

O-351-04

TRADE MARKS ACT 1994
and
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

IN THE MATTER OF DESIGNATION NO M781333
IN THE NAME OF HORNITEX-WERKE GEBR KÜNNEMEYER GMBH & CO. KG

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 70942 IN THE NAME OF
WEYERHEUSER COMPANY

**TRADE MARKS ACT 1994 and
The Trade Marks (International Registration) Order 1996**

**IN THE MATTER OF designation No M781333
in the name of Hornitex-Werke Gebr Künnemeyer GmbH & Co KG**

And

**IN THE MATTER OF opposition thereto under No 70942
in the name of Weyerheuser Company**

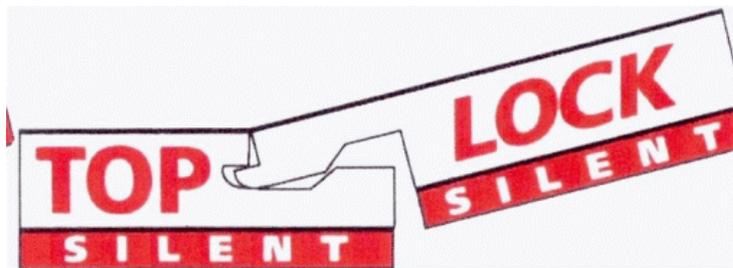
Background

1. On 25 April 2002, Hornitex-Werke Gebr Künnemeyer GmbH & Co. KG registered a trade mark under the Madrid Union, designating the United Kingdom as a country to which protection was sought to be extended.

2. The trade mark is protected in Class 19 in respect of the following goods:

Wood-based panels including such with decorative faced or vanished surfaces and with wood veneers, also as parts ready for assembly, laminates in the form of sheets.

3. The mark for which registration is sought is as follows:



The applicant claims the colours red, white and black as an element of the mark.

4. On 25 October 2002, Weyerheuser Company filed notice of opposition to this designation. The grounds of opposition are in summary:

- | | |
|---------------------------------|---|
| 1 Under Section 5(2)(b) | because the trade mark is similar and the goods for which registration is sought are identical or similar to the mark and goods owned by the opponents. |
| 2. Under Section 5(4)(a) | by virtue of the law of passing off. |

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

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

7. Both sides filed evidence in these proceedings. Neither side took up the offer of an oral hearing although the attorneys acting for the opponents filed written submissions in lieu of being heard. After a careful consideration of the evidence and submissions I hereby give my decision.

Opponents= evidence

8. This consists of a Witness Statement dated 16 September 2003, from James Sweet, UK Regional Sales Manager of Trus Joist sprl (Trus Joist Europe), a position he has held since 1 October 2001, having been with the company since 1998.

9. Mr Sweet says that Trus Joist Europe is the wholly owned operating division of the opponents with responsibility for marketing and selling amongst other things, products that are associated with the SILENT FLOOR brand in the UK. Exhibit JS1 consists of a resumé of the history of Trus Joist, the only reference to SILENT FLOOR being related to the acquisition of the company by the opponents in January 2000.

10. Mr Sweet describes the applications of timber in building, stating that the opponents= engineered timber is essentially made from strands, strips or veneers of machined timber which is glued together under pressure. Exhibits JS2 and JS3 consist of product literature for the opponents= products, including their SILENT FLOOR I beam system. The exhibits can be dated as originating from at least as early as 1999 and 1995, respectively.

11. Mr Sweet gives the turnover for his company= SILENT FLOOR system since its launch in the UK in 1997, which ranges from , 1,755,000 in 1997, rising year on year to , 17,131,000 in 2001, the last year prior to the relevant date. He says that joists, rim boards, beams and columns have been sold under the SILENT FLOOR brand, exhibit JS4 showing the use of the name on floor joists. Mr Sweet states that SILENT FLOOR goods have been sold throughout the UK.

12. Mr Sweet says that SILENT FLOOR goods have been extensively promoted throughout the UK, primarily in trade publications and at exhibitions giving examples of both, and as a sponsor of the Building Awards between 1998 and 2002. Exhibit JS5 consists of samples of promotional materials, including, an advertisement that shows SILENT FLOOR beams supporting a laminate floor, the same and similar advertisements appearing in trade publications, the earliest dating from July 2000. The earliest advertisement/feature relating to SILENT FLOOR appeared in RIBA Journal in January 1997. The exhibit shows the opponents= SILENT FLOOR to have received widespread exposure in the trade. Mr Sweet mentions that his company has advertised via a radio station and mainstream magazines to potential home buyers. He details the figures for advertising spend, although does not say that this is solely in respect of SILENT FLOOR. Exhibit JS6 consists of a brochure detailing the SILENT FLOOR product. It contains a section with a **Homebuyer= Guarantee** referring to

the products **A**used in your home@so is clearly aimed at the house buyer rather than the builder, but there is no information regarding the number issued. The brochure contains a copyright date of 1998.

13. Mr Sweet says that the main customers for his company=s products include the largest home build companies, some of which he lists. He goes on to say that the products are also sold through builder=s merchants, exhibit JS7 being a list of all dealers stocking SILENT FLOOR. He refers to the website of Travis Perkins, one of the merchants listed in exhibit JS7, highlighting that it is possible to view the opponents= SILENT FLOOR under the Timber section, and laminate flooring materials in the Prepared Softwood section. Mr Sweet considers this to show that the respective goods share the same channels of trade.

Applicants= evidence

14. This consists of a Statutory Declaration dated 3 March 2004, and comes from Helen Jane Forsyth, a partner in the firm of Keith W Nash & Co, the applicants= representatives in these proceedings.

15. Ms Forsyth refers to exhibit HJF1, which consists of a brochure for the applicants= laminate flooring products. The brochure is undated but Ms Forsyth confirms that the applicants have offered these products for sale in the UK since 2002. Exhibit HJF2 consists of product information and installation instructions for the laminate flooring. Ms Forsyth highlights that the applicants= goods have a decorative finish and do not provide the main structural strength of the floor which is provided by the floor joists to which the flooring is attached. Ms Forsyth refers to the differences in the nature of the respective goods, and the channels of trade.

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

Decision

17. Turning first to the objection based on Section 5(2)(b) of the Act. That section reads as follows:

A5.-(2) A trade mark shall not be registered if becauseB

- (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.@

18. An earlier trade mark is defined in Section 6 of the Act as follows:

A6.- (1) In this Act an earlier trade mark means

- (b) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

19. In a consideration of a likelihood of confusion or deception I must take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*;
- (g) 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*;
- (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*;

- (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.*

20. The opponents rely on two earlier marks; Community Trade Mark No. 528620 for the trade mark SILENT FLOOR, and UK trade mark 1451668 for the trade mark THE SILENT FLOOR. Both are in respect of the following specification of goods in Class 19:

A Structural support joists for use in or in the construction of floors.@

21. Turning first to the question of the similarity or otherwise of the respective marks. The case law states that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, but qualifies this by saying that the distinctiveness and dominance of individual components should have some bearing.

22. The figurative element of the applicants' mark is no more than a representation of the goods depicting how the individual planks connect together. SILENT is an ordinary English word the meaning of which will be readily understood by the consumer of the goods in question. Whilst I do not consider it to be a word apt to describe a characteristic of flooring per se, I believe that the consumer is likely to regard it as such. TOP LOCK is a combination of two ordinary English words that allude to a characteristic of the goods, a fact emphasised by the figurative element which depicts the two cross-sections being locked into position by use of a groove system on the top part of the leading panel. Whilst the descriptive relevance of these words is none too covert, the manner in which they are represented and their ungrammatical use ensures that they will speak to the consumer as a badge of origin, and on my analysis, if there is a distinctive and dominant element of the applicants' mark, it is these words.

23. The distinctive or dominant component of the opponents' earlier marks must be the word SILENT. I have stated in my analysis of the applicants' mark that from the academic question of its distinctiveness, I do not consider the word SILENT to be apt to describe a characteristic of floor joists per se. However, given its obvious meaning and the fact that in their product literature the opponents make frequent reference to the fact that their SILENT FLOOR joists do not distort and allow floors to squeak or become noisy this is how I believe the consumer will view the word.

24. The mark applied for consists of the words TOP LOCK contained within a figurative element that I recognise to be a cross-section of two interlocking laminate flooring sheets, with the words SILENT in the lower layer of each of the profiles. With the opponents' earlier marks being plain words, and the applicant's mark consisting of a device and words, it cannot be a surprise that on first impression I find the respective marks are visually very different.

25. In my analysis of the elements of the respective marks I expressed my view that the words TOP LOCK are the dominant distinctive element of the applicants' mark, and it is by these words that I consider the consumer will refer to the mark. Consequently, in oral use the marks will be completely distinct. I see no reason why the consumer would ignore the more

prominent words and refer to the applicants' mark by the word SILENT, that is unless they do so in conjunction with TOP LOCK. Insofar as both marks refer to SILENT they will send out the same conceptual idea.

26. On the question of whether the respective goods are similar I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 and in the judgement of the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C- 39/97 case. With these cases in mind I propose to consider the question of similarity by a consideration of the following factors:

- (a) The nature of the goods or services;
- (b) The end-users of the goods or services;
- (c) The way in which the goods or services are used;
- (d) Whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and the trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) In determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account.

27. Both specifications cover wood products for use in building, so to that extent their nature is notionally the same although laminate boards and flooring are more finishing/decorative products whereas the opponents' product is structural. Whilst the evidence shows the opponents' beams to be available to the building industry, and through builders' merchants, in reality I would say that it is primarily a product that would be sought and used by those engaged in the building trade. There is evidence that the builders merchant Travis Perkins is a stockist of the opponents' product also sells other wood products such as laminate flooring. Given that both are building materials I do not see this as surprising, and in my experience is typical of the trade. But as highlighted by the evidence, these goods are classified in distinct product areas. Although used in proximity to structural beams, I would not consider laminate panels/flooring and structural floor joists to be either complementary or competitive. The applicants' specification also contains the description 'A wood-based panels' the exact scope of which is uncertain and may well include goods much closer in nature and purpose to structural beams, and conceivably goods that would be considered at least complementary.

28. In my mind there is no doubt that the opponents have established a strong reputation in the name SILENT FLOOR in relation to their structural I beam joists, but that appears to be the extent of it. Although their promotional materials show the joists being used in conjunction

with flooring, this is purely part of the means of illustrating their joists; there is never any mention or suggestion that the company manufactures or supplies both.

29. On my assessment I would say that other than perhaps the wood based panels the goods covered by the applicants' specification are not similar to those of the opponents' earlier marks. As I have said, I am not entirely clear as to exactly what the description wood based panels would cover and it seems to be sufficiently broad to encompass goods that would be considered to be similar to the opponents' floor joists.

30. Given the technical nature of structural support beams for floors, it seems most likely that any potential purchaser, professional or DIYer, will exercise a good degree of care in the selection, paying attention to details such as length, specification, etc. The same must be said of the laminated products in the applicants' specification, which will be selected on colour, suitability etc.

31. If the opponents have a case, it exists in my view in the argument that there may be confusion through imperfect recollection. That argument relies upon the proposition that the addition of the words TOP LOCK in the applicants' mark will be insufficient to indicate a different trade origin to the public, but also that the word SILENT will be picked out of the applicants' mark, and through poor recollection be confused with the opponents' marks. In the *Sabel- Puma* case it was said 'The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.' which, if applied to this case would support the view that there is little likelihood of confusion.

32. In *Office Cleaning Services Ltd* [1946] RPC 39 it was held that where a trader adopts a trading name containing words in common use, some risk of confusion may be inevitable, but that risk must be run unless the first trader is allowed an unfair monopoly, and in such cases the Court will accept comparatively small differences as sufficient to avert confusion. This seems an eminently sensible approach. Whilst there is no evidence that the word SILENT is in common use in the trade, it is a word in common use in the English language, and in this case the differences in the respective marks are far from small.

33. Taking all of the above factors into account and adopting the global view advocated, I find that whilst there are some similarities these are more than outweighed by the differences. I do not consider that use by the applicants of their mark in respect of the goods for which they seek registration will cause the public to wrongly believe that their goods come from the opponents or an economically linked undertaking, and consequently, there is no likelihood of confusion. The ground under Section 5(2)(b) fails.

34. Turning to the ground under Section 5(4)(a). That section reads as follows:

5.(4) 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

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.

35. Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* case [1998] RPC 455 set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

36. To the above I add the comments of Pumfrey J in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* case, [2002] RPC 19, in which he said:

There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirement of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.

37. I have accepted that the opponents have discharged the onus of establishing that they have the requisite reputation in respect of SILENT FLOOR in respect of their I beam joists, and I believe the same must be said in respect of goodwill. However, as I have stated in my consideration above I do not consider that the respective marks are similar, and that being the case I do not see that I can find that use of the mark applied for in respect of the goods for which registration is sought would be a misrepresentation likely to lead the public to believe that their goods are those of the opponents, or are in some way connected. I do not consider

that the opponents are likely to suffer damage, and the ground under Section 5(4)(a) is dismissed accordingly.

38. The opposition having failed on all grounds I order the opponents to pay the applicants the sum of , 1,750 as a contribution towards their costs. This sum 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 30th day of November 2004

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