

O-032-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2444469
IN THE NAME OF SOLID FLOOR LIMITED
TO REGISTER THE TRADE MARK
SOLID FLOOR IN CLASSES 19 AND 37**

AND

**OPPOSITION THERETO UNDER NO. 95416
IN THE NAME OF FETIM B.V.**

Trade Marks Act 1994

**IN THE MATTER OF Application No. 2444469
in the name of Solid Floor Limited
to register the trade mark Solid Floor
in Classes 19 and 37**

and

**Opposition thereto under No. 95416
in the name of Fetim B.V.**

BACKGROUND

1. 23 January 2007, Solid Floor Limited made an application to register the trade mark SOLID FLOOR in Classes 19 and 37 in respect of the following specifications of goods and services:

Class 19 Solid wood flooring; wooden parquet flooring.

Class 37 Installation of wood flooring.

2. On 13 August 2007, Fetim BV filed notice of opposition to the application, the grounds of opposition, in summary, being as follows:

- “1. The mark SOLID FLOOR, applied for in respect of "solid wood flooring; wooden parquet flooring; installation of wood flooring", offends against subsections 3(1)(a) and/or 3(1)(b) and/or 3(1)(c) and/or 3(1)(d) of the Act.
2. The word "solid" has meanings such as "of stable shape", "of such material throughout", "of strong material or construction or build", "sound or reliable or real" and "floor" means "lower surface of room" and "boards etc of the lower surface of room".
3. It therefore follows that the combination of the two words SOLID and FLOOR produces a wholly descriptive expression which should be freely available to all, and which is devoid of any distinctive character; it is not capable of distinguishing goods and services of one undertaking from those of another. The expression designates the kind and/or quality of the flooring, and in relation to the services applied for, is descriptive of the services of installation of solid floors made of wood.
4. The specification of goods for the mark applied for includes the expression "solid wood flooring"; as "flooring" can be synonymous with "floor", the mark applied for in effect repeats part of the specification of goods, but without the modifier "wood".

5. Furthermore the expression solid floor is an indication that is customary in the current language of the flooring trade. By way of example there appears in Annex 1 copies of the following:

Details from the website of Türgon, in which, in relation to wood floors, it is clear that solid floor is utilised as description.

Details from Environmental Design 6th edition which appears to be a Building Regulations Approved document. In this, solid floor appears as a key word.

In the Wooden Flooring Sales website there are references to installing a solid floor.

The website of Jordan's Wood Flooring Warehouse makes reference to solid floor.

A page from the Channel 4 website, referring to flooring makes reference to solid floor.

The above examples show that solid floor is a clearly recognised description in the flooring field.

6. The records of the Trade Marks Registry say that the application is proceeding because of distinctiveness acquired through use. It appears that the evidence relied upon in allowing acceptance of this application was that submitted in connection with application (now registration) 2390415 which was for SOLID floor (Special Form) (Series of Two Marks). It does not appear that any evidence was submitted by the applicant specifically directed to this present application.
7. The applicant (via their trade mark attorneys) has been requested to withdraw the application but has failed to do so.”

3. The applicants filed a counterstatement in which they admit the meaning of the words “SOLID” and “FLOOR” as stated to exist in Collins English Dictionary, and that they were contacted by the opponents who requested the withdrawal of the application, but otherwise deny the grounds on which the opposition is based.

4. Both sides filed evidence in these proceedings which insofar as it may be relevant I have summarised below. The matter came to be heard on 26/27 November 2009, when the Applicants were represented by Mr Nicholas Saunders of Counsel, instructed by The Trademark Café Limited, their trade mark attorneys. The opponents were represented by Mr Michael Edenborough of Counsel, instructed by Mewburn Ellis LLP, their trade mark attorneys.

Opponent's evidence in chief

5. This consists of five Witness Statements. The first is dated 20 February 2008, and come from Michael Gregory Foster, a Trade Mark Attorney with Mewburn Ellis LLP and the opponent's representatives in these proceedings.

6. Mr Foster refers to Exhibit MGF1, which consists of a copy of the official application file to register SOLID FLOOR, the mark in suit. He makes particular reference to two paragraphs from the examination report. The first raises objections under Sections 3(1)(b) and 3(1)(c) of the Act based on the mark being considered a sign designating goods and services relating to solid floors. The second notes the existence of trade mark No 2390415 (also for the words SOLID FLOOR but in a logo or stylised form) owned by the applicants that had proceeded on the basis of acquired distinctiveness) and agreeing to copy the evidence across so that the application in suit can proceed on the same basis. Mr Foster notes that only one Witness Statement and no exhibits were copied to the later file.

7. Exhibit MGF2 consists of a copy of the official application file for 2390415, Mr Foster making reference to the fact that this application to register SOLID FLOOR as a series of two marks had also attracted objections under Sections 3(1)(b) and 3(1)(c) of the Act. He refers to a paragraph from the ex-parte hearing report in which the Hearing Officer stated that he agreed that the term "SOLID FLOOR" was more normally associated (though not exclusively) with concrete floors as opposed to wooden flooring and that the stylisation [sic] in the mark could not be completely ignored. Based on this the Hearing Officer deemed the mark to be "on the wrong side of the line" for *prima facie* acceptance, but when considering the evidence in more detail agreed that it was "just sufficient" but that the specification would need to be limited accordingly. Based on this Mr Foster draws the conclusions that SOLID FLOOR can be associated with wooden flooring; the stylisation added distinctiveness and that the evidence justified the acceptance of the stylised version.

8. Mr Foster next refers to details of the applicant's company taken from the Companies House website which he shows as Exhibit MGF3. He draws attention to the fact that the applicants had been incorporated on 4 December 1996 under the name Solid Developments Limited, changing to its current name on 22 February 2000. He highlights an apparent discrepancy in the Witness Statement of Eelke Jan Bles dated 5 October 2005 (Exhibit MGF2) in which is said "my company was founded in Amsterdam back in 1990" and "my company" (by inference Solid Floor Limited) having been registered in the UK on 4 December 1996. Whilst not strictly incorrect it would have been clearer if the earlier company (Solid Developments Limited) had been mentioned. I do not see that anything turns on this or that it should impact on my view of the accuracy of the evidence.

9. Mr Foster next goes to the meanings of the words "SOLID" and "FLOOR", Exhibit MGF4 being extracts for these words taken from Collins Dictionary. Attention is drawn to the definition for SOLID as including the statement "a solid substance, such as wood...", and FLOOR meaning "the inner lower surface of a room". Mr Foster goes to Exhibit MGF5 which he says shows that SOLID FLOOR is customary in the current language of the flooring trade". The pages were downloaded on 6 February 2007 which although after the relevant date, is only so by a matter of

two weeks or so, close enough that for it to be reasonable to infer that they show the position from prior to the relevant date. Even if this were not the case, from the copyright dates (2005/6) and the reference to the Building Regulations 2003/4 it is clear that they pre-date the application. These show SOLID FLOOR being used as a description in relation to wood flooring, and as a “keyword” in the Building Regulations. Exhibit MGF6 includes an exhibit from Diamond Floors.co.uk, which under the heading Real Woods advises customers that “Firstly, you must decide whether you require a SOLID floor, or an ENGINEERED floor. A solid floor is, as the name suggests, solid wood.” This exhibit has a copyright statement of 2007 placing this use at, or most likely after the relevant date. Exhibit MGF7 consists of documentation such as Patent Claims, building specifications and a Q&A section of a website, dating from 2002 onwards. The use also shows the description “wood” or “wooden” is also used as in SOLID WOOD[EN] FLOOR. Exhibit MGF8 consists of use of SOLID FLOOR, namely, by SOLIDFLOOR.COM and solidfloors.co.uk, dating from November 2004 to April 2005.

10. The next Witness Statement is dated 21 February 2008 and comes from Bastiaan Smits, an employee of Fetim B.V. from August 1999 to January 2004. Mr Smits says that as a Director of Fetim International Flooring in late 2002/2003 he was in touch with Mr Bles of the English chain of stores “Solidfloor” regarding the sale of various Fetim parquet products to his company. He says that as far as he can remember, in at least one telephone conversation Mr Bles mentioned that Fetim was using the name Solidfloor but that he considered the name belonged to him. He also mentioned Fetim having had a stand at a fair with the name SOLIDFLOOR.

11. Mr Smits recalls that on 11 November 2003 Fetim received a facsimile from Solid Floor Limited regarding Fetim’s products, Exhibit BS1 being a copy of the facsimile and resulting correspondence. The facsimile is on SOLID FLOOR headed paper with the contact details of Solid Floor Limited as the sender and signed by Eelke Jan Bles @ Solid Floor Chiswick. The fax is addressed to Sales @ Fetim and requests a brochure and pricelist. It further says that “For your information Solid Floor is a UK based company with 7 branches...specialised in supply and fit of solid timbers...”. Subsequent e-mails dated 12 and 18 November 2003 respond to the enquiry, SOLID FLOOR being mentioned in an e-mail address, and the name of Solid Floor Limited. Mr Smits says that he understands Mr Bles claims no knowledge that Fetim was using the name for parquet products prior to his filing application, which is not in line with the remarks made to him by Mr Bles.

12. The next Witness Statement is dated 21 February 2008 and comes from Renée Milca Graverde-Looper, a Benelux and European trade mark attorney of Shield Marks B.V. and advisor to Fetim B.V. regarding the opposition. Exhibit RMGdL is a copy of an e-mail dated 21 February 2008 from Peter Mau of Parkett International in response to a request for information regarding the circulation of the magazine. Mr Mau confirms that the magazine is published 3 times a year, and has been for the past four years. He states that the magazine is distributed to the wooden and laminate flooring industry, to trade professionals and dealers, to suppliers of installation materials and accessories. An attachment consists of a “Media Kit 2008”

13. The next Witness Statement is dated 19 February 2008 and comes from Menno Frederik Kronenberg, a Sales Representative with Fetim B.V. since 2001. Mr Frederik says that from 15-18 January 2005 he was present at the Domotex 2005 international trade fair for carpets and floor

coverings as a member of the Fetim B.V. staff. He recounts having met with Mr Bles, saying he particularly remembered the conversation because Mr Bles became agitated when he realised that Fetim was also using the name SOLIDFLOOR. Mr Kronenberg says that Mr Bles informed him that he was also using the name and asked how long Fetim had been using it. The conversation is said to have concluded with Mr Bles giving Mr Kronenberg his business card. Mr Kronenberg says that he told the Fetim marketing people but as far as he is aware no action was taken as Fetim were building up the SOLIDFLOOR name.

The next Witness Statement is dated 21 February 2008 and comes from Anthonius Pieter Wieringa, Director of Commerce of Fetim Professional. Mr Wieringa says that he joined Fetim in 1984 as a salesman and started his present position in 1998. Mr Wieringa says that Fetim started using SOLID FLOOR in the Netherlands in 1996. Exhibits APW1 and APW2 consist of copies of the Fetim company newsletter that he says was sent to approximately 15,000 Dutch clients, and translations into English, respectively. Exhibit APW3 consists of various items such as price lists, dealer lists and a letter to clients. None of these are in English so appear to have been targeted at the Dutch market. Exhibit APW4 consists of items of trade related literature. Exhibit APW5 consists of details related to the registration of “solidfloors.nl”.

Applicant’s evidence

14. This consists of 139 Witness Statements. The first two are both dated 21 May 2008 and come from Laurel Elizabeth McBray, a Trade Mark Attorney with Withers & Rogers. Much of Ms McBray’s first Statement consists of submissions in response to the Witness Statement of Michael Foster on behalf of the opponents which it is neither necessary nor appropriate that I should summarise here. I will therefore focus on any evidence of fact but will take the submissions into account in my decision.

15. Ms McBray says that although the opponents assert that SOLID FLOOR is not capable of distinguishing, as can be seen from Exhibit LEM1 they have, themselves, adopted the trade mark. The exhibit consists of brochures from Fetim Professional, which show “Solidfloor” with the TM symbol. In her second Witness Statement Ms McBray states that she considers the Witness Statements of Bastiaan Smits, Menno Frederik Kronenberg, Anthonius Pieter Wieringa and Renée Milca Graver-de-Looper to consist of no more than opinions and submissions relating to matters in the Netherlands and have no bearing on the issues.

16. The next Witness Statement is dated 15 May 2008 and comes from Eelke Jan Bles, the founder and a Director of Solid Floor Ltd, formerly Solid Developments Limited. The company was incorporated on 4 December 1996 and started trading on 7 March 1997.

17. Mr Bles says that he adopted and started to use the name SOLID FLOOR in Amsterdam in 1994, where he supplied wooden floors, incorporating the company Solid Floor Vennootschap onder firma on 1 January 1994, operating the company until it closed on 1 December 1996. He says that having developed an extensive range of wood flooring he moved permanently to London in 1996. Mr Bles goes on to set out the development of his business in the 11 years in which it has traded under the SOLID FLOOR mark in the UK, stating that turnover rose year on year from £198,000 in 1997-98 to £3,500,000 in 2006-7. For the same period the amount spent

on advertising is said to have risen from £6,000 to a peak of £118,000 in 2003-4 falling back to £98,000 in the final year. Mr Bles introduces Exhibit EJB(2)(1) which consists of pages from his company's website which he says show how the trade mark is used and the products with which it is associated. The print was taken on 21 September 2005 (although bear a copyright mark of 2004-2005) and shows SOLID WOOD being used in connection with wood flooring. Although clearly being used as a business name or trade mark, the pages also refer to "solid wooden floors" in a descriptive sense. The print shows details of eight branches throughout the UK.

18. Mr Bles gives details of the publications in which SOLID FLOOR products have been promoted or been the subject of features, Exhibits EJB(2)2 and EJB(2)3 being examples of the same. The first exhibit consists of extracts from publications aimed at the home and show SOLID FLOOR being used as a sign of origin for wood flooring. A page from a publication entitled Grand Designs contains a feature on European Oak flooring from Solid Floor – and beneath, "TIMBER: A GLOSSARY" listing terms that are used in connection with timber. There is a mention of "floating floor" but nothing for "solid floor". Exhibit EJB(2)3 contains extracts from various "flooring trade" publications such as "Floor Forum", which describes itself as an "International trade journal for import, export, distribution and laying of parquet, laminate, cork flooring and related products (with focus on the UK and Ireland)". This includes a feature on a restaurant project that mentions Solid Floor having supplied oak flooring. Exhibit EJB(2)4 consists of a promotional brochure showing use of SOLID FLOOR in relation to wood and carpet floor coverings.

19. Mr Bles goes on to say that although "SOLID" and "FLOOR" can be used to describe flooring which is made of solid wood, in his experience the terms "solid wood floors" or "solid wooden floors" are the descriptive terms most commonly used. He says that it is also common to insert the type of wood as in "solid white oak floors". Mr Bles then says that SOLID FLOOR has acquired a secondary meaning to members of the public and trade to signify the goods and services of his company. In support of this contention Mr Bles provides 97 Witness Statements as Exhibit EJB(2)5. These primarily come from persons that have, or in the past had commercial contact with Mr Bles or his company. A small number come from persons who had no prior knowledge of the applicant at the time of completing the Statement. The deponents are either from the flooring trade or some allied or connected trade such as architects, interior designers, etc. These are all pro-forma Witness Statements requiring only the completion of the details of the person giving the Statement, their relationship with the applicants and the period that they have known the SOLID FLOOR trade mark. The body of the pre-prepared text reads as follows:

"I know that Solid Floor Ltd. trades in wooden flooring and offers service related to the installation-of wooden flooring, and that it sells these goods and offers these services under the trade mark SOLID FLOOR.

I have known of the SOLID FLOOR trade mark for approximately () years.

In my experience, members of the public who are in the market for superior quality wooden flooring, who could be characterised as well informed, circumspect and observant consumers, recognise the name SOLID FLOOR as

denoting the products and services of Solid Floor Ltd. and have come to rely upon this trade mark to indicate the source of very high quality goods and services.

It is my opinion that if a third party were to use the name SOLID FLOOR or SOLIDFLOOR as a trade mark in the UK to designate the same goods and/or services as provided by Solid Floor Ltd., that this would result in confusion as to the source of those goods/services.”

Opponent’s evidence in reply

20. This consists of two Witness Statements. The first is dated 23 February 2009 and comes from Nathan Silver, an Architect and expert in town planning with over 40 years experience of specifying and using flooring products. Mr Silver says that he has been asked to give his opinion on whether SOLID FLOOR is a recognised expression in relation to wooden flooring and whether it is capable of representing a distinction between the goods and services of a particular trader. Mr Silver acknowledges that he recognises SOLID FLOOR as the name of a shop, Exhibit NS1 being a print from the applicants website. He says that SOLID FLOOR or SOLID FLOORING, often with additional adjectives, is used to describe one of several categories of timber flooring. He goes on to give an outline of the various types including “solid flooring” or “solid wood flooring” which is used to designate flooring made from a solid piece of timber. As Exhibits NS2, NS3 and NS4, Mr Silver highlights some specific examples of the use of “SOLID WOOD FLOORING”, “SOLID WOOD FLOORS”, and Beech/Maple SOLID FLOOR by traders. Mr Silver next gives his views on what SOLID FLOOR would mean to the public, architects and specifiers, stating that it would, without any further adjectives or suffix, be a term of art.

21. The final Witness Statement is dated 19 February 2009 and is a further Statement from Michael Gregory Foster. As evidence in reply it is not surprising that it consists mainly of submissions and whilst it is neither necessary or appropriate to summarise these I will, of course take them fully into account in my determination of the case. In response to Ms McBray’s contention that the requirement is to show that the term SOLID FLOOR was customary in the language of the trade from prior to the relevant date, Mr Foster provides Exhibit MGF9. This consists of a print from an internet archive showing pages captured on 4 February 2005 and 9 April 2006. The first shows the term “Solid” followed by a hyphen and then the word “floors...”. The next line is Semi-Solid in the same style. Clearly the word SOLID denotes wood flooring that is a single piece, whereas “Semi-Solid” describes flooring that has an upper laminate of wood over a substrate. The second page is a help section which gives guidance on “How to install a laminate floor”, “How to install an engineered floor”, “How to install a solid floor...”.

22. In response to the comment on the opponent’s use of Solidfloor and the TM symbol, as Exhibit MGF11 Mr Foster shows examples where the symbol has been used “in situations where the words concerned have little or no distinctiveness in relation to the goods or services concerned.” Mr Foster comments on what he sees as the ambiguity in the statement that there have been no objections to the use of SOLID FLOOR by any other trader in the UK. One possible reason suggested by Mr Foster is that it was seen as use of a term that ought to be free for all to use, it being known for names of companies to be comprised of descriptive terms. In

support Mr Foster provides Exhibit MGF12 which consists of details for The Concrete Block Company Limited and Concrete Floors Limited obtained from the Companies House website.

23. Exhibit MGF13 consists of an extract from the applicant's website, Mr Foster drawing attention to the fact that this only shows three as opposed to eight showrooms. Mr Foster asserts that the evidence from persons with a commercial or business relationship with the applicants is unlikely to be objective. Exhibit MGF 14 consists of an extract from The Trade Marks Handbook relating to independent evidence from the trade. Exhibit MGF15 consists of a decision of a decision from the Court of First Instance which commented on statements provided by parties related to the applicants. The decision concerned a situation where the parties giving evidence were commercially joined to the applicants.

24. That completes my summary of the evidence insofar as it may be relevant to these proceedings.

Decision

25. The opposition was made under Section 3(1) of the Act, and although originally citing subsection (a) this was not subsequently pursued. With this in mind the relevant sections 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.”

26. Before I turn to the grounds on which the opposition is based I will first comment on the opponent's use of Solidfloor as a trade mark which as can be seen from Exhibit LEM1 is in conjunction with the TM symbol. The inference I am invited to draw is that this contradicts the opponent's assertion that SOLID FLOOR is a wholly descriptive expression. Mr Foster sought to differentiate this use from the applicant's mark, stating that “...the word used is Solidfloor as a single word with solid and floor conjoined, thus making a non-dictionary word. Furthermore it is well known that the TM symbol is often used in brochures and advertising to try and assert rights

in a mark or a slogan, even for those that have minimal or no distinctiveness, perhaps to try (not necessarily successfully) to warn others away.” Mr Foster provides examples where the symbol has been used “in situations where the words concerned have little or no distinctiveness in relation to the goods or services concerned”. Conjoining the two words may make them less likely to be seen by the relevant public as a description, but whether it makes more distinctive than if they were separate is questionable; Mr Foster does not seem to think so. Whatever is the case, using a sign in such a way indicates no more than that the owners are using it as a badge of origin and want the world at large to know this, but establishing that it possesses a distinctive character and/or capable of registration is a different matter.

27. Going to the substantive grounds I will first consider the ground under subsection (d) of the Act which prohibits the registration of “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”. Mr Edenborough accepted that to succeed under this ground it is necessary to show that SOLID FLOOR has become customary in the trade, not that it is likely to do so.

28. In terms of relevant case-law, I note the judgment of the European Court of Justice (“ECJ”) in *Merz & Krell GmbH & Co. (Case C-517/99)* (“*Merz & Krell*”) where it was stated:

“31. It follows that Article 3(1)(d) of the Directive must be interpreted as only precluding registration of a trade mark where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought.”

29. I also note the decision in *Stash* (BL O–281-04) in which Professor Annand (sitting as the Appointed Person) referred to the Oxford English Reference Dictionary (1995) meaning for “customary” as being “usual; in accordance with custom”. So, to be satisfied that a sign has become customary in the current language or in the *bona fide* and established practices of the trade and consequently that the sign is incapable of distinguishing the goods of one undertaking from those of others, evidence must be provided to that effect, evidence establishing customary use in the UK.

30. In support of the ground under Section 3(1)(d) Mr Edenborough referred to three particular pieces of evidence:

The UK Building Regulations provided as part of Exhibit MGF5

PCT applications shown as MGF7

Extract from “A Glossary of Wood” at Exhibit MGF10

31. In respect of the Building Regulations Mr Edenborough refers to the use of SOLID FLOORS in a list of keywords. These are index terms, subject terms, subject headings, or descriptors that are used to capture the essence of the topic of a document. I do not consider there to be any

dispute that SOLID FLOOR (or SOLID FLOORS) can describe a type of floor. This is clearly the case so it is not surprising that the term appears as it does in a document related to building. What it does not show is whether the description is customarily used in connection with “solid wood flooring” and/or “wooden parquet flooring.”

32. Then there are the two PCT applications in which the term “SOLID FLOOR is used in the statement of claim for a “structurally integrated accessible floor system”. Mr Edenborough conceded that the fact there are two from the same person does not add any weight more than if there had been one, but the fact that there is one is relevant because it is a different sort of person using SOLID FLOOR as a term of art. Referring me to *Kirin-Amgen* RPC [2005] Case No: 9, paragraph 34, Mr Edenborough argued that those drafting a patent specification will tend to use words that have an accepted meaning, and particularly so when talking about prior art and the background to the invention. In *Kirin-Amgen* Lord Hoffman talked about patent construction:

"The question is always what the person skilled in the art would have understood the patentee to be using the language of the claim to mean. And for this purpose, the language he has chosen is usually of critical importance. The conventions of word meaning and syntax enable us to express our meanings with great accuracy and subtlety and the skilled man will ordinarily assume that the patentee has chosen his language accordingly. As a number of judges have pointed out, the specification is a unilateral document in words of the patentee's own choosing. Furthermore, the words will usually have been chosen upon skilled advice. The specification is not a document inter rusticos for which broad allowances must be made. On the other hand, it must be recognised that the patentee is trying to describe something which, at any rate in his opinion, is new; which has not existed before and of which there may be no generally accepted definition."

33. Referring me to a decision of the Court of Appeal in *Panduit and Band-it Corporation* [2002] EWCA Civ 465 Case No: A3/2001/0760, Mr Saunders argued that the statement of claim should not be taken as establishing fact without clear evidence from an expert witness as to what these terms actually mean, and if they are terms in the art, the court must be educated as to what they mean. Mr Saunders further argued that as PCT applications from a US-based inventor, their relevance in respect of the UK is questionable.

34. To my mind this evidence does not show SOLID FLOOR being used in connection with solid wood flooring or parquet flooring. The description in paragraph 4 refers to the metal rods being height adjustable and “rest on a conventional solid floor deck” and “the solid floor deck may be made of wood, concrete, etc. The accompanying diagram makes it clear that SOLID FLOOR is used as a reference to the sub-floor and not solid wood or parquet flooring.

35. The extract from the Glossary of Wood contains two meanings for SOLID FLOOR. The first is “A wood block floor on concrete.” The “wood block” could well be parquet but to my mind SOLID is a reference to the fact that the wood blocks are laid on “solid” concrete rather than to the block floor being of solid wood. The second describes SOLID FLOOR as being “Wood floors in which the joists are in contact side by side...” As I read it “SOLID” is used to indicate that the joists are not spaced with voids in between and not to solid (wood) flooring.

36. I am not satisfied that this evidence supports the proposition of commonality or usualness in the use of SOLID FLOOR. There is other evidence that shows use of SOLID FLOOR but not such that I can consider the term to be customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. The ground under Section 3(1)(d) is dismissed.

I will next consider Section 3(1)(c) which states that a trade mark shall not be registered if it consists 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 services, or other characteristics of goods or services.

37. Mr Edenborough referred to the application having been refused (ex-parte) which is not strictly correct. The application did attract an objection but was never the subject of a formal refusal. The examination report (MGF1) raises an objection on the grounds that the sign offended against sections 3(1)(b) and (c) because it “*may serve in trade to designate the kind of goods and services e.g. flooring and installation of flooring relating to solid floors*”. The applicants argued their case at a hearing at which the objection was maintained. The applicants did not challenge this through a formal appeal. Having used the mark they investigated whether the application could proceed by reason of acquired distinctiveness. Mr Edenborough submitted that taking this route disbarred the applicants from arguing and me from considering whether the mark is prima facie distinctive for the relevant goods and services. I disagree. The fact that an objection may have been raised as part of the ex officio examination does not bind me to accept that the objection was well founded. I could infer that by filing evidence to support the registration the applicants had conceded that the sign is prima facie devoid of distinctive character. However, by investigating the position with regard to acquired distinctiveness the applicants kept their powder dry. Had this approach failed they still had the option of the appeal whereas had they gone straight to a formal appeal they may well have lost the option of using their evidence.

38. Mr Edenborough asserted that not only is the application *prima facie* descriptive, the evidence that resulted in its advertisement does not support the contention that it has acquired a distinctive character. I was referred to the report of the *ex parte* hearing relating to the stylised mark in which the Hearing Officer stated “*I agreed ... that the term SOLID FLOOR was more normally associated (although not exclusively) with concrete as opposed to wooden flooring and that the stylisation in the mark could not be completely ignored. In summary, I felt that although the mark was the wrong side of the line for prima facie [distinctiveness], it was not greatly so*” (22 Mar 06, MGF2). He argued that as a matter of logic the plain word mark is even more on “*the wrong side of the line for prima facie*” distinctiveness, and so would require more evidence to overcome that objection. In addition, there is ample evidence to support the examiner’s conclusion that the term could be used in relation to wooden floors, as all the evidence adduced by Fetim relates to wooden, not concrete floors.

39. The evidence on which the earlier “stylised” application was allowed to proceed was copied and used as a basis for allowing the acceptance of the application that is the subject of these proceedings. The earlier mark looks as follows:



40. Whilst the stylisation is not great; it is still clearly the words SOLID and FLOOR, the mode of representation adds something (and I put it no higher than something) to the character that makes it less likely to be seen by the relevant public as being of descriptive significance. Given the Hearing Officer's assessment that the evidence filed was only "just sufficient" to allow acceptance of the stylised mark, it is easy to see why there should be a question as to its sufficiency in respect of the mark in suit. That said, I am required to assess the evidence not the hearing officer's comments.

41. There was little, if anything between Counsel in respect of the relevant law. Both referred to the judgment of the ECJ in *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-191/01 P ("*Doublemint*") which provides a helpful summary of the position in considering this issue, Mr Edenborough referring, in particular, to the following paragraph:

"32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned."

42. The mark concerned was *DOUBLEMINT*. Mr Edenborough stated that the CFI had decided that the uncertainty over the descriptive meaning, for example, "double strength" or "two types of mint" must mean that the mark is distinctive. The ECJ disagreed, broadly saying that if it is descriptive in at least one of its meanings, it is descriptive. The test is not whether the mark is exclusively descriptive, but whether the word at issue was capable of being used by other economic operators to designate a characteristic of their goods and services.

43. Both counsel also referred to *West (t/a Eastenders) v Fuller Smith & Turner Plc* [2003] F.S.R. 44 (Court of Appeal) in which was stated:

"If to a real or hypothetical individual a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act

for it will not provide the necessary distinction or guarantee.”

44. The Court of Appeal also said “It is in that sense that a common or descriptive meaning must be displaced.” which is of particular relevance in considering the proviso to Section 3(1). Mr Edenborough referred me to the reference to *Bach Flower Remedies* [2000] R.P.C. 513 cited in the *West* case, with the health warning that whilst the case may be wrong in the light of *Philips Electronics NV v Remington Consumer Products Ltd* [2003] R.P.C. 2, the comments, the thrust and the logic are probably still right. The quote is found in paragraph 31 of *West*, and is the judgment of Lord Justice Morritt (as he then was):

"The suggested conclusion....appeared to be that for the purposes of the proviso to section 3(1) and s.47(1) a mark might acquire a distinctive character from use if a significant proportion of the relevant class recognised it to bear both a distinctive character and descriptive connotations. I do not accept those submissions.... First, it has never been the law....that a mark must be universally recognised as distinctive. If it were otherwise the rights of traders would be dependent on the views of the ignorant and illiterate." Then if we drop further down to the penultimate sentence: "If to a real or hypothetical individual a word or mark is ambiguous in the sense that it may be distinctive or descriptive then it cannot comply with the requirements of the Act for it will not provide the necessary distinction or guarantee. It is in that sense that a common or descriptive meaning must be displaced."

45. Mr Edenborough’s asserted that this clearly supports his submission that if a descriptive meaning is not displaced and replaced with a distinctive meaning, the mark is bad. He further stated that even if a mark wears two hats and it is partly distinctive and partly descriptive, it is still bad.

46. I also note that in *Matratzen Concord AG v Hukla Germany SA*, (Case C- 421/04) (“*Matratzan*”) the ECJ stated:

“In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

47. Finally, I also note the decision of the CFI in *Ford Motor Co v OHIM*, Case T-67/07 (“*Ford*”) where it was stated:

“there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics”

48. Section 3(1)(c) pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all (see, for example, *Doublemint*).

49. There appears to be no dispute that the words “SOLID” and “FLOOR” are ordinary and well known English words. The definitions of SOLID cited in the Examination report (MGF2) include “Consisting of matter all through” and “of the same substance all through, e.g. solid rock”. Those given for the word FLOOR include “Also called flooring; the inner lower surface of a room” and “to cover with or construct a floor”. Individually these words have the capacity to convey a clear and descriptive reference to flooring made of a solid material, including wood, but the question is whether the same can be said of the words in combination. The registered proprietors accept that SOLID FLOOR is capable of describing certain types of floors, for example those constructed of concrete, but not wood floor or parquet flooring. Some support for this can be found in the evidence, for example, the Patent claims, Glossary of Wood and the oral evidence obtained from the cross-examination.

50. Mr Edenborough took the contrary view, in support referring to the exhibits provided by the opponents, the first being from the Frequently Asked Questions section of turgon.co.uk. Mr Edenborough refers to the question “What are the different types of floor, i.e. Solid, Semi-Solid & Engineered? The answer says “Solid – floors which have the specific wood for the whole thickness of the floor.” The word “SOLID” is the question and separated by a hyphen from the word “FLOORS” which is connected to the explanation. Whilst not showing use of SOLID FLOOR(S) it illustrates how the two words can work together as a description. Two further questions ask whether it is possible to have a SOLID floor on top of concrete or floorboards? The use of “SOLID” only works because of the previous explanation that it describes floors of a particular type.

51. The next exhibit is from the “Help” section of Wooden Flooring Sales “How to install a solid floor” giving the options of “nailing”, “gluing” or “floating”. Other questions refer to the installation of “engineered”, “laminated” and “wooden block/parquet”, all types of floors, which indicate that “SOLID” is being used in relation floors of a single wood. Unlike the “turgon” site there is nothing that explains what “SOLID” means. The index on the left of the page also lists “Engineered flooring”, “Laminated flooring”, “Hardwood block flooring” and “pre-finished solid flooring”. There can be little argument that this is use of SOLID FLOOR in a descriptive way in relation to the goods/services in question.

52. The following exhibit relied upon comes from the Jordan’s Wood Flooring Warehouse website. The welcome page says that “At Jordan’s we offer a massive range of wood floors. Whether you’re looking for Laminated, Engineered or a Solid floor, you need look no further ...”. The page later says “For engineered floors, take a look at Teka, Jive and Parador or for solid...” It is quite clear that “SOLID FLOOR” is being used as a description for floors that are neither laminated nor engineered, in other words, that are composed of a single wood. There is no way to date this exhibit so what it establishes is that SOLID FLOOR was at some time descriptive but not that that is the case at the relevant date.

53. An extract from the Channel 4 website contains a guide to choosing “hardfloors” which Mr Edenborough put forward as evidence from “...a completely different sort of person who is using

the term descriptively...not a retailer...not the Intellectual Property Office... more akin to a normal member of the public than to a specialist wood retailer...". In my experience it is not uncommon for interior designers, handymen, trade professionals or whatever to contribute to the presentation of television programmes and why not also websites. In the absence of evidence one way or the other, to say that this exhibit is evidence from the uninformed public is just conjecture. The exhibit says "For some nothing matches the beauty and easy maintenance of a solid floor. But which hardfloor best suits each room? Use our guide to help you decide". The page lists "The hard stuff" and "The really hard stuff", under the first placing wood and laminates". Mr Edenborough asserts that the exhibit shows SOLID FLOOR being used in relation to both wooden and non-wooden floors. A non-wooden floor is mentioned which is capable of having the surface effect that imitates wood. One argument in these proceedings is that SOLID FLOOR describes the base underneath the flooring which is how this use could be viewed. However, the preceding words "...nothing matches the beauty and easy maintenance..." show that the use is in relation to the flooring. Although the extract does not bear a date over the page there is a "Programme Archive" that includes "The best and Worst Places to Live in the UK 2006" placing the use within a year of the relevant date.

54. The Channel 4 exhibit includes an acknowledgement of a photograph having been provided by Junkers, which ties into an exhibit from that company found in Exhibit MGF6. The Junkers exhibit consists of a brochure, a section of which is headed "Solid advantages" going on to say "Durability: Junkers floors are solid, durable and give a unique sense of quality. A solid floor has the advantage that it can be sanded down ..." and later "That's why I chose a quality solid floor". This again shows the descriptive use of SOLID being in respect of the floor not the sub-base.

55. Exhibit MGF6 includes an exhibit from Diamond Floors.co.uk, which under the heading Real Woods advisers customers that "Firstly, you must decide whether you require a SOLID floor, or an ENGINEERED floor. A solid floor is, as the name suggests, solid wood." This exhibit has a copyright statement of 2007 placing this use at, or most likely after the relevant date.

56. These are typical of the use shown in the rest of the exhibits. The applicants refer to the fact that the Turgon and Wood Flooring Sales exhibits both originate from after the relevant date which is undeniably the case although only by a matter of days. The opponents countered by providing historical use from websites saying that in any event there is nothing to suppose that there had been an intervening event that would affect the distinctiveness or descriptiveness. These arguments are somewhat peripheral to the actual issue. Whilst evidence that a mark is being used descriptively for the goods/services at the time of application can be persuasive, such evidence is more an issue for an objection under subsection (d). Under subsection (c) it is not necessary that a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that one of its possible meanings could be used for such purposes (*Doublemint*).

57. The main evidence in support of the application comes from Mr Bles, who agrees that "SOLID" and "FLOOR" can be combined to describe solid wood/wooden floors or flooring, but only with a descriptor (wood, wooden, oak, etc) in between. His evidence to support the connection between SOLID FLOOR and the applicants has two parts. Turning first to the 97 Witness Statements (Exhibit EJB(2)5). These are all pro-forma Statements requiring only the

details of the deponent and their relationship and knowledge of the applicants and the SOLID FLOOR trade mark. Citing the decision of the CFI in *BIC SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-262/04 the opponents criticise this evidence because it primarily comes from persons who have been in commercial contact with the applicants. In the *BIC* case the CFI stated:

“78 As regards the distributors’ statements which the applicant produced to the Court, it must be recalled that, in order to assess the probative value of a document, it is necessary first to check the plausibility and truthfulness of the information it contains. In that regard account must be taken, inter alia, of the origin of the document, the circumstances of its preparation and to whom it is addressed, and whether it seems from the content to be sensible and reliable (Case T-303/03 *Lidl Stiftung v OHIM – REWE-Zentral (Salvita)* [2005] ECR II-0000, paragraph 42).

79 In the present case, first of all, the Court finds that some of the statements are made on behalf of distributors such as BIC Belgium SPRL, BIC Netherlands BV, BIC UK Ltd and BIC Viorex SA which, according to the applicant’s 2002 annual report, are subsidiaries of the applicant, and in which it has a shareholding of at least 99% (save for BIC Viorex, in which the applicant has a 50.5% shareholding, and BIC Ballograf AB, in which its shareholding is 16%). What is more, that finding was not disputed by the applicant at the hearing. It must be noted that those statements cannot therefore, by themselves, constitute adequate proof of the acquisition through use of distinctive character by the trade mark applied for, given the significance of the links between the applicant and its subsidiaries. They are only indicative and need to be corroborated by other proof...”

58. Although most of the deponent have or have had a commercial relationship with the applicants, distinct from the position in *BIC* they are all independent and free willed traders. The CFI did, however comment on the fact that “...all the statements... appear to have been dictated by the applicant, as they are all identical in content... comprise a preset text which has been translated verbatim into several languages and in some cases even simply photocopied, with blank spaces which have then been filled in by the distributors”. This was listed amongst the factors that led to a finding that the statements produced by the applicant were “insufficiently reliable” (para 81).

59. The pre-prepared text states that based on their experience they consider that a public in the market for superior quality wooden flooring would recognise the name SOLID FLOOR as denoting the products and services of Solid Floor Ltd. and have come to rely upon this trade mark to indicate the source of very high quality goods and services. They further attest that confusion would arise should a third party to use the name SOLID FLOOR or SOLIDFLOOR as a trade mark in the UK to designate the same goods and/or services.

60. Eight of these deponents were the subject of cross-examination. The questions were essentially aimed at establishing the prima-facie distinctiveness of SOLID FLOOR, whether distinctiveness had been acquired, and the deponent’s evidence attesting to the understanding of the relevant public. Asking each to focus on a time prior to their becoming aware of the

applicants, Mr Edenborough posed the question “if I were to say to you that I was interested in a wooden floor and I then said that, in particular, I wanted a solid floor, what would you understand by that term?” the relevant section of their answers being as follows:

Ms. Sarah Brendlor

A. Real wood floor

Mr. Richard Gordon

Q. You would not normally use those words, but it would be possible to describe a wooden floor using the term "solid floor"?

A. Yes.

Mr. Guy Matheson

A. In particular, you are referring to a timber floor.

Q. Yes, in the context of a wooden floor?

A. Ten years ago you would have meant a completely timber floor as in a single timber floor; single material.

Mr. Iain Collins

A. That it was to be made of solid timber.

Mr. Jeff Kahane

A. If somebody said a solid floor, that could cover a range of materials. Not carpeting, but one would take it as wood, stone, tiles, ceramic tiles could be arranged, but that would have the prefix 'a' is my understanding. Any solid floor.

Q. In the context that if I used that expression when I asked you that I was interested in a wooden floor?

A. At that time? You are still talking about 10 years ago?

Q. Yes.

A. If a client was asking for a wooden floor, then I would say there would be a range of companies who dealt in wooden floors, specialist companies.

Q. But what would you understand by the term SOLID FLOOR in the context of a client who is interested in a wooden floor?

- A. Again, at that stage, presumably, solid timber of some sort. I suppose it could be a composite. It could be an engineered floor. I would imagine something robust, but a thin laminate or an overlaid floating floor, which can be incredibly thin and short lasting.

Mr. Nicholas Dyer

- A. I think at that time one would have been thinking in terms of the material, such as a full piece of wood that would have been bonded to the building or marble tiles would have been bonded to the building and would have represented solid material prior to the flooring construction.

Ms. Barbara Rosemary Chandler

- A. I do not think you can apply the term SOLID FLOOR across the whole spectrum of flooring. I think you have to consider it in relation to the type of flooring we are discussing. Obviously, it does not apply to carpets. It could apply to vinyl floors and it applies to some wood floors. Actually, no, it is not a generic term. It does not really occur in wood floors. It might talk about solid wood, but you would not ask for a solid floor. Even within the wood flooring industry, you would not use the term, "I want a solid floor." You would say, "I want solid wood." "I want laminated wood."

- Q. If in the context of a conversation about a wooden floor --

- A. So we are moving specifically on to wood now?

- Q. Yes. -- I then use the phrase SOLID FLOOR, what would you understand that I meant by that term?

- A. I think if we are discussing wood, it would be pretty obviously, would it not? We would not mean solid wood. People would only worry about that if they have become truly aware of the different types of wood flooring that there are, which includes laminated. They would think flooring is made up of different laminations or it includes a veneer on top of something else, like a substrate of chipboard or whatever. It is a highly technical subject.

Mr Malcom Beckett

- A. I would ask them to re-specify that they meant a solid wooden floor as opposed to a solid stone floor or a solid resin floor or a solid steel plate floor.

- Q. If they then said that they wanted a wooden floor, what would you then understand them to mean?

- A. I would then ask them if they wanted the cheapest, nastiest photograph that you can buy of a wooden floor, which is like a photograph veneered on to a very thin substrate that

you might find in Ikea through to a proper veneer of timber, secured to a substrate of ply-board or an engineered board, through to planks of wood which have come from a tree and claim to be a solid plank of wood.

Q. So is one of the possible meanings of a solid floor in that context planks of wood?

A. A solid wood floor? I think a solid floor does not mean anything by itself. As a developer, if someone asked for a solid floor, I would say, "Are you meaning a concrete floor as opposed to a timber joist construction?" which misses the point entirely because it is not to do with the surface. It is to do with the structure.

61. Prior to having contact with the applicants, the majority would have regarded the term SOLID FLOOR (when used or mentioned in connection with wood flooring) as a description relating to solid wood flooring. After having read the transcript I am not entirely sure what Ms Chandler actually thinks. Her answer "I think if we are discussing wood, it would be pretty obviously, would it not?" seems to put her in the "would be descriptive of solid wood floor" camp but later Ms Chandler says "You would not go around saying, "I want a solid floor." which is clearly the opposite. Mr Beckett supports the applicant's contention that if SOLID FLOOR has any descriptive relevance for floors, it is the structure upon which it is laid, not the floor itself. Taken in the round this evidence supports the contention that prior to becoming aware of the applicants, to most the term SOLID FLOOR was descriptive of the goods or services in respect of which its registration is sought.

62. As a whole the evidence supports a finding that the words SOLID FLOOR in combination are devoid of distinctive character because they have a direct and specific relationship with the goods and services of the application, such that the public concerned will immediately perceive them, without further thought, as being a description of solid floors made of wood, including parquet/block floors. The same is the case in respect of service involving the installation of such floors. . As such, the mark SOLID FLOOR is open to objection under Section 3(1)(b) and 3(1)(c) of the Act.

63. This leaves the question of acquired distinctiveness. In the *Philips* judgment, C-299/99, the ECJ pointed out that a finding that a mark has acquired a distinctive character for the goods/services required reliable evidence showing that recognition of the mark as indicating the goods/services of one undertaking is as a result of its use as a trade mark. According to the ECJ in *Societe des produits Nestle SA v Mars UK Ltd*, Case C-353/03, this means "use of the mark for the purposes of the identification, by the relevant class of persons, of the product or services as originating from a given undertaking." (see paragraph 29 of the judgment). Acquired distinctiveness cannot be shown to exist solely by reference to general, abstract data such as pre-determined percentages of recognition by the relevant class of persons. The view is that of an average, reasonably well informed, observant and circumspect consumer who is unlikely come to recognise a sign as being indicative of the trade source of goods/services unless educated by the proprietor to that perception.

64. The words "SOLID" and "FLOOR" are well known English words. They have an obvious descriptive relevance to flooring made of a solid material which is the way in which the relevant

public is likely to regard the mark. The less likely that consumers would take the mark as a trade mark, or put another way, the more descriptive or non-distinctive it is, the more important it is to consider what, if anything, the proprietor has done to educate consumers that it is a trade mark.

65. The criteria to be applied is as set out by the ECJ in *Windsurfing Chiemsee*, in particular, 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations. The identification, by the relevant class of persons, of the product as originating from a given undertaking must be the result of the use of the mark as a trade mark which makes it capable of distinguishing the product concerned from those of other undertakings.

66. Turning first to the evidence relating to the use from which the mark is said to have acquired a distinctive character, which also comes from Mr Bles. He says that from 1994 to December 1996 he supplied wooden floors under SOLID FLOOR via a business in Amsterdam. Apart from saying that he developed an extensive range of wood flooring he gives no details on which to assess the significance of this use.

67. Mr Bles then says that he moved his business activities to London in 1996. He gives the turnover in the 11 years in which it has traded under the SOLID FLOOR mark in the UK as increasing year on year from £198,000 in 1997-98 to £3,500,000 in 2006-7. For the same period the amount spent on advertising rose from £6,000 to a peak of £118,000 in 2003-4 falling back to £98,000 in the final year. This shows reasonably long-standing use of the mark, and on their face the monetary figures seem to represent reasonably significant amounts for turnover and investment in promotion. What they do not tell me is the market share held by the mark or how intensive and geographically widespread the use has been.

68. Pages from applicant's website (EJB(2)(1)) illustrate how the mark is used and the products with which it is associated. The print shows SOLID WOOD in a plain font and in a logo form with a rectangular two-tone background with "SOLID" in plain white capitals in the darker upper portion and "FLOOR" in an italicised font in a lower white portion. Where the logo is placed on a background such as a photograph of a floor the colours of the text and background will vary depending on the background colour. The products mentioned consist of timber, carpet and seamless flooring. Although clearly being used as a business name or trade mark, the pages also refer to "solid wooden floors" and "solid oak floors" in a descriptive sense. The print shows details of eight branches throughout the UK although that has apparently decreased.

69. Exhibits EJB(2)2 and EJB(2)3 show examples of the promotion of SOLID FLOOR products or where they have been the subject of features, primarily in trade publications or those related to interior design. These depict wood flooring available from the applicants most usually in conjunction with the products of other traders, or as part of a larger feature on another business. The accompanying text mentions the names of the products shown in the feature alongside that of the supplier, including that of SOLID FLOOR making it reasonably obvious that SOLID FLOOR is not a product description, and undeniably so where preceded by the preposition

“from” or “by”. Such use may be educative, but if so, and to what extent is impossible to gauge. Nor can the fact that Solid Floor is used to identify the origins of the flooring be taken as establishing that the name is distinctive; the publishers no doubt use the name without any consideration of such issues. In some instances SOLID FLOOR is attached to the description in a way that leaves this open to question, for example, “Pre-sealed Grade A walnut, £108 per sq m, Solid Floor” compounded by the entry at the bottom of the page “For stockist details, see page 138”. Whilst publications such as “Ideal Home” and the Telegraph magazine are mainstream and can reasonably be inferred to have a wide circulation reaching a cross-section of the public, most seem to be trade-oriented with no information on the frequency or extent of their publication.

70. The mark appears in a number of forms, the most common being “Solid Floor” in a plain font. To the observant who notice that the initial letters are capitalized, this mode of representation is likely to be seen as unusual and less likely to be taken as a mere description in the way that a single case could. The mark also appears in the logo form referred to above. This stylisation separates the words “SOLID” and “FLOOR” in a way that, depending on how you look at it, is just as capable of being seen as a description as a badge of the trader. There are also a few instances where SOLID FLOOR website address is included.

71. The conclusion that I reach is that the evidence shows SOLID FLOOR being used to indicate the applicants are the providers of wood floors. They may well have established SOLID FLOOR as being distinctive of them, but whether and to what extent this may be the case is not possible to determine with any degree of certainty from the evidence. However, there is also evidence, for example, the Jordan’s Wood Flooring Warehouse, Channel 4, Junkers and Diamond Floors, showing that SOLID FLOOR was, and is, in descriptive use.

72. Returning to the information obtained in the cross examination. Having originated from “...the relevant class of persons...” these Statements provide a reasonable yardstick in answer to the question of whether the use of SOLID FLOOR as a trade mark has made it capable of distinguishing the products and services concerned, in this case flooring and flooring services, as originating from the applicants. Having questioned the deponents on their understanding of the term SOLID FLOOR before becoming aware of the applicants, Mr Edenborough moved forward to the present day, in the same context asking what they now understood by the term SOLID FLOOR?

73. The answers this time were more mixed. Ms Brendlor said it remains descriptive of solid wood floors but would associate such goods with the applicants. Mr Gordon again stated that generally it would mean a real wood floor, hardwood perhaps. Mr. Matheson and Mr Collins both gave similar answers saying that to an educated consumer solid floor would mean a planed or solid piece timber. Mr Kahane said that if a client said they would like to go for a solid floor he would immediately think of the company that he has dealt with. Mr Dyer did not think the position had changed in that in the context of wooden floors; SOLID FLOOR would still be a piece of wood bonded on to the fabric of the building. Ms Chandler was clearer this time saying that “I think you would always use the phrase "solid wood". You would not go around saying, "I want a solid floor". Mr Beckett maintained that SOLID FLOOR would be a reference to the supporting structure with the option of solid planks of wood as opposed to some kind of engineered board or veneer.

74. Whilst to some SOLID FLOOR signifies the applicants rather than being a type of flooring, the majority see it either as a description alone or as serving both a descriptive and trade mark function. If these deponents are representative of the relevant public/trade, the conclusion must be that that even though it may have a trade mark significance for the applicants, the descriptive meaning of SOLID FLOOR for the goods and services has not been displaced. As was stated in *West*, if a mark is ambiguous in the sense that it may be distinctive or descriptive then will not provide the necessary distinction or guarantee.

75. Mr Bles does not add to the clarity, in his evidence saying that SOLID FLOOR has acquired a secondary meaning to members of the public and trade to signify the goods and services of his company. Taken on its face the use of “secondary” could be interpreted as saying that SOLID FLOOR has two a significations, one of which is that of the applicant’s company, leaving open whether the other is as a description. It could, of course, be careless use of words, and in the absence of any reliance on this possible admission I do not propose to give it weight as such.

76. Mr Edenborough also questioned the deponents on their statements regarding the public’s awareness of SOLID FLOOR, asking how many had been canvassed. Not surprisingly none had specifically done so having made the statement based on their “experience” of a public “who are in the market for superior quality wooden flooring, who could be characterised as well informed, circumspect and observant consumers...” The conclusion given is that such people would “recognise the name SOLID FLOOR as denoting the products and services of Solid Floor Ltd and have come to rely upon this trade mark to indicate the source of very high quality goods and services.” One difficulty with words that have been prepared and essentially put in a deponent’s mouth is that it creates uncertainty as to how much thought was actually given to the contents prior to signing the Statement which possibly contributed to the CFIs comments on such evidence filed in *BIC*. More critically the deponents do not actually say on what basis they make the statement, nor whether any descriptive meaning has been displaced.

77. If the 97 Statements provided by the applicants are taken as indicative of the perspective of the trade this does not assist the applicants. However, there is no specific information that tells me how industry or other trade and professional associations would regard SOLID FLOOR when used in connection with the goods and/or services of the application.

78. Taking all of the above into account I come to the position that SOLID FLOOR consists exclusively of a sign or indication that may serve, in trade, to designate solid wood and parquet flooring and the service of the installation of such goods, Furthermore, the evidence does establish that the SOLID FLOOR has acquired a distinctive character such that to the relevant class of persons it serves to identify such product or services as originating from the applicants. Consequently, SOLID FLOOR remains open to objection under Section 3(1)(c). Section 3(1)(b) performs “a residual or sweeping-up function”, backing up the other provisions which contain specific and characteristic examples of types of marks that lack distinctive character: *Procter & Gamble Ltd’s Trade Mark Application* [1999] RPC 673 (CA) per Robert Walker LJ at 679. If a trade mark is entirely descriptive of characteristics of goods or services (and thereby prohibited from registration under section 3(1)(c)), it will also be devoid of any distinctive character under section 3(1)(b): Case C-363/99 *Koninklijke KPN Nederland BV v Benelux-Merkenbureau*

(*POSTKANTOOR*) [2004] ETMR 57 (ECJ) at [86]. The mark is therefore also objectionable under subsection (b).

71. The opposition having been successful, this leaves the matter of costs. In the normal course of events the successful party would expect to receive an award of costs, that is unless there are factors that justify not making such an award. It is also usually the case that any costs awarded would be in line with what is generally referred to as scale-costs.

72. Having invited the parties for their views on the question of costs, Mr Edenborough stated that he wished to reserve his position. He submitted that depending how the decision goes, it is foreseeable that the opponents might wish to make different sorts of submissions based on how the case has been conducted, mentioning in particular that it has been a long case and hearing, and the number of ancillary matters that have required work. Mr Edenborough said that broadly, this should point towards off-the-scale costs that would require evidence that was not before me.

73. Mr. Saunders did not object to this approach but said that whatever the result there is nothing that justifies an off-scale award. He went on to say that there are two different issues; the principle of whether the costs should be on-scale, and the separate issue of quantum. Mr Saunders considered that I may be able to decide the matter of principle without extensive or even any further submissions. Mr Edenborough took the opposite view arguing that a decision on principle requires submissions. I agree with both counsel. I could decide the matter of principle without submissions, but submissions would usually be expected. There is no disagreement that if costs beyond the normal scale are to be made, this will require submissions and supporting evidence on the quantum of the award.

74. With this in mind I direct that if the opponents consider the facts and circumstances of these proceedings justify an award of costs beyond the published scale, they provide submissions to this effect, supported by evidence on the quantum of any award, within one month of the date of this decision. If nothing is received by the due date I will make an award based on my assessment of these proceeding, with regard to, but not fettered by the scale of costs. The applicants also have one month from the date of this decision in which to make submissions on the scale of any costs. A supplementary decision will be issued confirming my decision and setting the period in which any appeal against the substantive decision and also the supplementary decision on any costs ward may be filed.

Dated this 29 day of January 2010

**Mike Foley
for the Registrar
the Comptroller-General**