

O-352-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3092910
BY REFINA LIMITED TO REGISTER THE TRADE MARK**

SUPERFLEX

IN CLASS 8

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 404751
BY INTERIOR FLOORING LIMITED**

Background and pleadings

1) Refina Limited (“the applicant”) applied to register the trade mark no. 3092910 in respect of SUPERFLEX in the UK on 5 February 2015. It was accepted and published in the Trade Marks Journal on 24 April 2015 in respect of the following goods in class 8:

Hand-operated tools and implements for treatment of materials, and for construction, repair and maintenance; trowels for plastering; spatulas [hand tools]; all the aforesaid for sale to professional plasterers and tradesmen only

2) Interior Flooring Limited (“the opponent”) opposes the trade mark on the basis of Sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994 (“the Act”). It argues that this is on the basis that the:

“two elements SUPER and FLEX are either the words SUPER or the abbreviated word SUPERBLY and the abbreviated word FLEXIBLE. When viewed by consumers they will understand those products as specified to be particularly flexible, even superbly flexible, associating the superlative ‘super’ as meaning that products are outstanding and of high quality. ...these terms are obvious and descriptive. There is no overall impression that goes beyond such meaning”

and

“use [of the mark is in an] industry of which those consumers will be influenced by the kind, quality and characteristics of the products that the applicant intends to offer. ...[the mark] gives rise [to an understanding that the] products ...[are] high quality and particularly flexible ... FLEX is merely an abbreviation of FLEXIBLE which is likely to be particularly required by purchasers ... and SUPER understood as meaning high quality and increasing the degree of the flexible nature of the products sought. These terms are obvious and descriptive.”

and

“SUPERFLEX is a term in common use and is nothing more than a generic descriptor or shorthand to inform consumers of the very nature and characteristic of a product. It is a term that is used widely in industry generally ... as a term to describe the nature of particular tools and implements ... especially in connection with construction tools, trowels and spatulas ...”

3) The applicant filed a counterstatement denying the claims made and counterclaiming that “(t)here is not a sufficiently direct and specific relationship between the Trade Mark and the Goods to enable professional plasterer/tradesman immediately to perceive, without further thought, a description of the Goods or one of their characteristics”. In response to the claim that the mark would be understood as being “particularly flexible, even superbly flexible” it claims that this is based on an assumption that consumers “would (artificially) dissect the Trade Mark and break it down into two elements, namely ‘SUPER’ and ‘FLEX’, (rather than reading the Trade Mark as simply “SUPERFLEX”), with the understanding ‘FLEX’ to be an abbreviation of the word “flexible”. It goes on to suggest that to describe a product as “super flexible” you would use that phrase and not the mark. It claims that, at most, the mark alludes to such characteristics.

4) Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary. A Hearing took place on 29 June 2016, with the opponent represented by Ms Jessie Bowhill of Counsel, instructed by BPE Solicitors LLP and the applicant by Mr Carl Steele of Ashfords LLP.

Opponent’s Evidence

5) This takes the form of a witness statement by Andrew John Hill, managing director of the opponent company. He states that he has been involved in the flooring industry, and associated with the plastering and rendering industry for over 30 years. He states that for the last 15 years, his company has been the largest in the UK for servicing of plastering, rendering and screeding machines and tool and machine hire.

6) Mr Hill states that SUPERFLEX is a term that is very common in the industry and has been used for many years and that it indicates a particular characteristic. He states that in the trowels and spatulas sector of the industry, there are many tools that use the term SUPER as a prefix. He offers the view that “there can be no doubt that the term functions as an adjective and designates a certain ‘extra’ quality about the goods when used. At Exhibit 1, Mr Hill provides a reference from an unidentified dictionary that shows that the word SUPER is an adjective meaning “very good or pleasant; excellent” or “very good; superfine” and provides the following example of use: “a super quality binder”.

7) Mr Hill claims FLEX is an abbreviation for the word ‘flexible’, a very desirable characteristic in the plastering, rendering and screeding industry. At Exhibits 2 and 3 he provides physical examples of plastic trowels from a Spanish manufacturer. The first carries the word FLEX and the second, stiffer bladed version carries the word MEGAFLEX.

8) Exhibit 4 provides a physical example of a trowel named SUPERFLEX. The relevant part of the blade is shown below:



9) It has a thinner blade than others on the market and consequently, Mr Hill claims, it will be perceived as being more flexible than a traditional trowel. He states that it is, therefore, common for manufacturers to come up with names that describe the

flexibility of the trowel. Exhibit 5 is a further physical example of a trowel. This example is called the MEDIFLEX and the relevant part of it is shown below:



10) At Exhibit 6, Mr Hill provides an extract from the applicant's own catalogue where it makes reference to the flexibility of tools and describes a spatula as having an "ultra flexible" stainless steel blade. Mr Hill states that this product is often referred to as the applicant's "superflex spatula". Exhibit 7 illustrates the applicant referring to its skimming spatula as being made with super flexible stainless steel.

11) Exhibit 8 consists of a further extract from the applicant's own website where some of its range of spatulas are described as "semi-flexible & ultra-flexible". Mr Hill explains that Exhibit 9 shows how others use a descriptive pre-fix to characterise trowels. This consists of two promotions of unknown origin for special offers on two different sizes of an "Ultraflex Finishing Spatula".

12) Mr Hill provides a screenshot of what appears to be a *Facebook* page where a user asks "Superflex trowel worth buying or stick with the mt". Mr Hill suggests that

“mt” stands for “Marshalltown”, what he describes as “the benchmark of all plastering trowels”.

13) Mr Hill claims that the term SUPERFLEX is used generically on online forums and social media by consumers, plasterers and professionals. Exhibit 11 consists of two screen shots, again from what appears to be *Facebook* where two users ask whether MT/Marshalltown are going to make “a superflex trowel”/“a supa flex trowel”.

14) Mr Hill states that Marshalltown are the biggest tool manufacturer in the world for plastering tools and have brought out a “DuraFLEX” model “to compete within the SUPERFLEX category”.

15) Exhibit 12 consists of an unspecified extract showing another third party (CK Tools) promoting a “4 Piece Superflex Scraper Set”.

16) Exhibit 13 consists of an Internet extract of unknown origin illustrating a pair of gloves described as “Typhoon Superflex 5mm Neoprene Gloves”. This is provided by Mr Hill to support his submission that there are many examples within the UK of the term SUPERFLEX being used to describe flexible characteristics of a product.

17) Exhibit 14 consists of an Internet extract of a user guide for “Superflex flexible PVC paint”. The guide goes on to state “Polymarine have formulated a specialist PVC paint called Superflex for the renovation of inflatable paints...”

18) Exhibit 15 consists of an Internet screenshot relating to *Loctite* manufacturing a white silicone paste described as “Superflex Silicone Sealant” and states “Forms permanent flexible waterproof seal”.

19) Not supported by an exhibit are Mr Hills' statements regarding the existence of a paint for coating roofs described as “SUPER-FLEX Elastomeric” that he claims has been on the market in the UK for over 30 year. He claims that it is described as a “thick flexible coating...”. Mr Hill also claims that this product would be applied to walls and roofing by trowel, spatula or roller. Mr Hill states that he was informed by the manufacturer of this paint that “the name SUPERFLEX was chosen to describe

the main function and characteristic of the product”. He provides a copy of an email from the manufacturer at Exhibit 16 that he claims confirms this, but what the manufacturer actually states is “We chose the name because of the ability of the product to flex...”

20) Exhibit 17 consists of an undated screenshot relating to information about a flexible tile grout product called “BAL SUPERFLEX wide joint”. Mr Hill highlights the “flexible” nature of the product.

21) Exhibit 18 consists of a screenshot of a comment on an online forum, dated “3rd December”, but no year is shown. The forum is at www.plastererforum.com and the comment includes the following: “... I have been tempted into buying a superflex... or should I get the mediflex as I’m not sure I want to go from stiff MT to a really springy superflex.” Exhibit 19 consists of an undated screenshot of another forum comment. The writer states “...it is time to embrace new ways just about to order 14” super flex ... Ps still love my MT”. Exhibit 20 is a third example of an online forum comment with the writer asking “is it me or should there be some kind of super flex corner trowel out by now to match our trowels and finish of the superflex family!”

Applicant’s Evidence

22) This takes the form of four witness statements. The first of these is by Peter Robert Walton Grey, Managing Director of the applicant.

23) Mr Grey provides an extract from the applicant’s internal accounting database showing that in 2014, the annual turnover of its SUPERFLEX trowels amounted to £217,000 and is the applicant’s second most popular product. The same exhibit illustrates that between 2008 and the filing date, turnover of SUPERFLEX trowels and spatulas was £472,000. Mr Grey provides year-on-year increases in turnover with an average of over 100% growth between 2009 and 2014. Example invoices showing sales of SUPERFLEX spatulas are provided at Exhibit PG2.

24) At Exhibit PG3A, Mr Grey provides an email exchange with Stuart Elsom of a company called Rollins. The subject of the exchange was a discussion between the

two gentlemen regarding the UK market for the sales of hand tools to professional plasterers and tradesmen. Mr Grey explains that Mr Rollins is the managing director of the company of the biggest trader in this field in the UK, *Marshalltown*: Mr Rollins and Mr Grey estimated that:

- This UK market is worth between £3 million and £5 million a year;
- Plastering tools and spatulas account for approximately 65% of this (i.e. between £2.08million and £3.25 Million per year).

25) Additionally, Mr Grey states that when considering the applicant and its three biggest competitors, it is the third biggest competitor in the market (SEE Exhibit PG23).

26) Mr Grey explains that the applicant has a history of creating product brand names separate to its REFINA house mark. It launched the SUPERFLEX branded plastering trowel. At that time *Marshalltown* also marketed plastering trowels with product brand names *Permashape*, the *Duraflex* and *Xtralite*.

27) Mr Gray states that the applicant's products are targeted at professional plasterers and tradesman and provided through various builders' merchants such as *Travis Perkins*, *Jewson* and *National Drywall & Insulation*. Exhibit PG11 consists of copies of invoices to these businesses. Product catalogues from between 2009 and 2015 are provided at Exhibit PG7 and illustrating SUPERFLEX skimming spatulas and trowels. In addition, SUPERFLEX spatulas and trowels have been promoted through the applicant's website that received over 61,000 visitors in the last full, year before the filing date.

28) Mr Grey outlines the applicant's marketing activities targeted at its 19,000 customers recorded on its database. This includes monthly emails, operation of a Facebook page and, since December 2011, a Twitter page. Mr Grey estimates that the applicant has spent £180,000 in promoting SUPERFLEX tools between 2008 and the filing date.

29) Exhibit PG17 consists of a selection of posts on the Plasterers' Forum at www.plasterersforum.com that Mr Grey claims refer to SUPERFLEX branded trowels. Typical of these are:

“Not liking your superflex anymore?...”

“... i love the speedskim it just that the handles are better on the superflex...”

“Anyone know if the superflex trowels are better than the gold permashape MT?”

“...can honestly say ive tried a lot of gadgets and gizmos and you cant beat flattening with the superflex and finishing with the ss trowel.”

“I use a s/steel m/town for a quick flatten then two trowels with the superflex keeping the blade almost closed...”

30) Mr Grey claims that because of the extensive promotion and sales of SUPERFLEX branded trowels and spatulas since 2008, the consumers of these goods would associate the name with goods originating from the applicant and not a description of a type of trowel.

31) Mr Grey states that the opponent uses the brand name “SuperFLEX” and has done since April 2014 and prior to that it was branded as “EZEflex”. Exhibit PG21 shows the opponent marketing a “NELA SuperFLEX” trowel.

32) Three further witness statements are provided by Joseph Dean Allen, Technical Support Representative of British Gypsum, Paul Jonathan Hancox, Wholesales Manager of Walls & Ceilings International Limited and Mark Patrick Darby, managing director of Handtools Xpress Limited.

33) Mr Allen states that when he hears the word “Superflex”, he thinks of the particular trowel manufactured by the applicant. All three witnesses state that they associate the name SUPERFLEX with the applicant rather than a description of the product.

Opponent's evidence-in-reply

34) This consists of a further witness statement by Mr Hill. Exhibit 21 consists of a screenshot from the Plasterers Forum where the applicant is referring to its product as "Refina Superflex Spatulas". Exhibit 22 is a similar post by the applicant where it replies to a user named "Gibbo" as follows: "do you use our superflex gibbo?" Mr Hill uses this as an example of the applicant itself using, what he claims, the term SUPERFLEX in a descriptive way. At Exhibits 23 to 26, Mr Hill provides four letters from individuals in the industry. Three of these are "to whom it may concern" letters. They all express the view that the term SUPERFLEX is descriptive.

35) At Exhibit 27, Mr Hill provides screenshots taken from various social media groups such as "Plasterers Banter" and "Plasterers Talk Group" on *Facebook*. These, Mr Hill claims, show SUPERFLEX being referred to descriptively such as in the following comments:

"...Marshalltown are bringing out a superflex. Not a duraflex. A superflex?"

"What's the best brand for the superflex trowel lads?"

Legislation

36) The relevant parts of section 3(1) of the Act read:

"3(1) The following shall not be registered –

(a) ...,

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

DECISION

37) In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

38) Whilst I recognise that section 3(1)(b) and section 3(1)(c) are independent of each other and require separate examination, in the current case, the opponent’s claims in respect of its grounds based upon section 3(1)(b) are the same as those based upon section 3(1)(c), namely that the term SUPERFLEX is descriptive of goods that are extremely or superbly flexible. There is no separate argument as to why the term should be open to objection under section 3(1)(b). Under these circumstances the section 3(1)(b) and section 3(1)(c) grounds will stand or fall together (see the comments of Anna Carboni, sitting as the Appointed Person in O-363-09 *COMBI STEAM Trade Mark*). With this in mind, it is not necessary for me to

consider the section 3(1)(b) ground separately to the section 3(1)(c) ground and I find it convenient to consider these grounds from the perspective of section 3(1)(c). At the hearing, Ms Bowhill agreed that the section 3(1)(b) and section 3(1)(c) grounds will stand or fall together.

Section 3(1)(c)

39) The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest

underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all

be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

40) It is well established that descriptiveness must be assessed through the perception of the relevant parties, including those in the trade (*Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, para 24) and I note that the specification of goods of the contested mark contains goods, such as plasterers' trowels and spatulas, that are limited to being provided to professional plasterers and tradesmen.

41) At the hearing, there was common ground between the parties that:

- the goods covered by the contested mark are aimed at professionals and tradesmen and that, as a result, the level of attention paid during the purchasing process is greater;

- flexibility is a key characteristic of the goods;

42) Both parties gave submissions on how I should interpret the evidence of how the term is used. On the part of the opponent, Ms Bowhill submitted that they overwhelmingly illustrate that the mark is used descriptively and that it is common practice in the trade to refer to tools by way of their characteristics. On the other hand, Mr Steele, for the applicant, submitted that I should interpret the evidence as illustrating trade mark use of the term SUPERFLEX. In truth, I find much of the evidence inconclusive as to which of these submissions is correct without firstly undertaking an analysis of the intrinsic characteristics of the contested mark.

43) On this point, Ms Bowhill made a statement that the meaning of SUPERFLEX is “very or extremely flexible, or both flexible and super (i.e. very good)” and that FLEX is a verb meaning “to bend” and an adjective meaning “flexible”. I have some difficulty with these submissions. The website www.oxfordreference.com provides definitions of the word FLEX. It includes the following from the Oxford Dictionary of English (3 ed.)¹:

verb

1. (with reference to a limb or joint) bend or become bent: [with *obj.*] : *she saw him flex his ankle and wince* | [no *obj.*] : *it's important to prevent the damaged wrist from flexing.*

■ [with *obj.*] cause (a muscle) to stand out by contracting or tensing it: *a group of bodybuilders flexed their muscles.*

■ [no *obj.*] (of a muscle) contract or be tensed: *a muscle flexed in his jaw.*

■ [no *obj.*] (of a material) be capable of warping or bending and then reverting to shape: *set windows in rubber so they flex during an earthquake.*

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http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0302740?rsk ey=G4ATCm&result=10

2. (as *adj. flexed*) (*Archaeology*) relating to or denoting a practice of burying a corpse with the legs drawn up under the chin.

noun

Brit. a flexible insulated cable used for carrying electric current to an appliance.

44) It is notable that there is no entry for FLEX as an adjective and no relevant meaning of FLEX as a noun.

45) The word FLEX is a verb meaning “to bend” but it is not clear to me that, when it is combined with an intensifying adjective such as SUPER, the combined term is descriptive. In ordinary English language usage when a verb has such an adjective placed before it, the verb mutates. For example, to describe something that is very bendy, it could be described as “super bendy” or “super flexy/super flexible” but it would not be described as “super bend” or “super flex”. I am unable to think of an exception to this rule, and when I put this to Ms Bowhill, she too was unable to provide any other example to support her submission that SUPERFLEX was descriptive because it consisted of an adjective plus a verb that describes something that is super flexible. It is my view that where FLEX is perceived as an un-mutated verb in the term SUPERFLEX, the term as a whole will be perceived as an allusive, even highly allusive, reference to the goods being of a very flexible nature. It is not a term that follows the normal rules of the English language and consequently will not be perceived as descriptive.

46) Secondly, there is no compelling evidence before me that FLEX is an adjective meaning “flexible”. Ms Bowhill directed me to Exhibit 10 of Mr Hill’s first witness statement where a contributor to an unidentified forum states, when talking about NELA trowels, that it has “a bit more flex than [his] MT”. Such use of FLEX is as an abbreviation for “flexibility”, but this one example occurring in a very informal forum post of unknown origin (as Mr Steele pointed out at the hearing, the following post shown in the exhibit is made by someone in Perth, Australia) and is insufficient to

support a claim to SUPERFLEX being used in trade, in the UK, to describe a characteristic of the goods.

47) Mr Hill, at his Exhibit 1 provides a dictionary reference for the word SUPER (see paragraph 6, above). The example of use that appears in this reference is “a super quality binder”. Such a type of use applied to the term SUPERFLEX, namely “a super flex trowel” will strike the average consumer as somewhat odd and grammatically incorrect; a “super flexible trowel” would be the appropriate and correct way to describe such a trowel. However, when used in the phrase “a SUPERFLEX trowel”, it will immediately identify to the average consumer a specific brand of trowel.

48) This all points towards a finding that the term SUPERFLEX is an allusive term and not descriptive. This being the case, the contested meaning of references to SUPERFLEX in the evidence come into focus. As I stated earlier, at the hearing the parties’ submissions took opposing positions on this. It is my view that the majority of references to SUPERFLEX by third parties shown in the evidence are references to the proprietor’s mark. If, as it appears, the term SUPERFLEX is allusive and not descriptive, it follows that this interpretation will follow through to the interpretation given to the term in these forum discussions. These discussions appear in informal language, often with absent or incorrect punctuation and with little attention to correct (or for that matter any) use of capitals. This is common and for such forums, and reduces greatly the impact of the absence of referring to a trade mark by way of using a capital first letter. Therefore, the absence of capital letters when referring to “superflex” or “super flex” in these forums does not lead me to conclude that such use is descriptive.

49) The applicant has adduced evidence from experts who state that they perceive the term SUPERFLEX as being descriptive. I have already found that all other factors point to the term SUPERFLEX being allusive and whilst I note the comments of these experts, I am not persuaded by their comments because it is not clear to me whether the difference between a term being descriptive and a term that is allusive (even highly allusive) of the same characteristics is fully understood by these experts nor the impact of the difference between the two categories has in respect of

assessing whether a mark is caught by section 3(1)(c). There are also additional factors why this evidence is not persuasive. Firstly, their evidence is not provided in a sworn form and consequently carries less weight. Secondly, it is not clear what level of independence these experts have from the opponent. Thirdly, the applicant adduces three witness statements from other experts, namely Mr Allen, Mr Hancox and Mr Darby who all attest to the term SUPERFLEX being a reference to a particular trowel produced by the applicant.

50) Finally, Mr Hill's evidence provides further examples of what he contends is descriptive use of the term SUPERFLEX. At Exhibit 13 he provides an Internet extract promoting "Typhoon Superflex 5mm Neoprene Gloves. It is my view that such use is equally consistent with use as a secondary trade mark as it is with descriptive use. Further, it relates to a different field and is of unknown origin and time period. The same criticisms apply to the evidence at Mr Hill's Exhibits 14, 15 and 17 relating to PVC paint, sealant and tile grout respectively. I find that these exhibits fail to support the claim that the term SUPERFLEX is descriptive.

51) In summary, I find that the mark SUPERFLEX is allusive rather than descriptive and, as a result, the opposition based upon section 3(1)(c) of the Act fails. Further, and as I noted earlier, the opposition also fails in respect of the grounds based upon section 3(1)(b).

Section 3(1)(d)

52) In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

"49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959,

paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and BSS, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and BSS, paragraph 40)."

53) Here, I must consider if the term SUPERFLEX is used in the current language and/or established practices of the trade or whether it functions to designate the goods of one undertaking from another. As I have already noted, it is not disputed that flexibility is a desirable characteristic for plasterers' trowels and spatulas, but as I have outlined earlier, the parties' have different interpretations of the evidence in these proceedings.

54) The evidence of use by the trade consists of physical examples of trowels produced by a third party. Here, it is my view that the use of the term SUPERFLEX is consistent with it being used as a secondary trade mark (see the photograph of the exhibit in paragraph 8, above where the term “SuperFLEX II” appears with the mark NELA and other matter on the blade of the tool). A second physical example of a trowel (see the photograph of the exhibit at paragraph 9, above) carries the term “MediFLEX”. A promotion is also shown for an “Ultraflex Finishing Spatula”. Both these terms, like SUPERFLEX, are capable of performing the function of a trade mark and their use shown in these exhibits is consistent with SUPERFLEX also functioning as, and being used as, a trade mark.

55) I have already dealt with the opponent’s claims that the forum use of the term SUPERFLEX demonstrates that it is used descriptively. I have found that it is not. Therefore, it is my view that such forums include references that are consistent with trade mark use and, consequently, do not support a claim that the term is used in the current language of the trade. Similarly, the examples of use of SUPERFLEX in respect of other products in other fields of trade show use consistent with secondary trade marks. Finally, it is worth noting here that, as Mr Steele submitted at the hearing, much of the use shown in the opponent’s evidence fell within a six year period when the applicant was the only trader using the term SUPERFLEX in the plastering trade, consequently, references to SUPERFLEX were inevitably to its product and use of it in a way that may be perceived as not as a trade mark can be explained by the fact that the user of the term had no need to differentiate it from any other trader’s SUPERFLEX products.

56) Taking all of the above into account, I conclude that the evidence fails to demonstrate that the term SUPERFLEX is used in trade to designate a particular type of goods or used in the established practices of the trade. The opposition based upon section 3(1)(d) fails.

Applicant's offer of fall-back specifications

57) In light of my findings, it is not necessary that I consider the applicant's offer of a number of fall-back specifications.

Summary

58) The opposition fails in its entirety.

COSTS

59) The applicant has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I take account that both sides filed evidence and that a hearing took place. I award costs as follows:

Considering statement and preparing counterstatement	£300
Evidence	£600
Preparing for, and attendance at hearing	£900
Total:	£1800

60) I order Interior Flooring Limited to pay Refina Limited the sum of £1800 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 21st day of July 2016

Mark Bryant
For the Registrar,
The Comptroller-General