

O/268/19

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3267739

BY SOLON SECURITY LIMITED

AND

OPPOSITION No. 411715

BY HENRY SQUIRE & SONS LIMITED

Background and pleadings

1. On 2nd November 2017 (“the relevant date”), Solon Security Limited (“the applicant”) applied to register the series of two trade marks shown below.



2. For present purposes, the differences between the marks is immaterial. Therefore, in the interests of simplicity, I shall refer to the applicant’s marks in the singular and use the second mark for comparison purposes. However, my findings shall apply to both marks.

3. The applicant seeks to register its mark in relation to:

Class 6: Bells; Bicycle locks; Bicycle locks of metal; Bolts (Door -) of metal; Cash safes of metal; Clips of metal for sealing bags; Cylinder locks of metal; Door bolts of metal; Door chains of metal; Door closers, non-electric; Door friction stays of metal; Door furniture of metal; Door hardware (Metal -); Door locks; Door openers, non-electric; Grab rails of metal; Letter boxes of metal; Letter plates of metal; Letter-box covers of metal; Metal bicycle locks; Metal chain door guards; Metal fittings for windows; Metal karabiners; Metal lock boxes; Metal locks for windows; Metal locks [non electric]; Metal sash locks; Metal window sashes; Non-electric door bells; Non-electric door chimes; Non-electric locks made of metal; Non-electric locks of metal; Non-metal safes; Safes; Safes [metal or non-metal]; Safes [strong boxes]; Safety boxes (Metal); Sash fasteners of metal for windows.

Class 9: Access control devices; Alarm sensors; Alarm signalling receivers; Alarm signalling transmitters; Alarm systems; Alarms; Alarms and warning equipment; Anti-intrusion alarms; Apparatus for recording of images; Apparatus for recording of sound; Apparatus providing night vision; Automatic

telephone dialers; Automatic timing switches; Burglar alarms; Cameras; Carbon monoxide detectors; Cell phone cases; Closed circuit television apparatus; Closed circuit television cameras; Closed circuit television systems (CCTV); Combination carbon monoxide and smoke detectors; Covers for smartphones; Dashboard cameras; Digital measuring apparatus; Digital thermometers, not for medical purposes; Digital video recorders; Door opening and closing detecting sensors; Door viewers [peepholes]; Dummy sensors; Electric timers; Electrical remote control apparatus; Electronic memory devices; Infrared cameras; Instruments for recording images; Instruments for recording sound; Intercoms; Mobile phone cases; Mobile telephone cases made of leather or imitations of leather; Mobile telephone covers made of cloth or textile materials; Motion detectors; Motion sensors; Motion sensors for security lights; Motion-activated cameras; Panic buttons; Passive infrared detectors; Passive infrared sensors; Peepholes for doors; Peepholes for doors [magnifying lenses]; Personal alarm apparatus; Personal alarms; Personal security alarms; Phone covers [specifically adapted]; Laptop cases; Light emitting diode [LED] displays; Credit card cases [fitted holders]; Holders adapted for mobile phones.

Class 11: Appliances for illumination; Bicycle lamps; Bicycle lights; Bicycle reflectors; Bicycle reflectors for attachment to spokes; Bulbs for lighting; Bulkhead lights; Cycle lights; Electric heaters; Electric lamps; Electric night lights; Electric torches; Flashlights [torches]; Flood lights; Floodlights; Garden lighting; Garden lights; Handheld spotlights; Head torches; Headlamps for use on cycles; Lamps; Lamps for outdoor use; Lamps for security lighting; Lamps for tents; LED flashlights; LED lighting fixtures; LED safety lamps; Lighting being for use with security systems; Lighting units; Lights for external installation; Lights for wall mounting; Outdoor lighting; Pen lights; Penlights; Pocket electric lamps; Pocket search lights; Pocket searchlights; Pocket torches; Pocket torches, electric; Rechargeable torches; Residential lighting fixtures; Safety lamps; Security lighting; Security lighting incorporating a heat activated sensor; Security lighting incorporating a movement activated sensor; Security lighting incorporating an infra-red activated sensor; Solar lamp units; Solar lamps; Solar lights; Solar powered lamps; Solar powered torches; Spot lamps; Spot lamps for household illumination; Spot lights; Spot lights for household illumination; Spotlights; Torches for lighting; Torches (Pocket -), electric; Ultra violet ray lamps, not for medical purposes; Ultraviolet lamps not for medical purposes; Wall lights.

Class 14: Key holders [trinkets or fobs].

Class 18: Credit card holders; Credit card holders made of imitation leather; Credit card holders made of leather; Wallets including card holders; Wallets incorporating card holders; Holders in the nature of cases for keys; Holders in

the nature of wallets for keys; Key holders; Holders in the nature of cases for keys; Holders in the nature of wallets for keys.

4. The application was accepted and published for opposition purposes on 24th November 2017.

5. Henry Squire & Sons Limited (“the opponent”) opposes the application. The opponent is the proprietor of earlier UK trade mark 948449. This mark consists of the word **Defender**. It is registered with effect from 19th September 1969 in relation to ‘padlocks’.

6. The opponent claims that:

- (i) The marks are identical or similar;
- (ii) The respective goods are also the same or similar;
- (iii) There is a likelihood of confusion on the part of the public;
- (iv) The earlier mark has been used since 1969 and has acquired a reputation and an enhanced degree of distinctiveness;
- (v) Use of the opposed mark would, without due cause, take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of the earlier mark;
- (vi) Registration of the opposed mark would therefore be contrary to s.5(1), s.5(2) or s.5(3) of the Trade Marks Act 1994 (“the Act”).

7. The opponent also claims to have acquired common law rights in the signs DEFENDER and GARAGE DEFENDER following the use of those signs since 1969 and 2008, respectively, in relation to padlocks and locks. According to the opponent, use of the opposed mark in relation to any of the goods covered by the application would be contrary to the law of passing off. Registration of the applicant’s mark would therefore also be contrary to s.5(4)(a) of the Act.

8. The applicant filed a counterstatement denying the grounds of opposition. I note that the applicant:

- (i) Claims that the device element of the opposed mark means that the respective marks are visually different;
- (ii) Accepts that the marks are phonetically identical, but claims that this is of little importance given that 'Defender' is a commonly used word without distinctive character, and that the applicant's goods are sold via its website and Amazon, i.e. through visual channels;
- (iii) Claims that the respective goods are different;
- (iv) Denies that the opponent has been using Defender and puts it to proof of the use of the mark, as well as the reputation and goodwill claimed under it;
- (v) Denies that the opponent has been using GARAGE DEFENDER since 2008, claiming that this is a third-party product;
- (vi) Claims that it has been using Defender since 2002/3 and the opposed mark since 2013, in relation to security products;
- (vii) Claims that the opponent is fully aware of the applicant's branding;
- (viii) Denies that there is a likelihood of confusion, or that use of the opposed mark would take unfair advantage of, or be detrimental to, the earlier mark.

The evidence

9. The opponent's evidence consists of two witness statements by Mr Glyn Green, who is its Technical and Operations Director. The second of Mr Green's statements was filed in reply to the applicant's evidence.

10. The applicant's evidence consists of witness statements by Mr John Fearnall, who is its Managing Director, and Mr Mark Fleming, who is its General Manager.

11. I have been through all the evidence. The evidence I consider to be relevant and material is covered below.

Representation

12. The applicant is represented by Primas Law Limited. The opponent is represented by McDaniel & Co., solicitors. Both sides filed written submissions

during the written stage of the opposition procedure (two submissions in the opponent's case).

13. A hearing was held on 27th February 2019. Mr Maxwell Keay appeared as counsel for the applicant. The opponent was not represented, preferring to rely on the written arguments already filed.

Proof of use

14. The opponent's earlier mark has been registered since 1969. Consequently, s.6A of the Act applies. The relevant parts are as follows:

"6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(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) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(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.”

15. The relevant period for establishing genuine use of the earlier mark is therefore 25th November 2012 to 24th November 2017.

16. Section 100 of the Act provides:

“100. 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.”

The onus is therefore on the opponent to show what use it has made of the earlier mark during the relevant period.

17. In *Walton International Ltd & Anor v Verweij Fashion BV*¹ Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C 416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I 4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or

¹ [2018] EWHC 1608 (Ch)

services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of

the use: Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Leno at [29]-[30], [56]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72] and [76]-[77]; Leno at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32].”

18. Mr Fearnall gives evidence that the applicant has been through the opponent’s sales brochures for 2013 to 2017, which cover numerous ranges of the opponent’s products, but none were marketed under the mark Defender.

19. Mr Green’s evidence is that the opponent is a long-established manufacturer of locks. It has sold padlocks under the Defender mark since 1969. He provides a list of 83 distributors². According to Mr Green, “*The opponent has sold goods to these stockists under the [Defender] Trade Mark between 2008 and the present date.*” In support of his claim, Mr Green provides a spreadsheet showing orders placed between 2008 and the date of his statement, which is 7th September 2018³. He says that padlocks sold under the Defender trade mark are shown in the list under the codes HS2, HS3 and 100 series (100 30, 100 40, 100 50 and 100 40LS). 5156 units were sold in this period at a value of about £26k. I note that the list covers order placed before and after the relevant period. Mr Green accepts that the most recent examples of padlocks sold under ‘HS’ references in evidence relate to sales made in

² See GG2

³ See GG3

2009. Accordingly, the evidence of sales under 'HS' references is irrelevant for the purposes of showing genuine use of the earlier mark during the relevant period.

20. It follows that the evidence in exhibit GG4, which appears to show padlocks being offered for sale on the opponent's website in April 2012 and May 2013 under the names HS2 Defender and HS3 Defender⁴, must be historical. These web pages must therefore have been left up on the opponent's website for several years after the goods shown on them were last available for sale.

21. According to my analysis of exhibit GG3, there were 159 sales of goods during the relevant period by reference to a code number in the 100 series. These sales were made to 3 customers: Ironmongery Direct, Greenham Trading and Toolstation Limited. Most of the sales were for multiple units. For example, Toolstation bought 138 units under reference 100 40 on 25th August 2015. On the same date, it bought 96 units under reference 100 50. The cost of the goods was about £2 or £3 each.

22. Exhibit GG7 includes an invoice dated 25th August 2015 from the opponent to Toolstation Limited which bears out the sales claimed in GG3 and described in the previous paragraph. I note that the invoice, like the spreadsheet in GG3, identifies the goods only by way of the opponent's code numbers. This means that the value of this evidence turns on Mr Green's evidence that the 100 series numbers relate to goods sold under the name Defender. Support for Mr Green's evidence about this is provided by copies of emails in evidence from Toolstation to the opponent dated 17th March 2016, 11th November 2016 and 27th June 2017. i.e. all within the relevant period. Each of these emails placed orders for "Squire Defender" padlocks or "Defender" padlocks by reference to 100 series code numbers. The emails also placed orders for "Defender" padlocks using code numbers 400 50 and 510 80. Mr Green's evidence is that these codes also relate to Defender padlocks. I find this persuasive evidence that the opponent sold Defender padlocks to, at least, Toolstation during the relevant period. And if that is correct, then the opponent probably made similar sales under the mark to Ironmongery Direct and Greenham

⁴ See GG4

Trading, as Mr Green claims. Indeed, an example of an invoice dated 2nd February 2015 to Ironmongery Direct for a 100 50 series padlock is in evidence⁵.

23. At the hearing, Mr Keay submitted that even if I accepted Mr Green's evidence about these sales, his evidence did not show how the Defender mark was used in relation to the goods or whether the Defender mark was visible when Toolstation etc. offered the goods for sale to the public (assuming they did). In this connection, Mr Keay pointed out that, since the end of the relevant period, the opponent has launched a new range of Defender padlocks. It has shown in evidence that the name Defender is used on these padlocks, as well as in the related promotional material. In this context, Mr Keay submitted that it was significant that the opponent had not been able to show that Defender was used on the padlocks sold during the relevant period.

24. I accept the evidence does not show that the opponent used Defender on padlocks during the relevant period. However, the opponent is only required to show that the mark was used "in relation to" to the goods. The evidence clearly shows that orders were placed for padlocks by reference to the name Defender during the relevant period. And Mr Green says that goods were sold under the mark in response to these orders. In the absence of cross examination, I accept his evidence on this point. It is true that he does not expressly say how the mark was used in relation to the goods. However, he provides extracts from Toolstation's sales brochure showing padlocks offered for sale to the public under the names 'Defender' and 'Squire Defender'. In these examples, the names are used to promote and identify the goods in the brochure entries, but not on the goods themselves. This clearly constitutes use "in relation to" the goods. And the obvious inference is that such use occurred with the consent of the opponent. Mr Keay pointed out that the Toolstation sales brochure in evidence is undated. Consequently, he submitted that this did not necessarily show use of the mark during the relevant period. Taking in isolation from the rest of the evidence, this is true. However, as Mr Green points out in his evidence, the product codes used by Toolstation in its sales brochure correspond to the ones it used when ordering specific 100 series padlocks (or 400

⁵ See GG10 page 101

50 and 510 80 padlocks) from the opponent in 2016 and 2017. Further, the absence of the Defender mark from the products shown in the sales brochure is consistent with the goods being 100 series Defender padlocks (or 400 50 and 510 80 Defender models) rather than part of the opponent's new Defender padlock range, all of which appear to bear the name Defender on the products themselves⁶.

25. It is, of course, for the opponent to provide cogent evidence of use⁷. However, in assessing whether the opponent has shown such evidence it is necessary to consider the evidence as a whole. The opponent's evidence satisfies me that, on the balance of probabilities, the mark was used by the opponent, and with its consent, during the relevant period, in relation to padlocks.

26. The scale of the use, although very modest, appears entirely consistent with the objective of maintaining a market for goods under the trade mark. I therefore find that the use shown is genuine use.

27. It follows that the opponent can rely on the earlier mark for the purposes of these proceedings.

The s.5(1) and (2) grounds of opposition

28. Section 5(1) and (2) of the Act are as follows:

"5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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 trade mark is protected...there exists a likelihood of confusion on the part of the

⁶ See GG9 and GG11

⁷ Per *Awareness Limited v Plymouth City Council*, Case BL O/236/13

public, which includes the likelihood of association with the earlier trade mark”.

(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”.

29. The presence of a figurative device in the applicant’s mark means that it is not identical to the opponent’s earlier mark. The s.5(1) of opposition must therefore be rejected as unfounded.

Comparison of goods

30. The earlier mark is registered for *padlocks*. Padlocks do not appear in the specification of the opposed mark. At the hearing, counsel for the applicant accepted that there was some degree of similarity between padlocks and the following goods in class 6 of the application:

Bicycle locks; Bicycle locks of metal; Cylinder locks of metal; Door locks; Metal bicycle locks; Metal locks for windows; Metal locks [non-electric]; Metal sash locks; Non-electric locks made of metal; Non-electric locks of metal.

31. I find that the terms *metal locks [non-electric]*, *non-electric locks of metal* and *non-electric locks made of metal* are wide enough to cover padlocks. It follows that these must be regarded as identical goods⁸.

32. In deciding whether, and to what extent, the other goods covered by the applicant’s application are similar to *padlocks*, I bear in mind the guidance of the Court of Justice of the European Union (“CJEU”) in Canon⁹, where the court stated that:

⁸ See *Gérard Meric v Office for Harmonisation in the Internal Market*, Court of First Instance at the ECJ, Case T-133/05, at paragraph 29 of the judgment

⁹ Case C-39/97, at paragraph 23 of the judgment

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

33. The other locks listed in paragraph 30 above are similar in nature and purpose to padlocks. i.e. locking something to something else, securely. The goods could also be in competition to a limited degree, e.g. a bicycle can be secured with a specialist bicycle lock or with a general purpose padlock. These goods are therefore highly similar.

34. The opposed application also covers:

Class 6: Door furniture of metal; Door hardware (Metal -); Door bolts of metal; Door chains of metal; Metal chain door guards; Metal fittings for windows; Sash fasteners of metal for windows.

35. The first two of these terms are wide enough to cover door locks. *Metal fittings for windows* is wide enough to cover window locks. It follows that these goods must also be considered to be highly similar to *padlocks*.

36. Door bolts and chains of metal are not locks, but they are closely related security items of common metal. Further, *sash fasteners of metal for windows* could include fasteners with a locking mechanism. There is therefore a certain degree of similarity in the nature and purpose of these goods and *padlocks*, although they are unlikely to be in competition and the method of use is different. Overall, I find that there is a low degree of similarity between *door bolts of metal*, *door chains of metal*, *metal chain door guards*, *sash fasteners of metal for windows* and *padlocks*. I note Mr Fearnall's evidence that the applicant sells *Carabiner Security Hooks*, *Door chains*, *Door braces* and *Push Button Key Safes*, which he appears to accept are “remotely similar to locks” although “certainly not comparable with the padlocks sold by [the opponent].” I have already accepted that *Door chains of metal* are similar to a low

degree to *padlocks*. I do not understand Mr Fearnall's evidence to amount to an acceptance that the other goods he mentions are similar to padlocks.

37. According to the opponent's written submissions, almost all of the applicant's goods in class 6 have the same purpose, users, nature, and are sold through trade channels as, padlocks. However, some of the applicant's other class 6 goods. e.g. *door openers (non-electric)*, *grab rails of metal* clearly do not have the same purpose as *padlocks*. The mere fact that they are also articles of common metal and have the same users, and possibly share the same trade channels, is insufficient, in my view, to create any material similarity between the goods. Nor is it decisive that some of the other goods in class 6 of the application may have potential uses in a security context. I do not therefore accept that the opponent has shown why *door openers (non-electric)*, *grab rails of metal*, *carabiner security hooks*, *door braces*, *push button key safes* or any of the remaining goods in class 6, are similar to *padlocks*.

38. The opponent submits that the goods covered by class 9 of the opposed application are similar to *padlocks* because they "*have the same purpose of providing security to the user*". The opponent further submits that the goods in classes 9, 11, 14 and 18 of the opposed application include goods which are similar to *padlocks* because they have "*....the same users, trade channels and complementary nature of the goods.*"

39. I reject the first submission. The mere fact that a padlock and an electronic access control device in class 9 both provide security to the user is such a high-level similarity that it is insufficient to create any material similarity between these goods. Padlocks are relatively crude locking devices for general purposes. They are very different in nature to an electronic access control device in class 9.

40. I also reject the second submission. The opponent has not clarified which goods in classes 9, 11, 14 and 18 it claims have the "*....the same users, trade channels and complementary nature of the goods*" as/to *padlocks*. In my view, none of the goods in these classes of the application are complementary goods to *padlocks* in

the sense identified in the case law¹⁰. Any overlap there may be in users, or in the usual trade channels through which they are sold, is insufficient, in my view, to create any material similarity between the goods.

41. I therefore find that *padlocks* are not similar to any of the goods covered by classes 9, 11, 14 or 18 of the application, or to the following goods in class 6:

Class 6: Bells; Cash safes of metal; Clips of metal for sealing bags; Door closers, non-electric; Door friction stays of metal; Door openers, non-electric; Grab rails of metal; Letter boxes of metal; Letter plates of metal; Letter-box covers of metal; Metal karabiners; Metal lock boxes; Metal window sashes; Non-electric door bells; Non-electric door chimes; Non-metal safes; Safes; Safes [metal or non-metal]; Safes [strong boxes]; Safety boxes (Metal).

42. This means that the opposition under s.5(2) fails in relation to the goods in classes 9, 11, 14, 18 as well as the goods specified in the previous paragraph. This is because s.5(2) of the Act presupposes that the respective goods/services are similar to some extent¹¹.

Average consumer and the selection process

43. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*¹².

44. Insofar as the goods are similar, the average consumer in this case is likely to be a member of the public seeking a security lock or related items. It may also be a

¹⁰ In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court of the ECJ stated that “complementary” means: “...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 those goods lies with the same undertaking”.

¹¹ See *Waterford Wedgwood plc v OHIM* – Case C-398/07 P, CJEU

¹² CJEU, Case C-342/97

tradesman or women selecting products for use by his or her customers. In either case, the selection of such goods is likely to be made mainly by picking goods out of a catalogue or on the internet, i.e. by visual means. However, word of mouth recommendations may also play a small part in the selection process, so the way the marks sound is of some, albeit secondary, significance.

45. Both kinds of average consumer are unlikely to pay more than an average degree of attention when selecting items of metal hardware.

Distinctive character of the earlier mark

46. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*¹³, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from

¹³ Case C-342/97

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

47. The word Defender is not descriptive of characteristics of padlocks, but it is not particularly distinctive either. It describes a person who defends someone or something. It therefore strongly ‘hints’ at the purpose of the goods, i.e. to ‘defend’ property from theft. It is not the sort of trade mark that the public would be surprised to find was used by more than one undertaking in relation to significantly different goods in the security field. In my view, it has a below average degree of inherent distinctive character.

48. It is true that the opponent has used the mark for a long time. However, the scale of use and promotion, at least in recent times, has been so low that it is unlikely to have made much impact on the relevant public. I therefore find that, at the relevant date, the distinctive character of the earlier mark had not been enhanced through use to any significant extent.

Comparison of the marks

49. It is clear from the CJEU’s judgment in *Sabel BV v. Puma AG*¹⁴ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components.

50. The respective trade marks are shown below:

Defender	 The logo for the 'Defender' trade mark, featuring a stylized circular graphic on the left and the word 'Defender' in a bold, sans-serif font on a black rectangular background to the right.
Earlier trade mark	Contested trade mark

¹⁴ *Sabel BV v Puma AG*, Case C-251/95 at paragraph 23

51. The earlier mark is just the word Defender. The opposed mark consists of the same word presented on a rectangular dark border with device to the left of it. The device resembles one sometimes used to represent the emission of sound. Some average consumers would recognise this, others would not. In either event, the device will make a more-than-negligible contribution to the visual impact created by the later mark. However, in my view, it is not sufficiently dominant or distinctive to make a bigger impact than the word Defender. I therefore find that this word will tend to dominate the impression the opposed mark makes on average consumers of metal hardware.

52. I find that the marks are highly similar to the eye.

53. There is no dispute that the marks are aurally identical.

54. The meaning of the word Defender, i.e. a person who defends someone or something¹⁵, is common to both marks. The opposed mark has no other meaning. I therefore find that the marks are conceptually identical, albeit that the shared concept is not a particularly distinctive one in the context of security apparatus.

Likelihood of confusion

55. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

¹⁵ Oxford English Dictionary

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(g) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(h) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) however, if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

56. The high degree of similarity between the marks indicates that there is a likelihood of confusion where the respective goods are similar. Therefore, even after making some allowance for the below average degree of distinctiveness of the word Defender for padlocks, I find that there is a likelihood of confusion if the opposed mark is used in relation to:

Bicycle locks; Bicycle locks of metal; Cylinder locks of metal; Door locks; Metal bicycle locks; Metal locks for windows; Metal locks [non electric]; Metal sash locks; Non-electric locks made of metal; Non-electric locks of metal; Door furniture of metal; Door hardware (Metal -); Door bolts of metal; Door chains of metal; Metal chain door guards; Metal fittings for windows; Sash fasteners of metal for windows.

57. Where the respective goods are identical, e.g. padlocks v metal locks, I find that there is a likelihood of direct confusion. Where they are similar, I find that there is a likelihood of association in the sense of indirect confusion, i.e. that the common element – Defender – will make average consumers believe that the goods sold under the parties' marks are those of one and the same undertaking, or of economically connected undertakings.

58. I note that, according to Mr Fearnall, the opponent has used its mark since 2002 in relation to a range of security products. This has been extended and now includes alarm systems, CCTV systems, personal alarms, torches, road safety products and property marking materials. None of these products appear to be similar to *padlocks*. This use is therefore irrelevant.

59. The only item for which the applicant claims to have used its mark, which I have found is similar to *padlocks*, is door chains. Mr Fearnall says that the applicant started selling 'defender' door chains in November 2014. He says that the applicant sold 54k *door chains*, *carabiner security hooks*, *door braces* and *push button key*

safes between 2014 and the date of his statement in October 2018. I cannot tell from this how many defender door chains were sold prior to the relevant date (or at all), or how much promotion of these goods took place (if any). Considering also the very modest level of sales of the opponent's Defender padlocks since 2014, there has not been sufficient honest concurrent use of the marks such that the functions of the earlier mark will no longer be damaged if the applicant uses the opposed mark in relation to door chains.

60. It follows that the opposition under s.5(2) succeeds to the extent indicated in paragraph 56 above. For the avoidance of doubt, if I had found that more of the goods covered by the opposed application were similar to some degree to *padlocks*, the degree of similarity would have been very low. Further, the earlier mark is not particularly distinctive. In these circumstances, I would still have rejected the s.5(2) ground of opposition in relation to the balance of the goods covered by the opposed application.

The s.5(3) ground of opposition

61. Section 5(3) states:

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

62. The first requirement is that the earlier mark had a reputation in the UK at the relevant date. In *General Motors*¹⁶ the CJEU held that:

¹⁶ Case C-375/97

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

63. The use shown of the earlier mark in this case is so low that the earlier mark clearly would not have been known to “*a significant part of the public concerned by the products or services covered by that trade mark*” at the relevant date. This ground of opposition therefore falls at the first hurdle.

The s.5(4)(a) ground of opposition

64. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

65. In *Discount Outlet v Feel Good UK*¹⁷ Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

66. There is no doubt that the opponent has a substantial goodwill and reputation in the UK as a lock maker. The difficulty with the opponent’s case is that the Defender mark appears to have played little part in the opponent’s reputation at the relevant date. It is possible that even the opponent’s modest use of Defender for padlocks would have meant that it was distinctive of its business to a substantial number of its customers, or potential customers. It may, therefore, have been able to bring an action for passing off if the applicant’s mark was used in relation to locks. However, in my judgment, the association between the sign Defender and the opponent’s business was sufficiently tenuous at the relevant date that it would not have been able to prevent the use of the applicant’s mark in relation to any of the goods for which I have rejected the opposition under s.5(2). This is because the applicant’s use of the opposed mark in relation to such goods would not have deceived a substantial number of the relevant public. Indeed, it is doubtful that anyone would have been deceived.

¹⁷ [2017] EWHC 1400 IPEC

67. I therefore find that the opposition under s.5(4)(a) takes the opponent's case no further than the opposition under s.5(2)(b).

Outcome

68. The opposition succeeds in relation to the goods specified at paragraph 56 above.

69. The opposition is otherwise rejected.

Costs

70. Both sides have achieved a measure of success. I therefore order each party to bear its own costs.

Dated 20 May 2019

**Allan James
For the Registrar**