

O/233/21

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK00003061828

IN THE NAME OF GRAHAM SAVAGE

FOR THE FOLLOWING TRADE MARKS:



(SERIES OF 2)

IN CLASSES 6, 11, 19, 37, 41 AND 42

AND

AN APPLICATION FOR REVOCATION

UNDER NO. 503080

BY MALGORZATA ANNA KOSC

BACKGROUND AND PLEADINGS

1. Graham Savage is the proprietor of the trade marks shown on the cover page of this decision (“the Contested Marks”). The Contested Marks were filed on 27 June 2014 and registered on 10 October 2014. The Contested Marks stand registered for the following goods and services:

Class 6 Metal building materials; pipes and tubes of metal; ceiling supports of metal; frameworks of metal for ceilings; metal framed false and suspended ceilings; parts, fittings and accessories for all the aforesaid goods.

Class 11 Apparatus for lighting; lighting; ceiling lights; light diffusers; light assemblies; light bulbs; light installations; light projectors; parts, fittings and accessories for all the aforesaid goods.

Class 19 Building materials (non-metallic); frames (non-metallic) for false ceilings; ceilings (non-metallic); false ceilings (non-metallic); suspended ceilings (non-metallic); suspended ceiling structures (non-metallic); cladding (non-metallic) for ceilings; coverings (non-metallic) for ceilings; parts, fittings and accessories for all the aforesaid goods.

Class 37 Ceiling repair; ceiling installation; ceiling construction; ceiling cleaning; ceiling maintenance; lighting repair; lighting installation; lighting cleaning; lighting maintenance; consultancy, information and advisory services relating to all of the aforesaid services.

Class 41 Education; providing of training; organisation of seminars; organisation of exhibitions and conferences for educational purposes; consultancy, information and advisory services relating to all of the aforesaid services.

Class 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services; interior design;

architectural design for interior decoration; architecture; consultancy, information and advisory services relating to all of the aforesaid services.

2. On 15 April 2020, Malgorzata Anna Kosc (“the applicant”) filed an application seeking to revoke the Contested Marks under section 46(1)(c) of the Trade Marks Act 1994 (“the Act”). Ms Kosc sets out her pleadings as follows:

“We ascertain that ‘Stretch Ceilings’ cannot be trade marked because of the following government rulings on the matter: the trade mark ‘described the goods or services it will relate to, for example, the word ‘cotton’ cannot be a trade mark for a cotton textile company’ and the term is ‘...too common and non-distinctive’. For a single entity to trade mark ‘Stretch Ceilings’ would be an act of non-compliance with these rulings.

A Stretch Ceiling is a suspended ceiling system in common usage and consists of two basic components – a perimeter track and a lightweight fabric membrane. The membrane stretches and clips into the track. In addition to ceilings the system can be used for wall coverings, light diffusers, floating panels, and exhibition spaces, and is therefore non-distinctive. All of those items are also in common usage around the world.

A Stretch Ceiling is a development and variation of the Dropped Ceiling or the Suspended Ceiling, which was first patented in the United States in 1919, and has been in production since this time. The technology has therefore been around and in use for over one hundred years. In fact, it would be more accurate to say: a combination of the technologies used in Stretch Ceilings have been around for over one hundred years. The components that make up a Stretch Ceilings have been around and used for multiple purposes for much longer – a period of time that cannot be defined.

The first ceiling system to be officially manufactured as a ‘Stretch Ceiling’ was created by Normalu® in 1969. Since this time Stretch Ceilings have been commonplace in offices, workplaces, hotels, commercial spaces, and residential homes in countries all over the world and on every continent. To

meet this demand, thousands of different companies, manufacturers, sellers, and distributors of multiple sizes and nationalities have all been involved in the production, selling, and installation of Stretch Ceilings (with, of course, varying degrees of success). Stretch Ceilings are therefore so commonplace that they cannot belong to a single entity, company, corporation, brand, manufacturer, or organisation. The same goes for the term 'Stretch Ceiling' and any associated wordage, because the term does not apply to distinctive use of the aforementioned technology.

Google and YouTube are arguably the biggest providers of public information in the world. Entering 'Stretch Ceilings' into Google returns over 50,200,000 results. Among the result are thousands of different companies who manufacture, sell, and install Stretch Ceilings. No single company is returned in the search, and companies' placement within the Google rankings and algorithms is merely a matter of each company's success, reputation, sales volume, brand awareness, advertising spend, and marketing techniques such as SEO. The longevity and trading period of these companies varies from decades to mere weeks.

Much in the same way that there are many thousands of manufacturers of cars, 'car' does not belong to a single entity. A car is an everyday item or product, and is far too commonplace and popular an item that 'car' belonging to a single entity would be impossible. There are many different makes of car, but in common parlance 'car' is immediately known and does not refer to a company or manufacturer.

Any legislation or trade mark cannot and should not be used to stop other companies using 'Stretch Ceilings', because the technology is far too common and non-distinctive to a specific use in a specific environment. We therefore firmly believe it is impossible for a single entity, company, or organisation to trade mark 'Stretch Ceilings' and thus apply for a revocation."

3. The proprietor filed a counterstatement denying the claims made and stating as follows:

“3. Section 46(1)(c) is contingent upon a finding of acts or inactivity of the proprietor which have led to the trade mark becoming the common name in the trade for a product or service for which it is registered.

4. The Applicant has not detailed any acts or inactivity of the Proprietor which have led to the Registered Mark allegedly becoming the common name in the trade for the products and services for which it is registered and is put to strict proof of the same.

5. Notwithstanding the above, the Proprietor has traded regularly under the Registered Mark since its registration on 10 October 2014. The Proprietor has also taken all action which could reasonably be expected in the circumstances to prevent the Registered Mark becoming the common name in the trade for the products and services for which it is registered, including placing a registered trade mark symbol next to the Registered Mark whenever it is used and investing in advertising under the Registered Mark.

6. Section 46(1)(c) is also normally contingent upon a finding that the trade mark has become the common name in trade for the products or services in question after the date of registration of the trade mark. The Applicant is therefore put to strict proof as to when, following the registration of the Registered Mark, the Registered Mark became the common name in trade for the goods and services for which it is registered.

7. Further, the Proprietor denies that ‘STRETCH CEILINGS’ is in fact a common name in the trade for the goods and services under the Registered Mark and the Applicant is put to proof of the same.

8. In any event, the Registered Mark is not merely a word mark but rather a figurative mark which incorporates the word ‘STRETCH’ in stylised red font with a unique, lowercase typeface and the word ‘CEILINGS’ in black font with an alternate lowercase typeface. Further, the Registered Mark features 6 distinctive graphic squares featured above the word ‘STRETCH’ which are

coloured in purple, blue, green, yellow, orange and red and which feature a characteristic line cutting through the graphic squares, clearly dominating the mark. In view of these numerous distinctive figurative element, the Proprietor denies that the Registered Mark has become the common name in the trade for the products and services for which it is registered.”

4. Both parties filed evidence in chief. The applicant also filed evidence in reply. The applicant is unrepresented and the proprietor has been represented throughout these proceedings by Briffa Legal Limited. Neither party requested a hearing, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

5. The applicant filed evidence in chief in the form of her own witness statement dated 5 October 2020.

6. The proprietor filed evidence in chief in the form of the first and second witness statements of Alexander Fewtrell dated 29 July 2020 and 7 December 2020 respectively and his own witness statement dated 4 December 2020. The proprietor's statement was accompanied by 25 exhibits and Mr Fewtrell's first statement was accompanied by 1 exhibit. Mr Fewtrell is the solicitor representing the proprietor in these proceedings.

7. The applicant filed evidence in reply in the form of her second witness statement dated 7 February 2021.

8. As noted above, both parties filed written submissions in lieu.

9. Whilst I have taken all of the evidence and submissions into account, I do not propose to summarise it here. Instead, I will refer to it below where necessary.

PRELIMINARY ISSUES

The Applicant's Identity

10. The form originally filed by the applicant in these proceedings was completed in the name of "Malgosia Kosc".

11. In his first witness statement, Mr Fewtrell provided a copy of a report prepared by a Professional Investigator.¹ The purpose of the report is to call into question whether the applicant had provided the correct name for the purposes of bringing these proceedings, both in terms of her own name and the name of a third party ("SK"), provided under the "contact details" section of the Form TM26(O).

12. In her evidence in reply, the applicant stated:

"2. [...] I Malgosia Kosc want to clarify for the purposes of these proceedings I have been using my nickname and my full name is Malgorzata Anna Kosc. I reason [sic] for this is because it is easier to pronounce my nickname rather than my actual name for most people in the UK that is why I opted to this. (Evidence of my ID has been attached with this witness statement as MK2)."

13. The applicant's statement was signed with a statement of truth and she duly filed a copy of her passport as proof of her identity.²

14. On 10 February 2021, the Tribunal wrote to the applicant as follows:

"The evidence rounds are now concluded. However, the Tribunal notes that you have been using your nickname of Malgosia Kosc for these proceedings rather than your actual name of Magorzata Anna Kosc. Whilst the Tribunal is prepared to accept the evidence you have filed under your nickname you are required to file an amended Form TM26(O) which provides your real name as the applicant

¹ Exhibit AF1

² Exhibit MK2

in these proceedings. Please submit the amended form on or before 24 February 2021.”

15. The applicant duly filed an amended Form TM26(O), listing her full name under the applicant’s details section. Consequently, I do not consider it necessary to address the identity questions raised by the proprietor any further.

Claimed non-distinctiveness of the Contested Marks

16. In her written submissions, the applicant has made reference to the fact that she considers the Contested Marks to be “non-distinctive”. As the proprietor correctly notes, that is not the same as an objection under section 46(1)(c). A claim that a trade mark is non-distinctive and, consequently, should never have been registered should be pleaded under section 3(1)(b) of the Act. That is not a ground pleaded for the purposes of these proceedings and, consequently, I need not address the matter any further.

Fraudulent phone calls

17. In her first witness statement, the applicant states:

“2. My husband [SK] is not directly involved in this case. He is only an alternative point of contact so please exclude him from any investigation. However, I was informed by him that he received a call from a person called Alex (not Andrew) from Intellectual Property Office. Also, there was no number displayed on his phone during that call. I find it a little bit surprising and wonder if it wasn’t Alex Fewtrell himself.”

18. In his second witness statement, Mr Fewtrell states:

“6. At paragraph 2 of the CA’s Witness Statement the Cancellation Applicant appears to suggest that I may have contacted the Cancellation Applicant’s husband, [SK] via telephone, fraudulently alleging to be a representative of the

UK Intellectual Property Office. This is categorically denied and I have at no time contacted [SK].

7. As a solicitor of the senior courts of England and Wales I would never engage in fraudulent conduct and I would take such allegations extremely seriously.”

19. For the avoidance of doubt, there is no evidence of any wrongdoing on the part of Mr Fewtrell and I see no need to address this point any further.

DECISION

20. Section 46 of the Act states:

“(1) The registration of a trade mark may be revoked on any of the following grounds –

[...]

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product of service for which it is registered;

[...]”

21. The provisions of section 46(1)(c) are based on article 12(2)(a) of the directive 104/89 and must be interpreted accordingly. I bear in mind that it is the perception of the mark by consumers or end users which is generally of decisive importance to the assessment of whether the mark has become a common name for the registered goods and services.³ However, I do not discount that for some goods and services, the perception of intermediaries may also be of note.

³ *Bjornekulla Frukindustrier AB v Procordia Food AB*, Case C-371/02

22. Whether a mark has become the common name in the trade for a particular product or service is a question of fact. I bear in mind that it is a qualitative test, rather than a quantitative one.⁴ As this is a question of fact, which is disputed by the proprietor, it is a matter on which I would have expected to have evidence from the applicant. However, the only evidence I have on the matter from the applicant is narrative evidence in the form of her witness statement, in which she states:

“4. [...] “Stretch ceilings” is a type of ceiling – when using Google search, the engine shows 10 million results proving that. [...]”

23. In her evidence in reply, she states:

“10. [...] it is clear that TM UK00003061828 is not maintainable in any sense since the name of the brand is clearly being associated a product [sic] which is far too common not only in the UK but around the world. [...]”

24. In a case of this kind, I would expect to see evidence from the applicant demonstrating that the mark has become generic. For example, one might expect to see examples of other traders using the term in practice, witness statements from individuals with standing within the relevant product or service market or survey evidence. No such evidence has been provided by the applicant in this case. To my mind, statements asserting that a mark has become generic, as set out in the applicant’s witness statement are not sufficient to prove a case of this kind; such statements of opinion should be supported by the corresponding evidence.

25. I note that the applicant refers to the report of the proprietor’s Professional Investigator, which describes the proprietor as supplying and installing “stretch ceilings in the UK”. The applicant puts this statement forward as proof that the term has become generic. That statement might suggest that the name has become a generic term. However, it might also indicate that he was referring to a specific product name used by the proprietor. Without further information, it is impossible to tell. In any event, one statement from an individual who may or may not be the relevant consumer or

⁴ *Hormel Foods Corporation v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch); [2005] E.T.M.R. 54 (Ch)

end user for the goods and services in question is not, to my mind, sufficient to prove the applicant's case.

26. It is also important to note that this case is not concerned with a word only mark. There are also colour and device elements to the Contested Marks. Even if the term "stretch ceilings" had become generic, I consider it likely that the additional stylisation, use of colour and device would be sufficient to overcome that objection in any event.

27. Mr Savage has provided evidence regarding the steps taken by the proprietor to prevent the mark from becoming generic. Specifically, he refers to various examples of the proprietor using the mark in conjunction with the ® symbol to ensure that it is known that the mark is a registered trade mark. However, as no evidence has been filed to support the claim that the mark has become generic, I do not consider it necessary to go into this evidence in any further detail.

CONCLUSION

28. The application for revocation is dismissed.

COSTS

29. As the proprietor has been successful it is entitled to a contribution towards its costs based upon the scale set out in Tribunal Practice Notice 2/2016. In the circumstances, I award the proprietor the sum of **£1,400**, calculated as follows:

Preparing a counterstatement and considering the applicant's Notice of revocation	£350
Filing evidence and considering the applicant's evidence	£500
Written submissions in lieu	£350
Official fee	£200

Total

£1,400

30. I therefore order Malgorzata Anna Kosc to pay Graham Savage the sum of £1,400. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 1st day of April 2021

S WILSON

For the Registrar