

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2004672
BY GEORGE M CALLENDERS LIMITED TO REGISTER
THE MARK ODPO IN CLASSES 17 AND 19**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO 43483 BY D ANDERSON & SON LTD**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2004672**
by George M Callenders Limited to register
the mark ODPO in Classes 17 and 19

and

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IN THE MATTER OF Opposition thereto under
No 43483 by D Anderson & Son Ltd

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DECISION

On 24 November 1994 George M Callenders Limited applied to register the mark ODPO.
The application was made in two classes as follows:

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Class 17 Insulating boards and insulating materials

Class 19 Non-metallic building materials

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The application is numbered 2004672.

On 15 November 1995 D Anderson & Son Limited filed notice of opposition to this
application. In summary the grounds of opposition are:

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i under Section 5(2)(b) by virtue of the fact that the opponents are proprietors of
a similar mark for the same or similar goods

ii under Section 5(4) in that the mark at issue is liable to be prevented by the law
of passing off

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iii under Section 3(1)(a) in that it is not a sign capable of distinguishing the goods
or services of one undertaking from those of other undertakings

iv under Section 3(1)(b) in that the mark applied for is devoid of any distinctive
character

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v under Section 3(1)(c) in that it consists exclusively of signs or indications
which may serve, in trade, to designate the kind, quality, quantity, intended
purpose, value, geographic origin, the time of production of goods or of
rendering of services or other characteristics of goods or services

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vi under Section 3(1)(d) in that it consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade

5 vii under Section 3(3)(b) in that it is of such a nature as to deceive the public

viii under Section 3(6) in that the application was made in bad faith.

Details of the earlier mark referred to in (i) above are as follows:

10	NUMBER	MARK	CLASS	JOURNAL	SPECIFICATION
15	1585819	ZERO ODP	17	6189/9265	Insulating material; fibres and felt; insulating board and insulating boards; all for roof insulation purposes.

The applicants filed a counterstatement denying the above grounds.

20 Both sides ask for an award of costs in their favour.

Both sides filed evidence in these proceedings. Neither side has requested a hearing in relation to the matter. Acting on behalf of the Registrar I, therefore, give this decision on the basis of the papers filed.

25 Opponents' evidence

30 The opponents filed a statutory declaration dated 27 May 1997 by John Alexander Groom, the Senior Trade Marks Manager of Trade Mark Owners Association Limited, their representative in these proceedings.

Mr Groom puts the opponents' case in the following terms:

35 "The Opponents' attention was drawn to an application for ODPO when it was advertised in the Trade Marks Journal and the express concern is that ODP is an industry term meaning "ozone depletion potential" and O would mean zero. They were concerned that this mark, if registered would inhibit their ordinary use of the term ODP with the word ZERO or the cypher 0 indicating zero.

40 The Opponents provided literature from a firm called Kingspan dated May 1996 which makes reference to "Zero Ozone Depletion Potential". Exhibited hereto and marked JAG1 is a sample of the Kingspan literature and reference is made to the use of the term "Zero Ozone Depletion Potential".

45 The Opponents provided us with names and addresses of companies involved in the manufacture of insulating material. A letter was sent to these and exhibited hereto and marked JAG2 is a specimen letter. Exhibit hereto and marked JAG3 are copies of the

replies received. The reply received from Thanex (UK) Limited makes specific reference to the fact that they have used ODP as a generic term for approximately seven years. All the other responses clearly indicate that the term ODP or ODPO or ODP ZERO is generally used in the trade and is particularly descriptive of insulating board and types of building materials which indicate that the products contain material that does not harm the ozone layer.”

Applicants' evidence

10 The applicants filed a statutory declaration dated 10 September 1997 by Gordon Pirret, the Managing Director of Callenders Ltd which is a wholly owned subsidiary of George M Callenders Ltd. He has been associated with the company since 1982.

15 Mr Pirret says that his company manufactures and sells a comprehensive range of roofing products. His company has recently introduced a range of Chlorofluorocarbon (CFC) and Hydrochlorofluorocarbon (HCFC) free roof insulation boards and systems. These are sold inter alia under the trade mark ODPO.

20 Commenting on Mr Groom's declaration he says

25 “I have read the Statutory Declaration of John Alexander Groom which has been filed on behalf of the opponents in these proceedings. I note that Mr Groom fails to mention, either in paragraph 2 of his Declaration or elsewhere in his evidence, that his clients, the opponents, were themselves seeking to register ODP as a trade mark as at the date these proceedings were commenced. It is a significant omission because the opponents' alleged rights in the “trade mark” ODP as applied for under No. 1585819 are among the grounds given in the opponents' notice of opposition. The evidence shows that the fact of the opponents' earlier application was not disclosed to the companies contacted by the opponents. Indeed, the specimen letter exhibited as JAG2 states that “the opposition is based on the fact that D. Anderson consider ODP to be a generic term within the industry.”

35 I should say in passing that No 1585819 referred to above was an application at the time these proceedings commenced but has since progressed to registration.

40 Mr Pirret goes on to say that the applicants are not seeking to register ODP as a trade mark or to prevent others from using it. He says that the applicants do not deny that “Ozone Depletion Potential” is a known term in the industry and points out that these words are a feature of the applicants' registered trade mark No 2000432, the use of which is illustrated in the company's brochure exhibited at GP1.

He adds that

45 “The Applicants are seeking to register the word ODPO which contains a clever allusion to the fact that insulation products with no capacity for ozone depletion are involved. There is no reason to suppose that this trade mark will, when used normally and fairly, inhibit other traders from using a bona fide description. None of the

materials exhibited to Mr Groom's Declaration show descriptive use of the word ODPO although the clearest invitation to supply examples of such use was made in the said specimen letter.

5 It is disingenuous of the opponents to suggest that the Applicants' application presents any kind of threat to use of the term ODP and it is simply untrue that the responses exhibited in the evidence indicate that ODPO is generally used in the trade.

10 Moreover, the opponents themselves have recently registered the word ZERO as a trade mark for insulation products and other goods under No. 1585820. Yet the alleged evidence exhibited to Mr Groom's Declaration shows several examples of descriptive use of the word ZERO in relation to insulation materials. If these exhibited materials were a fair test of generic or descriptive use then the opponents' own registered trade mark would be invalidly registered."

15 As a result Mr Pirret submits that the mark applied for is capable of distinguishing the applicants' goods.

That concludes my review of the evidence.

20 The opponents have raised no less than eight separate grounds of objection to this application but I think it will be apparent from the evidence summary that the main issue is the claimed descriptive nature of the mark at issue. This falls to be considered principally under Sections 3(1)(b), (c) and (d). As the opponents have in my view failed to support their other grounds of objection I formally find that the opposition fails under these other heads. In thus dismissing the other grounds of opposition for want of evidence or submissions at a hearing I am conscious of the fact that I have thereby excluded Section 5(2)(b) from my considerations. The latter does not necessarily require evidence for the tribunal to reach a decision. However, as can be seen from the summary of evidence the applicants, in response to the criticisms of their mark, have made a number of comments on the opponents' registrations including the "earlier trade mark" (No 1585819) on which they rely. It is, of course, the case that the opponents' registrations are not under attack in these proceedings. Nevertheless in the light of the issues raised and the decision I have reached below I do not consider it to be either necessary or appropriate to reach a decision on the Section 5(2)(b) ground and I decline to do so.

I now turn to the substance of the case which I regard as being the objections on Sections 3(1)(b), (c) and (d) which read as follows:

- 40 "3.- (1) The following shall not be registered -
- (a),
 - (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,
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quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

- 5 (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:

10 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.

15 I should say at the outset that whilst the applicants say that they have “recently introduced a range of Chlorofluorocarbon (CFC) and Hydrochlorofluorocarbon (HCFC) free roof insulation boards and systems. These are sold inter alia under the trade mark ODPO.” they have not supported or particularised these general statements. The proviso to Section 3(1), does not, therefore, come into play.

20 The applicants have conceded, as I think they were bound to do, that “Ozone Depletion Potential” is a known term in the industry. They have not gone quite so far as admitting that the abbreviation ODP is also in common use in the trade but they do say that “it is disingenuous of the opponents to suggest that the applicants’ application presents any kind of threat to use of the term ODP.” Taken in conjunction with the evidence submitted by the opponents I conclude that ODP is a recognised and commonly used abbreviation to indicate a characteristic of, particularly, insulation products.

25 However the applicants, by way of defence, contend that their mark is not ODP but ODPO. They argue that this is a clever allusion to a characteristic of the products and that ODPO is not generally used in the trade. These propositions need to be tested against the evidence supplied by the opponents. The latter have supplied copies of letters and trade literature from other firms in the insulation industry. Although these have not been accompanied by statutory declarations the evidence has not, it seems to me, been challenged by the applicants. The conclusion I draw from this material (particularly the promotional literature and product data sheets) is that the ODP rating is a significant feature of the sales pitch for insulation products. There is even a suggestion that a zero ODP rating is an industry requirement for accreditation purposes. I note, for instance, that the letter from Tarec UK (in Exhibit JAG3) refers to products within that company’s range which are both CFC and HCFC free and can be classed as having an “ozone depletion potential (ODP) of zero required under the BREEAM to gain a credit.” From the supporting product data sheet I take this to be a reference to a national building regulation standard though it is not explained in the letter itself. More specifically the literature and product data sheets supplied refer variously to

45 “Zero Ozone Depletion Potential”
(Kingspan Insulation)

“ODP = 0”
(Thanex (UK) Ltd)

“Ozone Depletion Potential 0”
(also Thanex (UK) Ltd)

5 “ozone depletion potential (ODP) of zero”
(Tarec UK)

10 “The term ODP is a relative measure using CFC11 as a reference point having a
value of 1”
(Vencel Resil Ltd)

15 I note also that Mr Harper of Celotex Ltd expresses the belief that “the term ODPO or ODP
Zero is already in widespread use by manufacturers of products which previously contained
ozone depleting substances and which are now made with substitutes which have zero ozone
depletion potential.” I treat Mr Harpers’ comments with some caution in so far as they are not
made in a statutory declaration and purport to represent the position in the industry but
without supporting corroborative material. Nevertheless taken with the other evidence filed
by the opponents it supports the overall view on the significance of a zero ODP rating. I,
therefore, conclude that this is a key feature of products of the kind at issue. It appears from
the material before me that traders use various methods of expressing the fact that their
products offer this feature using the words ozone depletion potential or the letters ODP along
with the word zero or the numeral 0. In my view ODPO would simply be seen as another way
of bringing together meaningful elements to express the same underlying concept. As Mr
Laddie QC (as he was then) said in PROFITMAKER Trade Mark (1994 RPC 613) “The fact
that honest traders have a number of alternative ways of describing a product is no answer to
the criticism of the mark. If it were, then all these other ways could, on the same argument,
also be the subject of registered trade marks. The honest trader should not need to consult the
register to ensure that common descriptive or laudatory words, or not unusual combinations
of them, have been monopolised by others.” Although the nature of the mark before me is
somewhat different I regard these comments as being equally applicable here.

30 In reaching the decision I have I do not lose sight of the fact that ODPO could be pronounced
as if it were made up of (pronounceable) word elements OD and PO rather than letters ODP
and O and that the final O could be seen either as a letter or a numeral. However the
important point in my view is how the mark would represent itself to actual or potential
customers of the goods. The evidence does not deal directly with the nature of the customer
base but, given the technical data supplied, I assume that the products are specified or
purchased by architects, builders, or other technically qualified personnel who are likely to be
familiar with product specifications and the environmental protection features of the products.
I consider that the descriptive significance of ODPO would be reasonably apparent to such
people. In short I have come to the conclusion that the mark offends against Section 3(1)(b),
(c) and (d) and that the opposition, therefore, succeeds under these heads. I am aware that the
Class 19 specification is broadly based and may include items for which ODPO does not carry
descriptive significance . However no restriction of the specification has been put forward to
avoid the objections that have been raised. As the applicants’ own evidence suggests that their
area of interest is building insulation it is unsurprising that they have not sought to proceed for
a more limited range of goods.

As the opponents have been successful in these proceedings I order the applicants to pay them the sum of £635 as a contribution towards their costs.

Dated this 15th day of May 1998

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M REYNOLDS
For the Registrar
the Comptroller-General