and *door frames*.

## **Decision**

### **Section 5(2)(b) ground**

35. Section 5(2)(b) of the Act states that:

---

<sup>13</sup> See, for example, NR11 and NR18.

“A trade mark shall not be registered if because –

...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

36. In considering the application for a declaration of invalidity under this section, I am guided by the following principles, gleaned from the decisions of the courts of the European Union in *SABEL BV v Puma AG* (C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (C-425/98), *Matratzen Concord GmbH v OHIM* (C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (C-334/05 P) and *Bimbo SA v OHIM* (C-519/12 P):

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## Comparison of goods

37. The goods to be compared are the applicant's *doors* and *door frames* and the registered proprietor's *doors made of wood for buildings* and *doors, not of metal*. In *Gérard Meric v OHIM*, T-133/05, the General Court stated that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark are included in a more general category designated by the earlier trade mark.”

38. The registered proprietor's goods are included in the more general category *doors*. Following *Meric*, they are identical.

## Average consumer and the purchasing act

39. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, I must bear in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: see *Lloyd Schuhfabrik Meyer*.

40. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading Limited), U Wear Limited, J Fox Limited* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that

constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”<sup>14</sup>

41. The average consumer of doors will either be a member of the general public, who would use the door in a domestic building or refurbishment project, or a professional user – a contractor, sub-contractor or tradesperson – working on large or small projects. Doors will be bought directly from the manufacturer, through builders’ merchants or other distributors, or from larger DIY stores. The average consumer is likely to use product brochures or websites, see adverts in specialist press and other publications, or view displays or advertisements in store. This suggests that the visual element will play an important part in the selection process. I will also need to take account of aural elements of the mark as the consumer may also order over the phone, or act on word-of-mouth recommendations. In my view, the average consumer will be paying at least an average level of attention, depending on the size and requirements of the project.

### **Comparison of marks**

42. It is clear from *SABEL BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, C-591/12 P, that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then,

---

<sup>14</sup> Paragraph 60.

in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”<sup>15</sup>

43. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

44. The respective marks are shown below:

Earlier mark	Contested mark
ENDURACOR	ENDURODOOR 

45. Although the registered proprietor’s marks have been registered as a series, there are differences in stylisation. I shall therefore make a separate assessment of each of these marks.

46. The first is the word “ENDURODOOR” in a standard font with no stylisation and presented in capital letters.<sup>16</sup> The overall impression of this mark is of the word “DOOR” with the prefix “ENDURO”. “DOOR” describes the goods in respect of which the mark is registered and is thus non-distinctive; “ENDURO” alludes to a quality of the product and, in my view, is the dominant and distinctive element of the mark. In making this finding, I have borne in mind the statement of the General Court in *Usinor SA v OHIM*, T-189/05, that:

“... while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik*

---

<sup>15</sup> Paragraph 34.

<sup>16</sup> I have already considered the extent of protection of a word mark in paragraph [24] above.

*Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02, *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57).<sup>17</sup>

47. The second mark consists of the same word in a stylised typeface comprising both upper- and lower-case letters. The “DOOR” element of the word is presented in bold red, with the “ENDURO” element in bold black. The use of red gives a slight emphasis to the end of the word and clearly separates the word “door” from the rest of the mark. As I have already found, “door” is non-distinctive, but I consider that the use of the different colours means that the mark is instantly seen to be made up of two elements and that, as in the first mark, “ENDURO” is the dominant and distinctive element.
48. The applicant’s mark consists of the word “ENDURACOR” in a standard font with no stylisation and presented in capital letters. The overall impression rests in the word as a whole.

#### *Visual comparison*

49. The marks are single words, with the contested series of marks having one more letter than the earlier mark (ten as opposed to nine). In the second mark of the registered proprietor’s series, two colours and a stylised font are used, as I have already noted. The first five letters of the marks are identical, as are the final two. I find that the first of the registered proprietor’s marks is highly similar to the applicant’s mark.
50. The applicant submits that the colours of the second mark of the series is irrelevant or, alternatively, does not materially affect the degree of visual similarity. In my view, though, the red highlights the end of the word, although not to the exclusion

---

<sup>17</sup> Paragraph 62.

of the beginning. The typeface is squared, and has a degree of stylisation, but this does not prevent the letters of the word being easily identified. All the letters are in lower case, except for the two Ds, and this gives the mark a uniform height from beginning to end. I find that this mark is similar to the applicant's mark to a medium degree.

#### *Aural comparison*

51. The applicant's mark will be articulated as "END-YUH-RA-COR", while the registered proprietor's mark will be pronounced "END-YUH-RO-DOR". When spoken at a moderate or fast pace, the third syllable of both marks is likely to be pronounced as an indeterminate, unstressed vowel. The stressed syllables are the second and fourth in both instances. I find that the marks are aurally highly similar.

#### *Conceptual comparison*

52. The first element of both the applicant's and the registered proprietor's marks alludes to something that endures or is enduring. The second element will be seen as the thing that endures. In the case of the registered proprietor's marks, it is clear that this is a door. The average consumer may identify the idea of a "core" in the applicant's mark, as in a substance or part that is at the centre of the product. To my mind, the marks are conceptually similar to a medium degree.

#### **Distinctiveness of the earlier mark**

53. There is, as has already been noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer*:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or

services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; 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 section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

54. The applicant claims that the earlier mark has an enhanced distinctive character owing to the use that has been made of it and that:

“As a result, it is highly likely that the Earlier Mark was known to a large portion of the relevant UK public in the sector for doorsets at the relevant date.”

It is not, however, the average consumer of doorsets that I must consider, but the average consumer of doors, as these are the goods upon which the applicant may rely. The evidence adduced by the applicant provides estimates of the size of the market for “performance doorsets”, but there is nothing to inform me of the size of the market for doors more broadly. It is not clear how much has been spent on promotion of the mark or how many consumers will have been exposed to any promotional activity. Furthermore, the relevant public for doors will be larger than the relevant public for doorsets. The opponent states that the mark has been used since 2008 and the projects highlighted in the evidence are widely dispersed

around the UK. However, the earliest dated evidence of use is from 2013.<sup>18</sup> On balance, I am unable to find that the earlier mark has an enhanced distinctive character and will therefore concern myself with its inherent character only.

55. I have already noted that the first element of the earlier mark – “ENDURA” – alludes to a quality to be found in the product: it is long-lasting and will withstand heavy use. The second element – “COR” – is not, however, descriptive of doors. It may bring to mind the idea of a “core”, but it is spelled differently. The word has been coined from the bringing together of these two elements, so there is an element of invention. Consequently, I find that the earlier mark has an above average, although not the highest, level of inherent distinctiveness.

### **Conclusions on likelihood of confusion**

56. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 36. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods/services may be offset by a greater degree of similarity between the marks, and vice versa.<sup>19</sup> The distinctiveness of the earlier mark must also be taken into account.

57. My findings can be summarised as follows:

- the goods are identical;
- the first of the registered proprietor’s marks is visually similar to a high degree of similarity to the applicant’s mark; the second in the series is visually similar to a medium degree;
- the marks are aurally similar to a high degree;
- the marks are conceptually similar to a medium degree;
- the earlier mark has an above average, although not the highest, level of inherent distinctiveness. The applicant has not shown that it has been enhanced through use for the goods in question.

---

<sup>18</sup> Exhibit NR7, page 1.

<sup>19</sup> *Canon Kabushiki Kaisa*, paragraph 17.

58. However, the global assessment I am required to make does not imply an arithmetical exercise, where the factors are given a score and the result of a calculation reveals whether or not there is a likelihood of confusion. I must keep in mind the average consumer of the goods or services and the nature of the purchasing process. Here I found that the average consumer would be paying an above average level of attention. I also note that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture he has kept in his mind.<sup>20</sup>
59. In *El Corte Inglés SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of words tend to have more visual and aural impact than the ends, although it must be acknowledged that this is not an invariable rule. The first of the registered proprietor's marks has the same beginning as the applicant's mark, and both are coined words with the same structure. I also found that the beginning of the registered proprietor's mark was the dominant and distinctive element, as "DOOR" is descriptive. The average consumer will not, in my view, notice the difference between the "A" and the "O", which join the two elements of the mark to make a whole. Given the identity of the goods, I find that it is likely that the average consumer will be directly confused, mistaking one mark for another.
60. I turn now to the second of the registered proprietor's marks. I found that the stylisation of the mark meant that the elements of the mark were more likely to be perceived separately. Even taking account of this, and the finding that the average consumer will be paying an average level of attention, in my view there is a likelihood of direct confusion, given the identity of the goods and the imperfect recollection of the consumer.

## **Conclusion**

61. The application for a declaration of invalidity succeeds in full. Under section 47(6) of the Act, the registration is deemed never to have been made.

---

<sup>20</sup> *Lloyd Schuhfabrik Meyer*, paragraph 27.

## **Costs**

62. The applicant has been successful. In the circumstances, I award the applicant the sum of £1450 as a contribution towards its costs. In calculating this figure, I have allowed £100 for the official fee, as the sections 5(3) and 5(4)(a) grounds were withdrawn when the opponent submitted its evidence. The sum is calculated as follows:

*Official fee for filing the notice of application for a declaration of invalidity: £100*

*Preparing a statement and considering the other side's statement: £300*

*Preparing evidence: £750*

*Preparation of written submissions: £300*

***Total: £1450***

63. I therefore order UK Fire Doors Ltd to pay Integrated Doorset Solutions Limited the sum of £1450. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**18<sup>th</sup> April 2019**

**Clare Boucher**

**For the Registrar,**

**Comptroller-General**