

O-266-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2293274  
IN THE NAME OF THE HOLLAENDER MANUFACTURING CO.**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 92082 IN THE NAME OF  
HOLLAENDER RAINER LIMITED**

## **TRADE MARKS ACT 1994**

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in the name of The Hollaender Manufacturing Co.**

**And**

**IN THE MATTER OF Opposition thereto under No. 92082  
in the name of Hollaender Rainer Limited**

### **BACKGROUND**

1. On 20 February 2002, The Hollaender Manufacturing Co. applied to register the trade mark HOLLAENDER in Class 6 in respect of the following specification of goods:

Structural metal pipe fittings used to join structural pipe sections in the construction of fences, railings, frames, partitions and the like; railing systems comprising structural metal pipe fittings and structural pipe; and accessories, such as gates, gate hinges and latches; handrails, posts, brackets and set screws; railing toeplates; toeplate splices, brackets and clamps; and rivet nuts.

2. The application proceeded to publication on the basis of Honest Concurrent Use (Section 7(1)(a) of the Trade Marks Act) with Registration No. 1531354, the earlier mark relied upon by the opponents in these proceedings.

3. On 30 October 2003, Hollaender Rainer Limited filed notice of opposition against the application, the grounds being in summary:

**Under Section 5(2)(b)** because the opponents' earlier trade mark contains the opposed mark in its entirety, and is similar to the opponent's earlier trade mark registration, and is sought to be registered for goods that are identical or similar to those for which the earlier mark is registered.

**Under Section 5(4)(a)** because the opponent has used the trade mark HOLLAENDER RAINER in relation to rails, pipes and tubes; rail couplings, rail connectors, rail joints; all being of metal; parts and fittings for all the aforesaid goods, in the UK, for a continuous period since 1985, and as such, enjoys goodwill and a reputation in relation to the mark for the goods specified.

4. The opponents also allege that the applicants' use of the mark HOLLAENDER is not

sufficient to satisfy the requirements for acceptance on the basis of Honest Concurrent Use under the provisions of Section 7(1)(a). This allegation is not a basis for opposing another mark, although where there has been concurrent use, this is a matter that I should rightly take into account in my “global assessment” of the likelihood of confusion.

5. Details of the earlier mark relied upon by the opponents is as follows:

<b>Number</b>	<b>Mark</b>	<b>Class</b>	<b>Specification</b>
1531354	HOLLAENDER RAINER	6	Rails, pipes and tubes; rail couplings, rail connectors, rail joints; all being of metal; parts and fittings for all the aforesaid goods

6. The applicants filed a Counterstatement in which they deny the grounds on which the opposition is based.

7. Both sides request that costs be awarded in their favour.

8. Both sides filed evidence in these proceedings. The matter came to be heard on 15 February 2006, when the opponents were represented by Ms Sarah Chatterley, of HLBBshaw, their trade mark attorneys. The applicants were represented by Mr Jeremy Pennant of D Young & Co, their trade mark attorneys.

### **Opponents’ evidence**

9. This consists of a Witness Statement dated 17 May 2004, from Gavin Paul May, Managing Director of Hollaender Rainer Limited, a position he has held since July 2002, having been employed by his company since 1991.

10. Mr May refers to Exhibit GPM01, which he says shows that his company was incorporated on 22 February 1980 under the name Mark Rainer Structural Limited, changing name to Rainer (Structural) Limited on 25 June 1987, and to its current name, Hollaender Rainer Limited on 7 October 1992. He says that as can be seen from the brochures shown as Exhibit GPM02, the main business of his company is the manufacture of hand railing, wall railing and balustrade systems, principally of metal, and the design, maintenance and installation of such goods. The brochures show the mark being used in connection with such goods, and although Mr May says that it originates from September 2003, there is nothing to indicate this.

11. Mr May states that his company adopted HOLLAENDER RAINER as a trade mark in late 1984, the first product brochure, shown as Exhibit GPM03, being printed in 1985. Although not referred to by Mr May, the product brochures mentioned above are shown as exhibits to a copy of a Statutory Declaration filed by Rainer Clover, and also by Stuart Jeffrey Blakemore in earlier opposition proceedings. The brochures show the HOLLAENDER RAINER trade mark being

used in connection with handrails and balustrade. Although the brochures are not dated, Mr May exhibits a statement by Mr Stuart Blakemore, who confirms that in 1983 he was an Accounts Manager with Compass Graphics, a graphic and advertising agency. Mr Blakemore states that his company was commissioned by the opponents to help market their range of handrails which resulted in the change of company name to HOLLAENDER RAINER. He further says that in November and December 1984, his company completed a series of layouts and visuals employing the name, from which the brochures were produced.

12. Mr May goes on to give the following details of his company's turnover in respect of goods sold under the mark, in the UK, in the years 1992 to 2002:

1992	£1,244,523
1993	£985,000
1994	£823,000
1995	£990,000
1996	£1,300,000
1997	£1,043,983
1998	£675,890
1999	£1,023,011
2000	£637,444
2001	£676,888

13. The final year covers a period after the relevant date and has been excluded.

14. Mr May goes on to refer to earlier oppositions numbered 44569 and 44826 involving the parties, and to Exhibits GPM03 and GPM04, which consists of copies of the evidence filed in those proceedings. Exhibit GPM03 consists of:

- (a) a Statutory Declaration dated 8 January 1997, from Rainer Clover, Managing Director of Hollaender Rainer Limited. Mr Clover confirms the company history, copies of certificates of incorporation and change of name being shown as Exhibit RC01. He says that in 1984, after considering alternatives he decided on a new name for the company of Hollaender Rainer, and confirms Mr Blakemore's involvement in the new brochures, Exhibit RC02 being the statement from Mr Blakemore referred to above. Mr Clover recounts a visit to the USA in February 1985 to source components, and to his visiting the offices of Hollaender Manufacturing Company. Inc. during which he showed them his company's products. Mr Clover states that Hollaender Manufacturing expressed their approval of his company's use of Hollaender Rainer, and that his company became the UK and Middle East distributor for a Hollaender Manufacturing product sold under the name of SPEEDRAIL. The brochure for the SPEEDRAIL shown as Exhibit RC03 cannot be dated, and whilst relating to the SPEEDRAIL, it refers to it as a HOLLAENDER RAINER product. The letter dated 8 March 1985 (Exhibit RCO4) from Hollaender Manufacturing to Mr Clover confirms the appointment of Mark Rainer (Structural) Ltd as distributor. Mr Clover says that Exhibit RC05 consists of a

photograph of his company's stand at the NEC Birmingham in 1985, but contrary to Mr Clover's statement, the HOLLAENDER RAINER mark is not visible. He says that exhibit RC06 shows the mark being used. The exhibit consists of a collection of printed matter showing HOLLAENDER RAINER being used as a company name, and also a name for a handrail system and component parts, from 1985 onwards, in some instances in conjunction with other trade marks such as SPEEDRAIL. He gives turnover figures for the years 1988 to 1996, which for the overlapping years are the same as those given by Mr May. For the years 1988 to 1991, these amount to £590,949, £734,232, £1,129,883 and £1,226,239 respectively. Mr Clover goes on to give details of a "representative sample" of his company's customers, although not when or for what. He provides details of the amounts spent promoting HOLLAENDER RAINER goods in the years 1990 to 1996, which range from £10,000 to just over £21,000 per annum, confirming that most advertising has been in specialist construction industry publications, and company directories. Exhibit RC07 consists of various invoices for advertisements, and samples thereof, from March 1988 onwards. Exhibit RC08 consists of copies of mail shots and promotional brochures which, although may refer to HOLLAENDER RAINER, cannot be dated as originating prior to the relevant date. He goes on to give details of the trade fairs at which his company has exhibited between 1985 and 1996. Mr Clover says that in 1992, Hollaender Manufacturing informed his company that it wished to terminate the distributor agreement, and whilst from that date his company has not sourced products from the USA, it has continued to sell goods under the mark.

- (b) a Statutory Declaration dated 10 February 1998, from Rainer Clover. Much of this Declaration consists of submissions on evidence filed by Hollaender Manufacturing in other proceedings. Where Mr Clover introduces evidence of fact I have summarised it, otherwise I will note it and take it into account. Mr Clover says that his company independently adopted, and was the first to use HOLLAENDER RAINER as a trade mark in the UK, and that they told Hollaender Manufacturing about their use as a matter of courtesy. He refers to a letter of 13 February 1985, referred to as Exhibit LSR9 (not exhibited) stating that "no such authorisation was required", and later referring to another letter of 6 February 1986 which stated that use of the HOLLAENDER RAINER name was to be closely controlled by Hollaender Manufacturing. He does not dispute that Hollaender Manufacturing had contact with potential distributors for their products in the UK in 1984 but denies that there had been any commercial use of the name HOLLAENDER as a trade mark. Exhibit RC1a to the Declaration consists of correspondence between Mr Clover and Hollaender Manufacturing regarding the buy-back of products following the termination of the distributorship.
- (c) a Statutory Declaration stated to be dated 10 February 1998, from Stuart Jeffrey Blakemore, the same Stuart Blakemore referred to above. Unfortunately only the first page of the Declaration has been included, which confirms that in 1984, Rainer (Structural) Limited decided to change its name and image, and exhibiting the company brochures for HOLLAENDER RAINER SPEEDRAIL.

- (d) a Statutory Declaration of 6 February 1998, from Peter Henry Rodwell, a Senior Premises Manager for English Welsh and Scottish Railways, a position he has held for 5 years. Mr Rodwell explains that he has responsibility for the maintenance of 65 depots and 2000 buildings. He recounts having been asked in February 1998 whether he was familiar with the name HOLLAENDER RAINER, stating that he had known the name for three years in relation to the design, manufacture and delivery of specialist safety barriers and hand rails.
- (e) the first page of a Statutory Declaration said to be dated 9 February 1998, from Ann Elizabeth Roome, a trade mark agent with Laurence Shaw & Associates. Ms Roome recounts in October 1997 and January 1998, having sent questionnaires to a random selection of Hollaender Rainer Limited's customers. Exhibit AER01 consists of a copy of the questionnaire, which asked, inter alia, whether the person being questioned is familiar with the name HOLLAENDER RAINER. Exhibit AER02 consists of completed questionnaires, but I do not know what proportion of those that were sent this represents, or whether this is all of the responses.
- (f) a Statutory Declaration dated 9 February 1998, from Sara Darwin, a qualified architect since 1989 with 8 years experience. Ms Darwin says that her job involves designing buildings, specifying products and running contracts. Ms Darwin recounts being asked whether she was familiar with the name HOLLAENDER RAINER, saying she confirmed that she knew them as a manufacturer of metal balustrade and guardrails.
- (g) an Affidavit dated 4 February 1998 from Dudley Bogart, a partner in Bogart International Sales, Ohio, USA. Mr Bogart confirms that his company handled all of the export for Hollaender Manufacturing Export Division from 1955 until his company's contract as their export management company was terminated in 1992. Mr Bogart recounts efforts to obtain business for Hollaender Manufacturing products in the UK, which ultimately led to contact being made with Mark Rainer (Structural) Limited in 1985. Mr Bogart says that detailed discussions took place, and that he knows (although not how) Rainer Clover proposed the name HOLLAENDER RAINER, which was adopted with the explicit approval of Hollaender Manufacturing. Mr Bogart states that prior to 1985 there were no sales in the UK through his organisation, and that he does not believe any other party would have made sales.
- (h) a Statutory Declaration dated 28 September 1999, from Rainer Clover. The Declaration is in reply to evidence filed by the opposing party in other proceedings, and as such consists of submissions. Whilst I will take these into account, without the primary evidence the submissions mean little. Mr Clover includes Exhibit RC01, which consists of extracts from the 1994, 1997 and 1999 editions of a publication entitled "Building Products Compendium" which contains details of HOLLAENDER RAINER products.
- (i) a Statutory Declaration dated 28 September 1999, from Laurence Shaw, a trade mark attorney with Laurence Shaw & Associates. The Declaration expresses surprise at the

assertion that HOLLAENDER RAINER products are inferior, and exhibits correspondence relating to this at LS01 and LS02.

- (j) a Statutory Declaration dated 24 September 1999, from Edith H Dodds, Managing Director of Abull Standards Limited, a company incorporated in 1979 as Abull Handrails Standards Ltd, specialising in the design and supply of safety railings. She confirms to have known of HOLLAENDER RAINER and their products for some fourteen years.
- (k) a Statutory Declaration dated 21 October 1999, from Veronica Tinney, Area Manager, Manufacturer Services, for Barbour Index plc, a company specialising in the provision of information services to the building and construction industry for some forty years, and from 1977, the publisher of a publication known as "The Barbour Index". Ms Tinney states that approximately 22,000 copies of the Index are distributed each year in some 18,000 offices throughout the UK. She confirms that Hollaender Rainer Limited have been subscribers to the Index since 1991, and, with the exception of 1995 and 1996, have been listed to date. Copies of the entries are shown as exhibits VT01 and VT02. Ms Tinney says that her company also runs a service known as The Barbour Index Enquiry Service, a telephone access to expert information, details of which are shown as Exhibit VT03. Ms Tinney confirms that any enquiry for products under the name HOLLAENDER RAINER or HOLLAENDER is referred to Hollaender Rainer Limited. She concludes her Statement by confirming that neither Hollaender Manufacturing or A.D. Fabricators, a UK distributor for that company have been subscribers, although as can be seen in Exhibit VT04, Hollaender Manufacturing were listed in a free edition published in 1999.

15. Mr May goes on to refer to the earlier proceedings, at Exhibit GPM05 providing copies of the decisions in opposition Nos. 44569 and 44826, and highlighting various comments and conclusions drawn by the Hearing Officer. He goes on to refer to the Appeal by the applicants to the Chancery Division of the High Court (Nos CH2001App010788 and CH2001App10789) and to the Application for Discontinuance although makes no comments as to their relevance. Exhibit GPM06 consists of copies of the Notice of Appeal and Notice of Discontinuance. Mr May says that as a result, his company's application, No 1531354 proceeded to registration, the applicants' application No. 1514305 being refused.

16. Mr May goes on to refer to the filing of the applicants' trade mark HOLLAENDER, to the ex-parte examination and acceptance of the application by the Registrar on the basis of Honest Concurrent Use, the related documentation being shown as Exhibit GPM07. The exhibit includes evidence of use in the form of a Witness Statement dated 31 March 2003, from Marc E Cetrulo, Vice President of The Hollaender Manufacturing Company, upon which the decision to allow the application to proceed on Honest Concurrent Use is based. Mr Cetrulo gives the following evidence:

His company originated the concept of aluminium structural fitting more than 50 years ago, and is recognised as a market leader in slip-on structural fittings, mechanical hand

rail systems, and accessories therefore.

The primary brand used is HOLLAENDER, with Nu-Rail, Speed-Rail, Mend-A-Rail, Interna-Rail, Rackmaster, Instant Structure and Bumble Bee all used as sub-brands under the HOLLAENDER banner.

Use in the UK dates from 1984, with sales between 1985 and 1992 being effected through Hollaender Rainer Limited as distributors, and since 1993, Doughty Engineering Ltd and A.D. Fabrications.

Turnover for goods sold by authorised distributors between 1993 and 2001 range from a base of US \$11,000 in 1994, rising, albeit not year on year, to a high point of US\$48,000, derived from sales of goods throughout the UK.

An average of US \$1,000 per year has been spent promoting goods under the trade mark HOLLAENDER.

The Exhibits MC1 to MC4 consist of the following:

- MC1 a catalogue marked as having been issued in July 1984. The brochure bears the HOLLAENDER name used on its own, in conjunction with other brands, and as part of the company name. It bears a reference “previous catalogue issued October 1978”. All contact details are in the US with nothing to indicate it was available in the UK. The exhibit includes details of catalogues issued in February 1985, April 1988, April 1989 and one bearing a copyright date of 1996. None are marked as having been in use in the UK, some have a contact details box where a distributor would be entered but these are blank.
- MC2 consists of similar catalogues and promotional materials showing use of HOLLAENDER as in MC1. Some parts can be dated but cannot be seen to have been available in the UK.
- MC3 an International Price List for SPEED-RAIL. NU-RAIL & RACKMASTER SLIP-ON FITTINGS and MEND-A-RAIL BOLT TYPE REPAIR FITTINGS. The cover page bears the reference “MANUFACTURED BY THE HOLLAENDER MFG.CO”, contact details for the Export Division of The Hollaender MFG.Co. and a European Agency at Wentworth & Co, located in Burntwood, Staffordshire, England. The following pages list the product range and prices for SPEED-RAIL. NU-RAIL & RACKMASTER, SLIP-ON FITTINGS. The final page lists this information for the MEND-A-RAIL, BOLT TYPE REPAIR FITTINGS. Whilst it is not obvious that the final page is part of the price list, that the previous pages list products for the

first three trade marks mentioned on the cover page, and the final page relates to the fourth, is sufficient to be able to say that this is one list. The final page is noted “EFFECTIVE DATE August 1, 1984”. The remainder of the exhibit consists of later price lists, although none bear any information that indicates that they were intended for, or used in the UK.

MC5 consists of the cover page of the June 1995 edition of “What’s new in Building”. The remaining pages consist of copies of advertisements, inter alia, one for HOLLAENDER Speed-rail Fittings” listing A.D. Fabrications Ltd as the UK’s only distributor. The exhibit includes another page from the publication, although I can see no mention of HOLLAENDER, and the sheet used by the Examiner in summarising the evidence.

Mr Cetrulo concludes his Statement by stating that he is not aware of any instances of confusion between his company’s mark HOLLAENDER and the HOLLAENDER RAINER mark, and that the two marks have co-existed in the UK without any apparent conflict for approximately ten years.

17. Mr May states that following the filing of written observations, he was notified in the official letters of 31 October 2003 that the application had been accepted in error. Copies of the observations and official correspondence are shown as Exhibit GPM08.

18. Mr May returns to his company’s use, saying that since 1992 they have continued to promote and sell goods under the trade mark HOLLAENDER RAINER. He refers to Exhibit GPM09, which consists of a collection of product brochures and information sheets, price lists and an estimate for the printing of letterheads and visiting cards. The product documentation is undated, and whilst some show a BSI standard dated as 1994, this does not necessarily mean that the brochure is from that date. The printing estimate is also undated, and being an estimate does not mean that it was ever fulfilled. One price list is dated December 1994 and relates to HOLLAENDER RAINER “slip-on” magnesium alloy wallrail and balustrade tube fittings. The name is shown as the company name above the contact details, and also separately above the product description. The second price list is not dated but bears a script entry “Price List Used From At Least Feb 1991”, and relates to HOLLAENDER RAINER steel ladders and safety cages. On both price lists an image of a hand grasping what appears to be a cross-section of a handrail appears either in conjunction, or in connection with the HOLLAENDER RAINER name.

19. Mr May goes on to give the following figures relating to his company's advertising expenditure in the years 1992 to 2002:

	£
1992	17,920
1993	17,00
1994	10,000
1995	13,000
1996	15,000
1997	28,085
1998	12,224
1999	6,617
2000	8,688
2001	5,452
2002	2,461

20. Exhibit GPM10 consists of advertising material that Mr May says has been used in promoting the HOLLAENDER RAINER mark. The exhibit includes quotations for the printing of brochures and leaflets in December 1992, and May-June 1994. Although these are quotations rather than firm orders, that they are provided to HOLLAENDER RAINER LIMITED establishes that that name was being used as a company name at the date of the quotation, but not that it was in use as a trade mark. The exhibit includes:

advertisements that appear to have been published in the March and July 1997 editions of DABS magazine, a trade publication, which show HOLLAENDER RAINER being used as part of the company name, the advertisement promoting goods sold under the trade names "SLIP ON", "EASY FIX", "OFFSET" and "INLINE".

invoices from DABS dated 26 February and 25 June 1997, for quarter page advertisements, the later being marked as a repeat of a previous.

An invoice from Barbour Index for an entry in the compendium 00 – noted as 7 product entries, and a copy of the related page listing HOLLAENDER RAINER handrails.

Purchase Order dated 17 April 2002, for space in "Specifier Review" in 2002. There is no mention of HOLLAENDER RAINER.

Invoice dated 31 May 2002 from Kingsford Advertising for making amendments to something printed, although it is not clear what. HOLLAENDER RAINER appears as the company name.

21. Mr May goes on to exhibit copies of two letters used in mail-shots, and mailing lists used by his company (Exhibit GPM11). The letters are dated 12 March 2001 and 9 October 2002, enclosing details of HOLLAENDER RAINER Ltd's "Speedclamp fittings" and/or "Belina"

balustrade systems. The letter dated 12 March 2001 is endorsed “Selection of letters sent with literature 2001/2002/2003 Average Nos 50-100 per month” which corresponds with Mr May’s Statement, but what is not said is how this is known to be the case. One list is endorsed “sent 3/9/93”, another “probably 93/94 Barbour List GPM”. The use of “probably” gives an air of uncertainty as to the accuracy of the statement. Three pages are headed April 1995, August 1996 and October 1997, but with no indication of whether, or when letters were sent. A letter from Barbour Index dated 13 March 1997 refers to the Index as having provided 1,671 labels with telephone numbers, but again there is nothing that shows anything further was done. The remainder of the exhibit consists of a proforma from Specifier Review notifying Hollaender Rainer that an enquiry had been received requesting further details of their product. These are dated from March 2001 to May 2002. Five are endorsed as having had literature sent, which leaves open the question of whether the other enquiries received a response.

22. Mr May goes on to list projects and their locations in which his company had either been involved in, or provided estimates for, in the period 1991 to 2001. Exhibit GPM12 consists of correspondence and tender/project documentation dated within the period specified by Mr May, and which tie up with the information given in his Statement. Mr May goes on to say that his company has also received enquiries from third parties wishing to represent Hollaender Rainer Limited, Exhibit GPM13 being “representative copy letters”. The exhibit contains three letters dating from February 1992 to April 1995, two of which express an interest in selling/distributing Hollaender Rainer products, the third being sent by Hollaender Rainer enclosing a price list. The exhibit also includes a press release announcing the appointment of William Hopkins & Sons Ltd as a distributing agent, but this cannot be dated.

23. Mr May goes on to refer to his company being the owner of three domain names incorporating the name HOLLAENDER RAINER, the first being registered “at least as early as January 27 2000”. He refers to Exhibit GPM14, which consists of an extract from his company’s website, Mr May highlighting the product entries under names such as “Slip-On”, “Inline”, EasyFix”, the only mention of HOLLAENDER RAINER being as the company name. The print was taken on 12 May 2004; there is nothing that shows this to have existed at the January 2000 date claimed by Mr May.

### **Applicants’ evidence**

24. This consists of five Witness Statements. The first is dated 17 February 2005, and comes from Adrian Hackett, Managing Director of N A Construction Limited.

25. Mr Hackett attests to having been aware of the HOLLAENDER trade mark for “about the last eight years through contact with John Goldsworthy of A D Fabrications Limited”. He says that during this time his company has, “on and off” purchased products sold under the trade mark, which he associates solely with The Hollaender Manufacturing Company. Mr Hackett says that he is aware of Hollaender Rainer Limited and their products, but has had no direct contact with the company, who, he believes to be an agent for The Hollaender Manufacturing Company.

26. The next Witness Statement is dated 18 February 2005, and comes from Steve Dunn, Managing Director of Exhibition Solutions. Mr Dunn states that he has been aware of the HOLLAENDER trade mark in the UK for some four to five years, during which time his company has bought products bearing the brand. He says that he is not aware of Hollaender Rainer Limited in the UK or elsewhere.

27. The third Witness Statement is dated February 2005, and comes from Dana Juricic of Mimo International. Mr Juricic states that he has been aware of the HOLLAENDER trade mark from having resided in the US for some twenty years. He says that his company has bought products bearing the brand in the UK for “around the last three years”, having located the products through a search which brought him into contact with John Goldsworthy of A D Fabrications Limited. Mr Juricic says that he associates products sold under the trade mark HOLLAENDER solely with The Hollaender Manufacturing Company, in the US, in addition to their use of the trade mark SPEEDRAIL. He says that he is not aware of Hollaender Rainer Limited in the UK or elsewhere, or any relationship between this company and the Hollaender Manufacturing Company.

28. The fourth Witness Statement is dated 17 February 2005, and comes from Rob Molyneux, Managing Director of Luxtrade Limited. Mr Molyneux states that he has been aware of, and his company has purchased products sold under the HOLLAENDER trade mark in the UK for at least the last ten years. He says that he associates products sold under the trade mark solely with The Hollaender Manufacturing Company, based in the US. Mr Molyneux says that he has been aware of Hollaender Rainer Limited for the last ten to fifteen years, and that he understands they used to be an agent for, and sell products originating from The Hollaender Manufacturing Company.

29. The final Witness Statement is dated 19 January 2005, and comes from John Goldsworthy, a Director of A.D. Fabrications Limited. Mr Goldsworthy refers to the trade mark registration, No 2293274 for the mark HOLLAENDER owned by The Hollaender Manufacturing Company. He confirms that his company has been the UK distributor for this company’s products “since at least as early as 1992”. Mr Goldsworthy says that the HOLLAENDER trade mark has been used extensively in the UK for, and on behalf of The Hollaender Manufacturing Company since at least as early as 1984.

30. Mr Goldsworthy says that despite long use, with sales amounting to some £50,000 annually for the last ten years and a market share for HOLLAENDER branded goods of some 30%, there has never been any objection by the opponents to The Hollaender Manufacturing Company using the HOLLAENDER name.

### **Opponents' evidence in reply**

31. This consists of a Witness Statement dated 19 July 2005, from Sarah Jayne Chatterley, a Trade Mark Attorney with HLBBshaw, the opponents' representatives. Not unusually for evidence filed in reply, the Statement consists of Ms Chatterley's views on the evidence submitted by the applicants, and comments on its probative value. Whilst I have read, and will take these submissions fully into account in my determination of this case, it is neither necessary, or appropriate that they be summarised.

### **Applicants' further evidence**

32. This consists of a Witness Statement dated 4 November 2005, from James R Davis II, Principal Attorney with Arent Fox PLLC, the US firm that represents The Hollaender Manufacturing Company. Mr Davis confirms that he has represented the applicants since 2004.

33. Mr Davis recounts that in August 2005, it came to the applicants' attention that their trade mark "SPEED-RAIL" was being misused on the website [www.productselector.co.uk](http://www.productselector.co.uk), a copy of the page being shown as Exhibit JRD1. The page refers to the product as being that of Hollaender Rainer Limited. Mr Davis says that he wrote to the owners of the website to point out the misrepresentation, and to try and ascertain the cause of the confusion. A copy of the letter is shown as Exhibit JRD2. He says that he received two e-mails in response (Exhibits JRD3 and JRD4), one of which confirms that the entry had been provided by Hollaender Rainer Limited in 2003, who had further confirmed ownership of the mark in April 2005. The second e-mail was sent following enquiries with Hollaender Rainer Limited, from which Mr Gavin May had explained the "historical legal connection" between the two companies, that his company had at some point in the past been entitled to use the mark, but that its inclusion was an oversight, their mark being SPEED-CLAMP.

### **Opponents' further evidence**

34. This consists of two Witness Statements. The first is dated 27 January 2006, and comes from Sarah Jayne Chatterley. The contents of the Statement consist of Ms Chatterley's views on the evidence submitted by Mr Davis II, and at Exhibit SJC01, copies of correspondence relating to its filing, and the collection of evidence in response. Whilst I have read, and will take this evidence into account in my determination of this case, it is neither necessary, or appropriate that it be summarised.

35. The second Witness Statement is dated 24 January 2006, and comes from Gavin Paul May, and is a response to the assertions made by Mr Davis II in respect of his company's use of SPEED-RAIL. Mr May refers to the fact that evidence relating to this matter has already been filed in Exhibit GPM03, providing further copies as Exhibit GPM15. Mr May again recounts his company's attempts to sell back the SPEED-RAIL stock that his company had bought from The Hollaender Manufacturing Company. He states that they refused to take the stock back, and to reduce the financial impact on the company, Hollaender Rainer decided to sell the products. He

points out that the goods sold by his company under the name were genuine SPEED-RAIL products. He refers to Exhibit GPM16, which consists of a letter dated 24 August 1992, by which The Hollaender Manufacturing Company ended Hollaender Rainer's appointment as a master stocking distributor. Mr May says that the inclusion of the trade mark in the directory was a long-standing arrangement, and its continued inclusion was an oversight.

36. Mr May says that the SPEED-RAIL goods were always sold in conjunction with the HOLLAENDER RAINER name, an arrangement that Hollaender Manufacturing did not disagree with. He refers to Exhibit GPM17, which consists of a further copy of the Statutory Declaration dated 19 August 1994, mentioning paragraph 8 in particular. He says that as can be seen from Exhibit GPM18, a print from his company's website taken on 6 January 2006, SPEED-RAIL is not mentioned.

37. Mr May goes on to refer to Exhibit GPM19, which consists of copies of evidence filed in other proceedings, asserting that these show that the applicants have previously made attempts to discredit the products supplied by his company. Two have already been summarised above as part of Exhibit GPM03.

a Statutory Declaration dated 13 March 1997, from Terry Walters, previously the proprietor of Light and Grip Store Limited. Mr Walters recounts that about five or six years ago, his company was looking to acquire SPEEDRAIL fittings from The Hollaender Manufacturing Company. He says that his company was advised that Hollaender Rainer Limited were the distributor, and that a number of orders were made with that company. Mr Walters says that the fittings supplied all bore the Hollaender Manufacturing Company's trade mark SPEEDRAIL, and that Hollaender Rainer Limited invoiced his company for the goods.

He goes on to refer to a further supply of unsatisfactory goods bearing SPEEDRAIL. He says that he made enquiries which revealed that Hollaender Rainer Limited were no longer the authorised distributor, and that SPEEDRAIL was now being supplied by A.D. Fabrications Limited. He says that his company subsequently received satisfactory orders of the Hollaender Manufacturing Company's goods from the new supplier. Mr Walters states that further investigations revealed that the unsatisfactory goods were not those of The Hollaender Manufacturing Company, but had been manufactured by, or on behalf of Hollaender Rainer Limited and branded SPEEDRAIL to make his company believe that they were genuine Hollaender Manufacturing products.

a Statutory Declaration of 10 February 1998, from Rainer Clover. This has already been summarised above.

a Statutory Declaration dated 31 March 1999, from Gerald McIntyre, Purchasing Manager for Lynton Commercial Units Ltd, a company producing exhibition units. Mr McIntyre states that he associates the trade mark HOLLAENDER with handrail fittings manufactured by a company of that name located in the US. He confirms having

purchased these goods from A.D. Fabrications Limited, the UK distributor. He says that he is aware of handrail fittings sold in the UK by Hollaender Rainer, but considers the finish on these products not to be as good.

a Statutory Declaration dated 28 September 1999 from Laurence Shaw. This has already been summarised above.

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

## **Decision**

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

“**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.”

40. 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.”

41. 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] RPC 199, *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 & Addidas 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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) 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*,
- (i) 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*,
- (j) 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*.

42. In the Statement of Grounds, the opponents cite one earlier trade mark, for the words HOLLAENDER RAINER. The mark applied for is the word HOLLAENDER, which is self-evidently the same in all respects to the first word in the opponents' earlier mark, and consequently, must be identical in the way it looks and will sound when spoken. However, the marks must be compared as a whole, and if only by the mere fact that the opponents' earlier mark has an additional word, there must be a difference in the overall appearance and sound of the respective marks. However, that the words are represented separately, and do not form a

meaningful whole or run through to soften their distinction, lessens the visual and aural impact of the additional word, or at least, does not take anything away from the significance of HOLLAENDER. Compared as a whole I consider the respective marks to be similar in appearance and sound.

43. To some, the word HOLLAENDER may give the idea of someone or something connected with the country of Holland, although given the unusual spelling this seems less certain when encountered visually. Combining the word with RAINER, which as I understand has no meaning is likely to lessen the possibility of this connection being made. A word that has a meaning, or that is familiar (even if with different spelling) is likely to appeal more to the eye, and be more memorable, and being that I am looking at two identical words, I consider it likely that the consumer, particularly with imperfect recollection, will take and retain a similar message from the respective marks.

44. As far as I am aware, and there is no evidence or argument to the contrary, neither word has any descriptive meaning in relation to the goods for which it is registered, and apart from as a trade mark or company name, is not a term customarily used in trade. This being the case I shall proceed on the assumption that both component parts are individually distinctive. But if only by virtue of its relative length and positioning (it generally being accepted that the beginnings of word marks have most significance in the impression created in the minds of the consumer), when compared to RAINER, the word HOLLAENDER is the dominant element.

45. The opponents' earlier mark is registered in Class 6 in respect of "rails, pipes and tubes; rail couplings, rail connectors, rail joints; all being of metal", and parts and fittings for such goods. The applicants are seeking registration in the same class, and for the following range of goods:

"Structural metal pipe fittings used to join structural pipe sections in the construction of fences, railings, frames, partitions and the like; railing systems comprising structural metal pipe fittings and structural pipe; and accessories, such as gates, gate hinges and latches; handrails, posts, brackets and set screws; railing toeplates; toeplate splices, brackets and clamps; and rivet nuts."

46. In my view it is self-evident that the goods of the subject application are identical in nature and purpose to those for which the opponents' earlier mark is registered, and there being nothing to indicate otherwise, share the same channels of trade and consumer base. In paragraph 8 of their skeleton argument, the applicants helpfully accept that the respective goods are similar and/or identical, so I do not need to give this question any further consideration.

47. In their evidence, both Mr May and Mr Clover refer to the opponents having adopted the HOLLAENDER RAINER name in 1984, putting it into use in 1985 in a brochure for handrails and balustrade, which he exhibits as GPM03. Whilst the brochure is not dated, a letter (Exhibit GPM03) from Mr Stuart Blakemore states that in 1983 he was employed as Accounts Manager for Compass (Graphic) Ltd, an advertising agency, commissioned by Rainer Structural as consultants to help market their range of handrails. Mr Blakemore says that Compass proposed

the change of image that led to the adoption of HOLLAENDER RAINER as a trading name, and by December 1984, a range of layouts and visuals that were used in brochures and stationery had been constructed. Mr Blakemore does not provide a copy of the artwork or any brochures with his letter, but in a Witness Statement (incomplete) that he filed in earlier proceedings, he exhibited a copy of a brochure (SJB01) which clearly shows the HOLLAENDER RAINER name, in this case in conjunction with the name SPEEDRAIL, the artwork matching that of other brochures in Exhibit GB03. That it mentions SPEEDRAIL, a trade mark that according to the evidence the opponents would not have been in a position to use until after their discussions with The Hollaender Manufacturing Company in February 1985, would seem to date it as having originated after that date. There is no information telling me how many, or to whom it was distributed.

48. The opponents have provided a significant amount of evidence, some of which is duplication, and to a large extent, undated and contains no information that casts light back. This being the case, it cannot be placed as relating to use at a time prior to the relevant date. That said, a number of exhibits can be seen to show use of HOLLAENDER RAINER in the years since its stated adoption. For example, a letter from Vencast Foundries Limited, dated 11 March 1985 is addressed to Hollaender Rainer (Structural) Limited, purchase orders and sales invoices dating from June 1988 bear the header HOLLAENDER RAINER, usually with a “hand/handrail” logo. Price lists dating from June 1985 and December 1994 list the HOLLAENDER RAINER structural tube fittings and Alloy Wallrail and Balustrade tube and fittings. A purchase order for advertising space dating from March 1988 relate to an entry for HOLLAENDER RAINER being placed in Kelly’s Directory. A feature in the March 1997 edition of the Design Architect Builder magazine contained an advertisement for the Hollaender Rainer Limited “SLIP ON”, “EASY FIX”, “OFFSET” and “INLINE” range of handrailing systems. An entry from the Building Product Compendium of 1994 refers to HOLLAENDER RAINER WALLRAIL, and an advertisement in “What’s new in Building” dating from December 1996 promotes HOLLAENDER RAINER SPEEDRAIL fittings. Other exhibits provide correspondence and business documents that show the opponents to have been trading as HOLLAENDER RAINER since 1991.

49. Turnover figures have been provided, which on their face do not seem to be particularly high, but this is in relation to a narrow range of goods. However, as I do not know the size of the market for such goods, or even an indication of the opponents’ market share, the figures on their own are not sufficient to put the trade into context.

50. The opponents refer to having spent around £10,000 to £21,000 per annum in the years between 1990 and 1996, in the promotion of goods under the HOLLAENDER RAINER name. This appears to have been spent on the production of product literature, advertising in specialist construction industry publications and company directories, and attendance at trade fairs. Examples of advertisements placed in the years from March 1988 have been provided, along with invoices detailing their costs, but as is all too common for this type of evidence, there is no evidence relating to when, where and how many brochures and directories were distributed, or the readership of the publications in which advertisements were placed which enables the

activity to be gauged in terms of its likely impact on the relevant consumer. Exhibits RC08 consists of copies of mail-shots and promotional brochures which, although referring to HOLLAENDER RAINER, cannot be dated as originating prior to the relevant date. A further example of a mail-shot is shown as part of Exhibit GPM11, which in this case can be seen to have been thought about (although not necessarily executed) in March 1997, when the Barbour Index provided name and address labels for a range of professionals, presumably connected to construction, in Middlesex, Bedfordshire, Berkshire, Cheshire, Manchester, Merseyside, and Ireland. Further letters confirm a mail-shot took place in March 2001 and October 2002, although it is not clear how many letters were sent. Probably the most useful evidence showing the extent to which the HOLLAENDER RAINER mark has been exposed to the relevant market is given by Veronica Tinney, who confirms that through their entry in the The Barbour Index, the mark could have reached a very significant number of consumers. However, unless those consumers had occasion to look for suppliers of handrails, an entry amongst many others will not necessarily have come to their attention.

51. I am content that the evidence is illustrative of a consistent use of HOLLAENDER RAINER, by the opponents, in connection with handrail system products, over the years since they first used the name in late 1984 or early 1985. However, given that the applicants claim this use was on their behalf, and that both parties appear to have been trading concurrently (in the same market), there are a number of questions to be addressed before I can say that the opponents are the rightful owners of any reputation gained through this use.

52. That there was a commercial connection between the parties is not a matter of dispute; it is the nature of this relationship. The letter of the 8 March 1985, from The Hollaender Manufacturing Company, confirms the appointment of Mark Rainer (Structural) Limited as a distributor. There does not, however, appear to be any form of documentation that regulates this arrangement or by which The Hollaender Manufacturing Company exercised control over the use of the trade mark or nature/quality of the goods for which it was used. What does seem strange is that following a change to using the name Hollaender Rainer Limited in "late 1984", having had brochures printed to reflect this, and paid a visit to The Hollaender Manufacturing Company in February 1985 during which Hollaender Manufacturing are said to have expressed or given "explicit" approval of the use of the new name, that in March 1985 they should send a letter appointing an agent under a name that they apparently should know was no longer current. This may, of course, be a simple oversight.

53. I am also unclear why The Hollaender Manufacturing Company felt the need to express their approval to the use of the name. From the evidence of Mr May, Mr Clover and Mr Bogart there can be little doubt that this was the case. Doing so gives the impression that this was either directly or indirectly sought, or Hollaender Manufacturing were under the impression that their approval was appropriate, if not necessary. Mr Clover's position is that he told Hollaender Manufacturing about his company's use merely as a matter of courtesy.

54. In his evidence, Mr Clover mentions that in 1992 The Hollaender Manufacturing Company informed his company that it wished to terminate the distributor agreement, which would seem

to suggest that it was The Hollaender Manufacturing Company holding the reins, but as I have said, there is no documentary evidence that defines the basis on which Mark Rainer (Structural) Limited were appointed distributors.

55. The closest that the evidence gets to shedding some light on the relationship can be found in the Statutory Declaration of 10 February 1998 executed by Mr Clover. In this he admits the existence of a letter of 13 February 1985, but as there is no copy exhibited, I do not know what it said, and Mr Clover does not actually say. He does, however, comment that “no such authorisation was required.”, which, if taken in conjunction with his preceding statements relating to the use and origins of the HOLLAENDER RAINER trade mark, suggests to me that this was a letter sent to Mr Clover by The Hollaender Manufacturing Company, either questioning Hollaender Rainers’s use of the HOLLAENDER trade mark, or granting authority to do so. Whatever is the case, the impression given is that it is The Hollaender Manufacturing Company who consider control of the mark to reside with them.

56. A further letter of 6 February 1986 referred to by Mr Clover, but again not exhibited, appears to indicate that use of the HOLLAENDER RAINER name was being controlled by The Hollaender Manufacturing Company. Mr Clover disputes this, saying that the aim of the letter was to ensure no products were brought into the range in competition. Without sight of the letter I do not see that I can take issue with Mr Clover; his explanation is plausible.

57. There are a number of issues raised by the evidence that give me cause to question the reliability of some of the facts pleaded. In his evidence, Mr May says that his company adopted HOLLAENDER RAINER as a trade mark in late 1984. He also refers to, and exhibits evidence from Mr Stuart Blakemore, an Accounts Manager with Compass (Graphics) Limited, who in a letter shown as RC02 to a Statutory Declaration by Rainer Clover says that in 1983 he was employed as Accounts Manager for a company commissioned by Rainer Structural as consultants “to help market the Rainer range of handrails”. This gives the distinct impression that it was in 1983 that the contact from Hollaender Rainer was received. However, in a Statutory Declaration, Mr Blakemore says that “In 1984 Rainer (Structural) Limited “decided to change its name and image..”. Unfortunately this Declaration is incomplete. Mr Blakemore goes on to say that “We proposed a change of image and the name HOLLAENDER RAINER Limited was chosen”. This contrasts with the evidence of Rainer Clover who states that in 1984, after considering alternatives he decided the company should adopt the new name of HOLLAENDER RAINER, and having started to use the new name in late 1984, “had a new brochure designed accordingly.”

58. The matter is further confused by the evidence of Dudley Bogart, who, from 1955 to 1992, was a partner in a company that handled all of the exports for Hollaender Manufacturing. Mr Bogart’s recollection is that Hollaender Manufacturing were trying to obtain business in the UK, and that he made his first contact with Mark Rainer (Structural) in 1985, and that they were the first company to “give us business by importation for sale and/or installation at British sites”. He goes on to state that detailed discussions between the parties took place and “I know that Rainer Clover proposed the name “Hollaender Rainer” which was adopted “soon afterwards”

with the “explicit approval” of The Hollaender Manufacturing Company.

59. Mr Clover refers to his company’s expansion into specialist handrailing in 1984, clearly indicating that this was a new area of business, but in another Declaration stating that in 1984 Mark Rainer (Structural) Limited “was already trading in hand railing and associated fittings...”.

60. Mr Clover says that use of the mark began in late 1984, at which time “no other party had made use of the mark HOLLAENDER or HOLLAENDER RAINER in the UK, which had been “independently adopted”. In another Statement he does not dispute that in 1984, The Hollaender Manufacturing Company had been in contact with potential distributors for their products, a fact that is given some support by the opponents’ evidence GPM07/MC3, which includes a price list dated August 1984 that shows a UK supplier for HOLLAENDER goods. It seems a remarkable coincidence that at the very time that a company long established in the US in the handrailing and balustrade sector under the name HOLLAENDER is attempting to expand into the UK market, and apparently had an existing contact in Wentworth & Co, that Mr Rainer’s company, without any prior knowledge, decided to move into the same market under a new trading style which incorporates the name HOLLAENDER, a word that appears to have no prior connection or relevance with either the products or the business.

61. These are, however, matters that should properly be raised and answered by examination of the persons giving evidence. That did not happen and I am left to make what I can of the evidence. Whilst these apparent inconsistencies are a cause for concern, they do not, of themselves, provide a sufficient basis for doubting the accuracy or truthfulness of the factual evidence given.

62. In summary, whilst it is clear that the opponents were for some time a distributor for the applicants products in the UK, and the evidence “hints” that the use by Hollaender Rainer Limited may have been on behalf of The Hollaender Manufacturing company, there is not enough to promote this from conjecture to inference. That being the case, I must accept the evidence at face value, and that any reputation derived from the use made of the HOLLAENDER RAINER trade mark is the property of the user, namely, Hollaender Rainer Limited.

63. This, of course leaves the matter of the use of HOLLAENDER that can be attributed to the applicants. The applicants say that they have been trading in the UK under the trade mark HOLLAENDER since 1984, ostensibly, in the years from 1984 to 1992 through the opponents acting as distributors on their behalf, a claim disputed by the opponents, and as I have stated above, is not conclusively supported by the evidence. But in any event, concurrent use can only occur where two (or more) parties are trading at the same time. Recognising these facts, the applicants claim to have been trading concurrently, with the opponents for a period of some ten years, that is, from 1992/3 when the opponents’ “arrangement” with The Hollaender Manufacturing Company came to end, and cite the fact that there are no instances of confusion reported. There is no suggestion that the applicants’ use has been anything but honest, but the fact that there has been honest concurrent use is not a defence which, in itself, will save an

application. It is, however, one of the relevant factors which should be taken into account in determining whether there is a likelihood of confusion.

64. There is evidence (GPM07/MC3) that shows the applicants as having an agent or distributor in the UK in August 1984. This exhibit consists of an International Price List for the Export Division of The Hollaender MFG.Co. This bears a reference to a European Agency at Wentworth & Co, and is noted as being effective from 1 August 1984. The applicants make no reference to this company, in fact, the only mention is by Dudley Bogart, who, in his Affidavit states that “In the UK we approached our local sales agent , Wentworth and Company”. This evidence shows use of HOLLAENDER by the applicants from an earlier date than their involvement with Hollaender Rainer Ltd and potentially that company’s use of HOLLAENDER RAINER. However, there is no information as to whether, and how many brochures were issued, whether the goods were promoted or any sales made. According to Mr Bogart, no sales were made by that company. As I have said, the applicants have not mentioned this evidence, let alone sought to rely on it, and without further information I do not consider it to form a safe basis for showing use.

65. Apart from evidence from the trade attesting to knowledge of the HOLLAENDER trade mark and its connection with The Hollaender Manufacturing Company, which in itself is insufficient to allow a mark to proceed on the basis of concurrent use, the applicants have filed no evidence relating to the mark in actual use. However, at GPM07 the opponents have exhibited the evidence upon which the decision to allow the application to proceed on honest concurrent use was based. This consists of the Witness Statement by Mark Cetrulo summarised above.

66. Mr Cetrulo gives turnover figures, albeit not at face value appearing to be that significant, but this is a trade in a narrow, if not specialised range of goods. I note that these are more specific figures than the ball-park figures quoted by Mr Goldsworthy, and as such I take them to be more reliable. The figures have not been put into the context of the market, but this is information that helps in assessing whether the use has been of a sufficient scale to give a real opportunity for confusion. Where, as in this case, the marks are similar, the range of goods is very limited and are known to have been offered in a defined market, to the same consumer base, information relating to market shares is of less relevance.

67. Part of exhibit MC5 consists of the cover page of the June 1995 edition of “What’s new in Building” that contained an advertisement, inter alia, for HOLLAENDER Speed-rail Fittings”, listing A.D. Fabrications Ltd as the only UK distributor. Whilst this is thin evidence, when considered in conjunction with the evidence from traders supplied by the applicants, it establishes that for at least seven years, and most probably longer, the applicants’ products were being promoted in the same market in which the opponents had been trading.

68. Taking all of the evidence into account, I consider that the marks/goods of both companies will have been exposed to the relevant consumer over a long period of time and to an extent that if there was going to be confusion, it should have materialised. Setting aside the claim of Mr

Walters (which I do not consider to be the consequence of confusion), there is no evidence of actual confusion despite the concurrent use. In “*Harrods v Harrodian* [1996] RPC 697 it was stated that whilst there is no requirement to demonstrate actual confusion, it is well established that where there has been extensive side-by-side trade without any actual instances of confusion, that can be an indicator that, absent some explanation, no confusion is likely. It is also well established that the absence of evidence of actual confusion is not decisive. This is partly because such evidence is notoriously difficult to obtain, and even if there has been relevant confusion, evidence may not exist because the purchaser is happy with the quality of the goods purchased and does not complain: they may not even be aware that they have been misled as to trade source. See, for example, *Bali v Berlei* [1969] RPC 472 at 492 (lines 12-21) and 498 (lines 1-16) and *Electrolux* [1953] 70 RPC 127 at 132. Partly for this reason it has long been held that the assessment of the likelihood of confusion is a matter for the tribunal to determine. See, for example, *GE trade mark* [1973] RPC 297 and *Neutrogena v Golden* [1996] RPC 473.

69. Given the period that the two parties appear to have been trading in the UK, and the closeness of the marks and trade circumstances, if there was going to be confusion it would seem to have had ample opportunity in which to occur, yet there is not one recorded instance. Of course it may well be that having been involved in a manufacturer/distributor relationship there would not be any confusion unless, as in the case of Mr Walters, the consumer was aware of the break in the connection. It could just as easily be that in a narrow market where the traders are known, that the consumer has learnt to differentiate between The Hollaender Manufacturing Company and Hollaender Rainer Limited, particularly given that both parties seem to consistently use HOLLAENDER in conjunction with sub-brands.

70. Not unusually, where, as in this case there has been some trade connection between the parties, the lines that surround the facts are not clearly defined. The two marks appear to have been living together in the same market without giving rise to confusion, but as is said above, the fact that none has come to light does not mean that there has not been any. Had the marks and/or goods not been so close, I may well have been justified in inferring that no evidence of confusion means there is no likelihood of confusion, but the marks are extremely close and the goods identical. I am mindful of the fact that although the opponents were undoubtedly aware that the applicants were using HOLLAENDER as a trade mark, they apparently had no objection or cause for complaint, that is, outside of their attempt to register it as their trade mark.

71. There are aspects of this case, some of which I have highlighted above give me cause to wonder whether, in denying the applicants their registration, I would be doing them a disservice, but I must determine the case on the facts not feelings. Making the best that I can of the evidence, I come to the view that in all of the surrounding circumstances, if the applicants were to use their mark in relation to the goods for which they seek registration, there is a likelihood of confusion and the ground under Section 5(2)(b) succeeds.

72. My decision under Section 5(2)(b) effectively decides the matter, and there is no need for me to go on to determine the ground under Section 5(4)(a). Had I done so, I consider that having found the opponents to possess a reputation in their mark HOLLAENDER RAINER gained through many years of trade, that I would have found them to also possess goodwill. Given that the marks are very close and the circumstances of trade identical, use of HOLLAENDER by the applicants would amount to a misrepresentation, and that damage was inevitable.

73. The opposition having been successful, the opponents are entitled to an award of costs. I order the applicants to pay the opponents the sum of £2,950 as a contribution towards their costs. This 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 20th day of September 2006

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