

O-048-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2220676  
BY CO-OPERATIVE INSURANCE SOCIETY LIMITED  
TO REGISTER A TRADE MARK IN  
CLASSES 6, 9, 19, 20, 35, 36 & 37**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
No. 52405 BY CISA S.p.A.**

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**IN THE MATTER OF Opposition thereto under  
No. 52405 by CISA S.p.A.**

### **BACKGROUND**

1. On 29 January 2000 Co-Operative Insurance Society Limited applied to register the trade mark CIS HOME in respect of the following goods and services:

**Class 06**

Metal locks; metal doors; parts and fittings for the aforesaid goods.

**Class 09**

Alarms; electric locks; electric security devices; parts and fittings for the aforesaid goods.

**Class 19**

Windows; window fittings; parts and fittings for the aforesaid goods.

**Class 20**

Doors; door fittings; parts and fittings for the aforesaid goods.

**Class 35**

Marketing services; business advice and business administration services.

**Class 36**


Insurance services; financial services; investment services; the provision of advice regarding the sale of financial/insurance goods and services.

**Class 37**

Property construction services.

2. The application was subsequently advertised in the Trade Marks Journal and on 23 April 2001 CISA S.p.A. filed a Notice of Opposition. In summary, the grounds were:

- (i) Under Section 5(2)(b) of the Act because the opponent is the proprietor of the following earlier registered trade mark which is similar to the mark and covers goods identical and similar to those contained in the Class 6 and Class 9 specifications of goods of the mark applied for:

TRADE MARK REGISTRATION No.	MARK	EFFECTIVE DATE	SPECIFICATION OF GOODS
823868		4 August 1961	Class 6 – Locks, padlocks and keys

(ii) Under Section 5(4)(a) of the Act by virtue of the law of passing off in respect to the goods contained within Class 6 and Class 9 of the application.

3. From the Statement of Grounds it is clear that the opposition is only in respect of Classes 6 and 9 of the application in suit.

4. The applicant filed a Counterstatement denying the grounds of opposition.

5. The opponent filed evidence and both parties forwarded written submissions for the hearing officer's attention. Both parties ask for an award of costs in their favour.

6. The parties are content for a decision to be taken without recourse to a hearing.

#### **OPPONENT'S EVIDENCE**

7. This consists of a witness statement by Roy McCawley dated 1 October 2003. Mr McCawley is a Director of CISA (UK) Plc, a subsidiary company of the opponent.

8. Mr McCawley states that the opponent's registered mark has been used in the UK, substantially in the form in which it was registered, since 1975 and goods carrying the mark have been sold in the UK since that date. He adds that goods on which the mark has been used include the following: padlocks; mortice locks; cylinders for locks; panic bars; electric and electronic locks; keys. At Exhibit RMB1 to his statement, Mr McCawley provides a schedule of product sales, a copy of which is attached as Annex One to this decision.

9. Mr McCawley goes on to advertising and promotion and details promotional expenditure in relation to this mark as follows:

1994	1995	1996	1997	1998	1999
£8671	£7078	£7860	£12142	£16448	£24960

10. Mr McCawley explains that the strategy of the opponent has been one of promotion by personal contact rather than by advertising and additionally, the figures do not include advertising and promotion by retailers. He adds that while the above

figures are not excessively high they nevertheless represent a considerable presence, in promotional terms, within a tightly knit industry.

11. Mr McCawley states that the opponent's mark was publicised in relation to the products for which it is registered at a number of exhibitions in the United Kingdom between the years 1992 and 2000. In support he refers to Exhibit RMB2 to his statement which a list of these exhibitions with places and dates. Also Exhibit RMB3 details his company's exhibits at the Independent Hotelier 1998 Exhibition, together with a letter confirming the participation of his company. Furthermore, to Exhibit RMB4 contains a swatch of photographs showing his company's stand at the Hospitality Show in February 1999 and Exhibit RMB5 contains a swatch of photographs depicting his company's stand at Hotelympia in January 2000.

12. Mr McCawley states that advertisements have been placed, inter alia, in GS Magazine, the Essential Product Guide for Hotels and Restaurants, Architectural Profile, Hotels Magazine, Glass and Glazing, National Merchant Banks Society, Hardware Buyers Guide, Building Update, Construction Magazine, Hotel, Product Information Review, the British Hotel and Catering and Institutional Purchasers Data Base, and Architectural Ironmongery Journal. Exhibit RMB7 to Mr McCawley's statement contains a swatch of such advertisements and publicity material. Exhibit RMB7 also shows a mouse mat and an excerpt from an article in the December 1999 issue of Hotel & Restaurant.

13. Mr McCawley goes on to draw attention to Exhibit RMB8 to his statement which comprises copies of a CISA Catalogue for the UK for August 1999 and an Architectural Ironmongers Net Price list for the year 1999, together with a number of informative CISA booklets and leaflets which describe the products. All these items carry the CISA Trade Mark. In addition, Exhibit RMB8 contains a CISA catalogue from the year 1980, showing the original form of the mark as registered and depicting a number of examples of products carrying that same mark. He next refers to Exhibit RMB9 to his statement which contains examples of packaging and labels, showing use of the CISA Mark.

14. Mr McCawley also refers to Exhibit RMB10 to his statement a swatch of orders from outside companies for CISA products.

15. Mr McCawley goes on to make a number of submissions in relation to the issue of similarity and the likelihood of confusion.

16. In relation to the opponent's reputation, Mr McCawley refers to the following Exhibits to his statement:

- (i) Exhibit RMB13 – a 1997 list of hotels throughout the world (including 83 in Great Britain) using CISA locks and safes;
- (ii) Exhibit RMB14 – a swatch of letters sent to the opponent by well-known international hotel chains, praising the opponent's products and concerning the use of the products.
- (iii) Exhibits RMB15 – a booklet about the history of the applicant.

17. Mr McCawley draws attention at Exhibit RMB18 to the result of a search which has been carried out for all trade marks covering the UK either applied for or registered in Classes 6 and 9 and beginning with the letters CIS. He concludes that on the date the search was carried out (November 2001) there were no other marks, either registered or applied for in these classes which covered either locks or other security products and which began with the letters CIS. In Mr McCawley's view this demonstrates that it cannot be argued by the applicant that there are a number of existing marks similar to the mark CISA and covering locks and other security products. Apart from the marks of the opponent, there is no other mark, covering the UK and beginning with the letters CIS, which is applied for or registered in respect of locks and security products except the registrations of the opponent.

## **OPPONENT'S WRITTEN SUBMISSIONS**

18. The opponent's written submissions are attached to a letter dated 5 November 2004 from Fry Heath Spence, the opponent's professional advisors in these proceedings.

19. In relation to the comparison of marks the opponent states that it wishes to concentrate upon three forms of reasonable and fair use and makes the following comments in paragraphs 8 to 18 of its submissions:

### ***"CISA word vs. CIS word***

The first is the form in which this mark will inevitably be used in communication. The word CISA appearing in the centre is a prominent part of the mark and is the only part that can be enunciated or typed. When referred to while speaking, or by telephone, or by email or other electronic communication, the mark will be referred to as "CISA", IE THE WORD. This is, of course, the phonetic appreciation called for by *Sabel v Puma*.

This is not to say that all word and device marks given automatic rights to the word included therein. Each case will stand on its merits, taking into account the absolute levels of distinctiveness of the word element and the device element, and where the balance of distinctiveness lies. In this case, the word is very much more distinctive, and the inherent distinctiveness of the lozenge (etc is not overwhelming. Accordingly, the recollection of the potential purchaser presented with the mark will be of the word element.

This comparison, of the words CISA and CIS BUILDINGS CIS HOME, CIS PERSONAL POSSESSIONS and CIS CONTENTS is straightforward. RMA18 confirms that there are no other marks registered in or in respect of the UK, in the industry sector concerned, which start with the CIS- element. Mr McCawley confirms that he is not aware of any other trade marks prefixed CIS used in the UK for locks and security products, evidence that the applicants chose not to challenge.

The suffixes, viz BUILDINGS, HOME, PERSONAL POSSESSIONS and CONTENTS are all very non-distinctive elements in the field of security. They are all simple descriptions of the things that are being secured. One way of approaching this is to note that the potential purchaser will recall the

distinctive element of these marks, ie CIS. *Sabel v Puma* calls for us to bear in mind, in particular, the distinctive and dominant components. Another is to note that such non-distinctive terms come within the 'halo' that is reasonable and fair use; the opponent produces a range of hotel-specific locks which it refers to as CISA HOTEL LINE (see RMA17); it must surely be entitled to produce a range of locks for private homes and refer to them as CISA HOME, and *mutatis mutandis* FOR THE OTHER SUFFIXES. The presence of these suffixes, non-distinctive as they are, does not therefore assist the applicant.

CISA and CIS differ only in the absence of the final letter 'A'. It is instructive to consider whether the applicant's mark would be allowed were the situation reversed; ie would CISA be regarded as dissimilar to a cited CIS? We think not. This leads to the conclusion that the marks are similar. Furthermore, it is well established that the initial parts of the mark are the most memorable; in this case the mark in question is identical to that very part of the applicant's mark. Again, this leads to a conclusion of similarity.

Mr McCawley gives evidence at several points in his witness statement (paragraphs 15, 16, 18 and 26) to the effect that he considers the marks to be similar and that confusion is likely. The proprietor has chosen not to contest this evidence. No evidence as to non-similarity or unlikelihood of confusion has been offered; not even a simple witness statement by a person in their capacity as a potential customer.

#### *CISA device vs. CIS device etc*

The second form of reasonable and fair use is that of the CISA device as set out above, and the CIS mark presented within a similar border. If the applications are allowed, then the applicant will in practice be permitted to use the marks in whatever manner they think fit. This includes use within reasonably simple border styles, such as that of the CISA device.

Again, the only difference will be the absence of the final 'A' and the presence of the non-distinctive suffixes. Our comments at paragraphs 10 to 13 are repeated.

#### *CISA device vs. CIS (etc) words*

The third form of reasonable and fair use is, of course, the CIS mark as registered and the CISA device as registered.

In this case, there is an additional point of difference in that the applicant's mark includes the ellipse and lozenge devices. However, as noted above, the word CISA appearing in the centre is a prominent part of the mark and is the only part that can be enunciated or typed. When referred to while speaking, or by telephone, or by email or other electronic communication, the mark will be referred to as CISA. Thus, the imperfect recollection of the potential purchaser who saw the CISA device mark would be that she or he had been offered CISA-branded products. The level of distinctiveness which may or may not be held by the lozenge (etc) will not be enough to outweigh the

inherent distinctiveness of the CISA word. As noted above, it is the distinctive components that are (*inter alia*) to be particularly borne in mind in line with *Sabel v Puma*.

It is interesting in these cases to ponder what part of the applicant’s mark led to the examiner’s decision to allow the application when it was made in 1961. Whilst we can only surmise we doubt that it was the lozenge border that so impressed the examiner.”

20. Turning to the comparison of goods the opponent, in paragraphs 33 and 34 of its written submissions, states that:

“This can be summarised as:

<p>Metal Locks</p> <p>Parts and fittings for metal locks</p> <p>Parts and fittings for metal doors</p> <p>Electric locks</p> <p>Electric security devices (being electric locks)</p> <p>Parts and fittings for electric locks (etc)</p>	<p>Identical to: “Locks”</p>
<p>Metal doors</p> <p>Electric security devices (not being electric locks)</p> <p>Alarms</p> <p>Parts and fittings for these goods</p>	<p>Similar to: “Locks”</p>

The goods in Classes 6 and 9 of the opposed applications are all therefore either identical or similar to the goods of the opponent’s registration.”

21. In relation to Section 5(4)(a) the opponent claims that the scale of its use has been significant and has had a significant impact and that as the respective marks are similar, confusion would result.

22. On costs, regardless of the outcome the opponent submits that the Registrar’s normal scale is appropriate.

## **APPLICANT'S WRITTEN SUBMISSIONS**

23. The applicant's written submissions are attached to a letter dated 4 November 2004 from Wilson Gunn M'Caw, the applicant's professional representatives in these proceedings.

24. In relation to the comparison of the marks, the applicant makes the following points:

### **“Visual Comparison**

The applicant's mark in each case is CIS in combination with another word element or elements. The applicant's mark is, in each case, much longer than the opponent's mark. The applicant's marks do not contain any logo element or any stylisation, whereas the opponent's mark comprises of letters which are highly stylised within a distinctive logo.

The only visual similarity between the marks is the letters in common CIS, however this small similarity is outweighed by the material differences in the additional elements of the applicant's and opponent's marks.

### **Aural Comparison**

In normal usage the opponent's mark would be referred to as the CISA logo whereas the applicant's marks would be CIS BUILDING, CIS HOME, CIS PERSONAL POSSESSIONS, CIS CONTENTS. It is submitted that there is no aural similarity between the marks.

### **Conceptual Comparison**

The applicant's marks do have connotations, as they contain everyday words with clear meanings. The words BUILDINGS, HOME, PERSONAL POSSESSIONS and CONTENTS would make a consumer think of insurance, particularly when the words are used in conjunction with CIS which would be recognised as an abbreviation of the well known insurance company. The opponent's mark has no clear conceptual meaning. It is consequently submitted that there is no conceptual similarity between any of the marks.”

25. Turning to the goods at issue, the applicant submits:

### **“Comparison of the goods**

The applicant's goods of the registration are ‘locks, padlocks and keys’, and the additional goods on which they claim to have used the mark are “security systems”. The goods and services of the application which are the subject of the opposition are those in classes 6 and 9. It is of course admitted that “metal locks” and “electric locks” are identical or similar goods to “locks”.

Taking into account the criteria for the comparison of goods and services outlined in the case of **British Sugar Plc v James Robertson & Sons**



**Limited [1996] RPC 281** we submit that none of the other goods and services of the application are identical to or similar with the applicant's goods.

Metal doors, alarms, and electric security devices differ in their nature, uses, users and trade channels from the applicant's goods.

### **Conclusion**

The applicant submits that the marks in suit are not confusingly similar and further that there is similarity of goods to only a very limited extent. The opposition for invalidity based on Section 5(2)(b) should consequently be rejected.”

26. On the Section 5(4)(a) ground, the applicant denies that the opponent possesses goodwill in its mark and states that as the marks are not similar, there is no misrepresentation.

27. The applicant requests a full award of costs as negotiations on a possible settlement were broken off by the opponent and the applicant has been put to the expense of preparing and filing submissions.

28. This completes my summary of the evidence and submissions filed in these proceedings. I now turn to the decision.

### **DECISION**

29. Firstly I go the Section 5(2)(b) ground. Section 5(2) of the Act reads as follows:

“5(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.”

30. An earlier right is defined in Section 6, the relevant parts state:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

31. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

32. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;
- (g) account should be taken on 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 was registered; *Lloyd*;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;
- (i) further, 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; *Marca Mode CV v. Adidas AG*;
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the

meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*

33. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection for such a mark. The opponent has filed evidence relating to the use of its CISA trade mark. While the evidence confirms use of the marks as registered (and also in other formats) and provides information on the turnover of goods sold, it provides no evidence of the opponent's market share or the extent of its reputation. Given the very large market for the goods for which the mark is registered – locks, padlocks and keys – it seems to me that the turnover details provided may not indicate a particularly high market share and do not enable me to infer that the opponent has an especially great reputation under the mark. Furthermore, expenditure on the marketing and promotion of the mark while significant is by no means remarkable and there are no details as to the extent of the circulation of the catalogues and advertising material referred to in the evidence. I would add that no supporting evidence from third parties or the trade has been filed.

34. On the evidence filed, I have no doubt that the opponent possesses goodwill and a not insignificant reputation in its earlier mark. However, it has not been shown to be a household name amongst the relevant public.

35. The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was recently considered by David Kitchen QC sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion.”

36. In the present case it seems to me that the opponent's earlier mark on a balance of its reputation and inherent nature is fully distinctive and deserving of a wide penumbra of protection. In my view CISA would be perceived as an invented word by the relevant customer and it is not a word which has a reference to the goods at issue.

37. In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the

degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of similarity in the goods, and the category of goods in question and how they are marketed. Furthermore, in addition to making comparisons which take into account the actual use of the respective marks, I must compare the application and the opponent's earlier registration on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods within the respective specifications.

38. In its evidence the opponent has drawn attention to the results of a search of the UK Trade Marks Register in Classes 6 and 9 in respect of marks beginning with the letters CIS. This amounts to no more than 'state of the register' information and is of no real assistance – *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281. My decision involves a comparison of the applicant's and opponent's particular marks and must be made on its own merits.

39. I now go on to a comparison of the applicant's goods with the opponent's goods.

40. In determining whether the services covered by the application are similar to the goods covered by the earlier trade mark I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (pages 296, 297) as set below:

“The following factors must be relevant in considering whether there is or is not similarity:

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

41. Whilst I acknowledge that in the view of the CANON-MGM- judgement by the European Court of Justice (3-39/97) the *Treat* case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in *TREAT*) are still relevant in respect of a comparison of goods.

42. In its written submissions the applicant sensibly concedes that its metal locks in Class 6 and electronic locks in Class 9 are identical and similar to those goods encompassed within the specification of the opponent's earlier registration. It denies that there is similarity between its remaining goods.

43. In relation to Class 6 the opponent claims that metal doors and parts and fittings are similar to its locks, padlocks and keys in Class 6. It seems to me that while the respective goods may share a function in keeping property secure and may be purchased at the same time eg doors with locks are supplied as a package by installers or through "D.I.Y." outlets, a door possesses more general additional applications and the manufacturers and the suppliers of the respective goods are usually different, specialised undertakings. Doors and locks/keys are complementary goods and are therefore similar to some degree. However, I do not, on balance, believe them to be closely similar. The relevant public would not, necessarily believe that the goods emanated from the same business undertaking ie locks and doors are specialised products, usually manufactured by different undertakings.

44. Turning to the position on the Class 6 "parts and fittings", it seems to me that a "lock" may, in ordinary language, be described as a part or fitting for a door.

45. I conclude that in relation to Class 6, the applicant's "metal locks" and "parts and fittings for the aforesaid goods" cover identical goods to that of the opponent's earlier registration and that "metal doors" possess some similarity to the goods of the opponent.

46. Turning to Class 9, the opponent submits that alarms, electric security devices and parts and fittings for those goods are similar to its goods. I have no doubt that the description "electric security devices" encompasses "electric locks". Accordingly, these goods and their parts and fittings are similar to the applicant's locks in Class 6. While "alarms" are security apparatus it seems to me that they are normally manufactured, supplied and purchased separately from locks, through different specialist suppliers, or in D.I.Y. outlets through different 'departments' or sections of the store. In my view "alarms" are not similar goods to "locks, padlocks and keys" but if I am wrong in this, any similarity is slight and I do not believe the relevant public would perceive that these particular goods emanate from the same source.

47. I now go to a comparison of the respective marks.

48. The application in suit consists of the two words CIS HOME, the word HOME being an obvious dictionary word clearly describing the entity in, or on, which the relevant goods are to be used. In relation to CIS, the applicant claims that it would be recognised as an abbreviation of the well known insurance company and therefore be perceived as three letters, as opposed to a word. No evidence of reputation has been filed by the applicant and even if I were to take judicial notice of reputation it would only be in relation to "insurance services" and not to the goods at issue in these proceedings. In my view CIS is likely to be perceived as an invented word in relation to the relevant goods. There is no separation or punctuation between the letters, to invite the customer to a different perception.

49. The opponent's earlier mark comprises the four letters CISA, making an invented word, on a light oval background within a four sided "diamond" shaped device. As mentioned earlier in this decision, this is a highly distinctive mark deserving a wide penumbra of protection.

50. The guiding authorities make it clear that I must compare the marks as a whole and by reference to overall impression. However, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in my comparison, reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how the marks would be perceived by customers in the normal course and circumstance of trade. I must bear this in mind when making the comparisons.

51. I go to a visual comparison of the respective marks. The word CISA incorporates CIS in (the first word of the applicant's mark) its first three letters. It differs to the mark in suit in that it contains an additional letter its final letter, the letter A. Furthermore, the opponent's mark is presented within a background device and the applicant's mark contains the non-distinctive word HOME. While the device is a prominent and noticeable element of the opponent's mark, it seems to me that the word CISA is the dominant, distinctive element of the mark as a whole. I would add that the invented word CIS is the dominant distinctive element of the applicant's mark. Notwithstanding that differences exist, it is my view that as the applicant's mark shares the first three letters of the prominent four letter word within the opponent's mark, overall visual similarity exists between the marks as a whole. The beginnings of words are more noticeable to the eye than their terminations, particularly in the context of highly distinctive invented words.

52. In relation to an aural comparison of the marks, it has long been held that in such comparisons "words speak louder than devices" and in this regard the significance of the background device to the opponent's registration is reduced. It seems to me that the opponent's mark would be described as CISA (pronounced SISA) and the applicant's mark CIS (pronounced SIS) HOMES. Dictionary words commencing with the letters CIS are invariably pronounced SIS eg cist, cistern, cistercian. While the word CISA contains an additional syllable, this is balanced by the fact that this difference is at the less noticeable termination of the word, rather than its commencement. While I do not lose sight of the fact that the applicant's mark also differs in that it contains the word HOME, it seems to me that the non-distinctive nature of this word is such that it would not have any significant impact in the aural separation of the marks. Notwithstanding the differences, the aural similarity that does exist means that, in my view, there is overall aural similarity when the marks are compared in their totalities bearing in mind the highly distinctive nature of the invented word within the opponent's mark and the degree of commonality.

53. Next a conceptual comparison of the marks. As both marks contain invented words (the opponent's mark also containing a not readily describable device element and the applicant's mark an additional non-distinctive word), they do not possess a clearly defined conceptual identity. However, both marks contain invented words which share the letters CIS (the dominant distinctive element of the applicant's mark and the first three letters of the opponent's four letter word). Accordingly, there is

some conceptual similarity overall, given the highly distinctive nature of the invented word within the opponent's mark and the degree of commonality.

54. The judgements of the European Court of Justice mentioned earlier in this decision make it clear that in my comparisons I must take into account the average customer for the goods and services, the category of goods and services in question and how they are marketed.

55. The customer for the relevant goods e.g. locks, door fittings etc. is the public at large as well as the trade. The relevant goods are sold/available through a wide variety of outlets and at a wide range of prices. In my view both the respective goods and services would normally be purchased with a good degree of care (which mitigates against confusion) but may be purchased on an infrequent basis, often following recommendation (which means imperfect recollection may prove a factor).

## CONCLUSIONS

56. On a global appreciation taking into account all the relevant factors, I have come to the following conclusions:

- (i) the opponent's earlier trade mark is highly distinctive and is deserving of a wide penumbra of protection;
- (ii) in relation to Class 6, the applicant's goods are identical and similar to those goods of the opponent, but the similarity between "metal doors" and the opponent's goods is relatively slight;
- (iii) in relation to Class 9, the applicant's "electric locks" "electric security devices" and parts and fittings for these goods are similar to those goods of the opponent's earlier registration but, "alarms" and parts and fittings for alarms are not similar goods;
- (iv) the applicant's mark is visually, aurally and conceptually similar to the opponent's earlier registered mark;
- (v) while the nature of the goods means that the customer would be relatively discerning, the identity and/or degree of similarity between the goods of the opponent and the goods of the applicant, together with the degree of similarity between the respective marks is such that, in all the circumstances, there is a likelihood of confusion in relation to –
  - a) "Metal locks" and "parts and fittings for the aforesaid goods" in Class 6,
  - b) "Electric locks", "Electric security devices", "parts and fittings for the aforesaid goods" in Class 9,

but no likelihood of confusion exists in relation to "metal doors" in Class 6 and "alarms" in Class 9 as any degree of similarity in the goods is slight.

57. The opposition under Section 5(2)(b) is successful except insofar as it relates to “metal doors” in Class 6 and to “alarms” and parts and fittings for alarms in Class 9.

58. In reaching this decision I have borne in mind that account should be taken of the highly distinctive character of the earlier mark and that the average customer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture he/she has kept in his/her mind.

#### **Section 5(4)(a)**

59. Next, the Section 5(4)(a) ground.

Section 5(4)(a) states:

“5 (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

60. The law on the common law of passing off is clearly set out by Geoffrey Hobbs QC, acting as the ‘Appointed Person’, in *Wild Child* [1998] 14 RPC 455:

“A helpful summary of the element of an action for passing off can be found in Halsbury’s Laws of England 4<sup>th</sup> Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (a) that the plaintiff’s goods or services have acquired a goodwill or reputation in the marks and are known by some distinguishing feature:
- (b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public or believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.”

The restatement of the elements of passing off in the form of this classical trinity has been referred as providing greater assistance in analysis and



decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the fact before the House."

61. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action of passing off where there has been no direct misrepresentation generally requires the presence of two factual elements;

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the Plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective field of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

62. Thus, to succeed in a passing off action, it is necessary for the opponent to establish that at the relevant date (i) they had acquired goodwill under this mark, (ii)

that use of the applicant's mark would amount to a misrepresentation likely to lead to confusion as to the origin of their services, and (iii) that such confusion is likely to cause real damage to goodwill.

## **GOODWILL**

63. In my considerations under Section 5(2)(b) I found that the opponent has a reputation in relation to locks, padlocks and keys. I have no doubt that it possesses sufficient goodwill to launch a passing off action.

## **MISREPRESENTATION**

64. While the opponent possesses a reputation in relation to locks, padlocks and keys, it seems to me that following the decision reached in relation to Section 5(2), the Section 5(4)(a) ground places it in no stronger position. There is no obvious stronger connection between those relevant goods which the opponent disputes and those goods for which the opponent possesses a reputation.

65. To succeed in relation to the relevant goods the opponent has to show that the relevant public will believe that these goods provided by the applicant are goods of the opponent.

66. I have already compared the applicant's and opponent's trade marks and found them to be similar. It is well established that in the law of passing off there is no limitation in respect of the parties' field of activity. Nevertheless, the proximity of an applicant's field of activity to that of the opponent is highly relevant as to whether the acts complained of amount to a misrepresentation.

67. In essence the question I have to address is whether the relevant public seeing the applicant's mark used on metal doors and alarms would be likely to believe the goods were being offered by the opponent. In *Harrods v Harrodian School* [1997] RPC 697, Millet LJ stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant's goods or services”.

68. In the recent case of *South Cone v Jack Bessant, Dominic Greensmith, Kenny Gary Stringer (a partnership)* 16 May 2001, HC 2000 APP 00617, Pumfrey J in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

“There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the

enquiry under Section 11 of the 1939 Act (\*see *Smith Hayden (OVAX)* [1946] 63 RPC 97 as qualified by *BALI* [1969] RPC 473). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

69. I do not consider that the applicant has discharged the onus of showing that the necessary misrepresentation required by the tort of passing off will occur in relation to metal doors in Class 6 and alarms in Class 9, following the opponent’s success under Section 5(2)(b). The opposition under Section 5(4)(a) fails.

## **OUTCOME**

70. The opposition has partially succeeded under Section 5(2)(b). It has succeeded in relation to metal locks and parts of fittings for these goods and also parts and fittings for metal doors in Class 6 and also in relation to electric locks; electric security devices; parts and fittings for these goods in Class 9. It has failed in respect of metal doors in Class 6 and alarms and parts and fittings for these goods in Class 9.

71. In light of the above the applicant may proceed to registration if within twenty eight days of the expiry of the appeal period the applicant files a Form TM21 restricting its Class 6 and Class 9 specifications to:

### **Class 06**

“Metal doors”

### **Class 09**

“Alarms and parts and fittings therefor”

72. As both sides have achieved a measure of success it seems to me appropriate that I make no order as to costs in these proceedings. In relation to the submissions of the applicant on this point (see paragraph 27 of this decision) I would only comment that there is no obligation on the opponent to resolve the issue through negotiation. There is no evidence that the opponent has conducted itself in an unreasonable or disproportionate manner. In the event, the opponent has been partially successful in these proceedings.

**Dated this 28<sup>th</sup> day of February 2005**

**JOHN MacGILLIVRAY  
For the Registrar  
the Comptroller-General**

**The Appendix is not attached.**