

O-432-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3022739
BY BANNOLD SUPPLIES & SERVICES LTD T/A "BANNOLD" TO REGISTER
THE TRADE MARK:

MANOR

IN CLASS 19

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 401288 BY
ACHESON AND GLOVER LIMITED

BACKGROUND

1. On 2 October 2013, Bannold Supplies & Services Ltd t/a “Bannold” (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 4 October 2013, for the following goods in class 19:

Paving stone; Paving blocks; Paving stones; Paving tiles; Paving; Paving blocks made of non-metallic materials; Paving made of non-metallic materials; Paving products (non-metallic-); Paving slabs, not of metal; Paving blocks, not of metal.

2. The application is opposed by Acheson and Glover Limited (“the opponent”) on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application with the opponent relying upon all of the goods in the following UK registration:

No. 2257691 for the trade mark: **MANORSTONE** applied for on 12 January 2001 and the registration process for which was completed on 29 March 2002:

Class 19 - Concrete paving slabs, blocks.

3. The applicant filed a counterstatement in which the ground of opposition is denied. The applicant stated:

“Our trademark application is for the word Manor (not MANORSTONE) which relates to a natural stone paving and walling product in a different class to the opposition. The product bears no resemblance and is not likely to cause any confusion with the public. Their product is a range of manufactured coloured concrete which bears no resemblance to our natural paving product.”

4. Neither party filed evidence, nor did they ask to be heard or file written submissions in lieu of attendance at a hearing.

DECISION

5. The opposition is based solely upon section 5(2)(b) of the Act which reads as follows:

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

(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.”

6. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means -

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had been registered for more than five years when the application was published, it is, in principle, subject to the proof of use provisions as per section 6A of the Act. In its Notice of Opposition, the opponent indicated that its earlier trade mark had been used upon all of the goods for which it is registered, however, as the applicant’s response to question 7 on the Form TM8 which reads: “Do you want the opponent to provide proof of use” was to tick the “No” box, it is not necessary for the opponent to show what use it has made of its earlier trade mark and it is entitled to rely upon all of the goods for which it is registered.

Section 5(2)(b) – case law

8. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

9. The competing goods are:

Opponent's goods	Applicant's goods
Concrete paving slabs, blocks.	Paving stone; Paving blocks; Paving stones; Paving tiles; Paving; Paving blocks made of non-metallic materials; Paving made of non-metallic materials; Paving products (non-metallic-); Paving slabs, not of metal; Paving blocks, not of metal.

10. Although in its counterstatement the applicant refers to what it considers to be the difference in the goods upon which the competing trade marks are actually used, that is not the correct approach. Rather, what I must do is compare the specification of goods applied for with those for which the earlier trade mark is registered. In approaching that question, I remind myself that in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (GC) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

On the principles outlined above, it is self evident that the competing goods must be regarded as “identical”.

The average consumer and the nature of the purchasing decision

11. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

12. The average consumer of the paving goods at issue in these proceedings is either a member of the general public buying for domestic use, or a professional user (such as a builder) buying on behalf of domestic and commercial clients. Irrespective, as both sets of average consumers are likely to select the goods from retail outlets such as builders’ merchants and home improvement stores or from the pages of catalogues or websites, the visual aspects of the competing trade marks are likely to be more important than aural considerations (although aural considerations must not be ignored). As to the selection process, the average consumer will need to ensure that the goods it selects are suitable for the particular location and purpose for which they are going to be deployed, and once deployed, the goods are unlikely to be replaced for some time. Given the wide range of colours, patterns and materials likely to be available and what is likely to be the not insignificant financial outlay, I would expect a member of the general public (who is likely to select such goods infrequently) to pay a relatively high degree of attention to the selection of the goods at issue; a degree of attention which is,

in my view, likely to increase when considered from the perspective of a professional user selecting the goods on a commercial basis for others and in which the sums in play are likely to be significantly higher.

Comparison of trade marks

13. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
MANORSTONE	MANOR

14. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives. In a letter to the Tribunal dated 15 April 2014, the opponent stated:

“We would submit that the applicant's trade mark MANOR and the opponent's trade mark MANORSTONE are highly similar and likely to be confused since both trade marks include the identical term MANOR and since the applicant is seeking registration in respect of goods which are identical and/or highly similar to the goods for which the opponent's MANORSTONE trade mark enjoys protection. The word STONE which forms the terminal element of the opponent's MANORSTONE trade mark is wholly descriptive and it is therefore the initial element MANOR which forms the most memorable and distinctive element of that trade mark.”

15. The applicant's trade mark consists of the well known English language word MANOR presented in upper case; there are no distinctive or dominant elements, the distinctiveness lies in the trade mark as a whole. The word MANOR is most likely (as per collinsdictionary.com) to be understood by the average consumer as meaning “(in medieval Europe) the manor house of a lord and the lands attached to it”; it is that meaning which creates the overall impression the applicant's trade mark will convey to the average consumer. Although the opponent's trade mark is presented as one word in upper case, as it consists of two well known English language words conjoined i.e. MANOR and STONE that is how the average consumer is likely to interpret it. The word STONE is most likely to be understood by the average consumer as meaning (once again as per collinsdictionary.com) as “the hard compact non metallic material of which rocks are made...” and “a small lump of rock; pebble.” As the opponent suggests, in

relation to the goods for which its trade mark is registered, the word STONE is likely to be considered descriptive by the average consumer. As a consequence, although the opponent's trade mark consists of two conjoined elements, as the second of those elements is likely to be considered descriptive, the overall impression created by the opponent's trade mark is, in my view, likely to stem from the word MANOR.

16. When considered from a visual and aural perspective, the fact that both trade marks either consist of (the applicant's trade mark) or contain the word MANOR as the first element (the opponent's trade mark), leads (notwithstanding the inclusion in the opponent's trade mark of the descriptive word STONE), to a fairly high degree of visual and aural similarity between them. Insofar as the conceptual position is concerned, as any conceptual message sent by the word MANOR will be the same in respect of both trade marks, and as the conceptual message conveyed by the word STONE is likely to be descriptive, the trade marks are, at the very least, conceptually similar to a high degree.

Distinctive character of the opponent's earlier trade mark

17. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As the opponent has not filed any evidence, I have only the inherent characteristics of its trade mark to consider. Although there is nothing to suggest that the trade mark MANORSTONE is descriptive of nor non-distinctive for the goods for which it is registered, as it consists of the conjoining of two well known English language words (the second of which is likely to be considered descriptive) it is, absent use, possessed of a no higher than normal level of inherent distinctive character.

Likelihood of confusion

18. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

19. Earlier in this decision, I concluded that: (i) the competing goods are identical, (ii) the average consumer is either a member of the general public or professional user who will select the goods by predominantly visual means and who will pay (at least) a relatively high degree of attention when doing so, (iii) the competing trade marks are visually and aurally similar to a fairly high degree and conceptually similar to (at least) a high degree and (iv), the opponent's trade mark is possessed of a no higher than normal degree of inherent distinctive character.

20. Having reached those conclusions, I have no hesitation finding that despite the (at least) relatively high degree of care taken during the selection process, there will be a likelihood of confusion. Given the descriptive nature of the word STONE, the competing trade marks are, in my view, likely to be directly confused i.e. mistaken for one another. However, even if I am wrong in that conclusion, the average consumer will, in my view, at the very least assume that the identical goods for which the applicant seeks registration, come from an undertaking economically linked to the opponent i.e. there will be indirect confusion.

Conclusion

21. As a consequence of the above conclusions, the opposition succeeds and, subject to any successful appeal, the application will be refused.

Costs

22. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Opposition fee:	£100
Total:	£300

23. I order Bannold Supplies & Services Ltd t/a "Bannold" to pay to Acheson and Glover Limited the sum of **£300**. 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 8th day of October 2014

C J BOWEN
For the Registrar
The Comptroller-General