

O-306-14

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2566832 IN THE NAME OF
ADVANTIX LTD IN RESPECT OF THE FOLLOWING SERIES OF TWO TRADE
MARKS IN CLASS 41:**

MINEX FORUM

MINEX Forum

**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO. 84660 BY UNIMIN CANADA LTD**

BACKGROUND AND PLEADINGS

1) Advantix Ltd (“the proprietor”) is the proprietor of the series of marks “MINEX FORUM” and “MINEX Forum” (“the registration”). It applied for the registration on 13 December 2010 and the registration procedure was completed on 26 August 2011. The registration covers the following services in Class 41:

Annual International Mining and Exploration Business Forum and Expo in Russia, Kazakhstan and Ukraine

2) On 1 February 2013, Unimin Canada Ltd (“the applicant”) applied for the registration to be declared invalid on the basis of Section 47(2)(a) and Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the ground that the marks are similar to two earlier marks in the name of the applicant and in respect of similar goods and services. The relevant details of the earlier marks are:

Relevant details	Specification of goods
913834 MINEX Filing date: 30 August 1967	Class 1: <i>Mineral substances included in Class 1 for use in industry.</i>
CTM 8287724 MINEX Filing date: 24 April 2009 Date of entry in register: 26 February 2010	Class 1: <i>Industrial minerals for use in the production of other products; processed, precipitated, calcined, thermally treated and/or chemically modified industrial minerals for use in the production of other products; industrial minerals, precipitated, calcined, thermally treated and/or chemically modified industrial minerals for industrial and manufacturing uses; processed mineral-based fillers for industrial use and for use in the production of other products; processed mineral-based fillers for use in paints, coatings and adhesives, plastics, rubber, and polymeric systems; natural and blended clays for industrial and manufacturing purposes; refractory clays and blends; silica sand for industrial and manufacturing applications, industrial sand and industrial quartz, glass sands, foundry and metallurgical sands, fracturing and filtering sands, silica based fillers, ground silica, microcrystalline silica and Tripoli, ceramic silica, glass and fiberglass silicas, abrasive compounds, cementing sands, coating and plastic fillers; quartz and high purity quartz, including electronic grade quartz; nepheline syenite, ground, surface treated, micronized and nano-sized nepheline syenite; alumina silicate, alumino silicate; ceramic and metallurgical fluxes; sodium, potassium and calcium feldspar and feldspar blends; olivine, including metallurgical grade olivine, refractory grade olivine, abrasive and water jet cutting olivine, filter grade and coated olivine and foundry grade olivine; dolomite, limestone, hydrated lime and quicklime; calcium carbonate, precipitated calcium carbonate, processed calcium carbonate and pharmaceutical grade calcium carbonate, calcite; calcium fluoride; precipitated calcium fluoride; processed calcium fluoride; blended</i>

	<p><i>foundry binders and prepared ceramic bodies; mica, ground muscovite mica; talc; zircon; industrial minerals, crushed, in particular syenite nephelite; ground minerals for industrial purposes, in particular nepheline-syenite; industrial chemicals; industrial products minerals of soil, namely syenite; minerals substances included in class 1 for use in industry; mineral industrial ground and principally nepheline syenite; industrial broken rock mass minerals, namely nepheline-syenite; all aforementioned goods not for use in sludge dewatering.</i></p> <p>Class 19: <i>Building materials (not of metal), industrial minerals for building and/or construction purposes; clays used as building materials; sand; firebricks; mineral based refractory bricks of various shapes and sizes used for high temperature environments and heat conservation; castable and rammable mineral based refractory bricks of various sizes and shapes used for high temperature environments and heat conservation.</i></p> <p>Class 40: <i>Beneficiating of minerals, treatment of minerals, processing of minerals, separating of minerals, cleaning of minerals sizing of minerals and blending of minerals.</i></p>
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3) The proprietor subsequently filed a counterstatement denying the applicant's claims and putting it to proof of use. It denies that the respective goods and services are similar and states that it "cannot see how the two trademarks can possibly 'overlap' of [sic] be confused".

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Both sides requested that a decision be made based on the papers on file and declined the opportunity to request a hearing. My decision that follows is taken after thorough consideration of all the papers.

EVIDENCE

5) The applicant's evidence takes the form of a witness statement by Mr Craig W Johnson, Vice President Corporate Marketing for the applicant. He provides evidence of the applicant's use of its mark. It is not necessary for me to detail this other than to record that the exhibits illustrate that the product sold under the MINEX mark are a "functional filler for paints and coatings" and have been promoted in the UK since 2004. Mr Johnson provides no turnover or marketing figures or any indication of market share. Each exhibited invoice relates to goods worth in the region of £320,000 to £350,000 of imported Minex products into the UK. These seven invoices are dated between 14 August 2009 and 7 February 2013.

6) The proprietor's evidence is in the form of a witness statement by its managing director, Mr Arthur Poliakov. He provides information regarding various international forums organised by the proprietor and explains that the Minex Forum was established in 2005. It is not necessary to summarise this evidence further.

DECISION

The legislation

7) The case has proceeded to final determination on the basis of Section 5(2) (b) of the Act, with such grounds being relevant in invalidation proceedings in view of the provisions of Section 47(2) of the Act. The relevant parts of Section 47 of the Act read as follows:

“47. - (1) ...

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) ...

8) Section 5(2)(b) reads:

“(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.”

9) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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.”

10) Of potential relevance to a ground of invalidation under Section 5(2) are the provisions that relate to proof of use. Section 47(2A) to Section 47(2F) details the circumstances where these provisions apply:

“(2A)* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless -

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if -

(a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes -

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

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

(2D) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community. (2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

** Note: Sub-sections 2A to 2E are an addition to the original Act, by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004 (SI 2004/946) which came into force 5th May 2004.*

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)”

11) Both of the applicant's marks are earlier marks as defined by Section 6(1) of the Act. Only the first of these two marks is subject to the proof of use provisions be virtue of being registered more than five years before the application to invalidate the mark was made. However, the applicants case is no stronger based upon its reliance on this mark than it is when relying upon the second mark that is not subject to proof of use. Consequently, I will not consider the issue of proof of use of the first earlier mark and I will base my considerations solely on the likelihood of confusion between the proprietor's mark and the applicant's second earlier mark.

12) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). 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) in determining whether similarity between the goods or services covered by two marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(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 and Adidas Benelux BV*,

(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*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

Comparison of goods and services

13) In assessing the similarity of goods and services, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have

pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

14) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

15) In terms of being complementary, the General Court (“GC”) stated the following in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

16) I also keep in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying to rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

17) In relation to understanding the scope of terms used in specifications, I keep in mind that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade” (*British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281) and that I must also keep in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning (*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267). However, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

18) I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

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

19) The applicant’s earlier CTM 8287724 MINEX is in respect to a broad range of goods that can be summarised as “industrial minerals”, “processed mineral based products for use in industry, in coatings, paints and for other uses”, “building materials” and also services that can be summarised as “treatment and processing of minerals”. There is nothing to be gained by comparing each term of the applicant’s earlier mark with those of the proprietor’s mark, but rather the same considerations and outcomes will apply when considering the broad groups of goods and services I have identified here with the services of the proprietor. With this in mind, I will conduct a comparison of the respective goods and services by grouping the applicant’s goods and services as follows:

Industrial minerals, processed mineral based products for use in industry, in coatings, paints and for other uses

20) All these goods are very obviously different in nature, intended purpose and methods of use to the proprietor's annual business forum and expo. Generally, there is a clear difference between goods and services. In this case these differences are so great that there is very little by way of similarity. Minerals are hard matter usually obtained from the earth, with innumerable practical applications and methods of use. The proprietor's services on the other hand are provided to representatives, investors etc of a particular industry for the purpose of sharing information, promoting developments, making business contacts. These respective goods and services are not in competition with each other, and neither are they complementary in the sense that one is important or essential to the other.

21) The fact that the business area concerned is mining and exploration (and this may include mining of and exploration for the minerals covered by the applicant's specification) is not a reason to find similarity. To find otherwise would provide an unreasonably broad penumbra of protection. There is no similarity between business forums and expos and industrial minerals etc. Therefore, taking account of the guidance referred to in paragraphs 15 to 18 above, I conclude that there is nothing by way of similarity between the applicant's goods and the proprietor's services.

Building materials

22) Applying the same reasoning as above, it is obvious that there is also no similarity between these goods and the proprietor's services. Here, the applicant cannot even rely upon an argument that the subject of the proprietor's business forum and expo is building materials. I conclude there is no similarity.

Treatment and processing of minerals

23) The treatment and processing of minerals is different in nature and intended purpose to business forums and expos. The former involves industrial processes with the intention of altering the minerals such as to be adapted for a given purpose. On the other hand, business forums and expos are a method of bringing members of a given industry or with a shared interest together to share information and promote businesses in that industry or with the shared interest. Clearly, their respective methods of use will be significantly different and neither are they in competition with or complementary to each other. Once again, the high point of a case for similarity is that the proprietor's business forums and expos are on the subject of mining and exploration and that its treatment and processing services are linked to such mining and exploration. Once again, as I have already discussed, this is not a sufficient reason to conclude there is any

similarity. Having considered similarity based on the criteria identified in the *Canon* and *Treat* cases, I conclude there is no similarity.

Outcome of finding no similarity between the applicant's goods and services and the services of the proprietor

24) In summary, I have concluded that none of the applicant's goods and services are similar with the services of the proprietor's registration.

25) Whilst there is no threshold level for similarity of goods and services (see *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA), there must be some degree of similarity for a finding of likelihood of confusion (*Waterford Wedgewood v OHIM* Case C-398/07). In the absence of such similarity, as is the case in here, the applicant for invalidation has no prospect of success. In light of this, it is not necessary for me to also consider the other factors that would normally be required as part of the "global appreciation" test for assessing likelihood of confusion.

26) The application for invalidation, therefore, fails in its entirety.

COSTS

27) The invalidation action having failed, the proprietor is entitled to a contribution towards its costs. I take account that neither side provided written submissions and that no hearing has taken place. I also take account of the fact that, despite both sides providing evidence, neither has been of value in reaching my decision. Further, the proprietor was not represented in the proceedings and therefore was not incurred legal fees. As the scale of costs published in the Registry's tribunal practice notice 4/2007 is based upon costs that include legal fees, I consider it appropriate to make an award in favour of the proprietor on the basis of the standard scale, albeit reduced to take into account that it was not professionally represented. Therefore, I award costs on the following basis:

Application fee	£200
Preparing Application and statement and considering statement in reply	£200
Considering other side's evidence	£100
TOTAL	£500

28) I order Unimin Canada Ltd to pay Advantix Ltd the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of July 2014

**Mark Bryant
For the Registrar,
the Comptroller-General**