

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION FOR
REGISTRATION NO. 1552223
BY DURAMAX INC**

AND

**OPPOSITION NO. 43049 BY H & R JOHNSON
TILES LIMITED**

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION FOR
REGISTRATION NO. 1552223
BY DURAMAX INC**

5

AND

**OPPOSITION NO. 43049
BY H & R JOHNSON TILES LIMITED**

10

BACKGROUND

15

Under No. 1552223 Duramax Inc of Middlefield Ohio, United States of America have sought to register the trade mark JOHNSONITE COLORMATCH in respect of:

20

Adhesives comprising waterproof mastic resins and epoxy compounds.

The application was made under the provisions of the Trade Marks Act 1938 (as amended) but was subsequently converted to one under the Trade Marks Act 1994 under the provisions of Schedule 3 paragraph 11(1) of that Act. Thus it has a date of application of 31 October 1994.

25

The application was accepted and published by the Trade Marks Registry and on 31 August 1995 H & R Johnson Tiles Ltd filed a Notice of Opposition to the application. The grounds of opposition are, in summary, as follows:-

30

(i) under the provisions of Section 5(2)(b) because the trade mark the subject of the application is similar to the opponents earlier trade mark such that there exists a likelihood of confusion on the part of the public

35

(ii) under the provisions of Section 5(3) as the applicants trade mark is similar to the opponents earlier trade mark such that in view of the reputation of the opponents in that earlier trade mark, use by the applicants of their trade mark will take unfair advantage of and be detrimental to the distinctive character and reputation of their trade mark

40

(iii) under Section 5(4)(a) because of the opponents earlier rights in the trade mark JOHNSON such that the applicants would be liable to be prevented from using their trade mark by the law of passing off.

45

The opponents earlier trade mark is recorded as follows:

<u>No.</u>	<u>Trade Mark</u>	<u>Class</u>	<u>Goods</u>
1214540	JOHNSON	19	Ceramic tiles.

5 The applicants for registration either deny or do not admit the grounds of opposition.

Both sides seek their costs.

10 Both sides filed evidence in these proceedings and the matter came to be heard on 6 July 1999 when the applicants were represented by Mr Martin Krause of Haseltine Lake Trademarks and the opponents by Mr Stephen Kinsey, Wildbore & Gibbons. Just prior to the Hearing the applicants amended their specification of the application by the addition of the following phrase 'but not including adhesives for ceramic tiles'. It is against that more limited specification that my considerations and decision applies.

15 **OPPONENTS' EVIDENCE**

This consists of a Statutory Declaration by Mr Martin Keith Payne, the Finance Director of H & R Johnson Tiles Ltd, the opponents.

20 Mr Payne states that the trade mark JOHNSON has been used in the United Kingdom by the opponents and its predecessors in title since 1901. It is the company's house mark and is often referred to as JOHNSON Tiles, for example. The trade mark is used in relation to ceramic tiles and related to products, turnover in respect of these goods in the United Kingdom in 1994 was £45million.

30 Mr Payne goes on to state that in his view the specification of goods covered by the application in suit, is such that it is likely that confusion as between the applicants trade mark and that of the opponents will occur. He produces a photocopy of literature obtained from the United States of America in relation to the full range of the applicants products which, he says, shows that although their products are rubber or vinyl (and adhesives for such), they include tiles (for floors, stairways etc.) and accessories, all of which are likely to be sold through the same trade channels as the goods of the opponent.

35 **APPLICANTS' EVIDENCE**

This consists of a Statutory Declaration by Mr Raymond T. Warner, dated ??? the Executive Vice President of Duramax Inc.

40 Mr Warner states that the Johnsonite Division of the applicants makes a variety of products for the flooring systems market including adhesives, vinyl and rubber tiles and sheet floor coverings, under floor suspension pads, bumper guards, cove base and cove base end strips, stair treads, stringing material and edging strips, rubber landing mats, caulking compounds and the like. The trade mark JOHNSONITE has been used on all of those products and registered
45 in the United States, Brazil, the Benelux countries, Canada, France, Germany, Italy, Japan, South Korea, Morocco and Mexico. The applicant, says Mr Warner, has never made ceramic tiles and has no intention of doing so in the future.

Mr Warner further states that the opponent, H & R Johnson Tiles Limited applied to register the trade mark JOHNSON in Class 19 for ceramic tiles on 30 March 1993 at the United States Patent and Trade Mark Office and he exhibits a certified copy of that registration. He notes that in order to register that trade mark the opponents filed a declaration attesting to use of the JOHNSON trade mark in the United States since at least 1950, and he exhibits a certified copy of the file history of the United States registration in support of that. As far as Mr Warner is aware there has never been one instance of confusion in the market place between any products bearing the name JOHNSITE the trade mark of H & R Johnson Tiles Limited. He goes on to provide the gross worldwide sales figures for Johnsonite Flooring System Products together with brochures which show the products produced and sold by the Johnsonite Division of the applicant. None of these products are, he states, ceramic tiles.

Finally, Mr Warner states that COLORMATCH is a trade mark of Duramax Inc. which is the subject of a United States registration. He notes that there has never been any suggestion that there has ever been any confusion between the trade mark COLORMATCH and any other trade mark.

OPPONENTS' EVIDENCE IN REPLY

This consists of a Statutory Declaration by Marina Stephanides and dated 23 January 1998. Marina Stephanides states that she is a designer employed by University College, London and that as part of her duties she designs the interiors for buildings belonging to the University that are to be refurbished. The information contained within the declaration is from her own knowledge and she is authorised to make the declaration on behalf of the University.

Marina Stephanides states that as part of her duties as a designer she specifies the materials to be used to decorate and refurbish the interiors of buildings. She is well aware of the substantial reputation and goodwill that the opponents have established in the trade marks H & R JOHNSON and JOHNSON in relation to ceramic tiles and flooring products in the United Kingdom and worldwide. She herself has specified the opponents' ceramic tiles under those trade marks for use in a number of refurbishment projects and in particular for use around sinks and washbasins within student rooms and for flooring upon stairways within student residences.

Marina Stephanides goes on to state that she is aware that the applicants have sought to register the trade marks JOHNSONITE and JOHNSONITE COLORMATCH in relation to a range of rubber based flooring products and adhesives for use in relation to such products. She believes that there is a strong likelihood of confusion between the applicants' trade marks and those of the opponents. This might occur when designers such as herself specify flooring and wall products and adhesives for use with these goods for the decoration of the interiors for new and the refurbishment of old buildings, also, she believes that there is a danger that designers may believe, in view of the closeness of the respective trade marks, that the applicants' products are in some way connected or produced by the opponents (perhaps a new rubber flooring product as an extension to their current range of ceramic tiles and flooring products). This may lead designers to specify the products of the applicants. Finally, she comments in some detail on the similarity of the respective trade marks.

Mr David Charles Watkins a Director of O S E L Architecture Limited, which provide services of architects to clients, has filed a Statutory Declaration dated 23 January 1998. Like the previous declarant, he believes that there is a likelihood of confusion as between the applicants and the opponents trade marks because of the latter's reputation within the building industry and amongst architects and architectural technicians such that professional architects and architectural technicians might specify the applicants products in mistake for the opponents. Alternatively, they may believe that the applicants products are in some way associated with the opponents. He too comments upon the similarity of the trade marks.

Mr Martin Keith Payne, the Finance Director of H & R Johnson Tiles Limited, the opponents, also provides a further Statutory Declaration, dated 30 March 1998 in which he states first of all that it is not surprising, as suggested by Mr Warner in his Statutory Declaration, that there has not been an instance of confusion in the market place between the respective parties trade marks and products. He is not aware of any use by the applicants of their trade mark in the United Kingdom. Insofar as confusion as between the respective products in other markets is concerned Mr Payne states that his company does not sell ceramic tiles under the trade marks JOHNSON and H & R JOHNSON in the United States of America or Canada, what they have sold in these countries is encaustic ceramic tiles for use in public buildings such as state and federal buildings ie. courts and civic halls. These are tiles produced by a special process and currently the opponents are the only company producing these in the world. The situation is completely different within the United Kingdom where the opponent sells encaustic ceramic tiles and ceramic tiles under both the JOHNSON and H & R JOHNSON trade marks, as well as other products. Mr Payne goes on to provide details of the company's turnover and advertising spend.

Mr Payne considers that the applicants' trade mark JOHNSONITE COLORMATCH is similar to his company's trade marks and he exhibits a number of items of promotional literature which set out the products produced by the opponent which he believes show that the goods covered by the applicants' application are similar in terms eg mastic resins, epoxy compounds, all being adhesives, can be used with ceramic and other floor coverings. From his own knowledge he is able to confirm that retailers tend to sell adhesives alongside the ceramic tiles or rubber and vinyl flooring products with which they are to be used, thus the same trade channels are used by both the applicants and the opponents.

At the start of the Hearing Mr Krause on behalf of the applicants applied to have additional evidence admitted into the proceedings under the provisions of Rule 13(2) of the Trade Marks Rules. The opponents, through Mr Kinsey, indicated that they had no objection to this evidence being admitted and would not seek an adjournment to file any evidence in reply. In those circumstances, and despite the fact that I was not wholly satisfied that the criteria set out by Mr Justice Laddie in Swiss Miss [reference] were met, I admitted this late evidence.

This evidence consists of a Statutory Declaration dated 6 May 1999 by Mr James Clifford Setchell a Trade Mark Attorney employed by the applicants Trade Mark Agents, Haseltine Lake Trademarks. This covers the copy of a Statutory Declaration dated 13 April 1999 and filed with the Trade Marks Registry in other proceedings between the parties. The copy Declaration and its exhibits seek to show that the word Johnson (and its derivations) is a well known surname and a name which is used by many businesses.

That concludes my summary of the evidence filed insofar as it is relevant.

DECISION

5 The first ground of opposition is based upon Section 5(2) which states:

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

- 10 (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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,
- 15 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

An earlier right is defined in Section 6(1)(a) which states:

20 "6.-(1)

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,"
- 25

First of all I consider the matter on the basis of the approach adopted by the European Court of Justice in *SABEL v PUMA* 1998 RPC 199 where they considered the meaning of Article 4(1)(b) of the Directive (104/89) which corresponds to Section 5(2) and stated that:

30

"... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion “depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified”. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

35

That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - “... there exists a likelihood of confusion on the part of the public...” - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details”.

40

45

I also have regard to CANON KABUSHIKI KAISHA v METRO GOLDWYN MEYER INC [reference] which also dealt with Article 4(1)(b) and the relationship between the nature of the respective trade marks and the similarity of the respective goods and services. It was stated:

5 "A global assessment of the likelihood of confusion implies some interdependence
between the relevant factors, and in particular a similarity between the trade marks and
between these goods or services. Accordingly, a lesser degree of similarity between
10 these goods or services may be offset by a greater degree of similarity between the
marks, and vice versa. The interdependence of these factors is expressly mentioned in
the tenth recital of the preamble of the Directive, which states that it is indispensable to
give an interpretation of the concept of similarity in relation to the likelihood of
confusion, the appreciation of which depends, in particular, on the recognition of the
trade mark on the market and the degree of similarity between the mark and the sign
and between the goods or services identified."

15 It also stated:

20 "On a proper construction of Article 4(1)(b) of the Directive, and distinctive character
of the earlier trade mark, and in particular its reputation, must be taken into account
when determining whether the similarity between the goods or services covered by the
two trade marks is sufficient to give rise to the likelihood of confusion."

25 Before considering the matter globally I compare the goods covered by the application in suit
(as restricted) and those of the earlier registration. For general guidance on the matter of the
comparison of goods I consider the guidance set out by Jacob J in TREAT [1996] RPC 281
namely:

- (a) the respective uses of the goods
- 30 (b) the respective users of the respective goods
- (c) the physical nature of the goods
- (d) the respective channels of trade.

35 The opponents' goods are ceramic tiles, the applicants are adhesives (but not for use with
ceramic tiles). The former are used as decorative floor and wall coverings and the latter for
securing one surface to another, their uses are therefore different. The users of one may be
users of the other but that must be a matter of coincidence.

40 The best that could be said is that tiles need some sort of adhesive to affix them to the wall or
to the floor they are intended to decorate. However, there is no evidence that producers of one
produce the other and therefore that the purchasers would associate one with the other. In this
45 case the applicants' goods are not for use with ceramic tiles and therefore the users are not
likely to be the same, other than as I have already said, as a matter of coincidence.

The physical nature of the goods is obviously different as are the channels of trade - though they might both be sold in the same retail outlet eg DIY stores. It is not apparent to me therefore that the goods are in any way similar.

5 The respective trade marks are as follows:

APPLICANTS

OPPONENTS

10 **JOHNSONITE COLORMATCH**

JOHNSON

15 The first word of the applicants trade mark includes the whole of the opponents earlier trade mark together with the letters ITE. The introduction of that third syllable does not in my view change the nature, appearance or sound of that element sufficiently, in my view, to say with any confidence that members of the public would not associate the opponents trade mark with that of the applicants. I am not persuaded that the addition of the second element in the applicants trade mark, COLORMATCH, is one which is of sufficiently distinctive character in its own right to reduce the likelihood of confusion resulting from association. This is because the term COLORMATCH could be seen as a descriptive one ie the adhesive comes in various colours to match that of the materials to be affixed together.

20 Having considered the individual elements which go to make up the tests I consider the matter from the global perspective. The respective goods are in my view different and are not associated in any way with each other. On the other hand the respective trade marks are similar. But the similarity of the trade marks is not such as to offset the difference between the goods to the point where the public are likely to be confused as to the origin of the respective goods. The ground of opposition based upon Section 5(2) therefore fails.

25 I go on to consider the grounds of opposition based upon Section 5(3) of the Act which states:

30 "5.-(3) A trade mark which -

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

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

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

40 First of all I am prepared to accept that the opponents have a reputation in their JOHNSON trade mark in respect of ceramic tiles. But this is solely because of the size of the turnover given. This just about overcomes the complete absence of any information about the market for ceramic tiles or the opponents' position in it; the lack of independent evidence in depth of the recognition by the relevant public of the opponents' reputation. I do however give weight to the sum of £45m in terms of turnover which is substantial by any standard and therefore on

the basis that 'size is important' accept their reputation in relation to ceramic tiles. As for demonstrating that registration of the applicants trade mark is likely to take advantage of or be detrimental to the repute of the opponents trade mark the factors to be considered are set out in AUDI MED [1998] RPC 863. I do not list them because I do not consider that I have been given any evidence which supports the allegation. The fact that the opponents have a reputation in their trade mark JOHNSON and the opponents are seeking to register JOHNSONITE COLORMATCH in respect of dissimilar goods is not sufficient. The trade mark systems worldwide protects the same or similar trade marks covering different goods and services in different ownerships. Any opponent who seeks to use Section 5(3) in order to persuade the Register to refuse the application must do so by showing that notwithstanding this there are factors surrounding their trade mark, the market in which they operate and the likely effect of the applicants' trade mark on it, such that their position is positively being taken advantage of (to their disadvantage). There is no such case made here and therefore the grounds of opposition based upon Section 5(3) is dismissed.

I turn to the grounds of opposition based upon Section 5(4)(a) which states:

"5.-(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 -

(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, or"

In WILD CHILD [1998] RPC 455, Mr Geoffrey Hobbs QC acting as the Appointed Person set out the considerations to be applied under this ground of opposition:

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd v Borden Inc [1990] RPC 341 and Erven Warnink BV v J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

The restatement of the elements of passing off in the form of this classical trinity has

5 been preferred as providing greater assistance in analysis and decision than the
formulation of the elements of the action previously expressed by the House. This
latest statement, like the House's previous statement, should not, however, be treated as
akin to a statutory definition of 'passing off', and in particular should not be used to
exclude from the ambit of the tort recognised forms of the action for passing off which
were not under consideration on the facts before the House."

10 Further guidance is given in paragraphs 184 to 188 of the same volume with regard to
establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with
footnotes omitted) that:

15 "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:

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

25 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.

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

- 35 (ii) the nature and extent of the reputation relied upon;
- (ii) the closeness or otherwise of the respective fields of activity in which the
plaintiff and the defendant carry on business;
- (ii) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (ii) the manner in which the defendant makes use of the name, mark etc complained
of and collateral factors; and
- 40 (ii) 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.

45 [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."]

As indicated earlier I am prepared to accept that the opponents have a reputation in respect of ceramic tiles and that these are sold under the JOHNSON trade mark. The applicants are seeking to register and use their JOHNSONITE COLORMATCH trade mark on adhesives, but not adhesives for ceramic tiles. The tiles will of course require an adhesive, but I have no
5 reason to believe that the public would expect one product to be associated in any way with the other - there is no evidence provided that this could be the case or that it is usual for a manufacturer of tiles, in particular, to manufacture also the adhesive for fixing them. In this case the applicant does not seek protection for adhesives for ceramic tiles and is therefore in my view operating in a field that is at some distance from that of the opponent.

10 I have already held that the trade marks are similar. It may well be also that the applicants and the opponents are in related business as (tiles made from ceramics and tiles of rubber and vinyl) but in relation to the goods covered by this application the applicants are in a different field to that in which the opponents have a reputation. I do not see that the opponents will suffer any
15 damage by the use by the applicants of their trade mark. In that regard I do not ignore the evidence of Marina Stephanides and David Watkins but in my view the statements refer to the fact that architects and designers specify tiles, but they do not, from what I have read, also specify the adhesive to be used to fix them. It does not therefore add anything to the considerations here.

20 In all of the circumstances, I hold that the opposition based upon Section 5(4)(a) fails.

As the applicants have been successful I order the opponents to pay to them the sum of £500

25 **Dated this 27 day of August 1999**

30

35 **M KNIGHT**
Head of Inter Partes Proceedings
For the Registrar
The Comptroller General