

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2007601
BY MAXAM SECURITY SERVICES LIMITED FOR
REGISTRATION OF A MARK IN CLASSES 6, 19 AND 37**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 46157 BY REGIONAL BUILDING MAINTENANCE LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2007601
by Maxam Security Services Ltd for registration
of a mark in Classes 6, 19 and 37**

5 **and**

**IN THE MATTER OF Opposition thereto
under No 46157 by Regional Building
Maintenance Ltd**

10

DECISION

15 On 3 November 1994 Maxam Security Services Limited, of Bellingham, London SE6 applied to register the mark MAXAM in Classes 6, 19 and 37 in respect of:-

20 **Class 6:** Shutters, doors, door frames, windows, window frames; door and window fittings; locks, bolts, all predominantly of metal; parts and fittings for all the aforesaid goods.

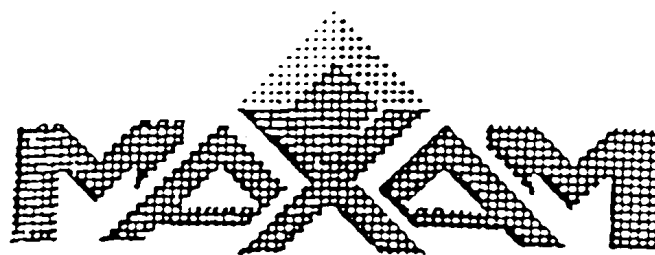
Class 19: Shutters, doors, door frames, windows, window frames; none of the above being predominantly of metal; parts and fittings for all the aforesaid goods.

25 **Class 37:** Rental and leasing of security apparatus.

The mark is in a stylised form, as shown below:

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On 24 December 1996 Regional Building Maintenance, of Edinburgh, filed notice of opposition to this application. The grounds of opposition are, in summary:-

- (i) under Section 3(6), in that the application in suit was made in bad faith;
- (ii) under Section 5(2), by reason of the conflict with the opponents' earlier trade mark, No 1240869;
- (iii) under Section 5(3), by reason of the opponents' use and registration of mark No 1240869;
- (iv) under Section 5(4), by reason of the opponents' earlier right in the mark registered as No 1240869.

The opponents ask that the application be refused in the exercise of the Registrar's judgement "and/or discretion" (The request for refusal in the exercise of the Registrar's discretion, of course, must necessarily fail since under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse a mark which is not barred from registration by one or other of the substantive provisions of the Act).

The applicants filed a counterstatement denying these various grounds.

The opponents subsequently filed evidence in support of their opposition. The applicants however, did not file any evidence, and did not ask to be heard. The opponents have indicated that they are content to seek the Registrar's decision on the basis of the papers filed in these proceedings, without recourse to a hearing. Acting on the Registrar's behalf and after a careful study of the papers, I now give this decision.

Opponents' evidence

The opponents' evidence consists of a Statutory Declaration by Harry Edwards, of Edinburgh EH4. Mr Edwards states that he is the Senior Partner of Maxam (his company), with which he has been associated since 1971. I should say at this point that Maxam's relationship with the opponents, Regional Building Maintenance, is not explained anywhere in the papers filed in these proceedings, but in view of the fact that Maxam is the present registered proprietor of registration No 1240869, and since the original applicant for that registration back in 1985, was Regional Building Maintenance Limited, I think it is safe for me to proceed on the basis that the opponents have changed their name since the commencement of these proceedings. The statement of grounds of opposition clearly states that the opponents (Regional Building Maintenance) are the proprietors of registration No 1240869, whereas Mr Edwards states that his company are the proprietors. The explanation for that change is not given, but for the purposes of this decision I will assume that it is not material to the matter in hand.

Mr Edwards goes on to state that his company's mark MAXAM was registered on 30 April 1985 and has been used continuously throughout the United Kingdom in respect of the goods

covered by the registration and associated goods. Mr Edwards exhibits catalogues and brochures detailing the range of goods sold under his company's mark.

5 Over the years says Mr Edwards, his company has also used a number of other trade marks prefixed or suffixed by the word MAX such as, MAXCRETE, TARMAX, PIPEMAX, TIMBERMAX and CUPROMAX. These marks are always used on goods or printed material bearing his company's mark, he says. Mr Edwards exhibits a number of leaflets bearing both the marks cited above and his company's mark.

10 Mr Edwards gives annual values of goods sold by his company in the United Kingdom under the mark for the period 1986 to 30 June 1996 (inclusive).

	Year	£
	1986	100,000.00
15	1987	110,000.00
	1988	130,000.00
	1989	150,000.00
	1990	160,000.00
	1991	160,000.00
20	1992	200,000.00
	1993	300,000.00
	1994	400,000.00
	1995	541,000.00
	June 1996	252,000.00

25 Goods bearing his company's trade mark are sold throughout the whole of the United Kingdom, says Mr Edwards, including the following larger cities and towns:-

	London	Southampton	Birmingham	Liverpool
30	Newcastle	Glasgow	Bristol	Cardiff
	Sheffield	Manchester	Blackpool	Edinburgh
	Brighton	Swansea	Nottingham	Leeds
	Belfast	Aberdeen	Londonderry	Dundee

35 Mr Edwards exhibits a list of some of his company's customers throughout the United Kingdom. These include "over 400 hospitals, 3000 educational establishments and the entire British Rail Network". Also listed are some 110 local authorities.

40 The approximate annual amounts which have been spent on advertising and publicising his company's mark for the years 1986 to June 1996 inclusive are given by Mr Edwards, as follows:-

	Year	£
	1986	3,500.00
	1987	3,500.00
5	1988	10,000.00
	1989	25,000.00
	1990	15,000.00
	1991	14,000.00
	1992	16,000.00
10	1993	15,000.00
	1994	10,000.00
	1995	30,000.00
	June 1996	10,000.00

15 Mr Edwards goes on to state that his company has received a number of letters from organisations which have purchased goods bearing his company's mark over the years. He exhibits those letters and says the organisations have all indicated that they associate the name MAXAM with his company or his company's goods, and that confusion would occur if they were approached by another company using the trade mark MAXAM.

20 I must record however, at this point, that the letters all clearly indicate that they were to some extent solicited, and that solicitation took place in circumstances which are not described or explained. I therefore disregard that evidence for the purposes of this decision.

25 Mr Edwards goes on to state that his company's goods and those of the applicants are used within the same sector of the market. Advertisements for his company's goods and those of companies producing goods identical to the applicants sometimes appear in the same publications, he says, and he exhibits a "Security 95" booklet published by Oldham Housing Services which contains an advertisement from his company and also one from a company
30 producing goods identical to those of the applicant's company. Mr Edwards exhibits a print of the applicant's brochure and he notes that on page 7, fig 23, the trade mark MAXAM is being used on goods which are in his opinion identical with or of a nature similar to the goods sold under his company's mark. Finally, Mr Edwards states his belief that use of the trade
35 mark MAXAM by the applicants would lead to confusion and that such confusion would seriously disadvantage his company.

The applicants did not file any evidence in response to this and I therefore turn to consider the grounds of opposition.

40 As stated earlier, these are found in Sections 3(6), 5(2), 5(3) and 5(4) of the Act. However, the opponents did not file any evidence in support of their opposition under Section 3(6); nor did they specify the basis of their allegation. Accordingly, I find formally that they do not succeed under that head.

I therefore go on to consider the matter under Section 5(2), which reads as follows:-

5.-(2) A trade mark shall not be registered if because -

- 5 (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- 10 (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.

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The applicants' mark is a stylised form of the word MAXAM, whereas the opponents' registered mark No 1240869 is MAXAM in plain block capitals. Nevertheless, I consider that for all practical purposes, including the purposes of this decision, the marks are identical. The relevant provision for me to apply, therefore, is 5(2)(a), above. The first thing I need to

20 consider is the similarity of the goods or services.

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At this point it is convenient to mention that an opposition (Opposition 45251 to Application No 2007606) very closely related to these proceedings and involving the same parties and the same marks, and with specifications of goods and services containing some items in common,

25 was decided by Mr D C Morgan of the Registry, in favour of the opponents. Mr Morgan issued his decision on 13 November 1997.

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The differences between the facts and the issues in those proceedings and in these proceedings are very small. They are:-

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- (i) in Opposition 45251 the applicants' mark was simply the word MAXAM in plain typescript; in this case the applicants' mark is the word MAXAM in the more stylised and elaborate form shown on page 2 of this decision;
- 35 (ii) the specification in Class 6 included additionally: "security screens; closure devices for building apertures; door and window fastenings, door and window closure device fastening and fittings and security fixings";
- 40 (iii) the specification in Class 19 included additionally; "security screens; closure devices for building apertures; door and window fastenings, door and window closure device fastenings and fittings, security fixings";
- 45 (iv) the specification of services in Class 37 included additionally; "installation, maintenance, repair and removal of security systems, including security screens, shutters and doors.

With these differences in mind I have considered Mr Morgan's findings in Opposition No 45251. For his analysis under Section 5(2), Mr Morgan employed the authoritative test for similar goods and services under the 1994 Act, which was laid down by Jacob J in *British Sugar PLC v James Robertson & Sons Ltd* (1996) RPC 281 at page 296.

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The matters to be considered are:-

- (a) the respective uses of the respective goods or services;
- 10 (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the
15 market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- 20 (f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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The applicants' mark is proposed for registration in respect of the specifications of goods and services set out on page 2 of this decision. The opponents mark is registered in respect of "adhesive-backed films of plastic material for window repairs and the like purposes".

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Mr Morgan's conclusion that the application he had before him did fall foul of Section 5(2) was principally based on his conclusions under (a) and (b) of the Treat test, which he expressed as follows:-

35 "a) The respective uses of many of the goods are the same or similar. The opponents goods, whilst mainly for glazing repairs, are also used for safety, security, privacy etc purposes. Some of the applicants metal or non-metal goods eg screens, shutters, closure devices for building apertures etc are intended for window protection.

40 b) The users of some of these goods are likely to be the same. Users looking at the possible options to improve the security of glass apertures could well encounter goods offered by both the opponents and applicants in the marketplace. Also, I assume that the services would form part of the total package provided by the applicants."

45 Of the goods in the applicants' Class 6 and Class 19 specifications before him, to which Mr Morgan's remarks appear applicable, only shutters, I would judge, in the prima facie, are

also found in the Class 6 and Class 9 specifications before me. The Class 37 specification, I would judge, continues to be principally directed towards security services. I therefore reach the same conclusion as Mr Morgan and I follow his findings in that case. Accordingly I find that the opposition is successful in respect of that specification.

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I therefore turn to consider what modification, of the applications under Classes 6 and 19 should be made, if any.

10 Article 5 of the Trade Marks Act 1994 does not make specific provision for partial refusal (except under Section 5(4), which allows refusal “to the extent that its use in the United Kingdom is liable to be prevented ... etc”). However Article 13 of the First Council Directive 89/104/EEC states:-

15 “Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.”

20 Article 13 of the Directive is a mandatory provision and it must be assumed therefore, that it is included in the Trade Marks Act 1994, which was enacted in implementation of that Directive. In a recent decision (as yet unreported), Mr Geoffrey Hobbs QC, sitting as the Appointed Person (Section 76(2) and Section 77 of the Act) in an appeal against the Registrar’s decision in the WILD CHILD case (Opposition No 43414 to Application No 2013102) said:-

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“The provisions of Art 13 are binding upon the Registrar of Trade Marks whose task it is to implement the Directive on behalf of the State in Registry proceedings in the United Kingdom.”

30 It therefore appears to me that the application in Classes 6 and 19 should be allowed to proceed to registration with the deletion of “shutters” from both specifications.

35 The outcome under Section 5(2), therefore, is that the opposition is successful to the extent that “shutters” is deleted from the Class 6 and Class 19 specifications, and the Class 37 specification is deleted entirely.

I now turn to consider the opposition under Section 5(3), which provisions reads as follows:-

40 (3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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 Community trade mark, in the European Community) 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.

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Under this section, I have only to consider the surviving items in the applicants' Class 6 and Class 19 specifications and decide if use of their mark would have the consequences for the opponents' mark which the provisions of Section 5(3) are there to prevent.

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From the evidence filed in these proceedings it appears to me that the opponents mark has very significant use in the public sector. The size of that sector makes it a significant portion of the relevant market, I believe. This argues for an extensive reputation residing in the opponents' mark, in a field which is not wholly unrelated to that in which the applicants would seek to operate. The applicants have not provided any evidence of their own to set against this; and, of course, there has been no hearing in these proceedings. I therefore feel that in view of the closeness of the market spheres covered by, respectively, the application and the opponents' registration, I have no alternative but to find that the opponents are successful under this section.

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The combined effect of these findings under Sections 5(2) and 5(3), is that the applications are refused in their entirety.

The opposition having succeeded I order the applicants to pay to the opponents the sum of **£535** as a contribution towards their costs.

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Dated this 26th day of March 1998

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M J TUCK
For the Registrar
the Comptroller-General