

O/447/11

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2432787
IN THE NAME OF JAMES BLAKE & CO (ENGINEERS) LIMITED
OF THE TRADE MARK**

THE METAL CENTRE

IN CLASS 6

AND

**THE APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 83784**

**BY
AMARI METALS LIMITED**

**In the matter of registration no 2432787
in the name of James Blake & Co (Engineers) Limited
of the trade mark**

THE METAL CENTRE

in class 6

and

**the application for a declaration of invalidity thereto
under no 83784
by Amari Metals Limited**

Background

1. THE METAL CENTRE is a trade mark registration standing in the name of James Blake & Co (Engineers) Limited (“the proprietor”). It was applied for on 16 September 2006 and completed its registration procedure on 23 March 2007. THE METAL CENTRE is registered for the following goods in class 6:

Steel; steel sheets, plates, sections and tubes; mild steel; aluminium; brass; purpose made metal work; stainless steel splashbacks; metals for welding; metal nuts and bolts; small items of metal hardware.

2. Amari Metals Limited (“the applicant”) filed an application on 7 June 2010 to have the trade mark declared invalid under section 47(1) of the Trade Marks Act 1994 (“the Act”). Section 47(1) states:

“The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection 1(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

The applicant claims that the THE METAL CENTRE offends sections 3(1)(b) and (c) of the Act. These state:

“3.— (1) The following shall not be registered –

.....

- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality,

quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

.....

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

3. The applicant’s claim under Section 3(1)(b) of the Act is that THE METAL CENTRE is unable to identify the goods of one undertaking from those of other undertakings. The mark consists of the word METAL which is the material from which the goods are made and the term CENTRE which means a place where an activity is concentrated. Therefore the mark means a place where the goods are located and is devoid of any distinctive character. The Section 3(1)(c) claim is along similar lines, with the additional claim that the mark informs the consumer what goods are available and from where with no additional distinctive elements. Further the mark is entirely descriptive of the geographical origin of the goods, consisting of the location from where the goods are distributed. It is a sign which other traders would reasonably wish to use to describe the characteristic of their goods and the location of their services.

4. The proprietor filed a counterstatement, denying the grounds and stating that THE METAL CENTRE is inherently distinctive for the goods for which the mark is registered. Further, or in the alternative, the proprietor claims that the mark has been in use since at least as early as 1995 and has acquired a distinctive character within the meaning of the proviso.

5. Both parties filed evidence and the matter then came to be heard before me on 8 November 2011. The applicant was represented by Mr Guy Hollingworth, of Counsel, instructed by Marks & Clerk LLP, and the proprietor was represented by Mr Ross Manaton, of Bromhead Johnson.

EVIDENCE

6. The applicant’s evidence takes the form of witness statements from Chris Meredith, Brian Watson, WJ Savage, Karl Weston, Matthew Sammon and Richard Chesworth. The proprietor’s evidence comes from Ronald Hunter Blake, Kenneth Giles, Bruce Woodall and Ross Timothy Manaton.

7. Chris Meredith

Mr Meredith has been the General Manager of The Metal Centre for the applicant (i.e. Amari Metals Limited) since 2000. He exhibits a number of customer invoices from The Metal Centre, which include in the small print “The Metal Centre is a business name of Amari Metals Ltd”. Company brochures, catalogues and promotional material also all show “The Metal Centre”. The goods sold by The Metal Centre are various metal extrusions, such as bars, tubes, angled and channelled

extrusions, sheets, rods, pipes and fittings. The photographs in the brochures show a substantial warehousing and distribution operation in relation to these metal goods; the warehouse covers 150,000 sq ft and holds 10,000 tons of stock. Mr Meredith gives turnover figures for The Metal Centre as £75,156,000 in 2000 rising to £138,259,000 in 2009. A photograph of the warehouse shows a sign saying 'The Metal Centre' on the outside of the building.

8. Brian Watson, WJ Savage and Karl Weston

These witness statements are claimed by the applicant to form independent trade evidence. Brian Watson works for Aalco Limited Belfast, which he says also trades as The Belfast Metal Centre. He states that the term "the metal centre" is a description commonly used in the metals industry. Curiously, the statement refers to use by the industry and "by our members". The same wording is also used by Karl Weston of Blackburns Metals Limited, another metal stockholder. Neither of these companies are trade associations: they are businesses. There is a whiff of the pro-forma about them. The other witness statement, from Mr Savage, shows that he is from a trade association and so his reference to members is not out of place. Furthermore, it transpires from the proprietor's evidence that Aalco Limited is a division of the applicant, so can hardly be said to constitute independent evidence from the trade. At the hearing, Mr Hollingworth accepted that the witness statements from Messrs Watson and Weston were not independent. I will therefore place little, if any, weight upon them.

9. WJ Savage is the Secretary of the Aluminium Stockholders Association ("ASA"). He gives some details about the credentials of the ASA (which includes working with government departments to safeguard the interests of the aluminium industry) and states that in his "professional opinion 'the metal centre' is a description which can be used by businesses in the metals industry."

10. Matthew Sammon

Mr Sammon is the applicant's trade mark attorney (for Marks & Clerk LLP). His witness statement serves to bring in, as exhibits, the results of internet searches which he states show generic use of the words "the metal centre". Not all of these results are shown expanded. Some of the exhibits are ambiguous: it is not always clear whether the words are being used as a trade mark or as a description of the business. For example, "Smiths Metal Centres is a stockholder and supplier of all forms of aluminium, brass, bronze, copper and steel" (exhibit MS1); "European Metal Centre Limited" (MS4); Plymouth Metal Centre (stockholders of stainless steel, aluminium, mild steel and plastics) (MS7); London Metal Centre (steel stockholders) (MS8); "The decision to use The Metal Centre as a primary source of supply was..." (MS9); "Amari Metals [the applicant]...currently has eight different business names operating in the UK, including The Metal Centre, Amari Metals International and Amari Copper Alloys..." (MS9); "Metal stockholder doubles hourly pick rates...1 Sep 2008...West Midlands stockholder The Metal Centre has doubled hourly pick rates..." (MS9); "£1million integrated sheet metal centre" (MS10); "British Aluminium...whose distribution and sales division trades as Baco Metal Centres..." (MS11); Corus Metal Centre network expands...Corus has opened new Metal Centres in Nottingham and Tewkesbury...Products include structural steel, tube,

plate, galvanised steel sheet and ancillary products.” (MS13); “The Scunthorpe metal centre in the Skippingdale Industrial Estate, which employs eight people, is part of the business [Corus steelworks] but is not facing any cuts, a spokesman said” (MS15).

11. Richard Chesworth

Mr Chesworth is a purchase manager of SES Multi Metal Stock Ltd, supplying stainless steel, mild steel, aluminium, copper and brass in all commercial forms to over 600 customers in the United Kingdom. Mr Chesworth gives prices for various types of metal in order to put the proprietor’s turnover figures into context (which I set out below). For example, in 2008 the average purchase price per tonne of mild steel hot rolled sheet 3mm thick was £581; stainless steel 2mm thick was £2,182 and aluminium 2mm thick was £2,058.

12. Ronald Hunter Blake

Mr Blake has been the proprietor’s managing director. His family started the business in 1938, when it was a blacksmiths, moving into engineering and stockholding. It was not called The Metal Centre in 1938; this name was given to one of three divisions of the family company in 1995 (trading started the following year). The other two divisions are called Fabrications Division, and Environmental Tanks Division. Mr Hunter states that The Metal Centre supplies metals such as stainless steels, alloys, mild steels and semi-precious steels in all forms, including angles, beams, channels, bars, sheets, stairs, guard rails, balconies, canopies, splash backs and cooker hoods. The Metal Centre was formed in 1995 to respond to demand for a readily accessible outlet for metal supplies and metalwork items and for metal which could be cut and shaped to order. Mr Blake states:

“The name THE METAL CENTRE was chosen because my colleagues and I were not aware of any other company using that name (or using the term “metal centre” in any other manner) and it was felt that this name would be memorable and would quickly be accepted by my Company’s existing customers and by potential new customers as denoting the new facility being offered by my company.”

13. Photographs of the business at this time show a building with a sign which says “Metal Centre”, although Mr Blake explains that the omission of “The” was a design layout decision. Various newspaper advertisements, radio advertisements, company flyers and website advertisement material show “The Metal Centre”. These all appear to be Scottish based (in particular, Edinburgh), as is the proprietor’s business itself. Exhibit RHB9 is a screenshot from the website which clearly shows the three divisions in three separate columns, headed by the titles “fabrication & STEELWORK, storage TANKS, the metal CENTRE”. An umbrella trade mark (Blake Group logo) sits above the three columns and heads all of the website pages. Part of a radio advertisement script (July 2007, Radio Forth) says “Come into the new and improved Metal Centre”.

14. Mr Blake states that the proprietor spends about £24,000 per annum on promotional activity. Unfortunately, neither advertising figures nor turnover figures between 2001 and 2006 are available due to the loss of records when a previous financial controller left the proprietor's employment. Turnover figures for 2000, 2007 and 2008 were £80,760, £246,226 and £378,332, respectively. Advertising via the internet appears to be the primary mode of promotion, with £12,000 spent annually on search engine optimisation and Google AdWords campaigns to point internet traffic towards The Metal Centre section (and another division). Mr Blake states that between January 2007 to 2011, 20,211 visits were made to the website from all parts of the United Kingdom. An accounting print at exhibit RHB13 shows sales to customers in Scotland, West Yorkshire, Staffordshire, Cheltenham, Durham, Egham (Surrey), Hull, Leicestershire, Merseyside, Northampton, Porthcawl (South Wales), Essex, Hertfordshire and Norfolk.

15. Mr Blake states that he is "not aware of any instance of use by any other traders of the phrase 'the metal centre' as a description of any characteristic or quality of any types of metal goods or of the location at which those goods may be acquired." He goes on to say that the applicant's use of the term indicates that the applicant itself regards The Metal Centre as a good trade mark.

16. Kenneth Giles

Mr Giles is a director of Mayfield Engineering Ltd. He states that he is aware of The Metal Centre as the industry recognised name of the steel supplying division of Blake Group. "This is the only company that I am aware of in the UK which uses the name The Metal Centre and I am not aware of anyone else using the term "Metal Centre" in relation to any steel supplying service."

17. Brice Woodall

Mr Woodall is the managing director of Oil Tank Supplies Limited. He states that his company "has used the services of The Metal Centre (a division of Blake Group) since 1997".

18. Ross Timothy Manaton

Mr Manaton is the proprietor's trade mark attorney (for Bromhead Johnson). His witness statement refers to marks already on the trade mark register, such as Early Learning Centre and Build Center, which he states were accepted for registration on a *prima facie* basis. This is of little assistance as, for instance, a combination such as The Garden Centre for retail of plants would be likely to meet resistance to acceptance as a trade mark. Each case turns on its own facts.

DECISION

19. This is not a relative grounds dispute. The applicant has filed, in addition to third party use, evidence of its own use of The Metal Centre. Its own use appears to be trade mark use (the position in relation to third parties is less clear). Use by other traders of a brand name is not a basis for an objection under section 3(1) of the Act¹. However, the applicant stands by its claims that THE METAL CENTRE is devoid of any distinctive character and is descriptive of the goods for which the proprietor's mark is registered.

Material dates

20. Section 72 of the Act states:

“In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

The date of application for the trade mark was 16 September 2006. Under section 47(1), the question of whether the mark was registered in breach of section 3(1)(b) and (c) falls to be decided as of this date. In the event that the applicant is successful to any extent, the proprietor relies upon the proviso to section 47(1) to show that the mark has acquired distinctiveness through the use which has been made of it, and so the position after 16 September is also relevant:

Where the trade mark was registered in breach of subsection 1(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

The grounds and the law

21. It is well established in law that the absolute grounds for refusing registration must be examined separately, although there is a degree of overlap between sections 3(1)(b), (c) and (d) of the Act: see *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] E.T.M.R. 57, the Court of Justice of the European Union (“CJEU”), paragraphs 67 to 70. That degree of overlap is reflected in the applicant's pleadings in which, effectively, descriptiveness (i.e. section 3(1)(c) considerations) is given as a reason for lack of distinctive character under section

¹ *Nude Brands Limited v Stella McCartney Limited and others* [2009] EWHC 2154 (Ch) Floyd J. “29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c).”

3(1)(b). In relation to section 3(1)(b), the CJEU said in *SAT.1 Satellitenfernsehen GMBH v OHIM*, case C–329/02 P [2005] E.T.M.R. 20:

“23 First, the essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see, in particular, Case 102/77 *Hoffmann-La Roche* [1978] ECR 1139, paragraph 7, and Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 30). Article 7(1)(b) of the regulation is thus intended to preclude registration of trade marks which are devoid of distinctive character which alone renders them capable of fulfilling that essential function.

24 Secondly, in order to determine whether a sign presents a characteristic such as to render it registrable as a trade mark, it is appropriate to take the viewpoint of the relevant public. Where the goods or services with which the registration application is concerned are intended for all consumers, the relevant public must be deemed to be composed of the average consumer, reasonably well-informed and reasonably observant and circumspect (see Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26, and Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 46).

25 Thirdly, it is important to observe that each of the grounds for refusal to register listed in Art.7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C–456/01 P and C–457/01 P *Henkel v OHIM* [2004] E.C.R. I-0000 , [45] and [46]).

....

27 Furthermore, in view of the extent of the protection afforded to a trade mark by the regulation, the public interest underlying Article 7(1)(b) of the regulation is, manifestly, indissociable from the essential function of a trade mark, as observed in paragraph 23 above.”

In relation to section 3(1)(c), the CJEU said in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*:

“54 As the Court has already held (*Windsurfing Chiemsee* , para.[25], *Linde*, para.[73], and *Libertel* , para.[52]), Art.3(1)(c) of the Directive pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

55 That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own

goods. Therefore, marks consisting exclusively of such signs or indications are not eligible for registration unless Art.3(3) of the Directive applies.

56 In those circumstances, the competent authority must, under Art.3(1)(c) of the Directive, determine whether a trade mark for which registration is sought currently represents, in the mind of the relevant class of persons, a description of the characteristics of the goods or services concerned or whether it is reasonable to assume that that might be the case in the future (see to that effect *Windsurfing Chiemsee* , para.[31]). If, at the end of that assessment, the competent authority reaches the conclusion that that is the case, it must refuse, on the basis of that provision, to register the mark.

57 It is irrelevant whether there are other, more usual, signs or indications for designating the same characteristics of the goods or services referred to in the application for registration than those of which the mark concerned consists. Although Art.3(1)(c) of the Directive provides that, if the ground for refusal set out there is to apply, the mark must consist exclusively of signs or indications which may serve to designate characteristics of the goods or services concerned, it does not require that those signs or indications should be the only way of designating such characteristics.

58 Similarly, whether the number of competitors who may have an interest in using the signs or indications of which the mark consists is large or small is not decisive. Any operator at present offering, as well as any operator who might in the future offer, goods or services which compete with those in respect of which registration is sought must be able freely to use the signs or indications which may serve to describe characteristics of its goods or services.”

The CJEU went on to say:

“71 Second, as has been observed in para.[34] of this judgment, whether a mark has distinctive character for the purposes of Art.3(1)(b) of the Directive must be assessed by reference to the goods or services described in the application for registration.

72 Further, under Art.13 of the Directive where grounds for refusal of registration ... exist in respect of only some of the goods or services for which that trade mark has been applied for ..., refusal of registration ... shall cover those goods or services only.

73 It follows that, where registration of a mark is sought in respect of various goods or services, the competent authority must check, in relation to each of the goods or services claimed, that none of the grounds for refusal listed in Art.3(1) of the Directive applies to the mark and may reach different conclusions depending upon the goods or services in question.

74 Therefore, it is not open to the competent authority to conclude that a mark is not devoid of any distinctive character in relation to certain goods or services purely on the ground that it is descriptive of the characteristics of other goods or services, even where registration is sought in respect of those goods or services as a whole.

75 As regards the second part of the question, whether a mark has distinctive character must be assessed, as has been observed in para.[34] of this judgment, first, by reference to the goods or services in respect of which registration of the mark has been sought, and, second, by reference to the way in which it is perceived by the relevant public, which consists of average consumers of those goods or services, reasonably well informed and reasonably observant and circumspect.

76 It follows that if, on completion of the examination of a trade mark application, the competent authority finds, in the light of all the relevant facts and circumstances, that the average consumer of certain goods or services, reasonably well informed and reasonably attentive, perceives a mark as devoid of any distinctive character with regard to those goods or services, it must refuse to register the mark for those goods or services pursuant to Art.3(1)(b) of the Directive.

77 However, it is of no relevance that the average consumer of other goods or services, reasonably well informed and reasonably observant, perceives the same mark as descriptive of the characteristics of those other goods or services for the purposes of Art.3(1)(c) of the Directive.

78 It does not follow from either Art.3 of the Directive or from any other provisions thereof that the fact that a mark is descriptive of certain goods or services is a ground for refusing to register that mark for other goods or services. As is stated in the seventh recital in the preamble to the Directive, grounds for refusal concerning the trade mark itself are listed exhaustively.

79 The answer to the sixth question must therefore be that Art.3(1) of the Directive must be interpreted as meaning that a mark which is descriptive of the characteristics of certain goods or services but not of those of other goods or services for the purposes of Art.3(1)(c) of the Directive cannot be regarded as necessarily having distinctive character in relation to those other goods or services for the purposes of subparagraph (b) of the provision. It is of no relevance that a mark is descriptive of the characteristics of certain goods or services under Art.3(1)(c) of the Directive when it comes to assessing whether the same mark has distinctive character in relation to other goods or services for the purposes of Art.3(1)(b) of the Directive.”

This section of the judgment shows that, as per Article 13 of the Trade Marks Directive², my assessment of the mark must be made in relation to each of the goods. I will approach this by grouping the goods into categories³. The judgment also shows that a mark which falls foul of section 3(1)(c) for some goods is not precluded from being devoid of any distinctive character for other goods for which registration is also sought but which are not objectionable under section 3(1)(c).

² Directive 2008/95/EC of 22 October 2008.

³CJEU *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau*, C-239/05.

22. In *Flying Scotsman* O-313-11, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, said:

“19. Since there is no obligation to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness when assessing the registerability of a sign under Section 3(1)(b), see Case C-104/00 P Deutsche Krankenversicherung AG v OHIM (COMPANYLINE) [2002] ECR I-7561 at paragraph [20], it is not necessary to dwell on the question of how far Section 3(1)(b) may go in preventing registration beyond the scope of Section 3(1)(c). It is sufficient to observe that a sign may be:

- (1) distinctive for the purposes of Section 3(1)(b), with the result that it cannot be regarded as descriptive for the purposes of Section 3(1)(c) and must be unobjectionable on both bases; or
- (2) neither distinctive for the purposes of Section 3(1)(b), nor descriptive for the purposes of Section 3(1)(c), with the result that it must be objectionable on the former but not the latter basis; or
- (3) descriptive for the purposes of Section 3(1)(c), with the result that it cannot be regarded as distinctive for the purposes of Section 3(1)(b) and must be objectionable on both bases.

These considerations point to the overall importance of establishing that a sign is free of objection under Section 3(1)(b).”

Mr Hobbs dealt with section 3(1)(b) of the Act first. Having found the mark under consideration to be free from objection under section 3(1)(b) of the Act, this excluded the possibility of refusal under section 3(1)(c) (paragraph 29 of his decision).

23. Whether a trade mark performs its essential function of enabling the consumer or end-user to distinguish the product or service from others which have another commercial origin will be a matter of first impression because the relevant average consumer does not analyse trade marks beyond what is usual in the ordinary course of purchasing the relevant goods. In this case, the proprietor’s goods are *Steel; steel sheets, plates, sections and tubes; mild steel; aluminium; brass; purpose made metal work; stainless steel splashbacks; metals for welding; metal nuts and bolts; small items of metal hardware*. The relevant public for some of these goods is not the general public. A specialist consumer makes use of steel sheets and plates. Other goods listed here may be bought more by the general public, such as splashbacks, nuts and bolts and small items of metal hardware. The specialist consumer will display an above average level of attention and the general public a reasonable or above average level of attention, having regard to the technical requirements for the task that requires the purchase of the goods.

24. In a commercial context, THE METAL CENTRE refers directly to a place where metal is sold. The registration is not for retail of metal which falls in class 35: in designating the type of establishment where the goods are for sale, the mark does not designate a characteristic of the goods themselves and so does not fall foul of section 3(1)(c) of the Act. I reject the applicant’s claim that the mark designates the

geographical origin of the goods in describing the location from where the goods may be bought; this is an unnatural definition of the adjective derived from 'geography'. A geographical location is a place name, not a commercial name.

25. However, escaping objection under section 3(1)(c) does not necessarily render the mark free from objection under section 3(1)(b). To hold that a sign must be regarded as distinctive if not wholly descriptive of the goods would be contrary to the CJEU's findings in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (see paragraph 79 of that judgment, quoted above) and many other cases which have come before it, including those relating to colours and the appearance of products and, in relation to words, marks which function purely as promotional statements. The question as to whether a mark is distinctive must be answered from the perspective of the relevant average consumer. As I have identified already, there are two types of consumer to consider in this case, arising from what I consider to be two distinct categories of goods in the specification. The categories are:

(i) *Steel; steel sheets, plates, sections and tubes; mild steel; aluminium; brass; purpose made metal work; metals for welding;*

This is the specialist consumer category.

(ii) *stainless steel splashbacks; metal nuts and bolts; small items of metal hardware.*

This is the general public consumer category.

Although *purpose made metal work* may include goods for the general public, it is a general term which includes all types of metal items, including those which may still be, for example, pipes, sheets, plates, sections and tubes, albeit made for a specific purpose.

26. Accordingly, the presumed expectations of the relevant average consumer may differ in relation to the categories of goods concerned. I think it clear that, in a commercial context, the meaning which would be immediately apparent would be a centre for metal, rather than a centre made of metal. A centre for metal identifies a particular type of commercial establishment: one which specialises in metal. It appears from the evidence that this term is used widely in this way. Some of the use is use as a sign without any other matter on the outside of warehouses, as can be seen from the applicant's own evidence (and, further, its invoices which refer to it as a business name of Amari Metals Ltd); in other cases it is preceded by a geographical location such as Plymouth or London; and in others it is accompanied by matter which could be said to be the trade name of the undertaking responsible for the metal centre, such as Baco Metal Centres, Corus Metal Centre network and Smiths Metal Centres. It is not altogether clear from the evidence whether some of the use is descriptive or meant to be a trade mark, albeit one commonly used in the trade (e.g. the reference to Smiths Metal Centres reads "Smiths Metal Centres is a stockholder and supplier of all forms of aluminium, brass, bronze, copper and steel").

27. I note that the proprietor's own website lists the names of its three business divisions. Two of these are purely descriptive (Fabrications Division, and Environmental Tanks Division) and although this fact is not determinative, it raises

doubt as to whether the name of the third division, The Metal Centre, is not also descriptive. As I have said, THE METAL CENTRE, is not descriptive of metal goods per se, but it appears from the evidence to be a description of an establishment specialising in (and retailing) metal. A centre is a place where a particular activity is concentrated or carried on. It is relevant that the words may describe such an establishment, it is not necessary that they already do so. It is also not relevant that there are other ways of describing such an establishment, such as 'stockholder'⁴. Whether or not other traders use it, THE METAL CENTRE is apt as a description of a business specialising in metal. This would be the impression upon the relevant average consumer for the category (i) goods i.e. those seeking metal, whether steel, aluminium, bronze, iron or copper. Indeed the proprietor states that the name was chosen as it "would quickly be accepted by my Company's existing customers and by potential new customers as denoting the new facility being offered by my company". There is no explanation as to why the name would quickly be accepted as "denoting the new facility"; it could be that a descriptive term was chosen as a fast-track way of informing customers as to the product or service provided. A catchy, invented mark, could also quickly be accepted by customers, but this obviously is not the case for THE METAL CENTRE. Quick acceptance by the proprietor's customers as a name denoting the proprietor's facility accords with my own view that the relevant average consumer for metal (i.e. category (i) goods) would quickly/immediately understand that THE METAL CENTRE is a retail establishment specialising in metal. The definite article will not cause that immediate perception to be altered.

28. Having established that the relevant average consumer in category (i) would immediately understand the nature of the retail service provided under the sign THE METAL CENTRE, the enquiry focus then shifts to whether the name of an establishment specialising in metal can be distinctive for the goods which are sold through such an establishment and, specifically, the goods for which the proprietor's goods are registered. Each case turns on its own facts and I bear in mind that I am considering two categories of goods and two types of average consumer. In a specialist area, the relevant average consumer (category (i)) is likely to perceive a close or integral commercial relationship between metal (category (i)) and THE METAL CENTRE, i.e. a retailer who specialises in metal. Putting it another way, the consumer will not pause to consider that there is not a close relationship between the mark for the business and the goods which are sold by that business. There will be an immediate assumption in relation to metal (category (i)) sold by 'the metal centre' that THE METAL CENTRE is a reference to the type of retail establishment

⁴ *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*. "101 Furthermore, for the reason given in para.[57] of this judgment, it is irrelevant for the purposes of determining whether the ground for refusal set out in Art.3(1)(c) of the Directive applies to such a mark whether or not there are synonyms permitting the same characteristics of the goods or services to be designated.

102 It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Art.3(1)(c) of the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially."

which sells metal and not a mark that sets apart that retailer's metal from those of other undertakings. In relation to metal (category (i) goods), THE METAL CENTRE is *prima facie* devoid of any distinctive character.

29. I do not consider the position to be analogous in relation to the category (ii) goods: *stainless steel splashbacks; metal nuts and bolts; small items of metal hardware*. THE METAL CENTRE describes a type of retail establishment which sells metal, but it does not describe a type of retail establishment which sells splashbacks, nuts and bolts or small items of metal hardware. These goods could be classified as ironmongery, sold by ironmongers or do-it-yourself retailers. There is not the level of close commercial context that I have previously found for the other goods in category (i). The general public would not perceive a close connection between THE METAL CENTRE, which is a general reference to metal, and specific, finished metal goods which have names of their own. There is no objection to these goods under section 3(1)(b).

30. The result of the *prima facie* analysis under section 3(1)(b) means that there is no need to look at section 3(1)(c) but, for the avoidance of doubt, and as shortly stated in paragraph 24, the 3(1)(c) ground fails. In the event that I found that any of the goods are objectionable *prima facie*, the registered proprietor relies upon the proviso to section 47(1). As I have found there to be no objection against the category (ii) goods, I need only consider the position in relation to:

Steel; steel sheets, plates, sections and tubes; mild steel; aluminium; brass; purpose made metal work; metals for welding;

31. The CJEU, in *Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber*, Joined Cases C-108/97 and C-109/97, held:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

32. A fundamental point that arises from the proprietor's evidence is that there is no evidence of the mark on the goods. There is evidence of the mark in relation to retail of metal and metal goods, but this is a service. As Mr Manaton said at the hearing, for whatever reason the proprietor chose to register the mark in class 6, not in class

35; however, his position was that the use shows simultaneous use on both goods and services because the undertaking providing the service also provides the goods. This relationship between retailing and goods is case specific and fact dependent. The public perception of a general retailer (such as Argos) who stocks a wide range of third party branded products may not be the same as the perception of a specialist public in relation to a specialist service and the goods provided by that service. Mr Blake refers to his establishment as a 'facility'. As I have said in relation to the prima facie section 3(1)(b) case, there is an objection under that section to THE METAL CENTRE for metal and the other goods in category (i) because the public will perceive a close or integral commercial relationship between such goods and a retailer who specialises in them.

33. Leaving that aside for the moment, there are other issues in assessing the proprietor's claim to distinctiveness acquired through use. *Windsurfing* refers to statements from the trade. The proprietor is critical of the applicant's 'trade' evidence. The proprietor's own such evidence does not escape analogous criticism. Mr Woodall is a customer of "The Metal Centre (a division of Blake Group)". This does not tell me much about the perception of the trade. Still less is the statement made by Mr Giles of Mayfield Engineering Ltd. He states that "This is the only company that I am aware of in the UK which uses the name The Metal Centre and I am not aware of anyone else using the term "Metal Centre" in relation to any steel supplying service". This is surprising when one considers that in this specialist industry the applicant has been trading under The Metal Centre since 2000, holding 10,000 tons of stock at any one time, with a turnover of £75,156,000 in 2000 rising to £172,998,000 in 2008. As Mr Manaton said at the hearing, the applicant has been trading using The Metal Centre as a trade mark "apparently quite successfully". This is putting it mildly considering the contextual pricing evidence which is given for the applicant by Mr Chesworth. Viewed against these facts is the proprietor's turnover figure, also in 2008, of £378,332. The proprietor does not state what share of the market it has. There is a large difference between the turnover figures of both parties which suggests that the proprietor does not enjoy a large share of the market. Added to that is the fact that a substantial part of the evidence relates to trade within Scotland (and this appears to focus upon the Edinburgh area). Although there is evidence of invoices from other areas of the United Kingdom and an internet presence and so the Scottish trading pattern is not determinative per se, it is a factor to bear in mind in putting together a picture emerging from the evidence⁵. The individual sale amounts to the various customers in other parts of the UK are not substantial.

34. I also note the screenshot from the proprietor's website which clearly shows the three divisions in three separate columns, headed by the titles "fabrication & STEELWORK, storage TANKS, the metal CENTRE", and the radio advertisement script (July 2007, Radio Forth) which says "Come into the new and improved Metal Centre" (i.e. there is no definite article juxtaposed with the words 'metal centre'). The presentation of the website does nothing to indicate that the public would attribute trade mark significance to divisional name "the metal CENTRE" when the other two divisional names, fabrication & STEELWORK and storage TANKS are so clearly descriptive. Taken as a whole, the evidence does not persuade me that the relevant

⁵ See the CJEU judgment in Case C-108/05 *Bovemij Verzekeringen NV v Benelux Merkenbureau*.

public has been educated to see the words as indicating trade origin rather than an informative statement; in my view, given the aptness for the words to describe the undertaking which provides the goods, the proprietor has not demonstrated that its use of THE METAL CENTRE has displaced its ordinary significance and that the scale and geographical spread of its use can assist its position. Even if I were to consider the evidence as use relating to goods as well as a service, it is not possible to find, on the evidence provided, that a significant proportion of the relevant public identifies the goods as originating from a particular undertaking because of the trade mark. The proprietor cannot rely upon the proviso to section 47(1) of the Act.

Outcome

35. The application for a declaration of invalidity fails in relation to *stainless steel splashbacks; metal nuts and bolts; small items of metal hardware*. The application succeeds in respect of *Steel; steel sheets, plates, sections and tubes; mild steel; aluminium; brass; purpose made metal work; metals for welding*. Accordingly, under section 47(6) the registration remains for *stainless steel splashbacks; metal nuts and bolts; small items of metal hardware* but is deemed never to have been made in respect of *Steel; steel sheets, plates, sections and tubes; mild steel; aluminium; brass; purpose made metal work; metals for welding*.

Costs

36. Each side has been successful in relation to approximately half the coverage of the specification and so I direct each side to bear its own costs.

Dated this 13th day of December 2011

**Judi Pike
For the Registrar,
the Comptroller-General**