

O-816-21

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3475919
BY PRESS & PASS LTD
TO REGISTER**



**AS A TRADE MARK
IN CLASS 6
AND OPPOSITION THERETO (UNDER NO. 421262)
BY
ROLLERDOR LIMITED**

Background & Pleadings

1. Press & Pass Ltd (“the applicant”) applied to register the trade mark set out on the title page on 18 March 2020. The mark was published in the Trade Marks Journal on 26 June 2020 in class 6 for *garage doors of metal; metal garage door rollers*.

2. RollerDor Limited (“the opponent”) opposed the application on 26 August 2020 under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) on the basis of its earlier UK trade mark no. 3349595, the detail of which is set out below. In addition the opponent opposed the application under section 5(4)(a) of the Act relying upon the sign ROLLERDOR for which it claims use since January 2009 in the UK on *garage doors, metal garage doors, metal garage door rollers, roller garage doors, electric garage doors, doors, parts and fittings for garage doors, installation of garage doors, repair and maintenance services for garage doors, manufacture of garage doors and their parts and fittings*.

UK TM No.3349595	Goods and services relied on
<p data-bbox="204 1084 614 1137">ROLLERDOR</p> <p data-bbox="204 1240 619 1272">Filing Date: 30 October 2018</p> <p data-bbox="204 1294 710 1326">Registration Date: 1 February 2019</p>	<p data-bbox="810 1084 1378 1989">Class 6: Common metals and their alloys; metal building materials; ironmongery, small items of metal hardware; pipes and tubes of metal; Metal garage doors; metal garage door rollers; prefabricated garages of metal; metal keys for locks; keys; door hinges of metal; door frames and casings of metal; door fittings of metal; door handles of metal; door pulls of metal; door locks; door openers, non-electric; door seals of metal; door bolts of metal; door fasteners of metal; bindings of metal; bolts of metal; brackets of metal for building; building materials of metal ; building panels of metal; door bolts of metal; door closers, non-electric / door</p>

	<p>springs, non-electric; door panels of metal; doors of metal; fittings of metal for building; folding doors of metal; frames of metal for building; framework of metal for building; hinges of metal; hooks [metal hardware]; latches of metal; lock bolts; locks of metal, other than electric; mouldings of metal for building; nails; nuts of metal; outdoor blinds of metal; partitions of metal; pulleys of metal, other than for machines; runners of metal for sliding doors; screws of metal; shutters of metal; shutter doors of metal; insulating doors of metal; outer doors of metal; springs [metal hardware]; swing doors of metal; roll doors of metal; frames of metal for doors; panels of metal for doors; fittings of metal for doors; safety fittings of metal for doors; overhead suspension tracks of metal for use with doors; parts and fittings for all the aforesaid goods.</p>
	<p>Class 19: Building materials (non-metallic); brackets, not of metal, for building; construction materials, not of metal; building panels, not of metal; door frames and casings, not of metal; door panels, not of metal; doors, not of metal; folding doors, not of metal; framework, not of metal, for building; mouldings, not of metal, for building; outdoor blinds, not of metal and not of</p>

	<p>textile; partitions, not of metal; shutters, not of metal; swing doors, not of metal; garage doors (non-metallic); prefabricated garages, not of metal; door surrounds (non-metallic); non-metal sliding doors; lift-up doors, non-metallic; sliding doors, not of metal; revolving doors, not of metal; outer doors, not of metal; vertically raisable rolling doors (non-metallic); doors made of plastic for buildings; doors (non-metallic) for use in garages; parts and fittings for all the aforesaid goods.</p>
	<p>Class 37: Building construction; repair services relating to garage doors; installation services relating to garage doors; installation and maintenance of garage doors; advisory services relating to the installation and repair of motors; installation and repair services relating to doors; installation and repair services relating to door fittings; installation and repair services relating to locks and lock fittings; administration, management, consultation, information and advisory services relating to the aforesaid.</p>
	<p>Class 40: Custom manufacture of garage doors and garage door parts and fittings; custom manufacture of prefabricated constructions elements; custom manufacture of doors and door parts and fittings; custom manufacture of shutters and shutter parts and fittings;</p>

	custom manufacture of door frames and casings; custom manufacture of door panels
--	--

3. The opponent's registration has a filing date that is earlier than the application's filing date and, therefore it is an earlier mark, in accordance with Section 6 of the Act. However, it is not subject to proof of use, having not been registered for five years prior to the application's filing date.

4. The applicant filed its defence and counterstatement on 21 October 2020, in which it denied the opponent's claims.

5. The opponent is represented by Novagraaf UK and the applicant is representing itself in these proceedings.

6. Both parties filed evidence and written submissions in lieu of a hearing. I make this decision following a reading of all the material before me.

Preliminary issues

7. In its counterstatement and again in its submissions the applicant makes reference to other third-party trade marks and company names which it considers to be similar to the opponent's mark for similar goods. The applicant also makes reference to its domain name and website and points out the differences between itself and the opponent

8. It is settled case law that the decision I must make must be based on fair and notional use, i.e. based on the trade marks/sign and the respective goods and services before me¹. In addition, simply because there are other allegedly similar trade marks and companies name in the same sector, this has no effect on my decision. This was set out in *Zero Industry Srl v OHIM*², where the General Court stated that:

¹ *Roger Maier and Another v ASOS* [2015] EWCA Civ 220

² Case T-400/06

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71). “

9. Furthermore, I cannot take account of any marketing considerations such as web sites as these are irrelevant to the likelihood of confusion. In *Devinlec Développement Innovation Leclerc SA v OHIM*³, the Court of Justice of the European Union (“CJEU”)⁴ stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

³ Case C-171/06P

⁴ Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Opponent's evidence

10. The opponent presented evidence in the form of a witness statement from Colin Browne dated 12 January 2021 and appended twelve exhibits. Mr Browne is the managing director of the opponent and states that the mark ROLLERDOR was first used in January 2009. The declarant also states that the opponent's goods are sold directly to customers via its website and through several third-party retailers. He also states that its customers are spread throughout the UK.

11. The opponent's turnover and advertising expenditure up to December 2020 are given below, although it is not indicated how much turnover relates to the goods and how much to the services.

Turnover

31 March 2016-31 March 2017	£2,328,490
1 April 2017- 31 March 2018	£3,254,240
1 April 2018- 31 March 2019	£3,853,642
1 April 2019- 31 March 2020	£3,948,276
31 March 2020 –December 2020	£4,185,914

Advertising expenditure

31 March 2016-31 March 2017	£104,577
1 April 2017- 31 March 2018	£134,593
1 April 2018- 31 March 2019	£220,833
1 April 2019- 31 March 2020	£240,339

31 March 2020 –December 2020	£156,338
------------------------------	----------

12. The declarant states that the mark is used on *garage doors; parts and fittings* and *installation and maintenance services of garage doors, parts and fittings*.

13. The declarant states that the opponent advertises annually in the Norwich Evening news, Eastern Daily Press and the Advertiser⁵ to around 1.5m print and online readers as well as attending the annual Self Build & Design Show (East) and the National Homebuilding Show as exhibitors⁶. As well as exhibiting at the Self Build & Design Show (East), the declarant states that exhibitors advertise in the Self Build & Design magazine which has a circulation of 50,000. The opponent also uses Facebook to promote its goods and services.

14. The declarant demonstrates examples of the mark in use on various marketing materials, brochures, warranty documents, installation instructions and on an electric garage door control mechanism itself⁷. However, I note that in addition to the word ROLLERDOR, the opponent also uses the following figurative marks on the goods and supporting materials mentioned above.



⁵ Exhibit CB7

⁶ Exhibit CB8

⁷ Exhibit CB5

15. The declarant also draws attention to 80 customer reviews for its goods and services hosted by a third party review website namely www.reviews.co.uk.⁸ The printouts are dated 7 January 2021 but the reviews themselves were posted between one month and two years prior to that date. Some reviewers opted to show their post codes. Where that was the case, I note the post codes are spread across the UK. Of the 80 reviews, some 59 mentioned ROLLERDOR.

Applicant's evidence

16. The applicant presented evidence in the form of a witness statement from Lewis Cartwright dated 5 May 2021. Mr Cartwright is a director of the applicant and appended seven exhibits. I do not intend to summarise these exhibits in detail, suffice to say that the declarant provides information on the applicant's launch in October 2019, the domain name purchase, turnover, Google ads advertisements and Trustpilot reviews from customers. Mr Cartwright also exhibits an email from a potential customer⁹ asking about the difference between the applicant's and the opponent's garage doors.

Opponent's evidence in reply

17. The opponent submitted evidence in reply in the name of Laura Morrish, a Chartered Trade Mark Attorney at Novagraaf UK, the opponent's legal representative, dated 12 July 2021. Ms Morrish questioned the relevance of the applicant's evidence in rebuttal. In addition, the declarant appended one exhibit namely a copy of an undated Google search which the declarant states "shows the proximity of the parties marks in various online searches"¹⁰, which she claims will cause confusion.

18. That concludes my summary of the evidence.

⁸ Exhibit CB10

⁹ Exhibit 3

¹⁰ Laura Morrish Witness Statement, paragraph 4

Legislation - Sections 5A and 5(2)(b)

19. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

20. Section 5(2)(b) of the Act is 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”.

21. The following principles are gleaned from the decisions of the EU courts¹¹ 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;

¹¹ Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

(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

22. In these proceedings, the applicant's *garage doors of metal; metal garage door rollers* in class 6 are self-evidently identical to the opponent's *Metal garage doors; metal garage door rollers* in the same class.

23. I do not need to consider the opponent's remaining goods or services as they do not put the opponent in any stronger a position.

The average consumer and the purchasing process

24. I next consider who the average consumer is for the contested goods and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.¹² For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question¹³.

25. The average consumer for the contested goods can be a member of the general public or businesses. The contested goods are potentially expensive purchases given they are bespoke fitted products. Moreover, the purchase of garage doors will require a high degree of attention from a consumer given they would have to consider size, function and other building/structural considerations. I find the purchasing process will be predominantly visual as a consumer will browse from brochures or other literature or from images online. There will be also be an aural

¹² *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch)

¹³ *Lloyd Schuhfabrik Meyer*, Case C-342/97.

aspect to the purchase process as consumers may seek advice from sales or technical staff.

Distinctive character of the earlier mark

26. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*¹⁴, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; 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 section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

27. I also find the guidance set out in *Formula One Licensing BV v OHIM*¹⁵ to be useful in this case where the CJEU found that:

¹⁴ Case C-342/97

¹⁵ Case C-196/11P

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

28. I begin with considering the earlier registration’s inherent distinctiveness. As per *Formula One*, the earlier mark must be considered to have some distinctive character. In this case the earlier mark consists of the single word ROLLERDOR. Although conjoined and missing an additional letter ‘O’, the mark so closely resembles the descriptive term ROLLER DOOR, I find the earlier mark to be only very low in inherent distinctive character in relation to the goods and services for which the mark is registered.

29. Next I consider whether the earlier mark’s distinctness has been enhanced because of the use made of it. It is apparent from the evidence provided that the mark has been used on the goods and services and in promotional activity both prior to and since registration. I note the *Windsurfing Chiemsee* factors set out above as to what I should consider. I find that the opponent has a consistent annual turnover

and advertising expenditure in relation to its goods and services. There is evidence to suggest that the opponent's customer base is spread across the UK. However there is no evidence provided of a market share or that there is a significant proportion of the relevant public who recognised the mark as indicating goods and services coming from a specific undertaking. At best I find that opponent has only enhanced its mark's distinctiveness for all its goods and services by a small degree that I would categorise as being distinctive to slightly above a low degree but not at a medium degree.

Mark comparisons


30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*¹⁶, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

31. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

32. The respective trade marks to be compared are shown below:

¹⁶ Case C-591/12P

Opponent's mark	Applicant's mark
ROLLERDOR	

33. The opponent's mark consists of a single word ROLLERDOR with no other aspect to it. Its overall impression resides solely in this word, but as already stated I find this mark is of a low distinctive character in relation to its goods and services.

34. The applicant's mark is a composite arrangement of words and a figurative element. There are three words in the mark, namely ROLLER DOORS and NET. Given the words DOORS and NET are separated by a dot, this will appear to consumers as a domain name, notwithstanding the word NET being rendered in a different colour. In terms of scale, the word ROLLER is larger and is as wide as the words beneath it being DOORS.NET. To the immediate left of the word element is a figurative device of a structure with a roof and a garage door arrangement. Both the figurative element and the words make a contribution to the overall impression of the marks but I find the words ROLLER DOORS.NET to have very little distinctive character given the contested goods so the greater level of distinctiveness in this mark lies with the figurative device.

35. Firstly making a visual comparison, I find the respective marks share the letters R-O-L-L-E-R-D-O-R. This comprises the entirety of the opponent's mark and the majority of the letters in the applicant's ROLLER DOORS word element. In terms of differences the applicant has two additional letters, O and S, in its ROLLER DOORS element making that element plural, an additional word element namely .NET and the figurative device element which has no counterpart in the opponent's mark. Weighing the similarities and the differences, I find that overall there is a medium level of visual similarity.

36. With regard to an aural comparison, the applicant's figurative device element will play no part. Turning then to the respective word elements, I find the opponent's mark will be pronounced as ROLLERDOOR. The applicant's mark will likely be

pronounced in full as ROLLERDOORS-DOT-NET as is usual with domain name suffixes. Taking this into account, I find there is aural similarity to a high degree.

37. Finally, in a conceptual comparison, I find that even though the opponent's mark is misspelled, as it so closely resembles visually and is the aural equivalent of the term 'roller door' that will be the concept brought to mind by the average consumer. The same concept will apply to the applicant's word element ROLLER DOORS albeit that the concept of the whole mark will be one of a website for roller door products. The figurative device being a structure with a garage door will reinforce that concept. Overall, I find the concept for the respective marks to be identical.

Likelihood of confusion

38. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where 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. It is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer and the nature of the purchasing process for the contested goods. In doing so, I must be aware 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 that they have retained in their mind.

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*¹⁷, where he noted that:

¹⁷ BL-O/375/10

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

40. Whereas in *Duebros Limited v Heirler Cenovis GmbH*¹⁸, Mr James Mellor Q.C., also sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

41. In considering the impact of the distinctive character or lack thereof, I keep in mind *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, where Mr Iain Purvis Q.C. again as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

¹⁸ BL O/547/17

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

42. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

43. In the course of this decision I have found that,

- The goods are identical
- The average consumer will be paying a high degree of attention in a primarily visual purchasing process
- The respective marks are visually similar to a medium degree
- The respective marks are aurally similar to a high degree
- The respective marks are conceptually identical
- The earlier registration’s distinctiveness has been enhanced but only to a slightly above low degree

44. Bearing in mind that I have already found the device element of the applicant’s mark to have no counterpart in the opponent’s mark, I do not find that there is direct confusion between the marks. Having only found a medium degree of visual similarity, in a primarily visual purchasing process, I do not think that the average consumer would mistake one mark for another. In my view there is too big a visual difference between the applicant’s mark and opponent’s mark for a consumer to be directly confused.

45. When turning to the question of indirect confusion, I must consider the distinctive strength of the shared word element, and I have already found that this element has low distinctiveness. Again, based on the guidance given in *Kurt Geiger*, it follows that there is less probability of indirect confusion. I am reassured in my conclusion

by the *Duebros* guidance which is also applicable here, namely that the average consumer may see the shared word element and find them to be coincidental use of descriptive language and not indirect confusion.

46. Taking the guidance given in *Kurt Geiger* into account I have found that the earlier mark is of low distinctiveness for goods and services relating to roller doors. What slight distinctiveness the earlier mark has comes from a single missing letter in its spelling. Given that the word element of the contested mark is ROLLERDOORS.NET which also has very low distinctiveness, in my view average consumers are much more likely to see the shared words as a coincidental use of descriptive language rather than an indication that the goods and services come from the same or related undertakings. As a result, consumers will rely on the other elements of the respective marks to determine the trade origin of the goods and services.

47. Overall the opposition fails under section 5(2)(b).

Section 5(3)

48. Having found no likelihood of confusion under Section 5(2)(b), I turn to consider the claim made under section 5(3). The opponent opposed the application under Section 5(3) of the Act based on the same earlier mark and for which it claims to have a reputation for all the goods and services set out at paragraph 2.

49. In particular the opponent argues in its statement of grounds¹⁹ that the application is so similar to its earlier mark such that it will benefit from the opponent's reputation and gain an unfair advantage. The opponent further contends this will negatively impact its reputation and business. It also claims that use of the application will dilute the distinctive character and reputation of its mark.

Legislation – Section 5(3)

50. The relevant part of the act states:

¹⁹ Statement of Grounds paragraphs 8-14

“5(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, 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 European Union trade mark or international trade mark (EC), in the European Union) 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.”

51. The relevant case law for consideration of section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Addidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the

future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

Reputation

52. I must firstly consider whether the opponent has met the test for reputation. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

53. Having considered the factors set out above and weighing in the opponent’s evidence I find that use of the earlier mark demonstrates a consistent annual turnover and advertising expenditure. There is also an indication of a UK wide customer base and advertising in the press on a regional basis but exhibiting at both regional and national events. There is evidence of promotional activity via the opponent’s website and social media. However, no market share has been indicated. Overall, I find that a small reputation has been established for *garage doors; parts and fittings* and *installation and maintenance services of garage doors, parts and fittings*.

Link

54. As noted above, my assessment of whether the public will make the required mental 'link' between the respective marks must take account of all relevant factors. The factors identified in *Intel* underlined below are:

The degree of similarity between the conflicting marks

55. For the reasons given at paragraphs 35-37, I find there is a medium degree of visual similarity, a high degree of aural similarity and conceptual identity.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

56. The contested goods will be purchased by the general public and businesses paying a high degree of attention, for the reasons given at paragraph 25. I have already found that the goods listed at paragraph 22 are identical.

The strength of the earlier mark's reputation

57. The earlier mark has a small reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

58. For the reasons given at paragraphs 28-29, the word ROLLERDOR is inherently distinctive to a very low degree. Given the use which has been made of this earlier mark, I find that its distinctiveness has only slightly been enhanced. As such it is distinctive to a slightly higher than low degree.

Whether there is a likelihood of confusion

59. For the reasons given at paragraphs 44-46, I do not find that there is a likelihood of confusion.

60. Although in *Intra-Press*²⁰ it was confirmed that the level of similarity required for the public to make a link between the marks may be less than the level of similarity required for an assessment on likelihood of confusion, in my view the level of similarity between these marks is still insufficient to pass the threshold. I find that the public will not make a link between the marks despite the identity of the goods, and that the absence of a link can be put down to the descriptiveness of the shared word element in relation to the goods and services. Put simply, the relevant public will not make a link as the parties both sell roller door products and will see ROLLERDOR/ROLLERDOORS.NET as describing the goods.

61. Having failed to establish a link, the opposition fails under section 5(3).

Section 5(4)(a)

62. Finally I turn to the claims made under section 5(4)(a) of the Act. The opponent opposed the application based on its alleged earlier rights in the sign ROLLERDOR. It claims to have used this sign since January 2009 and generated goodwill to that end on the following goods and services:

Garage doors, metal garage doors, metal garage door rollers, roller garage doors, electric garage doors, doors, parts and fittings for garage doors, installation of garage doors, repair and maintenance services for garage doors, manufacture of garage doors and their parts and fittings.

63. Use of the applied for mark would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

Legislation – section 5(4)(a)

64. Section 5(4)(a) states:

“(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-

²⁰ *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P

(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, where the condition in subsection (4A) is met,

(aa)

(b)

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.”

65. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

The relevant date

66. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*²¹, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM O-212-06* Mr Allan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess

²¹ BL O-410-11

whether the position would have been any different at the later date when the application was made.’ ”

67. The filing date of the application is 18 March 2020. In the applicant’s witness statement, the declarant Lewis Cartwright states that the website was launched in October 2019. Given that the website bears the applied for mark I shall assume that the mark was in use at that date, given that the applicant provided turnover figures for that period²². As such, I will assess all factors as at October 2019 (“the relevant date”).

Case law

68. In *Discount Outlet v Feel Good UK*,²³ Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

69. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

²² Witness Statement of Lewis Cartwright dated 5 May 2021

²³ [2017] EWHC 1400 IPEC

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Goodwill

70. The first hurdle for the opponent is to show that it had the required goodwill at the relevant date. The issue of what constitutes goodwill was discussed in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*²⁴ viz,

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

71. In *Smart Planet Technologies, Inc. v Rajinda Sharm*²⁵ Mr Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

72. The relevant market for assessing goodwill is the UK. At the relevant date the opponent had been using its mark for 10 and a half years, i.e. since January 2009. The turnover stated by the opponent between 2016 and 2019 is approximately £9.4m. As previously set out in the evidence in relation to establishing reputation, I am satisfied that the opponent has demonstrated that it has sufficient goodwill in the

²⁴ [1901] AC 217 (HOL)

²⁵ BL O/304/20

sign ROLLERDOR for *garage doors; parts and fittings and installation and maintenance services of garage doors, parts and fittings.*

Misrepresentation

73. In considering whether or not there is misrepresentation in this case, I firstly remind myself of the guidance given above in paragraphs 65-66 and turn to the nature of the opponent's mark. I have found that the opponent's mark is of a slightly higher than low degree of distinctiveness. Guidance on the issue of distinctiveness can be found in "The Law of Passing-Off"²⁶, the relevant paragraph, 8 -188, reads as follows:

"A descriptive term may be sufficiently distinctive to be protected against precise copying, but may still not enjoy protection of such wide scope as a term which is wholly arbitrary. Other traders are free to use similar descriptive expressions as their own trade names or marks, and smaller differences will suffice to distinguish them than in the case of fancy words. This may be expressed in terms of "the idea of the mark". When an arbitrary mark is in use by the claimant, deception can occur by the defendant adopting a mark which incorporates the same predominant idea even if the expression differs. If, however, the only idea which can be identified is wholly descriptive then such distinctiveness as exists can only lie in the precise form of words used, or something even more specific, such as the manner in which they are written. As may be seen from the *Office Cleaning*²⁷ case, there is an element of public policy here, in that a degree of confusion is held to be an acceptable price for keeping descriptive terms open to fair use by all.

74. The key passage from *Office Cleaning* is set out below:

"Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively

²⁶ Wadlow, Christopher. *The Law of Passing-Off*, Sweet & Maxwell 6th Ed.

²⁷ *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39

small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.”

75. As previously stated, I found the respective marks to be visually similar to a medium degree, aurally similar to a high degree and conceptually identical. In addition, it is clear that the parties operate in identical sectors with regard to roller doors for garages. In my view consumers who are looking for garage doors are much more likely to see the shared word element as a coincidental use of descriptive language for such a style of garage doors and would rely on differences in the respective marks (the slight misspelling, the device element) to distinguish between one garage door provider and another. Therefore, I find that there is no misrepresentation to the public. As there is no misrepresentation, there can be no damage.

76. The opposition under section 5(4) fails

Conclusion

77. The opposition has failed. Subject to any successful appeal of this decision, the application will proceed to registration.

Costs

78. The applicant has been successful and is therefore, in principle, entitled to a contribution towards its costs. As the applicant is unrepresented, the Tribunal invited it, in the official letter dated 21 July 2021, to indicate whether it wished to make a request for an award of costs. The applicant was invited to complete a costs pro-forma including a breakdown of actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the opposition. The letter made clear to the applicant that if the pro-forma was not completed “costs may not be awarded”. As the applicant did not respond to that invitation and as it has incurred no official fees in the defence of its application, I make no order as to costs.

Dated this 3rd day of November 2021

June Ralph

For the Registrar

The Comptroller-General