

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 12413
BY MASTERFRAME WINDOWS LIMITED
FOR A DECLARATION OF INVALIDITY IN RESPECT
OF TRADE MARK No. 1524198 IN THE NAME OF
PREMDOR CROSBY LIMITED**

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by Masterframe Windows Limited for
a Declaration of Invalidity in respect of
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Premdor Crosby Limited**

BACKGROUND

1. Trade Mark No. 1524198 is for the mark HERITAGE and is registered in Class 19 for the following specification of goods:

“Windows and window frames; parts and fittings for all the aforesaid goods; all included in Class 19; but not including glass for windows”.

2. The mark stands registered from the filing date of 18 January 1993.

3. On 14 March 2001 Masterframe Windows Limited applied for the invalidation of the trade mark registration under Section 47(1) of the Act on the following grounds:

- (i) it is registered in breach of Section 3(1)(b) and is devoid of distinctive character as the mark denotes windows or window frames built to a design or style of a previous age;
- (ii) it is registered in breach of Section 3(1)(c) as it consists exclusively of signs or indications which may serve, in trade, to designate the kind, intended purpose or other characteristic of the goods as the mark denotes windows or window frames built to a design or style of a previous age;
- (iii) it is registered in breach of Section 3(1)(d) as it consists exclusively of signs or indication which are customary in the current language or in the bona fide and established practices of the trade as the term HERITAGE is commonly used by competitor undertakings to denote building materials and windows to a design or style of a previous age.

4. The registered proprietor filed a Counterstatement denying the grounds of invalidity. The applicant filed evidence and both sides have requested an award of costs in their favour. Neither party requested a hearing.

APPLICANT’S EVIDENCE

5. This consists of a statutory declaration by Alan Burgess dated 27 September 2001. Mr Burgess is the Managing Director of Masterframe Windows Limited (the applicant), a

position he has held since 1991. Mr Burgess adds that he had been involved in the replacement window business since 1972.

6. By way of background to the invalidation action, Mr Burgess explains that his company's application to register the mark THE HERITAGE COLLECTION BY MASTERFRAME has had the registration in suit cited against it by the Registry.

7. Mr Burgess states that the mark in suit was invalidly registered for the following reasons:

- A) The word HERITAGE is commonplace and is well understood by the public at large. Dictionary definitions (provided at Exhibit AB1 to Mr Burgess' declaration) show that Collin's English Dictionary defines HERITAGE as "anything that has been transmitted from the past or handed down by tradition", Websters Revised Dictionary defines HERITAGE as "practices that are handed down from the past by tradition; any acquisition from past generations", Chambers Dictionary defines HERITAGE as "anything transmitted from ancestors or past ages", and The Shorter Oxford English Dictionary defines HERITAGE as "that which has been or may be inherited".
- B) Mr Burgess' internet searches for the words HERITAGE WINDOWS produced 234,000 hits, a great number from firms offering to supply traditional sliding sash windows under the name HERITAGE, and a search for the words HERITAGE SASH WINDOWS produced 2,780 hits and by adding in UK some 6,700 hits. Exhibit AB2 to Mr Burgess' declaration comprise print-outs taken from internet hits and also copies of advertisements taken from magazines, showing use of HERITAGE in relation to windows and some use in relation to doors, by third parties.
- C) The word HERITAGE is commonly used by many window supply companies as a style indicator for windows of a traditional style, namely sliding sash windows.
- D) The internet searches lead Mr Burgess to believe that HERITAGE is also used to describe traditional window styles used in conservation areas. In support of this contention, Exhibition AB3 to Mr Burgess' declaration contains copies taken from web sites eg in a sheet headed "Sheerframe" the company LB Plastics refers to "the suitability of PVC windows for heritage locations" other examples showing use in relation to heritage values and heritage planners are provided. Also, Exhibit AB3 contains a print-out from the internet site of a company called HERITAGE WINDOW AND DOOR in the U.S.A.
- E) Mr Burgess states that there are many examples of businesses using HERITAGE to denote traditional sash windows. At Exhibit AB4 to his declaration is a list of companies which include HERITAGE within their company name, all of which operate in the field of construction and home improvement. Mr Burgess adds that as there are at least nineteen companies offering construction and home improvement services under the name

HERITAGE, the mark consists exclusively of a sign which has become customary in the current language and in the bona fide and established practices of the window trade.

8. This completes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

9. The relevant parts of Section 3(1) of the Act read as follows:

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, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

10. In the present case I must consider whether, on a prima facie basis, the mark in suit meets the requirements of Section 3(1)(b), (c) and (d) of the Act. The proprietor has not submitted nor provided evidence that its mark has acquired a distinctive character as a result of the use made of it.

11. Section 72 of the Act is also relevant to these proceedings. It states:

“72. In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission or it.”

12. Accordingly, the onus is upon the applicant to show that at the relevant date (18 January 1993) the mark in suit was registered in breach of Section 3(1).

13. I now turn to a consideration of the evidence filed on behalf of the applicant for invalidation. Much of this evidence relates to information accessed from the internet and contains information relating to the position well after the relevant date for these proceedings.

Furthermore, much of this internet material relates to use outside the UK, in particular use in the U.S.A. eg Heritage Window and Door, Heritage Exteriors and Heritage Sliding Windows. This is not relevant to UK jurisdiction. It also appears to illustrate trade mark use by third parties in many instances, and there is no independent or third party evidence filed in support of the application. Nevertheless, the evidence contains items to which weight should be given and I will take this into account in reaching my decision.

14. I propose to consider this case in the light of the 20 September 2001 judgement of the European Court of Justice in *Proctor & Gamble Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case - 383/99P for the mark Baby Dry. This judgement gives very useful guidance on the test for descriptiveness under Section 3(1)(c) of the Act.

15. I give below paragraphs 37, 39 and 40 of the judgement in full:

“37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indication as trade marks is, as both Proctor & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indication which, because they are not different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.”

“39. The signs and indication referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indication satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way or designating the goods or services concerned or their essential characteristics.”

“40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services of their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

16. These paragraphs indicate that only marks which are no different from the usual way of designating the relevant goods or services or their characteristics are now debarred from registration by Section 3(1)(c).

17. The mark in suit is HERITAGE and comprises an obvious dictionary word whose definitions are provided in Mr Burgess' evidence. In the applicant's submissions the mark describes windows and window frames of a traditional type or nature, especially sliding sash windows, and is also used to describe traditional window styles in conservation areas.

18. I have already aired my criticisms of the applicant's supporting evidence - paragraph 13 of this decision refers. However, for the sake of completeness I would add that the evidence supplied by the applicant to substantiate the claim that HERITAGE describes traditional window styles, including traditional window styles in conservation areas (Exhibits AB2 and AB3 to Mr Burgess' declaration), as well as being after the relevant date, may merely indicate trade mark use by third parties or show that some styles of PVC windows may be suited to conservation areas or heritage projects. It does not follow that the word HERITAGE has a particular reference in trade to the kind, quality, purpose or other characteristic of the goods. Indeed, it seems to me that HERITAGE would form a very imprecise indication in relation to the goods whose natural descriptions would be eg "sash", "georgian" or "bowed". I conclude that the application for invalidation fails under Section 3(1)(c).

19. I go on to consider the Section 3(1)(b) ground taking into account the guidance set out in the decision of Geoffrey Hobbs QC sitting as the Appointed Person in *Cycling Is ...* [2002] RPC 37. In particular, I find paragraphs 66 to 71 of that decision, set out below, to be of particular assistance:

"66. That brings me to the question of whether the signs possess a distinctive character enabling them to fulfil the essential function of a trade mark in relation to goods and services of the kind specified in the application for registration. (The goods and services comprise "clothing footwear and headgear" in Class 25 and "advertising all relating to the cycling industry" in Class 35).

67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.

69. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral.

70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.

71. I do not suppose that such a person would pause to construe the signs when encountering them in any of the different settings (including advertising and promotional settings) in which they might be used. Even so, the degree of attention required to take note of the signs in the first place would be sufficient, in my view, to leave a well-informed and reasonably observant and circumspect person with the clear impression that the signs were being used with reference to goods and services related to cycling.”

20. In light of the above guidance I do not consider that the applicant has any stronger case under Section 3(1)(b) than under Section 3(1)(c). As stated previously, I believe the word HERITAGE to be an imprecise indication in relation to the goods and as such, I consider the word is likely to be perceived as being origin specific in the mind of the average customer ie the window and door trade and the general public. I find that the mark meets the requirements of Section 3(1)(b) of the Act.

21. Finally, I turn to the Section 3(1)(d) ground. In relation to this ground the applicant has also included evidence showing a list of nineteen companies, in the building services trade, whose name includes the word HERITAGE (Exhibit AB4 to Mr Burgess’ declaration). Mr Burgess submits that as there are so many companies offering construction and home improvement services under the name HERITAGE the mark consists exclusively of a sign which has become customary in the current language and in the bona fide and established practices of the window trade. I disagree. A company name is intended to be origin specific and the fact that a number of companies incorporate a word in their name, or even share the same word as their name, is far from conclusive in showing that the word is unable to function as a trade mark. In light of this and my earlier findings, the applicant cannot succeed under Section 3(1)(d).

22. I conclude that the application for invalidation under Section 47(1) of the Act fails. The applicant has not discharged the onus of showing that the mark was registered in breach of Section 3(1)(b), 3(1)(c) or 3(1)(d) of the Act.

COSTS

23. The registered proprietor is entitled to a contribution towards its costs. I order the applicant to pay the registered proprietor the sum of £750. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31st day of October 2002

JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General