

O-277-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2364876
IN THE NAME OF HNI TECHNOLOGIES INC**

AND

OPPOSITION NO. 93251 THERETO BY ILVE S.P.A.

TRADE MARKS ACT 1994

**IN THE MATTER OF application
No. 2364876 in the name of
HNI Technologies Inc
and opposition No. 93251
thereto by ILVE S.p.a.**

Background

1. Application No. 2364876 for the trade mark QUADRA-FIRE was filed on 3 June 2004 and stands in the name of HNI Technologies Inc. The application seeks registration for the following specification of goods in class 11:

Solid fuel burning decorative fireplaces.

2. Notice of opposition was filed on behalf of ILVE S.p.a. on 7 March 2005. Following a prompt review of its opposition case, it confirmed that the opposition should proceed on the basis of a single ground of opposition brought under section 5(2)(b) of the Act. The opponent relies on the following trade mark:

3. Community Trade Mark No. 2378842 for the trade mark: QUADRA in respect of *Built-in ovens and hobs, gas and electric cookers, extractor hoods.*

4. The opponent claims that the goods of the application are similar to all of the goods protected by the earlier mark.

5. The applicant subsequently filed a counter-statement essentially denying the ground of opposition. Both parties filed evidence. The parties were reminded of their right to be heard but neither requested a hearing although the applicant filed written submissions. After a careful study of all the papers, I give this decision.

Opponent's evidence

6. This takes the form of a witness statement by Bernard A Whyatt and is dated 7 March 2006. Mr Whyatt is a partner of the firm Brand Protect LLP who act as representatives to the opponent in these proceedings. Mr Whyatt confirms that the content of his witness statement is from his own knowledge or taken from the records of the opponent company and to which he has access.

7. Mr Whyatt states that he has visited the opponent's Italian language website which shows it to be a manufacturer of a range of products which include ovens, cookers, microwave ovens, sink, ranges and accessories, in particular a range of ovens which it sells under the trade mark QUADRA. At BAW 1, Mr Whyatt exhibits pages taken from the opponent's Italian website along with pages from an Australian website to show in the English language the range of cookers produced under its trade mark. Not all of the pages show download dates but where they do, they show dates of 7 March 2006 and what I take to be 14 October 2005.

8. Mr Whyatt goes on to say that the applicant is a manufacturer of a range of gas, electric and wood burning fireplaces and stoves and inserts. It also manufactures stoves (which he says would be known in Britain as wood burners), which are designed to burn pellets and which are sold under the name QUADRAFIRE. It also manufactures mantels and surrounds (“fire places”). Mr Whyatt says that at BAW 2 he exhibits the above mentioned products but the exhibit in fact consists of further website pages showing various products; the pages again showing download dates of 7 March 2006 and 14 October 2005.

9. There are a further two exhibits:

BAW 3: Mr Whyatt says this is a report of an internet search of websites that show both cookers and fireplaces. It is, in fact, the first ten of some 1,460,000 results returned from a search for the words “cookers” and “fireplaces” :

BAW 4 Webpages from a number of websites

10. Mr Whyatt gives no explanation of these two latter exhibits, all of which appear to have been downloaded on 7 March 2006.

Applicant’s evidence

11. This consists of two witness statements. The first is of Jaymie Heil and is dated 11 September 2006. Mr Heil confirms that the facts in the statement come from his personal knowledge and that he is authorised to speak on his company’s behalf in these proceedings.

12. Mr Heil states that he is the International Business Manager of Hearth & Home Technologies, a position he has held since 2003. Mr Heil explains that QUADRA-FIRE is a Hearth & Home technologies brand. He goes on to say that both Hearth & Home Technologies and the applicant are wholly owned subsidiaries of HNI Corporation with the applicant being the owner of the intellectual property of the parent company.

13. Mr Heil explains that goods are sold in the UK under the brand QUADRA-FIRE through a distributor, Anglia Fireplaces & Design Limited, of Cambridge. At JH 1 he exhibits a printout from the QUADRA-FIRE website and dated 11 July 2006, which identifies this company as the UK dealer. Mr Heil goes on to say that goods sold under the QUADRA-FIRE mark are stoves, fireplaces and fireplace inserts and at JH 2 he exhibits printouts from the QUADRA-FIRE website dated 5 September 2006 to illustrate this.

14. At JH 3 Mr Heil exhibits a printout dated 11 July 2006 again from the QUADRA-FIRE website and confirms that no apparatus for cooking of any type has ever been sold under the QUADRA-FIRE mark.

15. The second witness statement is of Graham J Vials and is dated 12 September 2006. Mr Vials is the Chairman/ Managing Director of Anglia Fireplaces & Design Limited, a position he has held since 1980. Again, Mr Vials confirms that the facts in

his statement come from his personal knowledge and that he authorised to speak on behalf of his company.

16. Mr Vialls states that Anglia Fireplaces & Design Limited is a retailer of fireplaces and stoves and the sole distributor in the UK for Hearth & Home Technologies including goods sold under the QUADRA-FIRE mark. At GJV 1 he exhibits a brochure showing the products his company sells. The brochure is not dated.

17. Mr Vialls goes on to say that QUADRA-FIRE products are traditionally sold through retailers such as his company and that he is aware that the previous UK importer of QUADRA-FIRE products is also a fireplace and stove retailer. Mr Vialls confirms that his company does not sell any apparatus for cooking, including ovens, hobs or cookers but sells fireplaces, stoves and accessories.

18. Mr Vialls states that he would not expect fireplace and stove retailers to also sell apparatus for cooking since they are in separate markets. He gives no explanation or evidence to support this view. He says that he is not aware of any fireplace and stove retailers who also sell apparatus for cooking, even in “large housing outlets”. He provides no explanation of what he means by this term.

19. Mr Vialls explains that the word QUADRA within the mark QUADRA-FIRE refers to the technology of the product as it has four burning stages. He provides no further explanation of what this means.

Opponent’s evidence in reply

20. This is a further witness statement of Bernard A Whyatt and is dated 26 February 2007. Mr Whyatt challenges Mr Vialls’ claim that his company does not sell any cooking apparatus and refers to Mr Vialls’ exhibit GJV 1 which he says contains several pictures of kettles and pans being heated on the stoves. Mr Whyatt states that these pictures also contradict Mr Heil’s evidence that no apparatus of any kind used for cooking has ever been sold under the QUADRA-FIRE mark.

21. At BAW 5, Mr Whyatt exhibits yet more internet printouts downloaded on 26 February 2007 to show that products sold as food cookers are also capable of heating and boiling water and burn wood.

22. At BAW 6 are exhibited the results of an internet search for “woodburners” carried out by Mr Whyatt on 26 February 2007. Mr Whyatt says that these results, plus the exhibits at BAW 3 and 4 show that cookers, fireplaces and stoves are sold in the same stores and through the same sales channels.

23. Mr Whyatt makes various comments on the meaning of particular words used to describe the parties’ products. I do not intend to summarise these comments but will, insofar as it is appropriate, take them into account. Likewise, comments he makes on the likelihood of confusion between the respective marks will be considered as appropriate.

24. That concludes my summary of the evidence.

Decision

25. Section 5(2)(b) of the Act states:

- “5.- (1)
- (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.”

26. The term “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 or International trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

27. The opponent’s registration is an earlier trade mark within the definition of Section 6 of the Act.

28. In determining the question under Section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R.723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant –but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma Ag*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG & Adidas Benelux BV*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

29. In essence, the test under section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities to show a likelihood of confusion, I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark registered and the applicant's registration on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered with the respective specifications.

Comparison of marks

30. Both marks are presented in block capitals. Visually and aurally, they both share the word QUADRA, with the applicant's mark also containing the second word FIRE separated from it by a hyphen.

31. In its evidence the applicant claims the word QUADRA refers to the good in issue having four burning stages though no further information has been provided to explain this claim. In its written submissions, however, it states QUADRA is an invented word with no meaning of itself though a meaning can be attributed due to the presence within it of the word QUAD. It does not say what meaning could be attributed but in any event, I have to consider the mark as a whole and must not indulge in an artificial dissection of the mark. I consider the word QUADRA would have no conceptual meaning to the average consumer but, instead, would be regarded by him as an invented word. In relation to the goods at issue which are solid fuel burning decorative fireplaces, the word FIRE is descriptive.

32. I consider the respective marks have a good degree of similarity. I also consider the earlier mark to have a good degree of inherent distinctiveness. The applicant has not provided any evidence of reputation in the market and so cannot benefit from any enhanced level of protection.

Comparison of goods

33. For ease of reference I set out the respective specifications below:

Application	Earlier Mark
Class 11 Solid fuel burning decorative fireplaces.	Class 11 Built-in ovens and hobs, gas and electric cookers, extractor hoods.

34. Each of the respective goods appear in class 11 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957 (as revised) (“The Nice Classification”). But this, of itself, does not make them similar goods.

35. The principles to be applied in considering the similarity of goods and services are to be found in the *Canon* case where the ECJ stated at paragraph 23:

“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 end users and their method of use and whether they are in competition with each other or are complementary.”

36. In *British Sugar Plc v James Robertson & Sons* (TREAT) [1996] RPC 281 it was considered that channels of trade should also be brought into the reckoning. Finally, it is well established that words appearing in specifications should be given no more than their natural meaning with reference to their context (see *Beautimatic International Ltd v Mitchell International Pharamceuticals Ltd and Another* [2000] FSR 267).

37. The goods covered by the earlier mark enable their user(s) either to prepare food by the application of heat from a specific heat source or to ventilate e.g. the cooking area. They are fittings in the nature of appliances most generally used in kitchens by

those preparing food. Both parties agree that the applicant sells a range of goods. But whatever goods it may sell, the application seeks registration only in respect of “solid fuel burning decorative fireplaces”. A fireplace is “an open recess in a wall of a room, at the base of a chimney, etc., for a fire; hearth” (Collins English Dictionary 5th Ed. 2000). It is not therefore actively used by anyone of itself but is a fixture within which e.g. a heat generating source such as a fire may be put and its structure is likely to vary depending on what type of heat source is to be placed in or on it. The nature, method of use and end users of the respective goods differ greatly. The respective goods are not in competition nor are they complementary. Whilst I have little evidence on the point it seems to me that the channels of trade are also unlikely to converge.

Likelihood of confusion

38. This is a matter of global appreciation taking into account all relevant factors including the interdependency principle that a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and services, and vice versa.

39. The matter must be considered through the eyes of the average consumer taking into account the fact that he will rarely have the opportunity to compare marks side by side. Taking all matters into account, I find that there is no likelihood of confusion in respect of the goods for which registration is sought. The opposition under section 5(2)(b) fails in its entirety.

40. The opposition having failed, the applicant is entitled to an award of costs. I take into account the limited nature and relevance of the evidence, particularly in relation to the relevant date in these proceedings, and the fact that the decision has been reached without a hearing. I order the opponent to pay the applicant the sum of £950 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of September 2007

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