

O-221-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2321968
IN THE NAME OF AGGREGATE INDUSTRIES UK LIMITED
TO REGISTER THE TRADE MARK ECOBLOCK IN CLASS 19**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 92202 IN THE NAME OF
COOPER CLARK GROUP LIMITED**

Trade Marks Act 1994

**IN THE MATTER OF Application No. 2321968
in the name of Aggregate Industries UK Limited
to register a trade mark in Class 19**

And

**IN THE MATTER OF Opposition thereto
under No. 92202 in the name of Cooper Clark Group Limited**

BACKGROUND

1. On 28 January 2003, Aggregate Industries UK Limited applied to register the trade mark ECOBLOCK in Class 19 in relation to the following specification of goods:

Paving blocks; cementitious and concrete paving elements and materials; paving stones; flagstones.

2. On 16 December 2003, Cooper Clark Group Limited filed notice of opposition to the application, the grounds of opposition being as follows:

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

3. The applicants filed a counterstatement in which they dispute the ground on which the opposition is based.

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

5. Both sides filed evidence, although neither requested to have an oral hearing on the case, electing instead to have a decision taken from the papers on file. After a careful study of the evidence I now go on to make my decision.

OPPONENTS= EVIDENCE

6. This consists of two Witness Statements. The first is dated 26 May 2004, and comes from Neil Grahame Hall, Chief Executive of Cooper Clark Group Limited, a position he has held for the previous twenty months.

7. Mr Hall claims that his company first used the mark ECOBLOCK during the summer of 1997, saying that the first available invoice dates from 23 July 1997 but the mark would have been promoted prior to that date. Mr Hall says that the trade mark is used in relation to a grass and soil protection system and associated services. Exhibit NGH1 consists of a video tape, recorded on 26 April 1999, that describes the ECOBLOCK product and service.

8. Exhibit NGH2 consists of invoices dating from 23 July 1997 through to the relevant date and beyond. All show ECOBLOCK being used in connection with a Agrass protection system and ECOPIN in relation to locator pins for the system. Exhibit NGH3 consists of a listing headed AEcoblock Installations giving details including the customer name and date of installation, the earliest being in July 1997.

9. Mr Hall gives details of the turnover for goods and services provided under the ECOBLOCK mark, which ranges from , 51,000 in 1997 rising almost year on year to , 824,000 in 2002, the last full year prior to the relevant date. Mr Hall confirms that sales have been made throughout England, Ireland, Scotland and Wales.

10. He goes on to give figures spent promoting goods and services under the ECOBLOCK mark in the years 1997 to 2003, being around , 22,000 per annum in 1997 to 2001, rising to nearly , 41,000 in 2002, 2003 being after the relevant date. Mr Hall says the mark has been promoted in a number of different ways, including, at the IOG Saltex 2001 Trade Exhibition at Windsor Racecourse, exhibit NGH4 consisting of an invoice for the stand, and photographs of the stand itself clearly showing the ECOBLOCK mark. Exhibit NGH5 consists of an advertisement promoting the opponents= attendance, and in particular, ECOBLOCK, at the Landscape 2000 Trade Exhibition. Mr Hall says that the mark has also been promoted through mail shots, exhibit NGH6 consisting of examples stated to date from 2001 (although the flyers do not show a date), and at various seminars and presentations made to existing and potential customers. Exhibit NGH7 consists of a training manual, and what appears to be screen prints of PowerPoint presentations, none can be dated. Exhibit NGH8 consists of a list of publications in which Mr Hall says ECOBLOCK has been promoted. Most show ECOBLOCK as the related product, the earliest date being February 1998. Exhibit NGH9 consists of copies of advertisements for ECOBLOCK. Exhibit NGH10 consists of a print taken from the opponents= website on 23 April 2004. Exhibit NGH11 consists of a copy of a business card printed in January 2001 for Kerry Abel, Technical Sales Executive for the opponents= Ecoblock Division.

11. Mr Hall goes on to say that in the soil and grass protection system market, the mark ECOBLOCK is well known and exclusively associated with his company . He submits that such systems are sold in the building products sector, and specifically to customers who would also purchase general building products, including paving. By way of example he refers to exhibit NGH12 which consists of an extract taken in May 2004 (well after the relevant date) from the website of a paving and drainage contractor, Mr Hall points out that his company advertises ECOBLOCK on the site alongside those of other companies, within the general building and paving products sectors.

12. The second Witness Statement is dated 25 May 2004, and comes from Lee Curtis, a Trade Mark Attorney with Pinsents, the opponents= representatives in these proceedings.

13. Mr Curtis refers to searches that he conducted on the Internet, exhibits LMC1 to LMC6 being extracts from various sites. Although downloaded well after the relevant date, Mr Curtis submits that they constitute proof that at that time, goods such as paving, general building products, and soil and grass protection systems were sold through the same channels, and conceivably that was the case at the date of application.

APPLICANTS= EVIDENCE

14. This consists of three Witness Statements. The first is dated 26 August 2004, and comes from Kevin Greaves, a Market Development Manager for Aggregate Industries UK Limited, a position he has held for six years, having been associated with the company since 1985. Mr Greaves= Statement consists of submissions on the evidence filed by Mr Hall on behalf of the opponents, and his opinion on the substantive issues in this case. Whilst I do not consider it to be appropriate, or desirable to summarise these submissions, I will take them fully into account in my determination of this case. One exhibit, KG1, accompanies the Statement, consisting of extracts from the websites of a number of suppliers of soil and grass protection systems, Mr Greaves asserting that this shows there to be many suppliers of such goods.

15. The second Witness Statement is dated 13 January 2005, and comes from Andrew D Houldsworth, who is employed by Nottingham City Council as a Team Leader in Highway Construction and Maintenance, and with over 30 years experience in the construction industry.

16. Mr Houldsworth says that a considerable part of his employment involves the purchasing of landscaping materials, and that he has to be aware of the many types of products available. He states that he is aware that the opponents= product, ECOBLOCK, is a type of plastic grass reinforcement with the specific use of stabilising grassed areas for use as hardstanding, a different application to the Charcon Eco Block. Mr Houldsworth says that he is a regular purchaser of landscaping materials which is how he knows of the Charcon Eco Block, which he describes as being part of a range of aesthetic landscaping materials which are traditionally used in commercial landscaping. He expresses his opinion that the trade mark ECOBLOCK will be utilised in different markets and will not lead to confusion.

17. The final Witness Statement is dated 28 January 2005, and comes from Nicholas Wilkins, Regional Design Manager of J S Bloor (Services) Limited. Mr Wilkins states that he has seventeen years experience in the construction industry in similar roles.

18. Mr Wilkins says that a significant part of his employment involves the specification and purchasing of landscaping materials, and that he has to be aware of the many types of products available. He says that over the past few years many types of plastic grass reinforcement have come to his attention, including the opponents= product, stating that these products are used where stabilisation of grassed areas is required to provide hard standing. Mr Wilkins says that he is a regular specifier/purchaser of concrete paving materials and has become aware of the opponents= ECOBLOCK product, which, he says, is used in very different applications to the applicants= goods. He concludes by giving his reasons why confusion is unlikely.

OPPONENTS= EVIDENCE IN REPLY

19. This consists of two Witness Statements. The first is dated 4 February 2005, and is a further Statement by Neil Grahame Hall.

20. Being reply evidence it is perhaps not surprising that much of Mr Hall= Statement consists of submissions on the evidence filed by the applicants, and his opinion on the substantive issues in this case. Whilst I do not consider it to be appropriate to summarise these

submissions in detail, I have done so where further information or clarification is provided. I will, of course, take all of the submissions fully into account in my determination of this case.

21. Mr Hall states that the goods sold under the ECOBLOCK mark are soil and grass protection systems, the services being the design and installation of the systems. He says that the service element is usually provided at no charge, and consequently, only , 30,000 of the turnover has been derived from services in the last three years. Mr Hall does not dispute that there are many companies selling similar goods, but says his company is the market leader with an 18% share of the plastic soil and grass protection system market. He refers to exhibit AH1, which consists of a report produced by the opponents in 2002, that states there to be three main products in the soil and grass protection industry, distinguished by material, namely, plastics, concrete and Aother@. The Aplastics@sector in which the opponents trade is shown as being the largest, accounting for , 3 million of an overall market of between , 5 to , 6 million, with the opponents being shown as the second largest in their sector. The report makes reference to the Aporous paving market@and gives details of the leading suppliers in the industry.

22. Exhibit A2 consists of a further extract from the website of A J McCormack and Son, Mr Hall pointing out that the Ahopsack@reinforced grass paving system shown is made of concrete and presumably is of the same nature as the products covered by the application. The hopsack system is described as using Aplain rectangular concrete paviors, laid to a pattern that leaves significant holes or pockets that are filled with soil and seeded...this technique can be used for residential driveways, or in the garden...any rectangular blocks can be used to create a hop-sack pattern resulting in varying pockets in the finished pavement. The edges of a hopsack pavement still need to be either against an existing sound structure, such as a wall, or with an edging unit...or laid on concrete, as described on the Block Paving Page@. The exhibit makes similar references to A spaced paving@using block paviors.

23. The final Witness Statement is dated 8 February 2005, and is a further Statement by Lee Curtis.

24. Much of Mr Curtis= brief Statement consists of submissions on the evidence filed by the applicants, namely, the Statements by Mr Houldsworth and Mr Wilkins. Whilst I do not consider it to be appropriate, or desirable to summarise these submissions, I will take them fully into account in my determination of this case.

25. Mr Curtis refers to exhibit L1, which includes a further print from the website of A J McCormack and Son, which Mr Curtis asserts clearly shows that concrete paving blocks are sold through the same trade channels as plastic soil and grass protection systems. The exhibit also includes prints from the websites of other companies that trade in soil and grass protection systems and paving blocks.

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

DECISION

27. The opposition is based on Section 5(4)(a). That section reads as follows:

A5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.@

28. Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* case [1998] RPC 455 set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

AA helpful summary of the elements of an action for passing off can be found in *Halsbury's Laws of England* (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] A.C. 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal, definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence

of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."@

29. To the above I add the comments of Pumfrey J in *South Cone Incorporated v Jack Bessant, and others*, [2002] RPC 19, in which he said:

A27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirement of the objection itself are considerably more stringent than the enquiry under S.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's* application (OVAX) (1946) 63 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.@

30. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced **B** as per the comments in *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] RPC 429.

31. That Mr Houldsworth and Mr Wilkins are aware of the applicants=product suggests that the applicants have used the mark that they seek to register, but there is nothing in the evidence that actually confirms this. That being the case, I must proceed on the basis that the relevant date is the date on which the application to register the trade mark was made.

32. The opponents claim to have used the name ECOBLOCK since at least July 1997, the use from that date being confirmed by an invoice forming part of exhibit NGH2 that is dated 23 July 1997. The invoice shows the word ECOBLOCK being used in relation to a soil and grass protection system, in other evidence shown to be made of plastic or HDPE (high density polyethylene). The associated fixings for the system are sold under the separate name ECOPIN. Mr Hall says that the mark has also been used in respect of a design and installation service although there is no specific evidence relating to this.

33. Mr Hall provides turnover figures for the period 1997 to 2003, although only the years to 2002 can be taken into account. On first impression these figures appear very modest. However, when put into the context of the total value of the soil and grass protection market, details of which have helpfully been provided by Mr Hall in exhibit A1, it can be seen that the opponents=turnover represents a significant level of achievement. In a sector that both sides accept has a large number of players, the opponents rate as number two with an 18% share, and with customers running the length and breadth of the country. Mr Hall indicates that the consumer of his company=s ECOBLOCK system would be the building products industry, and specifically, architects, building engineers, landscape architects, and building contractors. The opponents have made significant efforts in the promotion and advertising of the goods sold under the ECOBLOCK name, the focus being directed towards the architectural and construction sector reflecting the customer base. On the basis of the evidence before me I have no hesitation in concluding that, at the relevant date, the opponents and the soil/grass protection systems that they sell under the ECOBLOCK name, had accrued a reputation and goodwill amongst persons involved in the various sectors of the building design, engineering and construction industries.

34. The evidence shows the opponents= to have used the word ECOBLOCK in plain block lettering. The applicants are seeking to register the same word in plain block lettering. There is no stylisation that separates the words; the respective marks are identical.

35. The opponents have used the mark in respect of a soil and grass protection system. In general terms they describe the product as being an 'engineered solution to grass pavements', stating its applications as including car parks, emergency access lanes, service roads, pedestrian walkways and bridle ways. The information from the A J McCormack website (exhibit NGH12) describes these products as 'grass paving systems', and in a further extract from the website (exhibit L1), give the following explanation of the product:

There are a number of fairly common techniques available that allow grass to be incorporated into a pavement to provide 'the best of both worlds', ie, the appearance of grass but the load bearing capability of a well-constructed pavement or driveway. They can be utilised in those areas where the hard permanence of a typical pavement might be undesirable, such as in conservation areas, roadside verges, emergency services access, canal towpaths, farm tracks or rural settings...

36. From this it can be seen that the purpose of a soil and grass protection system is to provide an erosion resistant surface capable of taking traffic, human vehicular or otherwise, whilst retaining the appearance of a grassed area. The exhibits show that such systems are most commonly constructed from plastic or concrete, and can be in the form of concrete paving blocks, or interlocking cellular pavers made of concrete or plastic. It is the plastic cellular system that the opponents provide under the ECOBLOCK name.

37. The applicants seek to register ECOBLOCK in respect of 'Paving blocks; cementitious and concrete paving elements and materials; paving stones; flagstones'. As with soil and grass protection systems, goods of this description could be used to provide a hard surface capable of taking traffic, the only difference being that they would be visible and in some cases be selected for their aesthetic contribution to the surrounding area. It also seems to me that from the explanation in the preceding paragraphs, this specification is also capable of covering soil and grass protection systems. The term 'cementitious and concrete paving elements and materials' would encompass the same cellular system as the opponents' ECOBLOCK, the only distinction being the material from which they are constructed. The information relating to the 'hopsack' and 'spaced paving' reinforced grass paving systems shows that paving blocks are also used in constructing soil and grass protection systems. Cementitious and concrete paving elements and materials would also include blocks used in hopsack and spaced paving constructions. There is no specific mention of paving stones being used in such systems, but as stated in the extract from the A J McCormack website 'any rectangular blocks can be used to create a hop-sack pattern'. Insofar as these paving stones could be in the same form as block pavers I see no reason why they could not be. This leaves 'flagstones', which would be used to provide a visible hard standing, pavement or road, but being large slabs, would seem unlikely to be used in soil and grass protection systems.

38. Given that the goods sold by the opponents under ECOBLOCK, and those notionally covered by the specification of the application are similar, I do not see that there can be any difference in the market or how the trade is conducted. Even allowing for the fact that the consumer of soil and grass protection systems is likely to be very well informed, knowledgeable and circumspect, the only potential difference is the material from which the respective goods are constructed, which given that the marks are identical, is most unlikely to be enough to avoid deception or confusion. In my view the opponents have established their case and the objection under Section 5(4)(a)

succeeds.

39. The opposition having been successful, the opponents are entitled to a contribution towards their costs. I hereby order that the applicants shall pay the opponents the sum of , 1,650, this sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of August 2005

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