

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 716225
AND THE REQUEST BY RICHTER-SYSTEM GMBH & CO. KG.
TO PROTECT A TRADE MARK IN CLASSES 6 & 19**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 70246
BY ECOPHON AS**

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**IN THE MATTER OF International Registration No. 716225
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to protect a trade mark in Classes 6 & 19**

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**IN THE MATTER OF opposition thereto under No 70246
by Ecophon AS**

Background

1. International Trade mark Registration No.716225 is in respect of the mark EUROPHON. On 25 May 1999, Richter-System GmbH & Co. Kg. sought protection in the United Kingdom in respect of:

Class 6 Building materials made out of metal, ironmongery, suspensions for suspended ceilings, metal profiles for suspended ceilings and partition walls in dry mortarless construction; kits for suspended ceilings and partitions, mainly made out of metal profiles, suspensions, tiles and panels; tiles made out of metal and materials bonded to metal; panels made out of metal for suspended ceilings and partitions; screws made out of metal, door frames made out of metal; corner beads and lathwork made out of metal.

Class 19 Building materials (non-metallic), building boards (non-metallic), mineral fibre boards, gypsum boards, cement based boards and hard boards; tiles for suspended ceilings made out of mineral fibre, gypsum boards or bonded materials; panels for suspended ceilings and partitions; corner beads and lathwork made out of plastic, paper and glass fibre mesh.

2. The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with article 3 of the Trade Marks (International Registration) Order 1996 and details of the International Registration were published in accordance with article 10. The publication took place on 3 November 1999 in Journal number 6301.

3. On 3 February 2000, Ecophon AS filed notice of opposition to the granting of protection within the United Kingdom and claiming to have been using and have registered 3 trade marks, details of which are set out below. In summary, the grounds of opposition are:

Under Section 5(2) because the trade mark applied for is similar to the opponents' trade mark and is sought to be registered for goods at least some of which are identical with or similar to those covered by the opponents' trade mark. As a consequence, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with the opponent's trade mark.

Under Section 5(3) insofar as the goods are not similar, then by virtue of the opponents' reputation, use of the applicant's trade mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or repute of the opponents' trade mark.

Under Section 5(4) as a result of the reputation in the opponents' trade mark, use of the trade mark applied for in relation to the goods for which protection is sought is liable to be prevented by virtue of the law of passing off.

4. The marks relied upon in the grounds above are as follows:

Number	Mark	Class	Specification
1231962	ECOPHON	6	Metal ceilings; metal wall panels; and parts and fittings included in Class 6 for all the aforesaid goods.
1231963	ECOPHON	17	Sound and/or heat insulating materials made of inorganic fibres
1231964	ECOPHON	19	Building materials, roofing materials, ceilings, ceiling tiles, ceiling panels, wall panels, wall tiles, all made of inorganic fibres; parts and fittings included in Class 19 for all the aforesaid goods.

5. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based. Both sides request that an award of costs be made in their favour.

6. Both sides filed evidence in these proceedings. The matter came to be heard on 8 January 2002, when the applicants were represented by Ms Alison Cole of Urquhart Dykes & Lord, their trade mark attorneys, the opponents by Mr Guy Tritton of Counsel, instructed by Withers & Rogers, their trade mark attorneys.

Opponents' Evidence

7. This consists of an affidavit by Jan Lovostrom, Managing Director of Ecophon AB. The opponent company, Ecophon AS, is a subsidiary of Ecophon AB. Mr Lovostrom confirms that the facts and information contained in his affidavit are taken from his own knowledge, his experience in the trade or from the books and records of his company or have been told to him by someone else.

8. Mr Lovostrom states that his company is a leading manufacturer of acoustic ceiling systems for use in environments such as offices, schools etc. He confirms that he has read the notice of opposition and the counterstatement filed in these proceedings, for information purposes has attached them at exhibits JL1 and JL2 of his affidavit.

9. Mr Lovostrom sets out the details of the opponents' trade marks relied upon in these proceedings, referring to exhibit JL3 which consists of copies of the UK registration certificates and of details of the trade marks as published in the Trade Marks Journal. He goes on to mention two of these registrations, nos. 1231962 and 1231963 stating that the mark has been in continuous use in the United Kingdom since approximately 1984-85 in respect of the goods covered by the three trademarks upon which the opponents rely. Mr Lovostrom introduces exhibit JL4 which consists of a schedule setting out the opponents' worldwide registration of the ECOPHON trade mark.

10. Mr Lovostrom sets out figures for the sale, advertising and promotion of products under the opponents' ECOPHON mark for the period 1995-1999. I note that the sales figures are not broken down by class, neither is there any indication that the sales figures are limited to the goods detailed in the opponents' registrations.

YEAR	SALES FIGURES (£)	ADVERTISING & PROMOTION
1995	£7, 834, 964	£300, 000
1996	£8, 221, 584	£400, 000
1997	£9, 340, 181	£440, 000
1998	£10, 320, 193	£500, 000
1999	£9, 058, 217	£540, 000

11. Mr Lovostrom next refers to exhibit JL5, which consists of print outs from Ecophon Group's website detailing their history, structure and some financial details of the Ecophon Group since 1968 which is when its first subsidiary's were established. He then refers to exhibit JL6 which consists of number of brochures and product catalogues which detail the opponent's product range under the ECOPHON mark. They are dated from September 1989 onwards.

12. Mr Lovostrom concludes his evidence by giving his opinion as to the likelihood of confusion between the applicants' trade mark and the marks of the opponent. He states that

there are visual, phonetical and conceptual similarities between the marks, that there is a clear conflict between the goods of the application in suit and the goods of the opponents' mark, and therefore confusion will arise. Furthermore, he states that confusion is increased in view of the opponents' reputation and goodwill. He concludes by saying that even if they did not confuse one company with the other, at the very least, it is probable that they might assume that EUROPHON and ECOPHON were part of the same business.

Applicant's Evidence

13. This consists of a witness statement by Rosemary Anne Barker of Urquhart-Dykes & Lord, the applicants' trade mark attorney in these proceedings.

14. Ms Baker refers to exhibit RAB1 which consists of a list of 5 pairs of registered trade marks. Each pair consists of trade marks, in different ownerships, which share the same or similar suffix. However, in each pair the prefixes differ, the first mark of the pair being prefixed "ECO" and the second mark in the pair being prefixed "EURO". Ms Baker opines that as these marks co-exist in the same field (building materials) then there is an implication that the prefixes ECO- and EURO are considered sufficiently distinctive by the UK Registry and/or by the respective owners of these marks so as not to be likely to cause confusion. It is noted that some of the registrations listed are Community Trade Mark registrations and not marks registered by the UK Registry.

15. Ms Baker then refers to exhibit RAB2. This consists of a certified translation of a decision issued by the German Patent and Trade Mark Office. It is dated 21 February 2001 and concerns a conflict between the EUROPHON and ECOPHON marks. Ms Baker states that the decision reached was that the marks as a whole were so different that a risk of confusion does not arise.

Opponent's Evidence in Reply

16. This consists of a witness statement by Laurel Elizabeth McBray of Wither & Rogers, the opponents' trade mark attorney in these proceedings.

17. Ms McBray refers to the pairs of marks put forward by the applicant in their evidence. She states that the reason for co-existence put forward by the applicant is pure conjecture, there being other possible reasons, eg, the marks are not in use, the parties are not aware of each other's marks etc. She further says that state of the register evidence is not an accurate reflection of the actual state in the marketplace. She also adds that each mark must be considered on its own merits and that as the circumstances behind the acceptance of these other marks are not known, then they cannot be held to be comparable.

18. Nonetheless Ms McBray goes on to conduct an analysis of the marks and to give a number of reasons why she does not consider the examples to be on all fours, namely, no conflict of goods, some marks having a device element, some being Community Trade Marks, the suffixes being distinguishable etc.

19. Ms McBray then discusses the German decision evidenced by the applicants. She states

that decisions made in other jurisdictions are not binding upon the UK Registry. She also points out that the German decision was made on a pure mark by mark comparison, whereas in the present proceeding the opponent is also relying upon their reputation and goodwill. To this extent she refers to the guidance of the European Court of Justice in the *Canon v MGM* case which tells us that 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 made of it. This factor, she states, must be given due weight in determining whether there exists a likelihood of confusion.

20. That concludes my review of the evidence insofar as is relevant to these proceedings.

Decision

21. Turning first to the ground under Section 5(2)(b) of the Act. That section reads as follows:

“5.-(2) 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.”

22. An earlier trade mark is defined in Section 6 of the Act as follows:

“6.- (1) In this Act an “earlier trade mark” means-

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

23. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, 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 Schufabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27;

- (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*, paragraph 23; 15
- (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*, paragraph 23;
- (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*, paragraph 17;
- (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*, paragraph 224;
- (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*, paragraph 26;
- (h) further, 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; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly 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*, paragraph 29.

24. The opponents rely on three registrations for the trade mark ECOPHON in Classes 6, 17 and 19. Their registration in Class 6 covers metal ceiling and wall components which are self evidently identical goods to those covered by class 6, and similar to the goods in Class 19 of the application. Likewise, the opponents' registration in Class 19 covers identical goods in Class 19, and similar goods to those in Class 6 of the application. Although the opponents also have a registration in Class 17, I do not propose to give that any further consideration for if they are unsuccessful in respect of their registrations in Classes 6 and 19 they will be in no better position in respect of what are at best similar goods in Class 17.

25. That the respective goods are identical/similar and the specifications not limited in any way means that notionally I must consider the source of manufacture and the channels and the means of trade by which the goods reach the relevant consumer of the goods in question to be one and the same. Neither side submitted otherwise.

26. The term building materials covers a wide description of goods that can vary considerably in terms of sophistication, size, weight, application, technical specification, price etc. But

regardless of whether it is a small basic item as in a nail or a major prefabricated component such as a wall or ceiling system, if only because of the sheer size of range available the consumer will exercise a degree of care to ensure that a product suitable for the required application is obtained.

27. Whether the act of selection is visual or oral is likely to be influenced by the expertise of the consumer and nature of the product sought. Construction professionals may order products of a standard specification by means of a telephone call to the builders merchants but for major, specialised or made-to-order products will most likely order through a personal visit. The DIY enthusiast may also telephone the local supplier but are more likely to pay a visit to see the range available. Consequently I would say that aural and visual similarity of the respective marks should be considered to be of equal standing.

28. The mark for which protection is sought is the word EUROPHON. The marks relied upon by the opponents are for the word ECOPHON. Insofar as both marks begin with the letter E and share the common suffix "PHON" there is some degree of visual and aural similarity. However, the prefixes have an impact to the extent that I would say that though the respective marks may well have similarities, they are not similar in appearance or sound.

29. Whilst marks should be compared as a whole, it is inevitable that reference will be made to individual elements, particularly as regard must be taken of the distinctiveness and/or dominance of component parts. The applicants refer to the meanings of the prefixes EURO and ECO, and although they have not provided any corroborative evidence on this point, it has long been the Registrar's practice to regard the prefix EURO as denoting Europe or European, and that the prefix ECO denotes ecology or ecological. The decision of the German Patent and Trademark Office shown as exhibit RAB2 concurs with this practice. The decision also makes some comment on the suffix "PHON" as having some relevance to sound insulation properties. Whilst there is no specific evidence on this fact, I do not consider it out of order to refer to, and take judicial notice of the entry in Collins English Dictionary that shows PHON to be a "unit of loudness that measures the intensity of a sound by the number of decibels it is above a reference tone...". That said, I do not consider that this meaning will be readily apparent to other than to a specialist in the industry.

30. If the meaning of the suffix is known then the marks, insofar as they relate to sound will share some conceptual identity, but whether or not that is the case, the meaning of the prefixes will take this to no more than a passing similarity.

31. Even though the respective prefixes could be taken to be well known and more likely to be understood as a reference to a characteristic of the goods than the suffix, I do not consider that this means that the prefix should be regarded as being less distinctive than the suffix. If only by virtue of its positioning (it is well established that the beginnings of word marks are of most importance) the prefix could be regarded as the dominant component.

32. The opponents say that they first used ECOPHON in the United Kingdom in 1984-1985, and although there is no evidence of sales from that date, some of exhibits make reference to their presence in the United Kingdom dating from "the early 80's" and "1983" which would be consistent with the date claimed. Although they claim use in respect of all of the goods

covered by their three registrations the evidence only shows use in respect of ceiling and wall systems, primarily acoustic, and parts and fittings for such systems.

33. At first sight the turnover figures would appear significant in monetary terms. However, there is no information with regard to the unit cost of the ceiling and walling systems, nor is there any indication of the size of the overall market. Most of the installations shown in the evidence involve large commercial and municipal structures and likely to cost many thousands if not tens of thousands of pounds. These systems appear to be intended for use in new and existing industrial, commercial or public buildings for which the potential market must be sizeable. Consequently it is not possible to place the turnover figures shown into the context of the market as a whole, and even if limited to the ceiling and wall systems, I do not consider that the evidence is sufficient to establish that they are likely to have a reputation deserving of exceptional protection. I am also mindful that this is likely to be a limited area of trade where I would consider it probable that other traders in the market would be aware of competitors and their brands

34. The applicants make reference to other marks on the register that have either the prefix EURO or the suffix PHON as an element. It is well established that the bald fact of registration does not establish that a mark is in use and I attach no weight to this evidence.

35. Taking all of the above factors into account and adopting the “global” approach advocated, I come to the view that a person familiar with the opponents’ mark on seeing the applicants’ mark in use will not be deceived into believing that they are seeing the same mark, a mark from the same stable, or from an undertaking linked to the opponents. Accordingly, the ground founded under Section 5(2)(b) fails.

36. Turning to the ground under Section 5(3). That section reads as follows:

“**5(3)** A trade mark which-

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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.”

37. In *Pfizer Ltd v Euro Food-Link (UK) Ltd* ((ChD) [1999] 22(4) IPD 22039) Mr Simon Thorley QC sitting as a Deputy High Court Judge said:

"What is necessary is that the trade mark proprietor should prove the required reputation and should then satisfy the Court that the defendants use of the sign is:

- (a) without due cause; and
- (b) takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark."

38. I have already expressed my view that when considered as a whole the respective marks are not similar. But even if they were, for the reasons given above I do not consider that the evidence provided by the opponents establishes that the use they have made of their mark has built a reputation such that, if another trader were to use a similar mark, the later mark would derive some benefit from that reputation, nor that their mark would be harmed in any way. Consequently the ground under Section 5(3) also fails.

39. Finally there is the ground under Section 5(4)(a). That section reads as follows:

“5(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.”

40. 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:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) 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
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

41. Section 5(4)(a) of the Act offers protection to the goodwill and reputation built up by a trader through the use of a sign. Setting aside the question of the similarity of the respective marks, I have already highlighted the weakness of the opponents' claim to a reputation and they are in no better a position with respect to goodwill. Consequently, I do not see how I can find that they will suffer damage by the applicant's use of the mark in respect of the goods they seek to protect, and the objection under Section 5(4)(a) fails.

42. The opposition having failed on all grounds the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £635 as a contribution towards their costs. 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 18 day of June 2002

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