

O-261-08

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2355925  
IN THE NAME OF GLASS UK LTD

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 94456  
BY L. B. PLASTICS LTD

## TRADE MARKS ACT 1994

IN THE MATTER OF application  
No 2355925 in the name of  
Glass UK Ltd and in the matter of  
Opposition thereto under No 94456  
by L. B. Plastics Ltd

### **Background**

1. Application No. 2355925 has a filing date of 16 February 2004. It was originally applied for in the name of LMC Group Limited but, following an assignment, now stands in the name of Glass UK Ltd (“Glass”). The application seeks registration of the mark SHEERGLAZE in respect of the following goods and services:

#### Class 6

*Doors employing a metallic frame concealed between layers of glazing to enable the glazing to appear entirely frameless*

#### Class 37

*Building construction, repair, maintenance and installation services all relating to doors employing a metallic frame concealed between layers of glazing to enable the glazing to appear entirely frameless*

#### Class 42

*Research, development, design, consultancy and support services; all relating to doors employing a metallic frame concealed between layers of glazing to enable the glazing to appear entirely frameless.*

2. The application proceeded to publication and Notice of Opposition was filed on behalf of L.B.Plastics Ltd (“Plastics”). The grounds of opposition were based on Sections 5(2)(a), 5(2)(b) and 5(4)(a) of the Act, however in written submissions filed in lieu of a hearing, Plastics indicated its wish to “disregard” the opposition under Section 5(4)(a). I therefore proceed in respect of objections under Section 5(2)(a) and (b) only. Plastics’ grounds are, in brief:

- Under section 5(2)(a) based on its earlier mark No 1314615 for the mark SHEERGLAZE. Use is claimed in respect of *sealed glazing units*;
- Under section 5(2)(b) based on its earlier mark No 2322782 for the mark SHEER.

3. The earlier marks are registered in respect of the following goods and services:

#### Earlier mark No 1314615:

#### Class 19

*Building materials and building elements, windows, doors, window frames, door frames and secondary glazing assemblies, all being non-metallic products for use in*

*building and all being glazed or adapted for glazing; non-metallic double glazing and multiple glazing units, window panes and glass doors, all for building; parts and fittings for all the aforesaid goods; all included in Class 19*

Earlier mark No 2322782

Class 6

*Window frames, door frames, doors and door panels, window and door furniture, hinges, handles, fasteners and locks, mounting gear for sliding doors, all made wholly or principally of common metal; metal components for use in building, metal components for use in the construction of window frames and door frames; conservatories; frames for conservatories; parts and fittings for all the aforesaid goods.*

Class 17

*Plastics material for use in manufacture; composite materials incorporating plastics and wood for use in manufacture; extruded sections of plastics materials or of composite materials incorporating plastics and wood for use in building and in the manufacture of window frames, door frames, building products, fencing, decking, walkways, pontoons, verandahs, handrail assemblies, railings, roof structures, canopies, awnings, rainwater goods, guttering and gutter guards; plastics materials, fibre reinforced composite plastics materials and composite materials incorporating plastics and wood in the form of shaped sections, planks, sheets, slabs, rods, tubes, blocks, bars and films; non-metallic pipes, rods and tubes; articles made of plastics material, composite materials incorporating plastics and wood, rubber or other flexible material included in Class 17; materials for packing, sealing, insulating and weatherproofing; insulating materials for pipes, walls and roofs and for use in building; sound absorbing and sound deadening materials; seals and draft excluders; pre-formed products of plastics materials, composite materials incorporating plastics and wood, rubber or other flexible material for sealing, insulating and weatherproofing purposes; window and door seals; parts and fittings for all the aforesaid goods.*

Class 19

*Building materials, building components, building panels, non-metallic composite materials for use in building and construction; composite building materials incorporating plastics material and wood; windows, doors, window frames and door frames, secondary glazing assemblies; trim components for use in building, skirtings, architraves, covings, cladding, fascia boards, soffit boards, barge boards and window boards; rainwater goods, guttering and gutter guards; products for use in closing or filling wall cavities in buildings; drainage devices, vents and weepholes for wall structures; wall cavity trays; pipe and vent terminals, masonry fixings; wall, roofing and flooring products and materials; floor boards and floor panels; non-metallic decking, walkways and pontoons, verandah systems, handrail assemblies and railings; roof structures, canopies and awnings; fencing, fence panels, fence posts and lattice panels; window panes, glass doors, double glazed units for windows and for doors; articles included in Class 19 made of plastics materials; conservatories; frames for conservatories; parts and fittings for all the aforesaid goods.*

## Class 37

*Building construction services; services for the maintenance, repair and restoration of buildings and building components; custom fabrication, installation and replacement of window and door constructions; information services relating to building, to building components and to the construction, fabrication, installation and replacement of windows and doors; fabrication and installation of conservatories; all included in Class 37.*

4. A counter-statement was filed by Glass accompanied by a witness statement, dated 10 February 2006, of Warren Spencer Evans, Sales Director of the original applicant. Accepting that the earlier right relied on by Plastics under Section 5(2)(a) is identical to the mark applied for, the counter-statement otherwise denies all grounds of opposition. Mr Warren's witness statement sets out the reasons why. I do not intend to summarise this evidence but do take it into account and will refer to it as necessary in this decision.

5. Both parties filed evidence. Neither side requested a hearing and both sides filed written submissions at the conclusion of the evidence rounds. I write this decision on the basis of all material before me.

### **Evidence**

6. Leon Andrew James Litchfield filed a witness statement dated 14 June 2007 on behalf of Plastics. Mr Litchfield is a director of the company and has been an employee there for 21 years. He explains that Plastics and its predecessors in business have used the mark SHEERGLAZE continuously since 1988 in relation to sealed glazing units which are comprised of at least two layers of glass separated by a glazing bar. These units can be used in doors, windows, conservatories or curtain walling. The mark is applied to the glazing units by being marked on the glazing bar though he says it is "sometimes also marked on the glass". In excess of 99% of glazing units produced by his company are said to bear the mark.

7. Mr Litchfield provides figures of the approximate number of sealed glazing units bearing the mark SHEERGLAZE made per annum and the related turnover as follows:

Year	Units Made	Turnover
1998	2,800	£34,000
1999	2,800	£34,000
2000	7,800	£93,000
2001	17,500	£210,000
2002	30,400	£365,000
2003	46,800	£562,000

8. Mr Litchfield states that "the vast majority" of sales are "internal or to companies associated with" his company. Sealed glazing units have been sold throughout the United Kingdom, with customers including major house builders, hospitals and local councils. Many of the units are made to order for particular bespoke applications and for major building firms which use professional architects. Plastics does not use high pressure sales visits, cold calling or leaflet drops to promote sales of its products.

9. Mr Litchfield exhibits the following:

LL1 -photographs of products incorporating glazing units and showing use of the mark SHEERGLAZE on the glazing bars;

LL2 -photographs of products showing use of the mark on the glazing bars and glass;

LL3 -a copy of the British Standards Institute Kitemark Licence granted in relation to insulating glass units bearing the mark.

LL4 -Internet articles from “Sheernews” relating to various building projects which Plastics has supplied. The articles date from between November 2005 to November 2006.

10. For Glass, Warren Spencer Evans has filed a witness statement dated 22 February 2008 in addition to that filed with the Form TM8 and counter-statement. The following facts emerge from this evidence. Mr Evans is a director of the company and was, between August 2005 and November 2007, the sales director of LMC Group Limited, the original applicant for the mark in suit. Mr Evans explains that LMC Group Limited provided accountancy and administrative services to two of its subsidiary companies, Metal UK Limited and Glass UK Limited with the former being the main operational entity which sold SHEERGLAZE units and the latter the entity that made them. Whilst the application was originally made in the name of LMC Group Limited, the mark was transferred to Glass by an assignment dated 12 February 2008.

11. Mr Evans explains that Glass uses the mark SHEERGLAZE in relation to a very specific range of goods and services; these are goods and services which relate to concealed metallic-framed doors. Typically these doors are specified by architects after extensive dialogue with the company. As the doors use a metallic frame which is concealed between the layers of glass so that they appear frameless, they require an extensive knowledge of engineering rigid aluminium structures and can take several days to make. The process is complex and a typical door would cost in the region of £2000-£5000. Fitting of the doors is also highly complex and requires highly trained staff used to working with structural glazing and complex aluminium engineering structures. The doors are supplied to large commercial, educational or high-spec domestic building projects such as the St Pancras International Station building.

12. Mr Evans provides the following details of sales and advertising spend under the mark:

Year	2000	2001	2002	2003	2004	2005
No of units sold in the UK	15	35	57	182	211	228
Total value of the above units	£20,000	£156,000	£324,000	£862,000	£904,000	£962,000
Advertising/marketing spend in the UK	£10,000	£10,000	£36,000	£26,000	£24,000	£18,000

13. Commenting on Plastics’ business, Mr Evans says that it is a very sizeable company with a turnover in 2006 of £65 million. In that context, he states the turnover figures provided by

Plastics for glazing units bearing the mark, is very low despite Plastics' claim that the mark appears on 99% of its products. As can be seen from paragraph 7 above, turnover figures have been provided for the years 1998 to 2003 only and, despite impressive rates of increase over those years, cannot therefore properly be judged against total turnover figures for 2006.

14. Mr Evans states that he has carried out an internet search but can find no reference to Plastics' use of SHEERGLAZE either on its own website or in any kind of review of editorial or trade magazine. He gives no further information about how or when this search was carried out. He exhibits at Exhibit 1 a sample of the glazing bar as supplied to him and used by Plastics and which has the mark SHEERGLAZE printed on it.

15. Much of the rest of Mr Evans' witness statements are given to commentary which I do not intend to summarise but will refer to as necessary in this decision.

### **Decision**

16. Section 5(2) of the Act reads:

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

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

### **Objection under section 5(2)(a)**

17. An earlier trade mark is defined in Section 6 of the Act, the relevant parts of which state:

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

- (a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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”

18. Also of relevance are the provisions of Section 6A of the Act. Section 6A sets out the circumstances in which the provisions apply in relation to opposition proceedings, the relevant parts of which state:

“6 A(1) .....

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4)....

(5)...

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7)..."

19. Plastics rely under this ground on registration No 1314615. This has a registration date of 5 July 1989. It is an earlier trade mark as defined in Section 6(1) of the Act. The mark applied for was published for opposition purposes on 7 April 2006. The mark relied on by Plastics is subject, therefore, to the proof of use requirements set out above.

20. Section 100 of the Act provides that:

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

21. The requirements for “genuine use” have been set out by the European Court of Justice in its judgment in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and in its reasoned Order in Case C-259/02, *La Mer Technology Inc. v Laboratoires Goemar S.A.* [2005] ETMR 114. From these cases I derive the following principles:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark; i.e. to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must not be just internal to the undertaking concerned but must be “on the market” (*Ansul* paragraph 37);

- the use must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37)
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting the goods on the market (*Laboratoire de la Mer*, paragraph 25, referring to the earlier reasoned decision of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraphs 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

22. The earlier mark relied on by Plastics under Section 5(2)(a) is registered in respect of:

*“Buildings materials and building elements, windows, doors, window frames, door frames and secondary glazing assemblies, all being non-metallic products for use in building and all being glazed or adapted for glazing; non-metallic double glazing and multiple glazing units, window panes and glass doors, all for buildings; parts and fitting for all the aforesaid goods; all included in Class 19.”*

23. Plastics makes no claim to have used its mark on all the goods for which it is registered. Instead it claims to have used the mark in respect of “*sealed glazing units*”. I will return to this in due course.

24. Before moving on to consider the evidence of use filed by Plastics, there is one other issue I should deal with. As indicated above, the earlier mark relied on under section 5(2)(a) is registered for goods in class 19 of the Nice Agreement concerning the International Classification of goods and services for the Purposes of Registration of Marks of 15 June 1957. The heading for this class reads:

*“Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.”*

As the explanatory note makes clear, class 19 includes “mainly non-metallic building materials”. Glass has made much in its evidence and submissions to challenge the fact that Plastics’ goods are registered in class 19. Glass says, and Plastics do not deny, that the glazing units Plastics produces have a glazing bar within them made of metal. In his evidence, Mr Evans says that as “the glazing bar is metallic [it is] therefore not relevant to a Class 19 trade mark registration for non-metallic goods”. He goes on to say that “if [Plastics] had wanted a registration covering glazing units with metallic spacer bars they could readily have sought one in Class 6”. The implication I take from these comments is that glazing units containing a metal glazing bar should more properly be classified in Class 6, this being the class which covers, *inter alia*, metallic building materials and that any use on these goods should not be taken as proof of use of goods registered in class 19.

25. As the evidence shows, a glazing unit is made up of a number of components including two (or more) panes of glass with the panes separated at their edges by a spacer or glazing bar. The edges are then sealed to stabilise the connection between the edges of the panes and the spacer or glazing bar and to prevent the ingress of moisture between the panes. The complete glazing unit then needs to be fitted into a frame in order to make up the required door or window etc.

26. Clearly, the individual components making up the glazing unit can be made of very different materials. The appropriate classification of those individual components will depend on a number of factors including their actual composition and purpose. Whether Plastics has sought registration for the individual components making up its glazing units I know not but it is, in any case, irrelevant to my considerations in this case. Plastics’ earlier registration covers (complete) glazing units. As a glazing unit is made principally of glass, which is a non-metallic building material, and the spacer or glazing bar is merely a relatively small component within the unit rather than a metal frame to the glass, the registrar considers it to be appropriate to class 19.

27. I therefore go on to consider whether Plastics has shown genuine use of its earlier mark in relation to the goods on which use is claimed. The relevant period is the five year period ending with the date of publication of the application for registration, i.e. 8 April 2001 to 7 April 2006.

28. Glass submits that Plastics’ evidence does not show genuine use as what use is shown is merely internal use. In his evidence, Mr Litchfield states “the vast majority of the sales [of glazing units] have been internally or to companies associated with my Company”, though he provides no explanation of what specifically he means by this. In its written submissions, however, Plastics states that the glazing units it produces are “fitted into components such as doors and windows supplied by other companies within the Opponent’s group, and then sold to customers”.

29. The question of what constitutes “internal use” was considered by the Court of Appeal in *Laboratoire de la Mer Trade Mark* [2006] FSR 5. It was said:

“21. There was no suggestion in the evidence that the transactions were otherwise than at arm’s length. Although the quantities involved were modest and although there was no evidence of sales on by the importer to consumers and end-users, that does not mean that the use of the mark in the UK was internal or akin to internal use

by Goëmar. The result of the sales was that goods bearing the mark were in a different ownership in different hands in another country.”

And:

“51. The essential point is that the occasion was a transaction between the proprietor of the mark as seller of the goods, which were sold and shipped pursuant to an arm’s length apparently bona fide sale, to an independent wholesaler in this country. Such a sale cannot, in my view, be characterised as a transaction internal to the proprietor’s organisation.”

30. Plastics has used its earlier mark since at least 1988 in relation to glazed units and provides undisputed details of turnover and the number of units made for the years 1998 to 2003. Turnover increased from some £34,000 in 1998 to £562,000 in 2003 reflecting the increase in the number of units made which rose from 2,800 to 46,800. The glazing units are said to have been sold on to other companies within the same group before being sold on to end consumers throughout the UK with significant numbers of them being sold on to house builders and some to local councils. Some 99% of the units produced by Plastics are said to bear the mark on the glazing bar with some units also bearing the mark on the glass itself.

31. I am satisfied that sales of SHEERGLAZE branded goods were made to group companies (which are separate legal entities) in circumstances, particularly in view of the volume of sales, which are consistent with those goods being put into genuine commercial trade. Though the evidence indicates the nature of the sales is such that other companies within the same group as Plastics are intermediaries in the process by which the goods are placed on the market, those initial sales appear to be at arm’s length and are chargeable and commercial transactions. For these reasons I do consider such sales to be internal.

32. I find that Plastics has shown genuine use of its earlier mark in relation to *sealed glazing units*. As I indicated earlier, this particular term does not appear in the specification of goods as registered. The question of how tightly a specification needs to be drawn in the light of the use shown to have been made is a matter to be determined on a case by case basis having regard to the principles set out in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 and *Reckitt Benckiser (España) SL v OHIM (Aladin)* Case T-126/03. Applying that guidance, I find that Plastics has shown genuine use of its earlier mark and that a fair specification which reflects that use and is consistent with the manner in which the average consumer would describe those goods is *sealed glazing units* which come within the term *non-metallic double glazing and multiple glazing units* within the specification of goods as registered.

### **Comparison of marks**

33. There is no dispute that identical marks are involved.

### **Comparison of goods and services**

34. There is no dispute that the leading authorities and the principles to be applied derive from the following cases: *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v*

*Klijzen 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*, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen 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;
- (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 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 24;
- (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 & Adidas Benelux BV*, 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.

35. Given that each of the respective marks include goods classes, in my view this is where Plastics' strongest case lies and I will consider these first.

### **The average consumer and the purchasing process**

36. The average consumer for Plastics' goods is a company that wishes to incorporate them into its own goods (e.g. doors or windows) for onward sale or fitters (whether individuals or

companies) who install new or replacement parts. In relation to the goods included within Glass’s application, the average consumer is someone wishing to install a glazed door.

37. Both parties’ goods are at least reasonably technical and, whilst not uncommon, are likely to be purchased after consideration and discussion as to their cost, size, suitability for purpose, visual appearance, availability etc. and customers, whether individuals or businesses, are likely to be discerning and at least reasonably experienced.

### Comparison of goods

38. The respective goods at issue are:

Glass	Plastics
<b>6:</b> Doors employing a metallic frame concealed between layers of glazing to enable the glazing to appear entirely frameless	<b>19:</b> Sealed glazing units

39. The leading authorities on determining similarity of goods are well established and set out in the *Canon* case (supra) and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In *Canon*, the ECJ accepted that all relevant factors should be taken into account including the nature of the goods, their intended purposes, their method of use and whether they are in competition with each other or are complementary.

40. The criteria identified in the *Treat* case were:

- the physical nature of the goods;
- the respective uses of the respective goods;
- the respective users of the respective goods;
- the respective trade channels through which the goods reach the market;
- in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
- the extent to which the respective goods are competitive. Account may be taken of how those in trade classify the goods, i.e. whether the goods are put in the same or different sectors.

41. Clearly, not all factors will be equally relevant in all cases. Bearing in mind the above general guidance, I go on to compare the similarity of the respective goods.

#### Nature

Plastics’ goods are *sealed glazing units*. A glazing unit is not a stand alone item but rather is a glazed panel fitted into and forming a key component of e.g. a glazed door. Glass’s goods being doors fitted or covered with glass are, fundamentally, glazed doors. There is a degree of overlap in the nature of the respective goods.

#### Use/intended purpose

A sealed glazing unit is a component part of e.g. a glazed door. A glazed door is a hinged or sliding panel which closes the entrance to e.g. a building or room. Whilst sealed glazing units and glazed doors are distinct products, they both have a key purpose of allowing light to pass

through them and, depending on the type of glass used, may allow a person to see through them. Again, there is a degree of overlap between the respective goods.

#### Users

From the evidence it is likely that the person seeking to buy a sealed glazing unit is a manufacturer or supplier of e.g. glazed doors or those who are in the business of fitting new or replacement sealed glazing units. The user of a glazed door is likely to be an individual or company involved in some way with constructing or renovating a building. There is a potential overlap between the end consumer of sealed glazing units which have been incorporated into a door and the user of a glazed door.

#### Channels of trade/sales outlets

Neither of the respective marks is limited in any way and I have to consider the matter on a fair and notional basis. Sealed glazing units may be purchased direct from the manufacturer with end users also being able to purchase them on a supply and fit basis through specialist fitters. They may also be available already fitted into e.g. a door which is likely to be sold through specialist door manufacturers, builders' merchants and DIY stores. Glazed doors may also be sold through specialist door manufacturers, specialist fitters, builders' merchants and DIY stores. Again there is some potential overlap in the channels of trade and sales outlets.

#### In competition or complementary

There can be no doubt that the goods are not in competition. A person seeking to buy a sealed glazing unit would not buy a door and vice versa.

There have been a number of judgments of the Court of First Instance which deal with complementarity. In *Mülhens GmbH & Co KG v Ohim*, Case T-150/04, the Court recognised that goods may be aesthetically complementary but said:

“this aesthetic necessity, in that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use these products together.”

In *Alecansan, SL v OHIM*, Case T-202/03 the CFI noted the position set out in the opposition guidelines adopted by OHIM which state:

“As regards the complementary nature of the goods and services, it must be pointed out that, according to the definition given by OHIM in point 2.6.1 of Part 2, Chapter 2 of the Opposition Guidelines of 10 May 2004, goods or services are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or for the provision of those services lies with the same undertaking (see also to that effect Case T-85/02 *Diaz v OHIM* [2003] ECR II-4835, paragraph 36)”.

From these cases it is clear that the matter is not to be viewed in an overly broad sense. I need to consider whether there is some feature of, or functional, technical or aesthetic link between the goods which would lead a consumer to think that they would be marketed, sold or used together. In addition, complementarity may not be enough of itself to establish similarity of goods.

42. I have no evidence before me as to how sealed glazing units on the one hand and glazed doors on the other are classified by the trade and into which market sectors they may be put. As I indicated above, Plastics' goods are such as need to be incorporated into some sort of frame e.g. a door. Glass's goods are glazed doors. A sealed glazing unit is a key component of a glazed door such that there is a degree of complementarity between the respective goods.

43. My overall conclusion is that the respective goods are similar to at least a reasonable degree.

#### **Distinctiveness of the earlier trade mark.**

44. It is well established 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.

45. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Mayer*, supra) though he may subconsciously recognise a component elements as descriptive if the mark comprises or resembles other words known to him (see Case T-356/02 *Vitakraft-Werke Wührmann v OHIM –Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51). The word SHEERGLAZE is made up of the ordinary dictionary words SHEER and GLAZE conjoined. SHEER has no obvious meaning in relation to the goods, however, GLAZE is clearly descriptive and leads me to consider that the distinctiveness of the mark is somewhat "front-loaded". Taken as a whole, the mark is of a moderate level of distinctiveness.

46. Although Plastics has filed evidence of use of its mark, that evidence is limited. I have no idea of the size of the market for sealed glazing units but, given the proliferation of such articles in UK homes and commercial buildings, it is likely to be vast. Plastics' turnover and the number of units made by it are likely to be extremely small within the overall context of the market. I also take into account the fact that "the vast majority" of the sales shown have been made to associated companies. The evidence does not show the earlier mark to have gained any enhanced reputation through use.

#### **Likelihood of confusion**

47. This is a matter of global appreciation taking into account all relevant factors. As *Canon* makes clear, I have to consider the interdependency principle whereby a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa. It is not disputed that the marks are identical and I have found there to be at least a reasonable degree of similarity between the respective goods.

**Taking into account all relevant factors, I find that there is a likelihood of confusion and thus the opposition brought under section 5(2)(a) of the Act, succeeds in relation to the goods for which registration is sought in class 6.**

48. Glass's application also seeks registration for services in class 37 and 42 as set out at paragraph 1 above. As services, I do not consider them to be identical to goods being sealed glazing units but I go on to consider whether they are similar.

49. I have already found sealed glazing units to be reasonably similar to glazed doors. It seems to me that the services for which registration is sought in classes 37 and 42, which all relate to glazed doors also have a degree of similarity to sealed glazing units though to a lesser extent. **Taking into account all relevant factors, I find there is also a likelihood of confusion and thus the opposition brought under section 5(2)(a) of the Act succeeds in relation to the services for which registration is sought in classes 37 and 42.**

50. That essentially determines matters, however, in case I am found to be wrong in my determination of the ground of opposition under section 5(2)(a), I go on to consider the ground of opposition under section 5(2)(b).

**Objection under section 5(2)(b)**

51. Plastics relies under this ground on registration No. 2322782. This has a registration date of 8 August 2003 and thus, whilst it is an earlier trade mark as defined in Section 6(1) of the Act, it is not subject to the proof of use requirements set out above.

**Comparison of goods and services**

52. For ease of reference, I set out the respective goods and services below:

Glass's specification	Plastics' specification
<p>Class 6 Doors employing a metallic frame concealed between layers of glazing to enable the glazing to appear entirely frameless.</p> <p>Class 37 Building construction, repair, maintenance and installation services all relating to doors employing a metallic frame concealed between layers of glazing to enable the glazing to appear entirely frameless.</p> <p>Class 42 Research, development, design, consultancy and support services; all relating to doors employing a metallic frame concealed between layers of glazing to enable the glazing to appear entirely frameless.</p>	<p>Class 6 Window frames, door frames, doors and door panels, window and door furniture, hinges, handles, fasteners and locks, mounting gear for sliding doors, all made wholly or principally of common metal; metal components for use in building, metal components for use in the construction of window frames and door frames; conservatories; frames for conservatories; parts and fittings for all the aforesaid goods.</p> <p>Class 17 Plastics material for use in manufacture; composite materials incorporating plastics and wood for use in manufacture; extruded sections of plastics materials or of composite materials incorporating plastics and wood for use in building and in the manufacture of window frames, door frames, building products, fencing, decking, walkways, pontoons, verandahs, handrail assemblies, railings, roof structures, canopies, awnings, rainwater goods, guttering and gutter guards; plastics materials, fibre reinforced composite plastics materials and composite materials incorporating plastics and wood in the form of shaped sections, planks, sheets, slabs,</p>

	<p>rods, tubes, blocks, bars and films; non-metallic pipes, rods and tubes; articles made of plastics material, composite materials incorporating plastics and wood, rubber or other flexible material included in Class 17; materials for packing, sealing, insulating and weatherproofing; insulating materials for pipes, walls and roofs and for use in building; sound absorbing and sound deadening materials; seals and draft excluders; pre-formed products of plastics materials, composite materials incorporating plastics and wood, rubber or other flexible material for sealing, insulating and weatherproofing purposes; window and door seals; parts and fittings for all the aforesaid goods.</p> <p>Class 19 Building materials, building components, building panels, non-metallic composite materials for use in building and construction; composite building materials incorporating plastics material and wood; windows, doors, window frames and door frames, secondary glazing assemblies; trim components for use in building, skirtings, architraves, covings, cladding, fascia boards, soffit boards, barge boards and window boards; rainwater goods, guttering and gutter guards; products for use in closing or filling wall cavities in buildings; drainage devices, vents and weepholes for wall structures; wall cavity trays; pipe and vent terminals, masonry fixings; wall, roofing and flooring products and materials; floor boards and floor panels; non-metallic decking, walkways and pontoons, verandah systems, handrail assemblies and railings; roof structures, canopies and awnings; fencing, fence panels, fence posts and lattice panels; window panes, glass doors, double glazed units for windows and for doors; articles included in Class 19 made of plastics materials; conservatories; frames for conservatories; parts and fittings for all the aforesaid goods.</p> <p>Class 37 Building construction services; services for the maintenance, repair and restoration of buildings and building components; custom</p>
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	fabrication, installation and replacement of window and door constructions; information services relating to building, to building components and to the construction, fabrication, installation and replacement of windows and doors; fabrication and installation of conservatories; all included in Class 37
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**Class 6**

A straight comparison clearly shows that each of the respective specifications include “doors” in class 6. The specification of goods as applied for is limited in respect of the method of construction of those doors. Plastics’ specification is for doors at large within this class and could include doors such as Glass’s therefore identical goods are involved. In addition, the earlier mark is registered in respect of “doors” and “glass doors” in class 19. Bearing in mind the guidance referred to above on the similarity or otherwise of goods, it seems to me that a door as applied for in class 6 is at least highly similar if not identical to doors and glass doors in class 19.

**Class 37**

Both of the respective specifications also include services in class 37. I consider that all of the services applied for are included within the more general services for which the earlier mark is registered such that identical services are involved.

**Class 42**

Plastics also raises opposition to the services for which registration is sought in class 42 though the earlier mark is not registered in this class. Given this, I do not consider the services in class 42 to be identical to those for which the earlier mark is registered. That said, it seems to me, and bearing in mind the guidance set out in the *Treat* case above, that there is a high degree of similarity between Glass’s *design, consultancy and support services; all relating to doors employing a metallic frame concealed between layers of glazing to enable the glazing to appear entirely frameless* and Plastics’ *custom fabrication, installation and replacement [-] of door constructions; information services relating to [-] building components and to the construction, fabrication, installation and replacement of [-] doors* in class 37.

**Comparison of marks**

53. The earlier mark is the word SHEER. The mark applied for is the mark SHEERGLAZE which, as I indicated above, is made up of the ordinary dictionary words SHEER and GLAZE. Clearly, the word SHEER is common to both marks and appears as the first or only part of the mark. Whereas the earlier mark consists of five letters, the mark applied for consists of ten letters presented as one word. Given the commonality of the initial (or only) five letters, there are clear visual and aural/oral similarities between the respective trade marks. Given the overall length of the respective marks and the inclusion of the word GLAZE in the mark applied for, there are also some visual and aural/oral dissimilarities. I do not consider the word SHEER to have any obvious conceptual meaning whereas the inclusion of the word GLAZE within the mark applied for does bring glass to mind.

54. Taken as a whole, the respective marks are similar to a high degree.

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

55. As I indicated above, SHEER has no obvious meaning in relation to the goods for which it is registered and therefore it has a high degree of distinctive character. Plastics have not filed any evidence to show use of this mark and so it cannot benefit from an enhanced level of protection.

### **The average consumer**

56. I have already set out above my findings on the average consumer of Glass's goods and services. The goods of the earlier mark relied on under this ground are much broader than those relied under the earlier objection thus the average consumer differs. The earlier mark is also registered in respect of services. I consider the average consumer of the goods and services of the earlier mark relied on under this ground to be individuals such as homeowners or DIYers and companies involved in the building trade.

### **Likelihood of confusion**

57. Again, this is a matter of global appreciation taking into account all relevant factors including the interdependency principle. Having done so, I find that there is a likelihood of confusion. This would be a likelihood of direct confusion if the average consumer were to discount the second element of the mark applied for on the basis that it is wholly descriptive. I recognise, however, that the second is the word GLAZE rather than GLAZING and thus the average consumer may not go that far in his thinking but, in my view, there would still be a likelihood of indirect confusion that the goods and services came from the same stable. **The ground of opposition under section 5(2)(b) therefore succeeds.**

### **Costs**

58. Plastics has been successful under each of its grounds of opposition and is entitled to an award of costs. I order Glass to pay Plastics the sum of £1150, awarded on the following basis:

Filing Notice of Opposition	£300 & £200 fee
Reviewing Counterstatement	£200
Filing Evidence	£300
Reviewing Evidence	£150
Total	£1150

This sum is 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 26 day of September 2008**

**Ann Corbett  
For the Registrar  
The Comptroller-General**