

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Registration No. 2344825  
standing in the name of The Dunraven Window Group  
and**

**IN THE MATTER OF an application for a declaration  
of invalidity thereto under No. 82073  
by Geoffrey Inc**

**BACKGROUND**

1. Trade Mark No. 2344825 was applied for on 1 October 2003. The registration procedure was completed on 5 March 2004. The mark in question is:



and it stands registered in Class 19 for a specification of goods reading:

“Non-metallic building materials; windows, doors, porches, conservatories and roofing products; PVCU trims being parts or fittings for the aforesaid goods”.

I note that the colours light and dark blue and red are claimed as an element of the mark.

2. On 11 March 2005, Geoffrey, Inc applied for a declaration of invalidity against the above registration. The statement of case accompanying the application sets out the grounds of invalidity, these being

- (i) under Section 47(2)(a)/5(2)(b) of the Trade Marks Act 1994 on the basis that there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with the family of “R” US marks;
- (ii) under Section 47(2)(a)/5(3) of the Act on the basis that use of the mark in suit without due cause would take unfair advantage of, or be detrimental to, the distinctive character and the repute of the “R” US marks;

(iii) under Section 47(2)(b)/5(4)(a) of the Act in that use and registration of WINDOWS “R” US would be liable to pass off the Applicant’s rights;

and

(iv) that the applicant is entitled to protection under the Paris Convention as provided for under Section 56(2) of the Trade Marks Act 1994 in relation to use in the UK of marks of which the essential element is “R” US in relation to identical or similar goods where the use is likely to cause confusion.

3. The applicant gave details of its earlier marks, in the statement of case, which are summarised here:

No.	Mark	Classes	Filing Date
CTM 1786862	TOYS ‘R’ US	3, 5, 8, 9, 10, 11, 12, 14, 15, 16, 18, 20, 21, 22, 24, 25, 26, 27, 28, 29, 30, 32, 35, 36, 38, 39, 41 & 42	25 July 2000
CTM 1786946	‘R’ US	3, 5, 8, 9, 10, 11, 12, 14, 15, 16, 18, 20, 21, 22, 24, 25, 26, 27, 28, 29, 30, 32, 35, 36, 38, 39, 41 & 42	25 July 2000
UK 2213106	MUMS ‘R’ US	5, 25 & 35	2 November 1999
UK 2221685A	BABIES ‘R’ US DIRECT	35	9 February 2000
UK 2226162	TOYS ‘R’ US DIRECT	35	17 March 2000
UK 2233170	SNACKS ‘R’ US	35	19 May 2000

4. On 21 April 2005, a copy of the application for invalidation and the statement of case were sent, by recorded delivery, to the registered proprietor at the address recorded on the register. In the accompanying letter, it was stated that the registered proprietor would need to file a Form TM8 and counterstatement to defend the registration on or before 2 June 2005. The consequences of failure to defend the registration were set out in the letter; namely, that the application for a declaration of invalidity could be granted whole or in part. The Registry received notification that the registered proprietor had appointed a representative by way of filing a Form TM33, and those details were duly entered on the Register on 19 May 2005. The registered proprietor, however, did not file a Form TM8 and counterstatement by the due date.

5. It does not follow, however that the uncontested nature of this action will automatically mean success for the applicant for the declaration of invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicant to prove why it is that the registration should be declared invalid.

6. I am mindful of the decision in the *Firetrace Case* (BL 0/278/01) where the Hearing Officer stated:

“It is not sufficient to simply allege that a registration offends either Section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

The reason that the Hearing Officer arrived at this view is the statutory presumption of validity in Section 72 of the Act which states:

“In all legal proceedings.....the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transaction of it.”

7. With this in mind, on 16 June 2005, the Trade Marks Registry wrote to the applicant inviting the filing of any evidence or the making of any submission which it was felt would support the applicant’s case and, at least, establish a prima facie case. After two extensions of time, the applicant had, by 3 November 2005, provided a witness statement and one exhibit in support of its case. A third extension of time was allowed for filing an additional witness statement, which did not materialise. A hearing was not requested and this decision is, therefore, taken from the papers filed.

## **EVIDENCE**

8. The applicant for invalidity filed evidence by Jeremy Bankes Pennant, its professional representative in this matter. The evidence consists of a witness statement, dated 28 October 2005, and one exhibit: JBP-1. The witness statement is simply a list of what was contained in the exhibit; chiefly, previous opposition and infringement decisions which had gone in the present applicant’s favour. These are as follows:

- i. Geoffrey Inc v. Digital Wizardry Inc, National Arbitration Forum (2005);
- ii. Geoffrey Inc v. Toysrus, National Arbitration Forum (2003);
- iii. Geoffrey Inc v. Online Rus, WIPO Arbitration and Mediation Centre, Case no. D2000-1009 (2000);
- iv. Geoffrey Inc v. Lal’s International (BVI) Inc, UAE Ministry of Economy & Commerce, Trade Mark Section (2004);
- v. Toys “R” Us Inc v. Canarise Kiddie Shop Inc, 559 F. Supp. 1189 (1983);
- vi. Geoffrey Inc v. AlKofa Services, Haitham Younis Habib and Fadi Shuaib Shuaib, Dubai, Department of Justice, Court of First Instance (2005);
- vii. Toys “R” Us Inc v. Lamp R Us, 219 USPQ 340 (1983);
- viii. Geoffrey Inc v. Nails R Us, Instituto de Beleza E Saude, LDA, Court of Appeal of Lisbon (Second Instance Court) (2005);

- ix. Geoffrey Inc v. Baim Lab Co Ltd, Korean Intellectual Property Office, 3<sup>rd</sup> Division of the 1<sup>st</sup> Examination Bureau (2005);
- x. Geoffrey Inc v. National Canine Defence League, UK Patent and Trade Mark Registry (2003) and
- xi. Geoffrey Inc v. S Rus – www.toysrus.com WIPO D200-1008 (2000).

9. Apart from number “x”, which refers to a UK Trade Mark Registry opposition decision, the remainder of the decisions emanate from overseas jurisdictions, none of which are binding on the UK and none of which can shed any light on the position of the applicant’s marks in the UK, including what those marks might mean to UK consumers. The evidence filed in the UK case has not been adopted for the purposes of the present proceedings. On the face of it, the circumstances of that case were quite different to those pertaining here. I therefore find Exhibit JBP-1 to be of limited assistance.

10. The applicant’s arguments against the validity of the registered mark are contained within its statement of case. This commences with an assertion that the applicant is a wholly owned subsidiary of the “well known corporation, Toys “R” Us, Inc and is the proprietor of the famous “R”US mark, in addition to a large family of marks incorporating the “R” US suffix, throughout the world”. The applicant states that Toys “R” Us has used its marks continuously since 1985 in the UK, not only in relation to the retail of toys and sporting goods, but also a wide range of other goods, which it then goes on to list. Amongst this list are window latches, sun catchers, sunlight filters for windows and holiday window decorations. The applicant further asserts that “so associated is the term “R” US with Toys “R” Us that whenever consumers see it being used, they associate such use with Toys “R” Us, no matter the goods or services being offered.”

11. A sales figure of US \$11 billion for the fiscal year of 2003 is given, but none for the UK. The applicant states that there are sixty of its stores in the UK, including two near to the registered proprietor’s locality. Its website, www.toysrus.co.uk, averages between 1.25 and 2.5 million visitors per month.

12. The applicant says that the “R” US mark is either used alone or with a descriptive noun such as “toys”, “kids”, “babies” or “books”, but does not give any examples of such use in the UK. I have before me only the details of the applicant’s various UK and Community Trade Mark registrations referred to above. The applicant alleges that the dominant element of the mark in issue is “R” US and that “WINDOWS” is merely descriptive of the goods sold under the mark. It argues that there is therefore a likelihood of confusion on the part of the public, which includes a likelihood of association with the family of “R” US marks under section 5(2)(b) of the Act; that use of the mark without due cause would offend section 5(3) of the Act; and that use and registration of the mark would be liable to pass off the Applicant’s rights and that the mark is therefore vulnerable under section 5(4)(a)/section 47(2)(b) of the Act. Finally, the applicant asserts that the use of the “R” US marks throughout the UK over the past twenty years has resulted in the marks becoming famous and it therefore seeks the protection of the Paris Convention, as provided for under section 56(2) of the Act.

## DECISION

13. I propose to deal first with the grounds raised under Section 47(2)(a)/Section 5(2)(b). These sections read:

### Section 47

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

(b) that there is an earlier trade mark to which the conditions set out in section 5(1), (2) or (3) obtain...

(b) .....

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

### and Section 5

“(2) A trade mark shall not be registered if because –

(a) .....

(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.”

14. I take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*; who is deemed to be reasonably well informed and reasonably circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;

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

- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* ;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;
- (h) but if the association between the marks causes the public wrongly to believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*.

15. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion, I am guided by the judgments of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods or services, the category of goods or services in question and how they are marketed. The visual, aural and conceptual similarities must be assessed in relation to the overall impression of the marks, including an assessment of their respective distinctive and dominant components, but without unduly dissecting the marks. I must compare the registration being attacked and the applicant's earlier marks on the basis of any use made of the respective marks and also on the basis of their inherent characteristics, assuming normal and fair use of the marks on the goods covered within the width of their respective specifications. All this must be done from the perspective of the average consumer for the goods or services in the relevant territory.

### **Similarity of marks**

16. The applicant alleges that the dominant element of the mark in issue is "R" US. It states that its own "R" US marks are either used alone or with a descriptive noun such as "toys", "kids", "babies" or "books. It says that the "R" US marks gain their fame and distinctiveness primarily from the coined nature and distinctiveness of the term "R" US. The applicant, alongside its statement that the dominant element of WINDOWS "R" US is "R" US, adds that "WINDOWS" is merely descriptive of the goods sold under the mark. At this point, it is convenient to consider the ruling of the European Court of Justice in *Medion AG v Thomson Multimedia Sales Germany &*

*Austria GmbH* Case C-120/04, in the sense that the applicant's concern is that the registered proprietor has added an element (windows) to its own registered trade mark "R" US. However, the referring question to the court was concerned both with identical goods or services and also with the extra element being a company name. Neither of those fit these proceedings: "windows" is not a company name being added to another's trade mark and, as will be seen below, there is no similarity between goods and services in these proceedings.

17. In the English language, "r us" is incorrect grammar (and spelling) and that, in my views, is where the dominant element and the distinctive character of the applicant's earlier marks lie. The marks do not say "we are". The marks follow a linguistic pattern; that is to say, they consist of "r us" preceded by a word descriptive of the goods, and in the case of CTM 1786946, "r" us solus. Visually, aurally and conceptually, there is a certain degree of similarity, based on the linguistic footprint made by the "R US". However, it would be contrary to established EU jurisprudence to reduce the comparison of marks simply to A + B = likelihood of confusion. That is not what the average consumer does, rarely having the chance to compare marks side by side. It would be remiss of me to ignore the additional descriptive elements and stylization of the registration and it would be wrong to conclude that the initial, descriptive element should be disregarded in my global comparison. Consumers do not ignore the beginnings of marks and I must put myself in the shoes of that average consumer.

#### **Average consumer**

18. The average consumer for the goods of the applicant is the public at large, particularly those members of the public who have families. There is no reason to believe that this group of average consumers would be anything other than reasonably well informed, circumspect and observant, as envisaged by the European Court of Justice, in their purchasing habits of consumer goods. As for the goods which the registration covers, they are items which may be purchased for domestic or commercial premises, by householders or tradesmen. Such items are likely to be purchased with a degree of care.

#### **Similarity of goods and services**

19. An essential element of the global comparison of marks under section 5 of the Act is an assessment of the level of similarity between the goods and services of the respective marks. I bear in mind that a greater or lesser degree of similarity in this respect may be offset by a greater or lesser degree of similarity between the marks themselves. The applicant has not particularised which goods or services in its own registrations conflict with those of the registration under attack. In paragraph 2 of its statement of case, there is a list of goods and services which includes "window latches, sun catchers, sunlight filters for windows and holiday window decorations". At first glance, it would seem that these could be considered similar to the registered proprietor's goods.

20. However, I have been unable to find any mention of these items in the details of the applicant's earlier marks upon which it relies in these proceedings. The wording of section 5(2)(b) of the Act (implementing Article 4(1)(b) of Council Directive No.89/104/EEC of 21<sup>st</sup> December 1988),

“(2) A trade mark shall not be registered if because ... 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”,

does not provide for a finding of likelihood of confusion under the heading of section 5 without at least a similarity of goods or services. I am further guided in this respect by the European Court of Justice who, in *Canon*, stated at paragraph 22:

“It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

21. The judgment goes on to list factors which may be used in assessing similarity, including the nature of the goods or services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. I have used these measures in weighing the levels of similarity between the goods and services in the applicant’s and registered proprietor’s registrations and have been unable to find any similarity. In *euroMASTER*, T-31/04, the Court of First Instance, had this to say, at paragraph 35, about what complementary means in assessing similarity between goods and services:

“As for the complementarity of the goods and services referred to by the applicant, the Court points out that, under existing case law, complementary goods and services are those which are so closely linked that one is essential or important for the use of the other and consumers may therefore think that responsibility for the manufacture of these goods or the provision of these services lies with the same undertaking”.

I cannot find that the goods and services are in competition or that they are complementary, or that they share a common nature or intended purpose.

22. In *Raleigh International Trade Mark* [2001] RPC 202, Geoffrey Hobbs Q.C., sitting as the Lord Chancellor’s Appointed Person said:

20. “If the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered, the objection should be supported by evidence as to their “similarity” (whether or not the objection is directed to the use of an identical mark): Canon paragraph 22.

.....

21. Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under Section 5(2) must be to determine the net effect of the given similarities and differences”.

There is no evidence as to the purported similarity of goods and services. My considered view of the pleading under section 5(2)(b) is that there is a reasonable level of similarity between the actual marks, but that there is no level of similarity between the respective goods and services for which the applicant and the registered proprietor have cover. In reaching this view I have considered normal and fair use and have attributed to the listings of goods and services the core of their possible meanings that I would expect the average consumer to give them.

**23. The section 5(2)(b) ground for a declaration of invalidity under section 47(2)(a) is dismissed.**

**Section 5(3) of the Act**

24. Section 5(3) of the Act reads:

“(3) A trade mark which is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

25. The applicant has supplied limited evidence and submission in support of its reputation, little of which goes to the position in the UK. The statement of case does no more than to paraphrase the wording of the Act. As for evidence going to reputation, there is an assertion that the average number of visits to its UK website [www.toysrus.co.uk](http://www.toysrus.co.uk) ranges between 1.25 and 2.5 million per calendar month. There is a copy of a decision on a previous dispute before the Registrar involving the applicant and its trade marks and a different third party. Beyond those, there is nothing which helps me to gauge the extent of the reputation of the applicant in the UK. Even, for argument’s sake, if I were to infer from my own knowledge as an average consumer of the applicant’s goods and services that the applicant has a reputation for toy retailing, I must still satisfy myself that the registered proprietor’s mark will cause either of the two heads of damage specified in the wording of the Act: unfair advantage or detriment to the distinctive character of the applicant’s earlier marks.

26. Under section 5(3) there is no requirement for confusion as to origin. The ECJ said, in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd*, Case C-408/01:

“27. In that regard, it must be noted at the outset that, unlike Article 5(1)(b) of the Directive, which is designed to apply only if there exists a likelihood of confusion on the part of the public, Article 5(2) of the Directive establishes, for the benefit of trade marks with a reputation, a form of protection whose implementation does not require the existence of such a likelihood. Article 5(2) applies to situations in which the specific condition of the protection consists of a use of the sign in question without due cause which takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark (see Case C-425/98 *Marca Mode* [2000] ECR I-4861, paragraphs 34 and 36).”

However, there must be a connection between the applicant's and the registered proprietor's marks:

“29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23.

30. The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

27. I have already conducted a global appreciation of the similarities between the marks and came to the conclusion that, notwithstanding the lack of similarity between the goods and services, (similarity is not a requirement under this head), there is no likelihood of confusion between the marks. However, that is not, according to the paragraph cited above, a requirement under section 5(3). What is required is that the link is more than an association or calling to mind:

“102. I think it is clear that in order to be productive of advantage or detriment of the kind proscribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

That was what the court said in *Electrocoin Automatics Limited v Coinworld Limited and others* [2004] EWHC 1498 (Ch). In the same year, the High Court also said that there “must be real possibilities as opposed to theoretical possibilities” of the damage claimed, in *Mastercard International v. Hitachi Credit (UK) Plc* [2004] EWHC (Ch).

28. I doubt that the economic behaviour of the average consumer of non-metallic building materials, windows and doors, will be affected by the mark in suit, even if the applicant's marks are called to mind. There is no real possibility of it. The applicant has not directed me as to how it feels that the registered proprietor would gain an unfair advantage from its own reputation. It has also given me no clues as to how it feels detriment to its reputation would be caused by the applicant's mark. I am unable to find for the applicant under this ground.

**29. The section 5(3) ground for a declaration of invalidity under 47(2)(a) is dismissed.**

30. As regards the ground brought under section 56(2), the pleadings are somewhat thin in scope. I have concluded that failure for the applicant under section 5(2) and 5(3) or the Act means that it is not in a better position with regard to section 56(2). **The ground brought under section 56(2) is dismissed.**

31. The pleadings also included the ground of section 5(4)(a); however, there is nothing in the applicant's statement of case or evidence which would lead me to believe that they would be in a better position under this passing off heading than under section 5(2)(b). **The section 5(4)(a) ground for a declaration of invalidity under section 47(b) is dismissed.**

### **COSTS**

32. The applicant has been unsuccessful. However, the registered proprietor did not defend the application and there is no evidence that it has been put to any expense in these proceedings. As a consequence, I make no order as to costs.

**Dated this 08th day of August 2006**

**JC Pike  
For the Registrar  
The Comptroller-General**