

O/131/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2496940
BY HUNTON FIBER AS FOR THE TRADE MARK:**

SILENCIO

AND

OPPOSITION THERETO (NO 99253) BY EGGER RETAIL PRODUCTS GMBH

The background and the pleadings

1) Application 2496940 was applied for by Hunton Fiber AS (“Hunton”) on 5 September 2008. The mark consists of the word SILENCIO. The mark was published in the Trade Marks Journal on 27 March 2009. Various goods in classes 11, 17 & 19 are sought to be registered, but the opposition is only against:

Class 17: Packing, stopping and insulating materials; electrical, thermal and acoustic insulating material.

Class 19: Building materials (non-metallic)

2) Egger Retail Products GmbH (“Egger”) opposes the registration of the above application in respect of the above goods. Its opposition was filed on 26 June 2009 and is based on grounds under sections 5(2)(b) & 5(3) of the Trade Marks Act 1994 (“the Act”). A single earlier mark is relied upon, namely: International Registration (“IR”) 770882 which is in respect of the word SILENZIO. The IR is protected in the UK in respect of the following goods:

Class 19: Laminated chip board panels.

Class 27: Materials for covering existing floors, walls and ceilings, made from laminated chip boards.

3) The IR designated the UK for protection on 29 October 2001, protection subsequently being conferred in June 2002. The consequences of these dates are that: i) Egger’s mark constitutes an earlier mark in accordance with section 6 of the Act, and ii) the earlier mark is subject to the proof of use conditions contained in section 6A of the Act, protection being conferred more than five years before the publication of Hunton’s application.

4) Hunton filed a counterstatement denying the grounds of opposition. Hunton asked Egger to provide proof of use in respect of its earlier mark. Hunton accepts that its goods in class 19 are similar to the goods covered by Egger’s earlier mark, but it does not accept that the other goods it seeks to register are similar. It states that when the nature of the products and the marketplace are considered, consumers are able to distinguish between marks with relatively small changes. It states that the marks co-exist on the Norwegian register and have co-existed in the UK marketplace for several years. Hunton denies that Egger’s mark has a reputation claiming that if any party has a reputation then it is Hunton not Egger.

5) Both sides filed evidence. Both sides attended a hearing before me where Hunton were represented by Mr Guy Hollingworth, of Counsel, instructed by Marks & Clerk LLP and where Egger were represented by Ms Gillian Deas of D Young & Co.

The evidence

Egger's evidence – witness statement of Stefan Pletzer

6) Mr Pletzer is Egger's managing director. After setting out some background information, he explains that Egger's SILENZIO trade mark is used in relation to laminate floors which incorporate a sound-proofing underlay. Extracts from its website at www.egger.efp.com are provided which make various references to SILENZIO as an underlay (which helps with sound-proofing). The underlay forms part of the construction of certain laminate flooring products sold by Egger. The prints (which are contained in Exhibit 1) are dated 1 May 2009 and 8 June 2009, but which are said to show the continuing use of this trade mark in the UK. The prints also contain a page headed "EGGER Sales Offices for Laminate floors" which identifies a sales office in Hexam, Northumberland under the name "E.F.P. Floor Products".

7) Exhibit 2 contains three product brochures said to be from June 2006, July 2006 and April 2007. Printed on the side of each brochure, in small letters, are the designations "EM/4SO1_UK_07/06", "EM/54s01_UK_04/07" and "EM24S01_UK_067/06"; this is where the dates that Mr Pletzer refers to is taken. On the back of two of the brochures are contact addresses but none are in the UK. The brochures make reference to laminate flooring products (the names of which appear to be MEGAFLOOR and EMOTION) which have SILENZIO incorporated into them. Some of the references about SILENZIO read:

"The integrated silenzio underlay refines the sound of the floor...";

"ALL DECORS FROM MEGAFLOOR M1 AND M2 OPTIONAL WITH SILENZIO UNDERLAY AVAILABLE ON REQUEST";

"SILENZIO – Now hear the quiet. The sound-absorbing underlay fitted directly onto the panel makes the difference you can really hear. A pleasant warm sound, just like a wooden floor";

"4. Simply silent! The silenzio underlay promises optimum soundproofing for every floor, just like wood underfoot";

"Ahead of our time! The new trend decors in class 32 bring new colours into your life – on silent soles with the silenzio-system";

"Sounds like wood: the new silenzio system reduces the audible sound of echoes by almost a half and guarantees that warm "wood sound"."

8) The brochures contain what could be described as a key to the features of the flooring products, as shown in the following scan:

So much **quality** when it comes to:

Appearance:



2-SIDED WOODVISION® BEVEL

The longitudinal bevel enhances the natural beauty of the floor.



4-SIDED WOODVISION® BEVEL

The circumferential V-bevel creates a perfect wood floor appearance from all angles.

Surfaces:



AUTHENTIC LOOK

Surface with a hand-planed, scrubbed character. The natural, slightly wavy effect gives the floor a real authentic touch.



BRILLIANT

Rustic, deep-brushed structure set brilliantly in context thanks to the glossy surface.



CERAMIC

The Ceramic structure complements the tiled appearance perfectly.



RUSTIC

The deep-grained Rustic textured surface highlights the brushed and lively vigour of rustic decors.



VELVET MATT

The noble Velvet Matt surface creates a matt appearance all of its own.



WOODLINE

The natural Woodline surface brings classically elegant decors into their full glory.



NATURAL PORE

The surface that begs to be touched: The fine pore structure exactly follows the grain of the wood and lends pure vitality to the floor.

Comfort:



SILENZIO

Now hear the quiet. The sound-absorbing underlay fitted directly onto the panel makes the difference you can really hear: A pleasant warm sound, just like a wooden floor.



SILENZIO PLUS

Double the volume – double the comfort. The silenzio Plus System has a special 2.5 mm thick cellulose underlay for clear reduction in impact noise and room noise, as well as providing optimum comfort underfoot.



ANTISTATIC

The antistatic feature prevents electrostatic charges from building up. It goes without saying that all laminate flooring in the emotion® range has this feature.

Design:



One giant step ahead of its time. The new modern decors from class 32 bring new colours to life – but softly, softly with the silenzio system.



Profile:

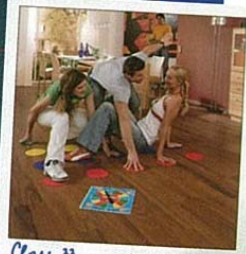


JUST clic!

The new JUST clic! profile guarantees perfect professional laying: no glue, "ready to walk on" immediately and excellent surface stability.

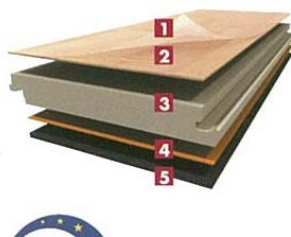
9) The icon representing silenzio appears on a good many of the products throughout the various brochures. The brochures also feature a representation of the construction of the flooring products, as shown in the following scan. Some of the information about the flooring products includes the thickness of the flooring e.g. "TOTAL THICKNESS: 9mm (8 + 1mm silenzio)":

Format	1292 x 192 mm
Total thickness, silenzio System Plus	10.5 mm (8 + 2.5 mm silenzio) 
Area per pack	1.49 m ²
Boards per pack	6 pcs.
Core	HDF swell-barrier plus
Class of use, Guarantee	33  25 year Guarantee
Applications	Ideal for heavy domestic and heavy commercial use.



Class 33 – robust, professional, creates space for ambitious projects and new ideas.

Guarantee valid in accordance with EGGER Guarantee Conditions.



- 1** Resilient, highly abrasion-resistant overlay
 - 2** Decor paper
 - 3** Special HDF-coreboard made from natural wood fibres
 - 4** Balancer
 - 5** silenzio underlay (only with identified decors)
- All papers are resin-impregnated.**



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10) Mr Pletzer provides sales figures for goods “for which it is registered” sold under the SILENZIO mark between 2002 and 2009. The figures fluctuate, the lowest being 38,893 Euro in 2002 the highest being 661,287 Euro in 2006. Two invoices are provided in Exhibit 3 from September and October 2002. The invoices are made out to UK businesses: Egger Floor Products Limited in Leeds and MCD Group in Kent. The designations used on the invoices include “FLOORLINE 31 ESPIRIT CLICI SILENZIO 10, 3mm” and “FLOORLINE 23 STYLE CLICI SILENZIO 8 mm”.

11) Reference is then made to the exhibition of SILENZIO goods in the UK at the Harrogate Flooring Show in September 2001. Photographs of its stand are provided which feature the words SILENZIO SYSTEM. It is stated that the goods are manufactured in Austria and are exported to the UK. It is stated that they are

available through Flooring2Floors, K Flooring Limited and EZ Flooring and others, between them covering the whole of the UK.

Hunton's evidence – witness statement of Arne Jebsen

12) Mr Jebsen is Hunton's managing director. He explains that SILENCIO was developed in 1998 as an insulation and sound impact board. He says that sales began in the autumn of 1998. An invoice from 1998 is provided in respect of HUNTON SILENCIO, made out to HUNTON FIBER (UK) Ltd (a 100% owned subsidiary of Hunton) through which the goods are sold and marketed in the UK. He states that the goods were stocked in the UK and sold to a variety of customers in the UK market. A document from 1998 (claimed to be from a brochure) includes a reference to Hunton's products which states "...focus right now is on a new 36mm sound insulation product; the *SilencioR*."

13) Mr Jebsen states that the mark has been used continuously since 1998. Accumulated sales in the last three years are £695,000. He adds that Hunton's product is used underneath flooring materials and is not visible after use. He contrasts this with Silenzio which he describes as laminated flooring boards used as a flooring material and clearly visible after use. He states that there is no competition but that there may be some complementarity. He states that Silencio is primarily sold to professional construction customers with a high degree of product knowledge.

Egger's reply evidence

14) No reply evidence was filed. Written submissions were, though, filed which I will bear in mind but will not summarise here.

The proof of use provisions

15) As stated earlier, the proof of use provisions apply to Egger's earlier mark. The use conditions are set out in section 6A(3) of the Act as follows:

"...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."

16) Section 100 is also relevant which reads:

“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.”

17) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely: the judgments of the Court of Justice of the European Union (“CJEU”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). The position¹ was helpfully summarized by Ms Anna Carboni, sitting as the Appointed Person, in BL O-371-09 *SANT AMBROEUS*:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a 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]; *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].

¹ Which also took into account the guidance set out in *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28

(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].

(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].”

18) The relevant period for my assessment is the five year period ending on the date of publication of Hunton’s mark, namely: 28 March 2004 to 27 March 2009. Mr Hollingworth made a number of submissions relating to Mr Pletzer’s proof of use evidence. I will break the issues down into two. I will come back to the nature of the evidence and the goods for which the use may or may not support, but I will deal firstly with the sufficiency of the evidence to prove anything. In relation to this, Mr Hollingworth highlighted that the website material is from after the relevant period, the invoices (one of which he assumed to be an internal invoice) are from before the relevant period, as is the evidence about the trade show. In relation to the brochures, it was stated that whilst some dates (from within the relevant period) were printed on them as part of a code (which also featured the letters UK), the evidence does not explain where they were circulated and in what amounts nor what the significance of the coding is; Mr Hollingworth also highlighted that the only contact details on the brochures were outside the UK. It was submitted that Mr Pletzer’s statement provided little by way of narrative and, therefore, his evidence was more akin to assertion than fact. In contrast to Mr Hollingworth, Ms Deas considered that, as a whole, proof of use had been demonstrated.

19) Whilst I agree that Mr Pletzer’s evidence could have been better, the post- and pre- relevant period evidence at least shows the start of a business through which the mark has been used and that the use has continued after the relevant period. In terms of the relevant period, turnover figures have been provided for goods sold under the mark. Based on this statement, which was never formally challenged prior to the hearing, together with the totality of the evidence, I am prepared to accept that the sales figures represent sales within the relevant period of laminate flooring with incorporates Silenzio in its construction (as per

the brochure evidence). The only remaining question is, therefore, whether the trade mark has been presented to the consumer and the nature of such presentation. Here I think the brochures may be relied upon. Mr Pletzer, although not providing the level of narrative Mr Hollingworth may have liked, does suggest that these are English language brochures issued in the UK. The position is supported by the use of UK in the coding. Whilst I note that there is no UK address on the brochures, this is not fatal to the evidence. The addresses in Germany and Austria may just be the primary European company addresses from who the goods are exported (as per Mr Pletzer's statement). If the brochures were for distribution in Germany and Austria it seems strange as to why they would be in English. All things considered, and all other things being equal, I consider that the normal tests for genuine use have been met and that the manner of use in the brochures reflects the nature of such use.

20) I used the expression "all other things being equal" in the preceding paragraph. This is because of the second issue which I said I would come back to, namely the nature of the evidence and the goods for which it may or may not support. The statement of use Egger made relates to the following goods:

Class 19: Laminated chip board panels.

Class 27: Materials for covering existing floors, walls and ceilings, made from laminated chip boards.

21) There is clearly no use of the mark in relation to coverings for walls and ceilings so what it boils down to are: laminated chip board panels in class 19 and laminated chip boards for covering existing floors. However, as can be seen from the evidence, SILENZIO is described as an underlay that is integrated into the panel. As Mr Hollingworth pointed out, the underlay is not made from chipboard so any use of an underlay would not be use of the mark in relation to the above goods. However, Mr Deas submitted that the mark functions as a trade mark in relation to the panels themselves. Mr Hollingworth referred to the decision of the Court of Appeal in *Du Pont* [2004] FSR 15 where it was stated:

"35 EIDP's evidence was accurately summarised in paras 9–15 of the hearing officer's decision. In essence that evidence established very substantial use of the trade mark DU PONT upon swing tickets and the like applied to clothes. A typical example is shown below.



36 Mr Hobbs submitted that the use of the trade mark DU PONT on that ticket was in relation to the clothes, alternatively in relation to the fabric. Both uses were trade mark use as the purpose and effect was to indicate a connection in the course of trade between the goods and his clients. I reject his first submission, essentially for the reasons given by the hearing officer in para.27 of his decision in the opposition to STD's trade mark application which the judge accepted to be correct in para.[48] of his judgment. In my view the word DU PONT as used on the swing ticket depicted in para.[35] above denotes that the yarn or fabric has a connection with the proprietor of the trade mark. That use may be use in relation to clothes, but it is not so as to indicate a trade connection between the clothes and the EIDP. Guidance consistent with that view can be obtained from the speeches of the *House of Lords in Aristoc Ltd v Rysta Ltd* (1945) 62 R.P.C. 65 . As Lord Simonds said at p.85:

“The word ‘trade’ has many meanings, wide or narrow, according to the context in which it is found. It is by the ascription to it of a wide meaning in s.68 of the Act that the respondents support their claim. But it appears to me that the subject matter, the history of the law and the context in which the word is found both in s.68 and elsewhere in the Act, unite to deny to it any such meaning. It might be true to say that the respondents carry on a trade which is connected with stockings, just as a cleaner carries on a trade which is connected with the goods that he cleans or a piano-tuner a trade connected with the piano he tunes, but it does not follow, and in my opinion it is not the fact, that there is in any such case such a connection in the course of trade between the goods and the person rendering that service or performing that operation as to satisfy the definition in s.68. It is unnecessary, and would be dangerous, to attempt to give a positive and exhaustive meaning to the word ‘trade’ in the definition. It is sufficient to say that it can bear no wider meaning than it would bear if the words ‘in the goods’ were added after it. The test is then whether the applicant for the mark can be said to trade in the goods, and this test is clearly not satisfied by one who merely renders some service in respect of them after they have reached the public.”

22) There are inherent difficulties relying on a decision made under the 1938 Act, a decision which related to section 10 of that law. I note, however, the finding that: “In my view the word DU PONT as used on the swing ticket depicted in para.[35] above denotes that the yarn or fabric has a connection with the proprietor of the trade mark. That use may be use in relation to clothes, but it is not so as to indicate a trade connection between the clothes and the EIDP”. More recent and more relevant guidance can be seen in the judgment of the Irish Supreme Court in *Compagnie Gervais Danone v Glanbia Foods Society Ltd* [2010] IESC 36 where it dealt with the name of an ingredient product used in

yoghurt; a full and detailed judgment was given including the following statements:

“One of the factors to be taken into account in the present case, in assessing whether or not the trademark when used on packaging for yogurt and extensively in its marketing and advertising, *inter alia*, for the recognised purpose, as found by the learned High Court judge, of distinguishing the appellant’s yogurt from others, is capable of, or does in fact, carry out its essential function, may be the characteristics of the goods in question. Certainly in the present case ESSENSIS is closely related to the product itself because it is used on the culture which gives it its unique, or one of its unique, characteristics. It is, in fact, “*integral to the make up or structure of the goods*” as mentioned at paragraph 42 of *Ansul*, supra., where the court granted protection to spare parts, even when “*not integral*” to the unused goods.

.....

I am satisfied that on a correct application of both the general principles of law found in the *Ansul* case and in later decisions of the European Court of Justice, and on the specific findings of the Court in relation to the type of use occurring in *Ansul*, these principles and findings clearly respond to and fully answer the legal issues arising in this appeal. On the correct application of both the general principles and the specific principles applicable to the factual evidence of trademark use in the *Ansul* case, these are such as to oblige me to conclude that the learned High Court judge applied an unduly restrictive interpretation of those principles, and that in doing so, she erred in law. Having regard to my findings on the correct application of the principles established in the case law of the European Court of Justice, upon which the learned High Court judge based her reasoning, I do not consider it necessary to invoke the case law of other Member States in relation to the correct application of the law found in the Directive and as transposed into Irish law by the Act of 1996. Moreover, I consider that the case law of the European Court of Justice, cited above, providing, as it does, a sufficiently clear basis upon which to determine the sole issue for resolution in this appeal, there is no requirement to refer any question to that Court for its opinion.

For the above reasons, I am satisfied that the appellant established before the High Court sufficient facts as to use of the trademark ESSENSIS upon which the learned High Court judge ought to have concluded that the use of that mark was genuine trademark use in respect of the products for which it is registered, namely yogurt, and that by reason of an unduly narrow application of the principles relating to trademark use, as established by the European Court of Justice, the learned High Court

judge misdirected herself in law on the application of the appropriate principles to the evidence established in the course of the hearing.”

23) I mentioned the above case at the hearing, but the parties’ representatives were not well sighted on it. I therefore allowed a period of time for further written submissions to be filed in relation to it. Egger’s submissions were based on the “essential ingredient” aspect of the decision and that this is what SILENZIO was in relation to the flooring product. It highlighted that the underlay is integrated into the flooring, being applied directly to it. Hunton submitted that the facts are materially different from the *Danone* case and that the judgment of the Irish Supreme court had given an overly broad interpretation of *Ansul*. It submits that SILENZIO is not an essential ingredient; it highlights the optional nature of the underlay and that it is “in no way subsumed within, or an in-dissociable part of, the laminated chipboard panel”. It is submitted that SILENZIO remains a distinct element albeit one that attaches to some of flooring panels. It is submitted that the close and consistent connection is also lost as none of the primary/secondary brands are used in conjunction with the mark (e.g. there is no use of phrases such as “MEGAFLOOR with SILENZIO”). In relation to the broad interpretation of *Ansul*, it is submitted that the CJEU firstly gave specific guidance on genuine use issues and then considered the exact facts of that case; in other words, the facts in *Ansul* were quite specific (component use preserving the mark which had previously been used for the complete product) and do not set out a general rule that component part use will always maintain a registration.

24) The mark must have been put to “genuine use....in relation to the goods or services for which it is registered”. The case-law is noted, but the matter to decide is fact orientated. There may be cases in relation to component/ingredient use where one form of use constitutes genuine use but another form may not. I think the *Danone* case, which is persuasive but not binding, supports the proposition that in *some* circumstances the use of component/ingredient name may constitute genuine use in relation to the complete product. That does not mean that all component/ingredient use will. The *Du Pont* case is borne in mind but I feel it is of limited value, in any event, even if it were more relevant then it would only indicate the corollary of *Danone*, a corollary which I have already accepted. I must look at the nature of the use and decide whether it is aimed at maintaining or creating an outlet for the goods (the finished flooring product).

25) There is no doubt that SILENZIO refers, specifically, to the underlay layer of the floor panel sold by Egger. It is not in all of the panels just certain ones sold. Hunton focuses on the optional nature of the underlay. In the first brochure relating to the MEGAFLOOR product, panels in the M1 & M2 MEGAFLOOR range identify SILENZIO as an optional extra available on request, but for the M3 MEGAFLOOR it appears integrated as standard. The other brochures relate to EMOTION flooring with the various ranges appearing to either have it or not; there does not seem to be an option to add the underlay if it is not already integrated. Looking, for example, at the EMOTION use, the primary mark is

EGGER, the secondary mark is EMOTION. As Ms Deas submitted, the fact that a mark is not a primary or secondary mark does not matter. A third level mark may still be genuinely used. The question, though, remains as to whether SILENZIO is being used as a third level mark in relation to the flooring. It points to the underlay as an integrated feature of the complete product. I agree with Egger that this is more akin to an essential ingredient/component. The fact that versions of the product may exist without the component does not matter. For those products into which it is integrated SILENZIO is a key feature/component. There is no option to remove it. In my view, the net affect of such use if that SILENZIO is performing, effectively, a dual role. Whilst it refers specifically on the one hand to the underlay component, it does so in a way that links that component with the complete product. In Hunton's further written submissions it highlighted that there was no use of designations such as "EMOTION with SILENZIO" – whilst this is true, the nature of the use is equivalent. It is informing the consumer that the product is EMOTION featuring SILENZIO. It therefore points as much to the complete product as to the underlay. The consumer may want the SILENZIO version of the product as opposed to the non-SILENZIO version. Such a role is aimed at maintaining a market for the finished product. I consider such use to meet the genuine use test in relation to the finished product.

26) In terms of the specifications of the earlier mark, there is a difference between the class 19 and class 27 terms. Class 27 relates to products for covering existing flooring which is what the product, as used, constitutes. There is no use of laminated chipboard panel distinct from the floor covering use. As such, I consider that the earlier mark may be relied upon only in relation to:

Class 27: Materials for covering existing floors, made from laminated chip boards.²

Section 5(2)(b)

27) Section 5(2)(b) of the Act reads:

"5.-(2) A trade mark shall not be registered if because –

(a)

(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."

² The specification is a fair one notwithstanding that the Silenzio component is made from cellulose, the specification reflects how the complete product will be described.

28) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

29) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or services can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

30) There is a reference to Hutton's goods being sold to professional construction workers. This may be so, but even though they may be so targeted, building materials can also be sold to the general public, albeit those who have an interest in DIY etc. Those in the construction industry may also purchase laminate flooring to cover floors in houses that they have built. In relation to laminate flooring, such goods may be purchased for corporate use, but a large proportion will be sold to the general public. In terms of a member of the public purchasing such goods, they may be DIY enthusiasts who intend to fit it themselves or they may intend to get it fitted by someone else (sometimes the company they are purchasing it from); either way, the member of the public will still consider the goods quite carefully before purchase.

Comparison of goods

31) The goods sought to be registered by Hunton are:

Class 17: Packing, stopping and insulating materials; electrical, thermal and acoustic insulating material.

Class 19: Building materials (non-metallic)

32) Following my proof of use assessment, the earlier mark is to be considered on the basis of:

Class 27: Materials for covering existing floors, made from laminated chip boards.

33) Mr Hollingworth highlighted that no evidence as to the similarity of the goods has been provided by Egger. His comments were made in light what the CJEU stated in the *Canon* case, the relevant part of which reads:

“22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

34) However, whilst the above is noted, it may not always be practical to adduce evidence of similarity, for example, it may be that the nature of the goods/services is well-known so that it would be a waste of effort and resource to provide evidence. Such an approach was advocated by Mr Hobbs QC (sitting as the Appointed Person) in *Raleigh International trade mark* [2001] R.P.C. 11 where he stated:

“If the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered, the objection should be supported by evidence as to their “similarity” (whether or not the objection is directed to the use of an identical mark): Canon paragraph 22. Paragraph 23 of the Judgment in Canon indicates that it is appropriate to consider the pattern of trade with reference to factors such as those (uses, users and physical nature of the relevant goods and services; channels of distribution, position in retail outlets, competitive leanings and market segmentation) identified by Jacob J. in *British Sugar Plc v James Robertson v Sons Ltd.* [1996] RPC 281 at 296, 297.”

35) The failure to provide evidence as to similarity cannot therefore be fatal to Egger’s case, however if the goods being compared are not self-evidently similar on the basis of the normal forms of assessment, then the failure to provide evidence will be more telling.

36) I will begin by comparing the building materials in class 19 with the goods of the earlier mark. The term building materials is a relatively wide one, however, it would contain within its ambit laminated chipboard panels that could be used as flooring (forming the flooring as a whole rather than coverings for flooring). In the

absence of a revised specification, it is appropriate to make the comparison on this basis even though there may be other goods that are less similar. I will, though, also make a comparison on the basis of the goods that Mr Jebson referred to in his evidence (an insulating chipboard panel that is then covered) as this would no doubt have reflected the core of any fall-back specification if one had been put forward.

37) Comparing firstly a laminated chipboard panel used as flooring (in comparison to a floor covering), the goods could be of the same nature (chipboard). Mr Hollingworth highlighted that the class 19 goods form the permanent floors and the class 27 goods are floor coverings. This may be so, but the purpose is still similar. The methods of use may not be identical but there will be a degree of similarity, albeit the floor coverings will be laid upon an existing floor whereas the class 19 goods will be laid upon struts or other sub floors. It is not clear where the respective goods will be sold, they are unlikely to be sold next to each other but could be sold in the same establishments that focus on building materials/DIY products. I consider there to be a good deal of similarity. When comparing the goods with an insulating chipboard panel that is then covered, then Mr Jebson refers himself to the possible complementary relationship because such goods may be used beneath the floor coverings. The nature may be similar as is the manner in which they are laid. The complementary relationship may lead to them being located in close proximity to each other. There is, again, a good deal of similarity.

38) I must also make a comparison between:

Class 17: Packing, stopping and insulating materials; electrical, thermal and acoustic insulating material.

and

Class 27: Materials for covering existing floors, made from laminated chip boards.

39) I asked the parties representatives what the class 17 goods listed above actually covered. Ms Deas suggested that they were materials for filling gaps and holes which could be used for sound dampening. Mr Hollingworth also referred to stopping gaps but such goods seemed to him to be somewhat dissimilar from laminate flooring and that there was no evidence to the contrary. The tribunal is obviously in a difficult position with such terms. The use of the word material is not indicative of a board type product but will be more akin to a material that is packed into cavities such as walls, loft spaces etc for insulating and acoustic insulating. In view of this the nature is not the same as a laminate floor panel, nor is the method of use. The goods are certainly not competitive and absent evidence it is not self evident that such goods are complementary to laminate flooring. There is no evidence, for example, that such goods can be used in

conjunction with laminate flooring. There may be some aspects of similarity in terms of trade channels, but this is fairly superficial. They may be some similarity on a general level that the goods may perform acoustic insulation which could be a feature (although not primary purpose) of laminate flooring. Weighing up all this, the most I conclude is that any similarity is of a low degree.

Comparison of the marks

40) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components.

41) The respective marks are SILENCIO v SILENZIO. The applicant accepts that the marks are similar. However, in view of the interdependency of the various factors, I will make an assessment on how similar the marks are. In that respect, I observe that the marks are of similar length (both being 8 letters long) and that the first five letters of each are in common. There is a difference in the endings “-CIO” as opposed to “-ZIO”. This creates a point of difference both aurally and visually. However, I do not consider the impact of this difference to be hugely acute. I consider there to be a reasonably high degree of aural and visual similarity. In terms of concept, both marks are evocative of the words SILENCE/SILENT with the result that the marks are likely to be perceived by the average consumer as foreign (perhaps Spanish or Italian) equivalents of such words. This creates conceptual similarity. Overall the marks are highly similar. I should add that even if I am wrong on my assessment of concept and that there will be no evocation of the word SILENCE/SILENT then the marks will instead be perceived as invented and, as such, there is no conceptual difference to counteract the visual and aural similarities; the marks will still be similar to a reasonably high degree

The distinctiveness of the earlier mark

42) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent point of view, the mark SILENZIO is evocative of the words SILENCE/SILENT, a word which has some relationship with the goods (i.e. those that have sound-insulating properties). However, considered as a whole the mark is only mildly allusive. I consider the mark to possess an average (neither weak nor strong) degree of distinctiveness.

43) The use made of a mark may enhance its distinctive character. Evidence has been provided of the use made. However, whilst sales figures have been given, I have no evidence as to the significance of such sales in the UK market. Whilst the figures themselves do not strike me as insignificant, they are not of

such a level that it could be inferred that they are particularly significant either. The position is not helped because there is no advertising or promotion taking place, or at least none which is set out in the evidence. On this basis, I cannot hold that the earlier mark's average degree of distinctiveness is enhanced to any material extent.

Likelihood of confusion

44) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. When deciding the result then I should say that the claim in Hunton's counterstatement that the marks co-exist (on the Norwegian register and in the UK marketplace) adds nothing. Co-existence on any register is indicative of little. Furthermore, in terms of co-existence on the UK market, the levels of use do little to persuade me that there has been sufficient co-existence to lead to a telling indication and, furthermore, the goods may have been targeted at different markets (Huton states that its goods are marketed at professional construction customers).

45) In relation to the goods sought to be registered in class 19, I have found a good deal of similarity with the class 27 goods of the earlier mark and a reasonably high degree of similarity between the marks. I bear in mind the principle of imperfect recollection but, also, that the purchasing process is unlikely to be a causal one and a more than average degree of consideration will be used. Whilst this has the potential to mitigate, to a degree, imperfect recollection, my finding is that the degree of similarity between the marks is acute enough to cause confusion as to trade origin of the goods at issue. The closeness of the marks will mean that the average consumer is likely to be confused as to trade origin when he encounters the goods in question which have a good deal of similarity and may be seen as a complementary product or one which is an expansion of its product range. **There is a likelihood of confusion in relation to the goods sought to be registered in class 19 and the opposition succeeds to that extent.**

46) In relation to class 17, the position is somewhat different. The goods have at best only a low degree of similarity and there is no obvious relationship in trade between them. Whilst it is possible that the average consumer could encounter them in trade, the lack of any real complementary relationship, or a relationship which would strike them as an obvious trade expansion, will mean that the average consumer will at best pause to wonder about whether there is an economic connection between the providers of the respective goods, but such

wonder will not result in a likelihood of confusion. **The opposition fails in relation to the class 17 goods.**

Section 5(3)

47) For any claim under this ground there is a pre-requisite that the earlier mark has a reputation. In *General Motors Corp v Yplon SA* [1999] ETMR 122 and [2000] RPC 572 the CJEU stated:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

48) My comments in relation to enhanced distinctiveness demonstrates that this ground would fail. In any event, Egger did not really pursue the ground at the hearing. **The claim is dismissed.**

Costs

49) Given the roughly equal measure of success/failure, I do not propose to favour either side with an award of costs. I bear in mind that the section 5(3) ground was not pursued before me, but I cannot see that this will have put Hunton to any real additional cost so as to affect my costs assessment.

Dated this 23rd day of March 2012

**Oliver Morris
For the Registrar,
The Comptroller-General**