

O-433-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3352598 BY
J. MAC SAFETY SYSTEMS LIMITED
TO REGISTER:**

MACDECK

AS A TRADE MARK IN CLASS 19

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600001068 BY
MACDECK LANDSCAPING LIMITED**

Background & pleadings

1. On 12 November 2018, J. Mac Safety Systems Limited (“the applicant”) applied to register the trade mark MACDECK for goods in class 19. The application was published for opposition purposes on 23 November 2018.

2. On 22 February 2019, the application was opposed under the fast track opposition procedure by Macdeck Landscaping Limited (“the opponent”). The opposition is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon trade mark registration no. 3291217 for the trade mark shown below, which has an application date of 19 February 2018 and a registration date of 18 May 2018. The opponent relies upon all the goods for which its trade mark is registered:



Class 19: Decking (Non-metallic -); Modular plastic decking to serve as a ground cover; Non-metal decking; Fiber reinforced plastic construction materials.

3. The opponent claims the goods of the application are identical or similar to the goods for which its earlier mark is registered, and that the marks are identical or at least similar to “a tremendous degree”. The opponent claims, as a result, that there is a likelihood of confusion between the marks.

4. The applicant filed a counterstatement. Whilst admitting that the trade marks are similar (but denying they are identical), the applicant denies that there is a likelihood of confusion. It states that the goods are not similar. As a result, the applicant denies the basis for the opposition.

5. The opponent is represented by S. William Wallace & Company Limited; the applicant is represented by Wilson Gunn.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Marks Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. The applicant filed brief written submissions. The opponent did not file written submissions, but I will treat the contents of its notice of opposition as its written submissions.

Decision

9. Section 5 of the Act states:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

10. In *S.A. Société LTJ Diffusion SA v Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) stated:

“54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

11. In *Reed Executive plc v Reed Business Information Ltd*, Court of Appeal [2004] RPC 767, Jacob L.J. found that ‘Reed’ was not identical to ‘Reed Business Information’ even for information services. He stated that:

“40. It was over “Reed Business Information” that battle was joined. The composite is not the same as, for example, use of the word “Reed” in the sentence: “Get business information from Reed”. In the latter case the only “trade-marky” bit would be “Reed”. In the former, the name as a whole is “Reed Business Information”. The use of capital letters is of some visual significance – it conveys to the average user that “Business Information” is part of the name. If the added words had been wholly and specifically descriptive – really adding nothing at all (eg “Palmolive Soap” compared to “Palmolive”) the position might have been different. But “Business Information” is not so descriptive – it is too general for that.”

12. The opponent claims in its statement of case:

“The Opponent’s earlier Mark is, for all intents and purposes, identical (especially phonetically) to the later applied for Mark, being the element MACDECK. The minor stylisation of the initial M of the earlier Mark is likely to go unnoticed by the average consumer, per SA Societe LTJ Diffusion v SA SADAS.”

13. The applicant’s mark is for the word mark MACDECK, whereas the earlier mark is registered as

ACDECK

14. I do not agree that the stylization of the M at the start of the opponent’s mark is minor. Nor do I agree that it is likely to go unnoticed by the average consumer. I will say more later in this decision about its visual impact in the mark; however, it suffices for present purposes to find that the marks are not identical because the presence of the stylized M means that, viewed as a whole, the mark cannot be said to contain differences so insignificant that they may go unnoticed by an average consumer. The section 5(1) and 5(2)(a) grounds of opposition fail. I will move on to look at the ground under section 5(2)(b) of the Act.

15. The registration upon which the opponent relies qualifies as an earlier trade mark. As it had been registered for less than five years on the date on which the contested application was applied for¹, it is not subject to proof of use. Consequently, the opponent is entitled to rely upon it for all of the goods for which it stands registered.

16. The following principles are gleaned from the decisions of the courts of the European Union 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*

¹ As these proceedings commenced after 14 January 2019, when the Trade Mark Regulations 2018 came into force¹, the relevant period for proof of use purposes is the five years prior to and ending on the date of application of the contested application.

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 greater 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

17. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“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.”

18. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“82 ... there is a close connection between [the goods], 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...”.

19. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

20. The applicant restricted its specifications following the filing of the opposition. The competing goods, as they now stand, are as follows:

The opponent’s goods	The applicant’s goods
Class 19: <i>Decking (Non-metallic -); Modular plastic decking to serve as a ground cover; Non-metal decking; Fiber reinforced plastic construction materials.</i>	Class 19: <i>Scaffolding; safety scaffolding; safety platforms; access hatches; all of the aforesaid goods made wholly or principally of non-metallic materials; parts and fittings for all the aforesaid goods.</i>

21. The opponent’s statement of case stated:

“The opposed application covers “safety decking” which is encompassed in the earlier registration’s recitation of “decking (non-metallic)” and “non-metal decking” and is therefore identical. The other goods covered are highly similar to those covered in the earlier registration to the extent where confusion of the relevant public is both likely and inevitable. The goods have the same uses: creating raised horizontal platforms; have the same users: the specialised building trade; share the same channels of trade: e.g. builders merchants and are complementary: for example, the latter goods may be used to erect the former.”

22. This statement of case was filed when the applicant's specification contained the term *safety decking*, which was removed by the applicant after opposition. I agree with the opponent that had that term remained in the specification, it would have been identical to the opponent's goods. However, I do not accept that the applicant's goods, as they now stand, are highly similar to the opponent's goods. In fact, there is a question as to whether there is any similarity at all for some of them.

23. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

24. The opponent's *Decking (Non-metallic -); Modular plastic decking to serve as a ground cover; Non-metal decking* would be construed as boards or other modular systems used to cover the ground for people to sit and walk on. They are commonly used in gardens, instead of patios or paving, and, for example, in outside seating

areas in pubs. This is the natural way in which the UK public would perceive the term decking: for use at ground level. Conversely, the UK public would perceive the term *scaffolding* to be an arrangement of metal poles and boards for use at an elevated level against the side of a building where construction work is taking place. Its purpose is to give construction workers safe access to the higher parts of the building, so that they can stand and use walkways, rather than working from ladders. At a general level, both decking and scaffolding contain boards of some description; however, scaffolding also comprises a considerable number of connected metal poles. The nature of the goods differs, as does their purpose, as explained. One would not choose decking instead of scaffolding, and vice versa. They are not complementary in the sense described in the caselaw cited above. Scaffolding is a specialist good, not sold in DIY shops, which do sell decking. There is no evidence that builders' merchants sell scaffolding and decking. The method of use of scaffolding is that it is accessed via ladders or stairways, with a safety harness clipped to the scaffolding rig, whereas decking is accessed by stepping onto it, or by a short series of steps. The method of use differs.

25. I find that there is no similarity between the opponent's *Decking (Non-metallic -); Modular plastic decking to serve as a ground cover; Non-metal decking* and the applicant's *Scaffolding; safety scaffolding*.

26. There is also no similarity between the opponent's *Fiber reinforced plastic construction materials* and the applicant's goods. Use of a mark in relation to a material or ingredient used to make a finished product does not necessarily constitute use of the mark in relation to the finished product. In *El du Pont de Nemours and Company v OHIM*, case T-288/12, the GC considered manufacturing materials against finished articles, concluding they did not share nature, purpose or method of use, were not in competition and were not complementary:

"35. In this connection, it should first of all be noted that the parties agree that the goods in Classes 1 and 17, which are covered by the earlier marks, cover plastic or synthetic products which are used as a raw material. Conversely, the goods in Classes 9 and 12, which are covered by the mark applied for, are

finished products. Therefore, they are of a different nature and can be neither substitutable nor competing.

36. Next, as regards the intended purpose of the goods at issue, it should be noted, first, that the applicant confuses the concept of the intended purpose of the goods with that of the public targeted by those goods when it claims that the goods at issue may have a common intended purpose since those goods can be directed at the automotive industry and the electric or electronic industry. That argument must therefore be rejected. Secondly, the intended purposes of the goods at issue are different since the goods in Classes 1 and 17 are intended to be turned into other products, whereas the goods in Classes 9 and 12 are intended (i) to produce, conduct, distribute, transform, store, regulate and control electricity, and (ii) to transport persons or objects, respectively.

37. Their methods of use are also different since the goods covered by the earlier marks are a raw material which will be used in order to manufacture another product, the final product being capable of falling within various industrial sectors, whereas the goods covered by the mark applied for are finished products to be used as such.

38. Furthermore, as regards the complementary nature of the goods at issue, it should be remembered that goods or services are complementary where they have a close connection, in the sense that one is indispensable to, or important for, the use of the other in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking. By definition, goods and services intended for different publics cannot be complementary (see *easyHotel*, paragraphs 57 and 58 and the case-law cited).

39. In that regard, the Court must reject the applicant's argument that the goods at issue may be complementary in so far as the goods covered by the earlier marks may be used for manufacturing the goods covered by the mark applied for. Goods cannot be regarded as complementary on the ground that one is manufactured with the other (see, to that effect, judgment of 13 April 2011 in Case T-98/09 *Tubesca v OHIM — Tubos del Mediterráneo (T TUMESA*

TUBOS DEL MEDITERRANEO S.A.), not published in the ECR, paragraph 49).”

27. Consequently, even if elements of the applicant’s goods were made from fibre reinforced plastic, this fact alone would not make them similar. I find that these goods are not similar.

28. I cannot see that the applicant’s *access hatches* bear any similarity to the opponent’s goods. The opponent has made no submissions on the matter. I decline to find any similarity between *access hatches* and the opponent’s goods.

29. In relation to the applicant’s *parts and fittings for all the aforesaid* goods, I have considered whether scaffolding boards (which could be a part or fitting of scaffolding) are similar to the opponent’s non-metallic decking. However, decking boards and scaffolding boards are very different types of goods. Decking has an aesthetic appeal, whereas scaffolding boards are extremely robust, rough planks of wood, designed to be assembled, and disassembled, many times. There is no evidence that such goods are sold in the same outlets. They are not complementary or substitutable. That they can both be walked upon is too general to find similarity of nature or purpose. They are not similar.

30. This leaves the applicant’s *safety platforms*. This term could cover ground-level or low-level platforms, such as one might find at an event, or covering pavement repairs. Such platforms could consist of modular plastic components. The goods share nature, purpose, method of use, and could be in competition. There is a high level of similarity between the applicant’s *safety platforms* and the opponents’ *modular plastic decking to serve as a ground cover*.

The average consumer and the nature of the purchasing process

31. As the case law above indicates, it is necessary for me to determine who the average consumer is for those goods I have found to be similar; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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 in these terms:

“60. 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.”


32. The only goods in the application which are similar to the opponent’s goods are *safety platforms*. These are more likely to be purchased by businesses or municipal authorities than by members of the public. They are likely to be a considered purchase given that they are for ensuring safety and are likely to be predominantly a visual purchase, given that the purchaser will want visual confirmation of suitability, size and so on. The opponent’s goods could be bought by both individuals and businesses. Again, these will be predominantly a visual purchase, as aesthetic qualities will play a large part in choosing decking. They will also be a reasonably considered purchase given that the goods will be expected to last *in situ* for some degree of time.

Comparison of trade marks

33. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*:

“.....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.”

34. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

The opponent’s trade mark	The applicant’s trade mark
	<p style="text-align: center;">MACDECK</p>

35. The applicant’s mark comprises a single component, MACDECK. The overall impression of the mark resides solely in this component. The opponent’s mark also consists of a word element, but the initial M is stylised. This contributes to the overall impression of the mark, but does not dominate it.

36. There is a good deal of visual similarity between the marks. They both consist of the word MACDECK. The marks are not identical, as per my earlier finding, since there is a visual point of visual difference between them: the initial stylised M in the opponent’s mark. However, they will be articulated in the same way: MACDECK. I think this is more likely than ACDECK, where the opponent’s mark is concerned; the initial M is clearly recognisable as such. Neither mark has a meaning, so the conceptual comparison is neutral. Overall, the marks have a high degree of similarity.

Distinctive character of the earlier trade mark

37. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

38. As the opponent has filed no evidence of any use it may have made of the trade mark upon which it relies, I have only its inherent characteristics to consider. The mark has no meaning. Even if one considered that there is an allusion to decking (from DECK), this is vague and meaningless when preceded by MAC. The mark has a high degree of inherent distinctive character or, at the very least, a good level of distinctive character. In making this finding, I have considered only the element of the opponent's mark which is similar to the applicant's mark²; i.e. not the stylisation of the M.

Likelihood of confusion

39. 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. One of those principles 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. I have found that there is no similarity between the opponent's goods and the applicant's *Scaffolding; safety scaffolding; access hatches; all of the aforesaid goods made wholly or principally of non-metallic materials; parts and fittings for all the*

² *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, at [38] and [39].

aforesaid goods. As per *Canon* at [22], there is no likelihood of confusion where the goods are dissimilar. The opposition fails against these goods.

40. This leaves *safety platforms* to consider. Despite a heightened level of attention during the purchasing process, the high degree of similarity between the marks, the high level, or at least a good level, of distinctiveness of the earlier mark and the high level of similarity between the marks combines to cause a likelihood of confusion. There is no conceptual hook for the average consumer to remember, which means that the marks may be imperfectly recalled and directly confused. However, even if the average consumer notices the difference between the marks in terms of the stylised initial M, they will put this down to a variation on the brand, either by the same undertaking or an economically linked undertaking. In this scenario, the likelihood of confusion will be 'indirect'. Either way, the opposition succeeds against *safety platforms*.

Outcome

41. The opposition fails in respect of *Scaffolding; safety scaffolding; access hatches; all of the aforesaid goods made wholly or principally of non-metallic materials; parts and fittings for all the aforesaid goods*. The application may proceed to registration for these goods.

42. The opposition succeeds under section 5(2)(b) of the Act in respect of *safety platforms*. The application is refused for these goods.

Costs

43. The applicant has been more successful than the opponent, proportionately. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice ("TPN") 2 of 2015. The applicant's written submissions were very brief, so I will award below the scale minimum for preparation of written submissions. I award costs to the applicant on the following basis, offsetting an amount to allow for the success of the opponent in relation to *safety platforms*:

Considering the opposition and preparing the applicant's statement:	£200
Preparation of written submissions	£100
Offset	- £50
Total	£250

43. I order Macdeck Landscaping Limited to pay to J. Mac Safety Systems Limited the sum of £250. This sum is to 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 25 July 2019

Judi Pike
For the Registrar,
the Comptroller-General