

O-379-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3034466
BY INSIGNIA INVESTMENTS LIMITED**

TO REGISTER THE TRADE MARK



IN CLASS 6

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 402230 BY ECLISSE S.R.L.**

Background and pleadings

1. This dispute involves the registration of the following trade mark application no. 3034466:



Mark:

Filing date: 11 December 2013

Publication date: 28 February 2014


Applicant: Insignia Investments Limited

Goods: Class 6 “Door closers, non-electric; Door fittings, of metal; Door friction stays of metal; Door furniture of metal; Door handles of metal; Door hardware (metal-); Door knobs of common metal; Door knockers of metal; Door lever furniture of metal; Door locks; Door openers, non-electric; Door pulls of metal; Door pushes of metal; Door seals of metal; Door springs, non-electric; Hinges for doors and windows (metal-); Hinges of metal having a spring action; Locks of metal, other than electric; Metal door bolts; Metal door kick plates; Metal door latches; Metal door trim; Metal locksets; Safety fittings of metal for doors; none of the aforesaid being for use in relation to sliding doors or windows.”

2. The mark has been opposed by Eclisse s.r.l (“the opponent”) under Sections 5(2)(b) and (3) of the Trade Marks Act 1994 (“the Act”).

3. The section 5(2)(b) objection is based on the following earlier UK and Community Trade Marks (“CTM”), pertinent details of which are below:

Mark	Number	Filing date	Registration date	Goods and services relied upon
ECLISSE	UK 1481184	31 October 1991	16 April 1993	Class 6: Metal building products; structural metal building elements; metal frames for sliding doors and windows; all included in Class 6.
ECLISSE	CTM 380931	30 July 1996	18 November 1998	Class 6: Frames of metal for casings and frames, particularly for sliding doors and for windows.

	CTM 8162018	19 February 2009	22 November 2009	<p>Class 6: Frames of metal for casings and frames, in particular for sliding doors and for windows.</p> <p>Class 20: Interior and exterior doors.</p> <p>Class 35: Selling of frames and counter-frames of metal for door and window casings and doors and windows, in particular sliding doors and windows, interior and exterior doors in retail outlets, online, by mail order, telephone and television shopping programs.</p>
ECLISSE BIAS	1235276 ¹	28 March 2014 (claiming priority date of 8 November 2013)		<p>Class 6: Door buffers of metal; door stops of metal; sash locks of metal; dampers of metal; door fittings of metal; frames of metal for building; doors of metal; door panels of metal; runners of metal for doors; door openers, non-electric.</p> <p>Class 19 Runners, not of metal, for sliding doors; frames, not of metal, for building; door frames, not of metal.</p> <p>Class 20 Buffers, not of metal, for doors; accessories, not of metal, for doors; dampers, not of metal, for doors. Goods and services limited to: Buffers, not of metal, for doors; door handles, not of metal; door latches, not of metal; door bolts, not of metal; non-metal guides for sliding doors; door stops not of metal; non-metal profiles for door brush seals; non metal stroke-end cushioning for doors; non-metal brackets for doors; clasps not of metal, for doors; non-metal sliding door brush seals; screws, not of metal, for doors; door nuts, not of metal; locks, other than electric, not of metal, for doors; fittings not of metal for sliding doors.</p>

¹ This is an International Registration which has designated the CTM

4. The section 5(3) objection is based on the following earlier UK and Community Trade Marks (“CTM”):

Mark	Number	Filing date	Registration date	Goods and services relied upon
ECLISSE	UK 1481184	31 October 1991	16 April 1993	Class 6: Metal building products; structural metal building elements; metal frames for sliding doors and windows; all included in Class 6.
ECLISSE	CTM 380931	30 July 1996	18 November 1998	Class 6: Frames of metal for casings and frames, particularly for sliding doors.

5. In the opponent’s statement of case it argues that there are “considerable similarities between ECLISSE and ECLIPSE”, and that the mark contains the descriptive words “Architectural Hardware...so should be disregarded in a comparison of the marks”. Further, it claims that the applicant’s goods are either “identical to, or similar to, or complementary to the Opponent’s goods upon which the opposition is based”. Accordingly, it claims that the application should be refused registration under section 5(2)(b) of the Act.

6. With regard to the section 5(3) claim the opponent states that “the Applicant would benefit from the advertising and publicity carried out by the Opponent, and from the kudos associated with the Opponent’s marks”. It also claims that if the public were confused in relation to the economic origin then this could have an economic effect on the opponent and its exclusivity could be diluted. The opponent also claims that the later use will be out of its control and that poor quality or inferior goods could cause detriment to its valuable reputation and business.

7. The applicant filed a counterstatement denying the claims made and requested that the opponent proves the reputation that it is relying upon. In accordance with section 6A of the Act the applicant also puts the opponent to proof of its use of some of the relied upon class 6 goods.

8. The proceedings went through five rounds of evidence. The evidence is summarised below and the written submissions shall be referred to the extent that it is considered appropriate/necessary.

9. A hearing took place before me via video link on 15 July 2015, with the applicant represented by Ms Sylvie Tate of Groom Wilkes & Wright LLP, and the opponent by Mr Michael Foster of Mewburn Ellis LLP.

Evidence

Opponent’s evidence

Witness Statement of Michael Gregory Foster and exhibits MGF1 – MGF3

10. Mr Foster is a trade mark attorney for Mewburn Ellis LLP. They are the professional representatives of the opponent.

Exhibit MGF1 is an extract from Cassell's Italian-English English-Italian dictionary. The dictionary confirms the opponent's claim in the statement of case that the English translation of the Italian word "Eclisse" is "Eclipse".

Mr Foster states that the words Architectural Hardware appearing in the marks is descriptive of the applied for goods.

Exhibit MGF2 is an extract from the Collins dictionary which states that one of the meanings of the word architecture is "buildings or structures collectively". Mr Foster also highlights one meaning of the word "hardware" as being "mechanical equipment, components, etc."

Exhibit MGF3 is Wikipedia article entitled "Architectural ironmongery". The article indicates that an equivalent term is architectural hardware, and a list of examples of items covered by the term is included in the article.

Witness Statement of Luigi De Faveri and exhibits LDF1 – LDF11

11. Mr De Faveri is the Chairman of the board of directors of the opponent. This is a position he has held since 1989.

Turnover

12. Mr De Faveri provides the following turnover figures and states that they are wholesale prices to the UK, with a typical mark up from the wholesaler to the end user to be in the region of 40-45%.

Year Ending 31 December	€Thousands	€£ exchange rate at, or near, the year end	Equivalent Thousands £
2009	410	1.11	369
2010	605	1.17	517
2011	646	1.20	538
2012	689	1.22	564
2013	904	1.20	753

Advertising spend

Year Ending 31 December	£ Thousands
2008	17
2009	35
2010	43
2011	45
2012	51
2013	86

13. He states that Eclisse has subsidiaries and authorised dealers in many countries in the world, including the following European Union countries: Austria, Bulgaria, Czech Republic, Finland, France, Germany, Greece, Hungary, Latvia, Lithuania,

Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the UK. The authorised dealer for the UK was previously called The David Barley Company.

Exhibit LDF1 is a print out from www.eclisse.eu/Company which details the history of the opponent. It states that the business was formed in Italy in 1989, and then began distributing to the UK on 1 January 2010 via Eclisse (UK) Limited.

Exhibit LDF2 is a further website print out which is headed "Brand evolution". It states the "The Italian word "Eclisse" corresponds to the English "Eclipse", the astronomical phenomena of partial or complete obscuring of one celestial body by another." It goes on to state: "The concept lends itself well to the primary function of sliding door systems: the doors disappear inside the wall". The web screen print was taken on 24 September 2014, which is after the relevant period.

Exhibit LDF3 comprises copies of invoices relating to exhibiting at Grand Designs at the Birmingham National Exhibition Centre from 8 to 10 October 2010. The invoices are dated 5 March and 27 August 2010.

Exhibit LDF4 comprises a selection of brochures. Brief details of these are as follows:

- Brochures 1 and 2 are both dated "02/2013" and predominantly include advertisements for sliding doors (including automatic) with the parts and fittings thereof. The mark is used with and without the device.
- Brochure no.3 is dated "04/2013" and headed "Eclisse pocket door system, i.e. the door slides within the wall. It includes a UK address.
- Brochure no.4 is not dated. It shows the Eclisse mark with and without the device and refers to "Pocket doors".
- Brochure no.5 is dated "10/2013" also shows Eclisse mark with and without the device and refers to "Pocket doors".
- Brochure no.6 is dated 03/2011 and headed "Sliding pocket door systems".
- Brochure no. 7 is the same as above but dated 11/2011

Exhibit LDF5 comprises catalogues that show use of the mark Eclisse only in relation to sliding doors. The catalogues have a copyright date of "02/2010" on page 31.

Exhibit LDF6 comprises a selection of advertisements placed in publications such as Professional Builder, The Builder and Grand Designs. Brief details of the publications are as follows:

- Bottom left hand corner of the first brochure is dated August 2009/GRAND DESIGNS and refers to Eclisse sliding doors.
- Professional builder brochure is dated July/August 2013 and refers to “sliding pocket door systems”.
- Professional Builder magazine/brochure dated December 2009, April, September, October and November 2013.

Exhibit LDF7 comprises copies of various invoices issued to The David Barley Company and subsequently to Eclisse UK. Mr De Faveri states that the invoices relate to the advertisements published in Grand Designs, The Builder and Professional Builder.

Exhibit LDF8 comprises copies of 393 invoices from 2009, 2010, 2011, 2012 and 2013 issued by the opponent.

Exhibit LDF9 comprises further invoices from The David Barley Company. The invoices are within the relevant period. In the top right hand corner is the following:



Exhibit LDF10 is a print out from the opponent’s website. It is headed “DISTRIBUTORS” and lists the various distributors, stockists and head office. They are spread throughout the UK.

Exhibit LDF11 comprises a number of invoices which have been sent to various customers which Mr De Faveri states are located in various European Union countries.

Applicant’s evidence

Witness Statement of Marc Flynn and exhibits MF1 – MF15

14. Mr Flynn is the group Chairman of Insignia Investments Limited, who is the holding company of Frisco (UK) Sales Ltd. Mr Flynn states that Insignia and Frisco have imported and sold high quality ironmongery including hinges, door furniture, locks, bolts, latches, levers, closing devices for more than 30 years. Mr Flynn provides the following turnover figures for goods sold under the ECLIPSE trade mark by Frisco (UK) Sales Ltd in the UK:

Year	Turnover £
2004	8,916,316
2005	9,244,105
2006	11,133,215
2007	11,336,811
2008	12,029,904

2009	8,157,769
2010	9,007,058
2011	8,454,554
2012	8,646,565
2014 (to 31 March)	10,943,374

15. Mr Flynn provides the following Insignia and Frisco advertising spend for the ECLIPSE trade mark:

Year	£
2004	14,914
2005	12,047
2006	15,405
2007	5,988
2008	6,538
2009	3,131
2010	4,553
2011	2,800
2012	23,705
2014 (31 March)	33,902

16. Mr Flynn states that the mark ECLIPSE is synonymous with his company and Frisco, and they used it continuously since 1993. He also states that Frisco owned and traded under the UK specific domain name eclipse-hardware.co.uk since 2009. A copy of the whois information page evidences the domain name and is submitted at Exhibit MF1.

Exhibit MF2 is a selection of extracts from test reports which have been commissioned by Frisco in relation to their goods. The reports are dated 1999 – 2005.

Exhibit MF3 is a selection of Certificates of Conformity which refer to the goods under the ECLIPSE trade mark. The certificates are dated 2004 - 2010.

Exhibit MF4 is a 2009 pricelist which shows the mark in the top left corner.

Exhibit MF5 are copies of 65 invoices dated between 22 May 2000 and 1 December 2014.

Exhibit MF6 is a selection of extracts from the websites and promotional literature of these companies. The websites include well known hardware retailers such as Screwfix and B&Q.

Exhibit MF7 is an undated point of sale photograph of ECLIPSE goods.

Opponent's evidence in reply

Witness Statement of Padraic Healey and exhibit PH1

17. Mr Healey is a director of Eclisse UK, a position he has held since June 2011. Prior to this, he was the General Manager of Eclisse UK. Mr Healey states that in January 2010 the private partnership, The David Barley Company, changed their name to Eclisse UK (it was subsequently incorporated on 22 June 2011). They are the authorised distributors of ECLISSE products.

Witness Statement of Rebecca Victoria Anderson and exhibits RVA1 and RVA2

18. Ms Anderson is a trainee trade mark attorney at Mewburn Ellis LLP, and assists Mr Foster. Ms Anderson states that she conducted internet research on 9 February 2015.

Exhibit RVA1 to Miss Anderson's witness statement is a print out from the ROMARIN International Trade Mark Register search database. It contains details of the opponent's earlier registration number 1235276, for the mark ECLISSE BIAS (Stylised).

Exhibit RVA2 is a selection of website print outs which advertise for sale various doors, accessories thereto, etc. Ms Anderson states that these print outs demonstrate that "sliding doors and structural frames and casings for sliding doors are regularly sold through the same trade channels as door furniture".

Witness Statement of Michael Gregory Foster and exhibits MGF4 – MGF6

19. This is the same Mr Foster who submitted a witness statement in chief, dated 3 October 2014.

Exhibit MGF4 is a screen print out which shows a red wavy line underneath the word Eclisse which indicates that it is not recognised by the Outlook® email program. The email program offers suggestive alternatives, with the first option being Eclipse. Mr Foster submits that: "The fact that the Outlook® email program gives the word *Eclipse* as the first alternative for *Eclisse* in the English (United Kingdom) spell checking points to the two words being considered similar."

Exhibit MGF5 are two pages from the Collins Spanish-English English-Spanish dictionary. They state that the Spanish word hola can be translated into English as hullo. Mr Foster submits that this means that the spell checker simply looks at supposed misspellings, and does not attempt to suggest a translation if it considers that a word is misspelt.

Exhibit MGF6 is a screen print out which shows a red wavy line underneath the word hola. In this instance the Outlook® email program did not suggest hullo.

Applicant's further evidence

Witness Statement of Sylvie Tate and exhibit ST1

20. Miss Tate is a trade mark attorney at Groom Wilkes & Wright LLP, the applicant's professional representatives. Attached to Miss Tate's witness statement is exhibit ST1 which is a screenshot from Outlook. The intention of this screenshot appears to counter exhibit MGF to Mr Foster's witness statement. I do not consider any further analysis is required.

Proof of use

21. The relevant statutory provision is Section 6A, which states:

"Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

Section 100 of the Act

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Relevant date

22. The applicant requested that the opponent provide proof that it has made genuine use of their earlier registrations within the five year period ending on 28 February 2014, as per section 6A of the Act. The relevant five year period is 1 March 2009 to 28 February 2014.

23. The applicant requested that the opponent provide proof of use in relation to the following relied upon marks:

1) Mark: ECLISSE

Number: 1481184

Goods (POU requested): Class 6 “Metal building products; structural metal building elements; metal frames for sliding doors; all included in class 6”

2) Mark: ECLISSE

Number: 380931

Goods (POU requested): Class 6 “Frames of metal for casings and frames, particularly for sliding doors”

Relevant case law

24. In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-

1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]".

25. Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

26. It is clear from the evidence that the opponent has used their ECLISSE mark in relation to sliding doors and the casements which the doors slide into.

27. During the hearing I asked Mr Foster to point to examples of where the mark is used for the remaining goods within the specification. He referred me to “anti-warp” profiles which are special U-shape profiles that fit into the bottom of the door to make sure that it does not warp and stays plane. He argued that this is one example of use beyond the sliding doors and casements. The exhibit he referred to stated:

“Anti Warp Profile: Supplied as standard with SINGLE and DOUBLE systems, this U shaped profile fits into the bottom of the door not the floor and ensures the sliding action remains smooth over time even if the door should warp. No floor track or threshold needed, continuous floor surface right through the doorway”

28. In my view, the above goods can be considered to be a part or accessory to the sliding door or casement and not a metal building material. This view is supported since the evidence states that they are “supplied as standard” and not sold individually.

29. Having taken all of the relevant factors into consideration I find that the ECLISSE mark has only been used in relation to:

“Metal frames and casings for sliding doors and windows”.

Decision

Legislation – section 5(2)(b)

30. Sections 5(2)(b) of the Act is as follows:

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

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

Relevant case law

31. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case

C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Average consumer and the purchasing act

32. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

33. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer at paragraph 60 in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

34. The goods in question are accessories and parts for doors, plus frames and casings for sliding doors. Generally the average consumer for the goods is the trade, though I do not discount that DIY enthusiasts may also encounter the goods. Members of the trade are likely to acquire the goods following perusal within DIY stores, trade magazines, catalogues or internet searches. Therefore, they are likely to be self selected items following a visual inspection. However, I do not disregard aural considerations since the goods may be purchased following a conversation with other tradesmen or advice provided by a shop assistant.

35. The cost of the goods can vary from being a relatively inexpensive door closer or handle to a very expensive door which slides into a casing within a wall. The level of care and attention for the latter would be greater than the former.

36. It is evidenced by the opponent that the word “eclisse” is Italian for “eclipse” – the dominant element of the application. I am of the view that you would require a relatively strong grasp of Italian to know this translation. Whilst there may be consumers of the goods that would have such knowledge, they would most definitely be in the minority and not considered to be the “average consumer”, i.e. a tradesmen or DIY enthusiast.

Comparison of goods

37. In the judgment of the Court of Justice of the European Union in *Canon, Case C-39/97*, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their

intended purpose and their method of use and whether they are in competition with each other or are complementary”.

38. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

Opponent’s goods following proof of use requirements (ECLISSE)

Applicant’s goods	Opponent’s goods
Class 6 “Door closers, non-electric; Door fittings, of metal; Door friction stays of metal; Door furniture of metal; Door handles of metal; Door hardware (metal-); Door knobs of common metal; Door knockers of metal; Door lever furniture of metal; Door locks; Door openers, non-electric; Door pulls of metal; Door pushes of metal; Door seals of metal; Door springs, non-electric; Hinges for doors and windows (metal-);Hinges of metal having a spring action; Locks of metal, other than electric; Metal door bolts; Metal door kick plates; Metal door latches; Metal door trim; Metal locksets; Safety fittings of metal for doors; none of the aforesaid being for use in relation to sliding doors or windows.”	Class 6 “Metal frames and casings for sliding doors and windows”

39. During the hearing, Ms Tate argued that in the event I find use for “metal frames for sliding doors” then these differ to the goods of the application since they are bespoke items which require specialist fitting. Generally I agree with this submission. However, the applicant’s goods are various parts, fittings and/or components for doors, and opponent’s goods are metal frames and casings for sliding doors and windows.

40. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

41. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

42. In my view there is a degree of complementarity between various parts, fittings and furniture for doors with the frames and casings thereof. The end users are likely to be the same insofar that somebody who wishes to buy a door may also seek to purchase additional fittings (for example a door knob, hinge, handle, etc.) to match. In view of this they will reach the same end user via equivalent distribution channels. However, the level of complementarity only results in a moderate degree of similarity between the goods.

Comparison of the class 6 goods in relation to ECLISSE BIAS (no. 1235276)

43. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

44. In my view, the term “door fittings of metal” is very broad covering various items which would be attached to, or be required to, fit a door. Therefore, with the exception of “hinges for windows (metal-)", applying the principle of *Merica*, I find that all of the applicant’s goods are identical to the broad term.

45. The term “door fittings of metal” covers hinges for doors. Whether the hinges are for doors or windows they are likely to be sold in the same places and via similar

distribution channels. However, a fundamental difference is that they are different in nature, i.e. one is for a door and the other for a window. Further, they are not in competition with one another. Therefore, I find that there is a low level of similarity between the goods.

Comparison of marks


46. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

48. Merely comparing the marks would mean that the opponent’s best case would rest with their ECLISSE mark. However, given the interdependency principles, in particular that a greater degree of similarity between the goods may offset a lesser degree of similarity between the marks, I must also assess the position with regard to ECLISSE BIAS.

49. For the avoidance of doubt, the opponent is in no better position in relying on CTM 8162018 from either a comparison of marks, goods or both. Therefore, that particular registration shall not be assessed. Further, the same principle applies to CTM 380931 for the mark ECLISSE. I shall firstly deal with the ECLISSE mark:

Opponent’s trade mark	Applicant’s trade mark
ECLISSE	

50. The applicant’s mark is made up of three elements: 1) the distinctive word “eclipse”, 2) the descriptive words “Architectural Hardware” and 3) the graphical representation of an eclipse. The “eclipse” part of the mark is far more dominant than the words Architectural Hardware, which is descriptive of the goods. The word


“eclipse” carries greater weight, both in terms of distinctiveness, size, position, relative to the device and descriptive words. Whilst the mark contains a representation of an eclipse taking place I do not consider it to be the most distinctive element of the mark. In my view, what is immediately noticeable is the well known dictionary word, eclipse.

51. The opponent’s mark comprises of a single invented word: ECLISSE. It has no ordinary dictionary definition and does not allude to any aspect of the goods.

52. Visually there must be some similarity between the marks in view of there being only one letter difference between ECLISSE and eclipse. However, the marks are not highly similar given the two additional elements in the application, namely the words Architectural Hardware and the graphical representation. Therefore, I conclude that there is a moderate degree of visual similarity between the respective marks.

53. Aurally the application would be pronounced as EC-LIPSE and the opponent’s mark would sound like EC-LEASE. Therefore, the only difference between the respective marks is LIP and LEE in the middle of each. There is a medium degree of aural similarity.

54. Conceptually, the application will be given its normal meaning and this will be how it is remembered. The representation of an eclipse merely reinforces the message conveyed by the word. The earlier mark will be viewed as an invented word. It was argued that because eclisse is Italian for eclipse they have the same conceptual meaning. I disagree. No evidence has been put forward with regard to the number of Italian speaking individuals there are in the UK and how this may impact the conceptual comparison. In my view, the contested mark will be remembered in the manner in which it is intended, i.e. an eclipse, whereas no conceptual identity will be attached to the earlier mark. Therefore, I do not consider the marks to be conceptually similar.

Opponent’s trade mark	Applicant’s trade mark
<p>ECLISSE BIAS</p>	

55. I have already outlined the dominant and distinctive elements of the applicant’s mark in paragraph 50. There is no need to duplicate those findings here. With regard to the opponent’s mark, it comprises of two elements: the invented word ECLISSE and the well known dictionary word, BIAS. The combination of words has no obvious meaning. Further, BIAS is in a darker font, I do not consider this to results in it word being more dominant than ECLISSE.

56. I found earlier in this decision that there was moderate to medium (at best) level of similarity between ECLISSE and the application. The inclusion of the word BIAS can only lessen the level of similarity.

57. Aurally, the opponent's mark has an additional word which, due to it not being descriptive, would be verbalised. Therefore, I now find that there is a moderate degree of aural similarity. Visually I now find the respective marks to be similar to a low degree. Conceptually, I have already concluded that I do not consider ECLISSE and the application to be similar. Therefore, the opponent cannot be in any better position with ECLISSE BIAS.

58. Overall, I find that the addition of BIAS renders the degree of similarity to the application to low.

Distinctive character of earlier mark

59. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

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

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

60. The distinctive character of the earlier mark is another important factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24).

61. The opponent has filed turnover and advertising figures together with examples of how the mark is used. The turnover figures vary from £369,000 in 2009 to £753,000. In Mr De Faveri's witness statement he states that the typical mark up from the wholesaler to the end user is in the region of 40-45%. In my view, the turnover figures appear to indicate a healthy business. However, no evidence has been filed to indicate the size of the market and/or the size of the market which the opponent has. Accordingly I am unable to determine whether the opponent has enhanced distinctive character through the use it has made of the mark.

62. With regard to the mark's inherent distinctive character, the word eclisse is an invented word which does not describe, and is not allusive to, any characteristic of the goods. In view of this, I consider the opponent's mark to have a high degree of inherent distinctive character.

Likelihood of confusion

62. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. This includes keeping in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. One of the principles in the authorities states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*).

63. I summarise my findings in relation to the ECLISSE mark below:

- There is a moderate degree of similarity between the respective goods.
- Since the earlier mark is an invented word, which does not allude to the goods, I consider it to be highly distinctive.
- The level of attention paid to the purchasing of the goods will vary depending on the price.
- The goods will be purchased following a visual inspection, though aural considerations will be taken into account.
- There is a moderate degree of visual similarity, medium degree of aural similarity and no conceptual similarity.

64. Whilst some of the findings I have outlined above, lean towards a likelihood of confusion, I am mindful of the comments in *The Picasso Estate v OHIM*, Case C-361/04 P, whereby the Court of Justice of the European Union found at paragraph 20 that:

“By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

65. In the present case, I am of the opinion that the conceptual differences outweigh the other findings. The word ECLIPSE will be immediately recognised by the average UK consumer, the word ECLISSE will not. Whilst I accept that Italian speaking individuals will understand the meaning, I do not consider them to be the average consumer of the goods. Bearing in mind my finding that there is no more than a moderate degree of similarity between the goods, I do not consider there is a likelihood of confusion. Even though a conceptual difference is not always sufficient

to overcome aural and visual similarities between marks², in the case before me, the conceptual difference is much more marked than the visual and aural similarities between the marks. This means that the conceptual difference strongly offsets the lower levels of aural and visual similarity that exists between them. Accordingly, the opposition under section 5(2)(b) fails.



66. Whilst I found that the majority of the goods covered by the ECLISSE BIAS mark are identical, this does not offset the overall low level similarity between the marks.

67. The section 5(2)(b) claim fails.

Section 5(3)

68. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), 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.”

Relevant case law

69. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

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

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

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

² See *Nokia Oyj v OHIM*, Case T-460/07

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

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

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

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

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

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

70. The conditions of section 5(3) are cumulative. Firstly, the applicant must show that its earlier mark ECLISSE has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, the applicant must establish that the level of reputation and the similarities between the parties' marks will cause the public to make a link between the marks, in the sense of the earlier marks being brought to mind by the later marks. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the applicant will occur. It is unnecessary for the purposes of section 5(3) that the

goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

In *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC), Geoffrey Hobbs QC, as a Deputy Judge of the High Court held at paragraph 76 that:

“Article 9(1)(c) provides protection for Community trade marks which have a reputation “in the Community”. Kenwood suggested that this means a reputation across the Community as a whole or at least a large area of it. I do not agree. In the case of a trade mark registered at the national level, protection of the kind provided by art.9(1)(c) can be claimed for trade marks which have a reputation in the sense that they are known by a significant part of the public concerned by the products or services covered by that trade mark in the territory of registration. Since the territory of registration is part of the Community, the trade mark has a reputation in the Community. The trade mark does not cease to have a reputation in the Community if the national registration is either subsumed within a Community trade mark registration under art.34(2) of the CTMR on the basis of a valid claim to seniority or duplicated by a Community trade mark registration. In principle, a Community trade mark should not receive less protection than a national trade mark with a reputation in the same territory. I think that the aim should generally be to prevent conflict occurring in any substantial part of the Community and that the United Kingdom can for that purpose be regarded as a substantial part of the Community, with or without the addition of France and Germany. It thus appears to me that Whirlpool's Community trade mark has a reputation in the Community.”

71. The reputation of the mark must be established in a substantial part of the territory of the UK: see, by analogy, *Case C-238/06 Alfredo Nieto Nuno v Leonci Monello Franquet*.

72. The onus is upon the opponent to prove that its earlier trade marks enjoy a reputation or public recognition and it needs to furnish the evidence to support this claim. Earlier in this decision I assessed whether the opponent has an enhanced distinctive character due to the use made of the mark. I concluded that insufficient evidence has been provided. In view of these findings, although the mark is in use, I am unable to conclude that the opponents' earlier mark has the required reputation

73. For the avoidance of doubt, in the event I had found that the opponent did have the requisite reputation, I would have referred to the CJEU guidance set out in case C-408/01, *Addidas-Salomon*, and concluded that there would not have been a “link” between the respective marks:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, *Case C-251/95 SABEL* [1997] ECR I-6191, paragraph 23 in fine,

and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

74. The section 5(3) claim fails.

Overall conclusion

75. The opposition is refused, the application (subject to an appeal) shall proceed to registration for all of the applied for goods.

Costs

76. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £2700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side’s statement	£400
Preparing evidence and considering and Commenting on the other side’s evidence	£1300
Preparing for and attending a hearing	£1000

77. I therefore order Eclisse S.r.l. to pay Insignia Investments Limited the sum of £2700. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of August 2015

**MARK KING
For the Registrar,
The Comptroller-General**