

O-459-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3082441
BY
FRANK SCHRIJVER UK LIMITED
TO REGISTER THE TRADE MARK**



IN CLASSES 19, 37 AND 42

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO 60000223
BY
SCHRIJVER VOCHTBESTRIJDING B.V.**

BACKGROUND

1. On 20 November 2014, Frank Schrijver UK Limited (the applicant) applied to register the mark on the cover page of this decision in respect of goods in classes 19, 37 and 42 of the Nice Classification System¹, as follows:

Class 19

Building materials (non-metallic); damp course systems; damp course materials; damp proof course; damp proof membranes; damp proof membranes of synthetic plastics materials; bituminous products in the form of membranes for damp-proofing; damp regulating systems; bricks; channels of non-metallic materials for transmitting air for ventilation; non-metallic air vents for buildings; venting ducts (non-metallic); air ducts of non-metallic materials for buildings; bricks adapted for removing damp from walls; vented bricks for removing damp from solid walls; vented bricks for removing damp from cavity walls; parts and fittings for all the aforesaid goods.

Class 37

Advisory services relating to the repair of buildings; advisory services relating to the maintenance of buildings; building maintenance and repair; consultancy services relating to the repair of buildings; installation of fittings for buildings; installation, construction and repair services relating to damp control and/or ventilation; damp proofing services; ventilation services.



Class 42

Technical advice services; building inspection services [surveying]; measuring the environment within buildings; home inspection services [surveying]; preparation of technical reports; research services in relation to damp control and/or ventilation; technical advice services in relation to damp control and/or ventilation; drafting of reports in relation to damp control and/or ventilation; survey services in relation to damp control and/or ventilation.

2. The application was published on 19 December 2014, following which, Schrijver Vochtbestrijding B.V. (the opponent) filed notice of opposition against the application under the fast track opposition procedure.

3. The opposition was brought under sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (the Act) for which the opponent relies upon Community Trade Mark Registration (CTM) 012940342 and under section 5(2)(b), for which the opponent relies on CTM 012940599. In both cases the opposition is filed against all of the applicant's goods and services. Both marks are shown below:

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

| Mark details and relevant dates | Goods and services relied upon |
|--|---|
| <p>CTM: 012940342</p>  <p>CTM: 012940599</p>  <p>Date of applications: 5 June 2014</p> <p>Date of entries in the register: 21 November 2014</p> | <p>Class 19 Building and construction materials and elements, not of metal; Non-metallic air vents for buildings; Ducts of non-metallic materials for transmitting air for ventilation purposes and damp treatment; Damp-removal elements for installation in walls, including masonry; Parts and mounting materials for the aforesaid goods.</p> <p>Class 37 Construction consultation in the field of ventilation of walls and removing damp from walls; Construction of walls, including masonry; House building; Advisory services relating to building construction; Building sealing; Installing building and construction materials and elements (not of metal) into existing buildings, ventilation ducts for buildings (not of metal), ducts of non-metallic materials for transmitting air for ventilation purposes and damp treatment, and damp-removal elements for installation in walls; Repair of buildings; Maintenance and repair of parts of buildings; Renovation and repair of buildings; Installation services in relation to building and construction materials and elements (not of metal), ventilation ducts for buildings (not of metal), ducts of non-metallic materials for transmitting air for ventilation purposes and damp treatment, and damp-removal elements for installation in walls, including masonry.</p> <p>Class 42 Inspection of buildings (surveying), in particular in the field of ventilation of walls and damp; Conducting damp measurements on walls; Technical consultancy in relation to ventilation of walls and damp in walls; Engineering design, technical, chemical and medical surveying services; Architectural and engineering services, Including drawing up expert reports.</p> |

4. On 7 April 2015, the applicant filed a counterstatement, denying the grounds of opposition.

5. Rules 20(1)-(3) of the Trade Marks Rules (TMR) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does. It reads:

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

6. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions.

7. No leave was sought in respect of these proceedings.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

9. A hearing was neither requested nor considered necessary. The opponent filed written submissions. I make this decision having considered all of the papers before me.

DECISION

10. The opposition is based upon, sections 5(1), 5(2)(a) and 5(2)(b) of the Act which read as follows:

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

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11. 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) or 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.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

12. The opponent's marks are earlier marks but are not subject to proof of use because, at the date of publication of the application, they had not been registered for five years.² The opponent is therefore entitled to rely on them for all of the goods and services for which they are registered.

13. I turn first to the objection based upon section 5(1) of the Act, for which the opponent relies on CTM 012940342. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34 (*Sadas*), the Court of Justice of the European Union (CJEU) said in relation to what constitutes an identical trade mark:

“51. There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

52. However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] E.C.R. I-3819 at para.[26]).

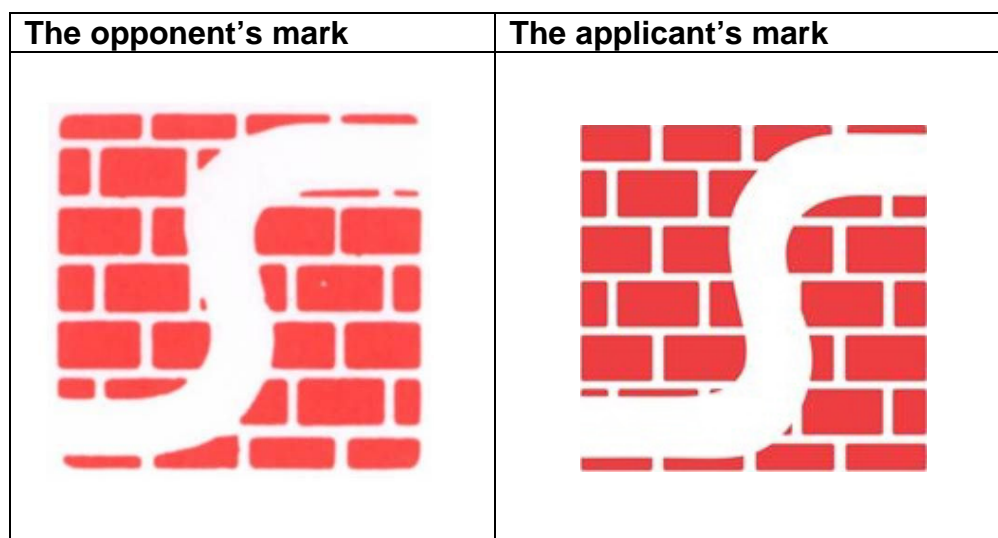
53. Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

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

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5 May 2004

Comparison of marks

14. The marks to be compared are:



15. I note that the opponent's earlier mark makes a claim to the colours red and white. However, for the reasons given in *Specsavers International Healthcare Limited & Others v Asda Stores Limited*³, I need say no more about the colour limitation.

16. The opponent's mark consists of what it describes in its statement of grounds as a letter 'S', superimposed on a brick wall. The applicant's mark comprises an 'S' shape, placed on top of a number of red rectangles which appear to create a 'brick wall'. In both cases, the letter element is white on a red background and in both cases there are seven rows of bricks which make up the background. On a careful inspection, it is possible to see that there are some differences in the marks such as the placement of the 'S' shape which is slightly further right in the application, the brick shapes in the opponent's marks have rounded edges and there appears to be a very faint pale grey border around the background, which is most evident in the top left corner of the mark.

17. The CJEU make clear in *Sadas* that:

"...insignificant differences between the sign and the trade mark may go unnoticed by an average consumer."

18. I find that the differences I have identified between these marks are minimal and are only evident upon very close scrutiny of the marks side by side. I therefore conclude that the applicant's mark is identical to the opponent's earlier mark as the differences are so insignificant as will go unnoticed by the average consumer.

³ Case C-252/12

Comparison of goods and services

19. The goods and services to be compared are as follows:

| The opponent's goods and services | The applicant's goods and services |
|---|--|
| <p>Class 19 Building and construction materials and elements, not of metal; Non-metallic air vents for buildings; Ducts of non-metallic materials for transmitting air for ventilation purposes and damp treatment; Damp-removal elements for installation in walls, including masonry; Parts and mounting materials for the aforesaid goods.</p> <p>Class 37 Construction consultation in the field of ventilation of walls and removing damp from walls; Construction of walls, including masonry; House building; Advisory services relating to building construction; Building sealing; Installing building and construction materials and elements (not of metal) into existing buildings, ventilation ducts for buildings (not of metal), ducts of non-metallic materials for transmitting air for ventilation purposes and damp treatment, and damp-removal elements for installation in walls; Repair of buildings; Maintenance and repair of parts of buildings; Renovation and repair of buildings; Installation services in relation to building and construction materials and elements (not of metal), ventilation ducts for buildings (not of metal), ducts of non-metallic materials for transmitting air for ventilation purposes and damp treatment, and damp-removal elements for installation in walls, including masonry.</p> <p>Class 42 Inspection of buildings (surveying), in particular in the field of ventilation of walls and damp; Conducting damp measurements on walls; Technical consultancy in relation to ventilation of walls and damp in walls; Engineering design, technical, chemical and medical surveying services; Architectural and engineering services, Including drawing up expert reports.</p> | <p>Class 19 Building materials (non-metallic); damp course systems; damp course materials; damp proof course; damp proof membranes; damp proof membranes of synthetic plastics materials; bituminous products in the form of membranes for damp-proofing; damp regulating systems; bricks; channels of non-metallic materials for transmitting air for ventilation; non-metallic air vents for buildings; venting ducts (non-metallic); air ducts of non-metallic materials for buildings; bricks adapted for removing damp from walls; vented bricks for removing damp from solid walls; vented bricks for removing damp from cavity walls; parts and fittings for all the aforesaid goods.</p> <p>Class 37 Advisory services relating to the repair of buildings; advisory services relating to the maintenance of buildings; building maintenance and repair; consultancy services relating to the repair of buildings; installation of fittings for buildings; installation, construction and repair services relating to damp control and/or ventilation; damp proofing services; ventilation services.</p> <p>Class 42 Technical advice services; building inspection services [surveying]; measuring the environment within buildings; home inspection services [surveying]; preparation of technical reports; research services in relation to damp control and/or ventilation; technical advice services in relation to damp control and/or ventilation; drafting of reports in relation to damp control and/or ventilation; survey services in relation to damp control and/or ventilation.</p> |

20. In *Gérard Meric v OHIM*, Case T-133/05, the GC held that:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

Class 19

21. In class 19 the opponent has the term *'building and construction materials and elements, not of metal'*. All of the applicant's goods in the same class are non-metallic building and construction materials. These are clearly identical goods.

Class 37

22. In class 37, the applicant's *'Advisory services relating to the repair of buildings', 'advisory services relating to the maintenance of buildings' and 'consultancy services relating to the repair of buildings'* are included within the opponent's term *'advisory services relating to building construction'*. These are identical services.

23. The applicant's specification for *'building maintenance and repair'* is included within, at least, the opponent's terms, *'repair of buildings; maintenance and repair of parts of buildings; renovation and repair of buildings'*. These are identical services.

24. The *'installation of fittings for buildings'* contained in class 37 of the application is included within *'Installing building and construction materials and elements (not of metal) into existing buildings'* in the opponent's class 37 specification. These are identical services.

25. The applicant's *'installation, construction and repair services relating to damp control and/or ventilation; damp proofing services; ventilation services'* are included, at least, within the broad installation, construction and repair services contained in the opponent's specification, such as, *'Repair of buildings; Maintenance and repair of parts of buildings; Renovation and repair of buildings'* and *'Installing building and construction materials and elements (not of metal) into existing buildings'* as well as *'Installation services in relation to building and construction materials and elements (not of metal), ventilation ducts for buildings (not of metal), ducts of non-metallic materials for transmitting air for ventilation purposes and damp treatment, and damp-removal elements for installation in walls, including masonry'*. These are identical services.

Class 42

26. The applicant's *'building inspection services [surveying]'* and *'home inspection services [surveying]'* are included within the opponent's *'inspection of buildings'*, in the same class. These are identical services.

27. The terms, *'measuring the environment within buildings', 'preparation of technical reports', 'research services in relation to damp control and/or ventilation', 'technical*

advice services in relation to damp control and/or ventilation, *drafting of reports in relation to damp control and/or ventilation* and *survey services in relation to damp control and/or ventilation*, are included within the following terms of the opponent's specification, *engineering design, technical, chemical and medical surveying services* and *architectural and engineering services, including drawing up expert reports*. These are identical services.

28. With regard to the applicant's *technical advice services*, the opponent's specification includes, *technical consultancy*, in respect of ventilation of walls and damp in walls, as well as technical services at large. In accordance with *Meric* these are identical services.

29. Consequently, I conclude that terms in the applicant's specification in classes, 19, 37 and 42 cover identical goods and services to those included in the opponent's specification for the same classes.

Conclusion

30. In view of my conclusions that the respective marks and the respective goods and services are identical, the opposition based upon section 5(1) of the Act succeeds, in its entirety. That decides the matter, however, if I am found to be wrong in respect of the identical nature of the goods and services at issue, and they are found to be non-identical, they are evidently so highly similar that the opposition would clearly succeed under the grounds based on 5(2)(a) of the Act.

Costs

31. The opposition having succeeded, the opponent is entitled to a contribution towards its costs. The award stands as follows:

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| Preparing a statement and considering the other side's statement: | £200 |
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| Official fee: | £100 |
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| Total: | £300 |
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32 . I order Frank Schrijver UK Limited to pay Schrijver Vochtbestrijding B.V. the sum of £300. 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 5th day of October 2015

**Ms Al Skilton
For the Registrar,
the Comptroller-General**