

TRADE MARKS ACT 1994

**IN THE MATTER OF Application N^o: 2232407B
by Transframe International Limited
to register a Trade Mark and**

**IN THE MATTER OF Opposition N^o: 52234
by Metalforce Limited.**

1. On 12th May 2000 Transframe International Limited, 1-3 Sterling Court, Loddington, Kettering, Northants, NN14 1RZ applied to register the mark TRANSFRAME INTERNATIONAL for:

‘Storage apparatus; article storage apparatus; apparatus for storing articles during handling, transport, loading, unloading of articles; aids for storage, handling, loading, unloading and transport of articles; storage units; stillages, stillages fitted with wheels, containers, trays, pallets, platforms, all for use in storage and/or handling and/or transport of goods; parts and fittings for all aforesaid goods.’ (Class 6)

‘Transport apparatus; transport systems; transport apparatus and installations, all for handling, loading, unloading and transporting articles; transport apparatus and installations for pulling, pushing and carrying of loads; containers, trays, all for use in storage and/or handling and/or transport of goods; trailers; parts and fittings for all aforesaid goods.’ (Class 12)

The opponents are Metalforce Limited. It claims prior right in the mark, and states that registration would be contrary to s. 3(6) of the Act, and s. 5(4)(a) of the Act. S. 3(3)(b) is also pleaded.

2. A Counterstatement was provided by the applicants, in which the grounds of opposition are denied. Both parties ask for costs to be awarded in their favour.
3. The matter came to be heard on 23rd July 2002, where the opponents were represented by Timothy Gregory of T M Gregory, their trade mark agent. The applicants did not attend.

‘Parallel’ Decision

4. Application No. 2232407A, for the mark TRANSFRAME, is opposed by the same opponents as in this matter, under opposition No. 52233. A decision has been made in those proceedings, and found in favour of the opponents.
5. As the evidence, exhibits and submissions in the instant case are identical to those in opposition No. 52233, I do not believe I need to repeat them here. Neither have I found the result to be any different. I will, however, briefly indicate my findings for this opposition, for each of the grounds pleaded.

S. 3(3)(b)

6. In their Statement of Grounds, the opponents state:

‘The Applicant has no place of business nor any commercial dealings outside the United Kingdom. The element INTERNATIONAL of the Applicant’s Mark is therefore of such a nature as to deceive the public as to the geographical origin of the goods. Registration of the Mark applied for would therefore breach section 3(3)(b) of the Trade Marks Act 1994.’

7. This is pretty thin. I see no reason why calling a business by the common appellation INTERNATIONAL would lead customers to believe that the goods sold to them must come from abroad. I understood it as a reference to the possible extent of their trade, not a reference to the potential source of their products. I notice that Mr. Gregory did not argue this ground at the hearing, or mention it in his skeleton argument. I’m not surprised. It fails.

S. 3(6)

8. I see nothing that disturbs my finding in opposition No. 52232. This ground also fails.

S. 5(4)(a)

9. There is, of course, the difference between this mark and that in opposition No. 52232 in that it contains the additional word INTERNATIONAL. There is no evidence that Norton Fabricators used this word in developing the goodwill I found under the name TRANSFRAME. However, I consider that the passing off case would still succeed, as the potency of the mark in the instant case comes from the TRANSFRAME element. INTERNATIONAL would, in my view, be considered to be suggestive of a range of TRANSFRAME products, and confusion – that is, misrepresentation - would still occur. As before, the opponents succeed on this ground as well.
10. The opposition is successful, and the opponents are entitled to a contribution to their costs. The applicants are ordered to pay them £1000. This sum reflects the reproduction of evidence in this matter, and in opposition No. 52233. It is to be paid within seven days the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 08 Day of August 2002.

**Dr W J Trott
Principal Hearing Officer
For the Registrar.**