

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2140532
BY INGERSOLL-RAND ARCHITECTURAL HARDWARE GROUP LIMITED
TO REGISTER A TRADE MARK IN CLASS 6**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 48086
BY YALE SECURITY INC AND YALE SECURITY PRODUCTS LIMITED**

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by Yale Security Inc and Yale Security Products Limited**

BACKGROUND

1. On 2 August 1997 Ingersoll-Rand Architectural Hardware Group Ltd (previously Newman Tonks Group Plc) applied to register the mark “2003 S” in respect of “door closers; parts and fittings for the aforesaid goods.”
2. On 23 January 1998 Yale Security Inc and Yale Security Products Limited (jointly) filed notice of opposition. The grounds of opposition are in summary:
 - a) under Section 3(1)(a) as the mark applied for is not a mark within the definition of a trade mark contained in Section 1(1) of the Trade Marks Act 1994;
 - b) under Section 3(1)(b) as the mark applied for is devoid of distinctive character;
 - c) under Section 3(1)(c) as the mark applied for consists exclusively of a sign or indication which serves in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods, or other characteristics of the goods;
 - d) under Section 3(1)(d) as the mark consists exclusively of a sign or indication which has become customary in the current language or in the bona fide and established practices of the trade;
 - e) under Section 3(3)(a) as the mark applied for is contrary to public policy to the extent that it is descriptive and/or suggestive of the millennium;
 - f) under Section 3(3)(b) as the mark is of such a nature as to deceive the public as to the nature, quality or origin of the goods claimed.
3. The applicants filed a counterstatement denying the above grounds.
4. Both sides filed evidence.
5. Both sides ask for an award of costs in their favour.

6. The matter was set down to be heard on Tuesday 22 October 2002. The applicants gave an early indication that they did not intend to be represented at the hearing. In the event the opponents also chose not to attend or be represented on the appointed day. Neither side has filed written submissions nor indicated that the matter has been resolved. Acting on behalf of the Registrar I give this decision.

7. This is one of four related cases between the parties. The issues are in substance the same in each case but the actions differ in terms of the evidence filed. In particular the applicants have filed evidence in support of their position in two of the cases but not the other two. The opponents' evidence too differs slightly as between the individual cases. It follows that the cases have not been consolidated.

Opponents' Evidence

8. This consists of two statutory declarations and one affidavit. The first statutory declaration, dated 26 October 1998, comes from Mr Simon Scowcroft. Mr Scowcroft explains that he has seven years experience in the door hardware trade in relation to door closers and security in particular and that he has been employed by the Newman Tonks Group Plc, Williams Security Products and Jebron Limited. Mr Scowcroft confirms that the information contained in the declaration comes from his own knowledge and experience of the said trade. The following relevant information emerges from this declaration:

- Mr Scowcroft is aware that a number of companies use the numeral 2000 and variations thereof as product codes designating ranges of door furniture including door closers. In relation to door closers, it is common practice in the trade for manufacturers or suppliers to use four figure numbers to identify different ranges of door closers, different types of door closers within that range, and different characteristics in each type. The numerals 1000, 2000, 3000, 4000 and 5000 are used by several manufacturers or suppliers to depict the different series of door closers which they produce. In this context the numbers 1, 2, 3, 4 and 5 are intended to indicate the particular range. Subsequent numbers are used to indicate various other performance and functional characteristics of the door closer;
- The Newman Tonks Group protocol for numbering the door closers which it sells under the Trade Mark BRITON is as follows:

first digit	-	range
second digit	-	backcheck or delayed action function
third digit	-	slide track feature
fourth digit	-	power size

- The Yale protocol is:

first digit	-	range
second digit	-	backcheck function
third digit	-	slide track feature
fourth digit	-	power size

- The Jebron protocol is:

first digit	-	range
second digit	-	power size
third digit	-	backcheck or delayed action function
fourth digit	-	slide track or hold open feature

- The above style of nomenclature has been used by manufacturers and suppliers of door closers for many years, and the practice of using numbers which indicate these various common features of door closers is known to those who specify or purchase door closers and is accepted as a method of describing the attributes of the particular brand of closer. The origin of the closer would be identified by such Trade Marks as BRITON, YALE, GEZE, DORMA, JEBRON, ARROW etc, since it is the normal practice in the trade to use such marks in association with the aforesaid product codes. Exhibit SS1 shows examples of the applicants' packaging and that of other companies showing this practice;

- The applicants, like other manufacturers and suppliers of door closers, do not use the numeral 2003/2003 S as a trade mark but rather as a product description or code. Exhibit SS2 consists of copies of brochures illustrating the applicants' BRITON 2000 door closer and equivalent door closers of the opponents and of Jebron Limited.

9. An affidavit, dated 23 October 1998, comes from Mr John Davenport. Mr Davenport explains that he is the Controller of Yale Security Inc and has been employed by the company for a total of 26 years, the last seven of which have been in a senior position. Mr Davenport confirms that the information contained within the affidavit is derived either from his own knowledge or from company records. The following relevant information emerges:

- The opponents introduced their 2000 series door closer in 1984, as evidenced by Exhibit JD1. It first exported door closers bearing product descriptions in this series in 1985. Such exports were made from the United States throughout the world including the United Kingdom. Exhibits JD2, JD3 and JD4 show examples of the descriptive literature the company produced for the United States and other English speaking countries including the United Kingdom in recent years featuring its 2000 Series door closers;

- Mr Davenport exhibits (JD5 to 7) computer print outs showing the breakdown of sales by his company of 2000 series door closers. Suffice to say that sales are recorded in the UK for the years 1995 to 1997. Further exhibits (JD8 to 10) show the breakdown of sales by product code;

- The opponents have always promoted their door closers under their principal trade mark YALE distinguishing between the various types of closer by the product codes. Mr Davenport confirms that these codes are not fanciful designations but were adopted by the company to conform with the designations used in the hardware trade for many years to indicate the type and performance of door closers. In this context, Mr Davenport confirms that he has read the statutory declaration of Simon Scowcroft

and that the significance of the designations which he describes therein are true and accurate to the best of Mr Davenport's knowledge and belief. Mr Davenport finally confirms that, to his certain knowledge, such designations are currently used by manufacturers and suppliers of door closers as a means of distinguishing between the various kinds of door closers and consequently cannot be the sole property of any single manufacturer or supplier.

10. The final statutory declaration, dated 28 October 1998, comes from Mr David Lake. Mr Lake explains that he is a Director of Farncombe International Limited, a company which specialises in investigations in Trade Marks and Intellectual Property matters and that he has 15 years experience as a Private Investigator. In February 1998, Farncombe International was instructed by Marks & Clerk to undertake an investigation into the hardware trade to determine with what frequency, if any, manufacturers and suppliers involved in that trade utilised the numeral 2000 and variations thereof to indicate their product ranges and the characteristics of their products. Exhibit DL1 is a copy of his report. I do not intend to reproduce the contents of the report in this decision. Several of the exhibits mentioned in the report were missing from the evidence. The conclusion drawn from the report is that a significant proportion of door and window furniture manufacturers use four digit numbers to identify and market specific ranges of products. These numbers are normally multiples of 1000 and there are several instances when the number 2000 has been used.

Applicants' Evidence

11. This consists of two statutory declarations, from Mr Dennis May and Mr Alan Henry. In the first declaration, dated 29 April 1999, Mr May explains that he is the company secretary of Ingersoll-Rand Architectural Hardware Group Limited, a position he has held since 1991. Mr May confirms that the information contained in the statutory declaration comes from his own personal knowledge and that of the company records. The following relevant information emerges from this declaration:

- The applicant company introduced its 2000 Series door closer in 1968, as evidenced by Exhibit DM1. The unregistered trade mark 2003 was first used by the company at least as early as 1972, as shown by Exhibits DM2 and DM3. Exhibits DM4, DM5, DM6, DM7, DM8, DM9 and DM10 show copies of brochures, advertisements, price lists and further descriptive literature which the company has produced and distributed in the United Kingdom featuring its 2003 door closer;
- The company introduced its 2003S door closer in 1989. Exhibit DM11 shows a price list for the product and DM12 a leaflet;
- Exhibit DM13 is a computer print out showing the UK sales of the company's 2003S door closer for 11 months from January 1993 to November 1993. During this period the company sold 184,205 door closers under its 2003S trade mark at an ex-factory value of £5,076,175.15. Exhibits DM14 and DM15 show sales figures for the years 1995 and 1996. DM14 shows that in 1995 374,329 2000 Series door closers were sold at an ex-factory value of £10,526,259.65 and that sales of the company's 2003S door closers account for at least 220,841 units sold at an ex-factory value of £6,652,504.15.

In 1996 the equivalent figures were 111,334 units sold at an ex-factory value of £3,508,141.60.

12. The second statutory declaration, dated 29 April 1999 comes from Mr Alan Henry. Mr Henry explains that he is the Regional Ironmongery Manager of George Boyd Limited, a position he has held since 1994. The company is the distributor of various architectural ironmongery products and distributes the goods of Ingersoll-Rand Architectural Hardware Group Limited, together with competing brands such as Dorma, Geze and Jebron. The company has been distributing Ingersoll-Rand's 2003S door closers since 1989. Mr Henry confirms that he recognises the sign 2003S as that of Ingersoll-Rand Architectural Hardware Group Limited, and believes this sign designates their products.

Opponents' Evidence-in-Reply

13. This consists of an affidavit and a statutory declaration. The affidavit, dated 13 July 1999, comes from Mr Michael J Colitti. Mr Colliti explains that he is the Manager of Finance and Legal Administration for Yale Security Inc and has been employed by the company for two years. He confirms that he has also had two years experience in the hardware industry and that he has reviewed the statutory declarations filed on behalf of the applicant-that of Mr Denis May and Mr Alan Henry. The affidavit consists of submissions in response to these declarations with the following comments made:

- Exhibit DM1: this is being used to evidence the date of first use but there is no reference to when this catalogue was printed;
- Exhibits DM5 through to DM10 and DM12: In all the photographs, each time the applicant has used the numeral "2003" or "2003S" it is in conjunction with the name/mark BRITON;
- The numeral 2003S is being used by the applicants to denote the size of the door closer. Exhibit DM11 clearly refers to "2003S" as "a door closer size 3." Page 2 of product group 1 of this exhibit reveals that the last numeral of the product number denotes the size of the closer for all of the 2000 Series as well as the 2500 and 2700 Series;
- Exhibits DM4 and DM11 clearly show that the applicants use the numerals "2003" and "2003S" as product numbers rather than Trade Marks. It is obvious from this exhibit that the Trade Mark upon which the applicants rely to identify the origin of their products is BRITON.

14. In relation to the statutory declaration of Mr Alan Henry, Mr Colliti makes the following observations:

- Neither Mr Henry, nor Mr May, have challenged the Mr Simon Scowcroft's interpretation of the significance of the use of numbers by hardware manufacturers to identify the characteristics of door closers;

- In paragraph 3 of his declaration, Mr Henry makes reference to the word “brands”, in paragraph 4 he makes reference to the word “mark” whilst in paragraph 5 he uses the word “sign”. This suggests he is unsure as to what the numeral “2003S” is supposed to represent. Moreover, his references to the numeral “2003S” in paragraphs 4 and 5 of his Declaration suggest that this numeral is the only brand or mark or sign which the applicants apply to their door closers when his experience in the hardware/ironmongery trade must have taught him that this is only one of many numeral designations which the applicants use to distinguish between the types of door closer which they manufacture.

15. The statutory declaration, dated 22 December 1999 comes from Mr Simon Scowcroft. I do not intend to reproduce the declaration here as it is substantially repeating the points made by Mr Colliti.

16. This concludes my review of the evidence in so far as it is necessary.

DECISION

17. Section 3(1) of the Act reads as follows:

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (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,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

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.”

18. The opponents have raised an objection based on Section 3(1)(a) of the Act. In particular they say “The mark applied for is not a mark within the definition of a trade mark contained in Section 1(1)”. Section 1(1) reads:

“1.-(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

19. Section 1(1) does not set out to provide an exhaustive list of what can constitute a trade mark but I note that letters and numerals are specifically provided for. In AD2000 Trade Mark [1997] RPC 168 Mr G Hobbs QC, sitting as the Appointed Person indicated that if a sign represented graphically is only capable to the limited extent of being not incapable of distinguishing, it is not excluded from Section 3(1)(a). That seems to me to be the case here. However signs not objectionable under Section 3(1)(a) may still be objectionable under other provisions of Section 3.

20. There are now numerous authorities dealing with the application of Section 3(1)(b), (c) and (d) of the Act.

21. In relation to Section 3(1)(b) Mr Justice Jacob said in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

“Next, is “TREAT” within Section 3(1)(b). What does *devoid of distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without further educating the public that it is a trade mark?”

22. In relation to Section 3(1)(c), the ECJ has indicated in *Procter & Gamble v OHIM*, Case C-383/99, that the sub section is directed at signs:

“... that may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought.”

23. In relation to Section 3(1)(d) the ECJ has said in *Merz v Krell GmbH*, Case C-517/99, that:

“35 It must first of all be observed that, although there is a clear overlap between the scope of Articles 3(1)(c) and 3(1)(d) of the Directive, marks covered by Article 3(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered.”

24. The opponents in this case have made plain the nature of their objection namely that numeral combinations are in use in the trade as indicators of particular characteristics of the goods (door closers). That evidence speaks for itself and does not require elaboration or repetition on my part. For ease of reference the Annex to this decision contains a number of examples of the descriptive nature of the numbering system used by manufacturers of door closers. They consist of:

- an explanatory page from Yale’s (the opponents) own brochure showing the significance of each element of the number series;

- a similar page from a Jebron brochure again clearly identifying the information conveyed by the numbering system used;
- a page from the applicants' own catalogue which illustrates the characteristics claimed by Mr Scowcroft in his statutory declaration;
- the final page is also drawn from the applicants' own brochure and demonstrates that the final element, in this case S, is also likely to be descriptive of a particular finish. That this is a long standing practice can be verified by reference to the Newman Tonks 'Briton' brochure for 1982 which indicates that "For the convenience of our customers we have introduced a system of code letters applicable to finishes".

25. The particular import of the above is that the reference numbers/letters used are not just for the internal convenience of the manufacturers. They are actively promoted as the means by which customers can identify their requirements. It would perhaps be going too far to say that the numbering systems constitute an industry standard. Mr Scowcroft's evidence suggests that, whilst Yale and Briton use the first, second, third and fourth digits to signify identical characteristics, Jebron achieves the same result in a slightly different way (e.g. power size is indicated by the second digit rather than the fourth in the case of Yale and Briton). Nevertheless that does not detract from the central proposition that the numbers and letters represent a system of codification of various characteristics of the products and that customers have been educated to expect this to be the case. Moreover I consider that the evidence shows this to have been the position as at the material date in these proceedings. In short the opponents have established a compelling case which supports objections under Section 3(1)(b), (c) and (d) of the Act.

26. That is not the end of the matter in this particular case because the applicants have filed evidence of use. Mr May's evidence indicates significant levels of sales of the 2003S door closer. It was said in *Bach and Bach Flower Remedies Trade Marks*, [2000] RPC 513:

"First, use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality."

27. If the use relied on has not been in a trade mark sense and there is nothing to suggest that the relevant public has been educated to see it in that way then the use cannot assist the applicant in establishing a position under the proviso to Section 3(1). That is precisely the position here. There has undoubtedly been use of 2003S but, save for Mr Henry's evidence which I will come to below, there is nothing to indicate that the use has been as a trade mark. The applicants' position is not helped by the fact that more obviously trade mark matter is present notably the word 'Briton' but also a stylised NT device which I take to represent the initials of Newman Tonks. Nevertheless the presence of other trade marks does not in itself mean that 2003S cannot function as a sub-brand. It is a question of fact as to whether it does. On the basis of the applicants' own evidence it clearly does not.

28. Despite this Mr Henry says that he does recognise 2003S as the applicants' sign or mark. There are difficulties with this evidence:

- Mr Henry is in the employ of a company which acts as the applicants' distributor. He can scarcely be said to be an independent source;
- there is no indication that he has seen or been asked to respond to the detailed claims made in Mr Scowcroft's and Mr Davenport's evidence;
- Mr Henry is presumably not an expert in trade mark matters. He variously refers to brands, marks and signs and his belief that 2003S designates the applicants' goods. But he does so in circumstances which leave me in some doubt as to whether he simply recognises that Ingersoll-Rand produce a door closer codified as 2003S or whether he genuinely considers that it is being used as a trade mark;
- he does not comment on other traders' practices despite the fact that his company distributes other competing manufacturers' goods;
- his evidence flies in the face of the rest of the evidence in the case.

29. I have no hesitation, therefore, in concluding that the evidence does not establish that the applicants are entitled to benefit from the proviso to Section 3(1). In the circumstances I see no need to consider the remaining grounds under Section 3(3) of the Act.

30. The opposition has been successful under Section 3(1)(b),(c) and (d).

31. The opponents are entitled to a contribution towards their costs. I bear in mind that this is one of four separate cases and there is some overlap in the evidence and resultant savings. I order the applicants to pay the opponents the sum of £800. 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 6th day of November 2002

M REYNOLDS
For the Registrar
the Comptroller-General

Annex in paper copy only