

O-220-20

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No.3293094
BY SAFETY ASSURED LIMITED
TO REGISTER IN CLASSES 6 & 19
THE TRADE MARK
DOOR FINGER PROTECTOR**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 415667
BY
PLANET GDZ AG**

BACKGROUND

1) On 27 February 2018, Safety Assured Limited (hereinafter the applicant) applied to register the trade mark DOOR FINGER PROTECTOR in respect of the following goods:

In Class 6: Safety fittings of metal for doors and windows; parts and fittings therefor.

In Class 19: Safety fittings of synthetic plastics for doors and windows; parts and fittings therefor.

2) The trade mark was inherently non-distinctive, but evidence was submitted to show that, by the date of application, the mark had in fact acquired a distinctive character as a result of the use made of it. The application was subsequently published for opposition purposes on 7 December 2018 in Trade Marks Journal No. 2018/049.

3) On 1 March 2019 Planet GDZ AG (hereinafter the opponent) filed a notice of opposition. The opponent contends that the instant mark is devoid of distinctive character; consists of a sign which serves in trade to designate the intended purpose of the goods and consists of a sign which has become customary in the current language of the trade. As such the mark in suit offends against Sections 3(1)(b), (c) and (d) of the Act.

4) On 10 May 2019 the applicant filed a counterstatement basically denying all the grounds of opposition.

5) Both sides filed evidence; both sides seek an award of costs in their favour. Neither side wished to be heard although both provided submissions which I shall refer to as and when necessary.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 18 July 2019, by David Yeomans the opponent's Trade Mark Attorney. He provides the results from internet searches carried out on 27 June and 15 July 2019 as exhibits:

- DY1: Shows the result of a search under “Door Finger Protectors” on the website “Ironmongery and more”. It shows three products from two different manufacturers the “Zero Plus Finprotect Plus” and Orbis Finger Protection Hinge”
- DY2: From the Amazon website is a product from a company called “Beautiful Beginnings” which is labelled as “Door Finger Protector” the product even has “FINGER PROTECTOR” emblazoned upon it. There are other products listed at the bottom of the page which include “Cardea Child Door Finger Guard”, “Cardea Domestic Child Door Finger Guard” and “Cardea Child Safety Door Finger Pinch Guard”.
- DY3: A search of eBay provides a result for a “finger protection set” which is described as “child baby safety protection finger door guard socket protector corner cushions”. In the list of what is included in the set it states: “Door Finger Protector: attached to the door as shown to stop little fingers being caught”.
- DY4: A search on eBay provides a result under “Home safety child / baby finger protector door jammer”.
- DY5: An Amazon search which yielded a result for “Door Cord Finger Protector”
- DY6: A search of eBay provides a result for a “child baby safety door stop stopper foam finger guards finger protector”.

APPLICANT’S EVIDENCE

7) The applicant filed three witness statements. The first, dated 13 September 2019, is by Marine Body the applicant’s Trade Mark Attorney. She provides the following exhibit:

- MB1: This is a copy of the witness statement and exhibits by Stephen Robert Webb, dated 22 February 2019, provided in support of the application. Mr Webb is the Managing Director of the applicant who has been with the company for 23 years. He states that in 1995 he invented a Hinge Cavity shield to protect against injury when installed on domestic and light commercial doors. This was sold under the mark FINGER PROTECTOR. In 2007, the design was modified to enable two such shields to clip together to offer protection on larger commercial thickness

doors. This product was branded DOOR FINGER PROTECTOR, and the two products had different codes to help differentiation with the original smaller product being coded HC (Hinge Cavity) the larger being coded HCL (Hinge Cavity Large). He provides the following exhibits which are duplicates of those filed later and which start at exhibit SRW6 for reasons which are not explained.

- SRW6: Identical to SRW2.
- SRW7 & 9: Identical to SRW 3 & 5.
- SRW8: Identical to SRW4.
- SRW10: Identical to SRW6.
- SRW11: Identical to SRW7.
- SRW12: Identical to SRW8.
- SRW13: Identical to SRW9.
- SRW14: Identical to SRW10.
- SRW15: Identical to SRW11.
- SRW16: Identical to SRW12.
- SRW17: Identical to SRW13.

8) Ms Body provides another witness statement, dated 27 November 2019. She contends that the correct descriptive terms for her client's product is "door guard" or "door finger guard". She contends that the opponent's evidence should be ignored as being after the relevant date and then provides a number of internet searches which are after the relevant date. She claims that the applicant is unable to quantify its market share. She contends that the relevant public are company directors not the general public. She provides the following exhibits:

- MB1: A search on Google dated 15 November 2019 against the term DOOR GUARD. These all show security items such as bolts or door openers apart from a single entry which refers to "Finger Guards /Door protection" from an online shop called "fingerkeeper.co.uk".
- MB2: A search on Google dated 15 November 2019 against the term DOOR FINGER GUARD. This shows a number of different companies offering different products which all protect fingers from getting trapped in doors under a variety of names such as "Finger protectors for doors", "Fingershield door finger guard", "door hinge protectors", "Door finger protectors" (use by

Ironmongery direct.co.uk not the applicant and claimed by Ms Body to be an infringement of the applicant's mark) and "finger protection",

- MB3: A search on Google dated 15 November 2019 against the term DOOR GUARD which is said to reveal results from 1 January 2013 -1 January 2018. These all show security items such as bolts or door openers apart from a single entry which refers to "Finger Guards /Door protection" from an online shop called "fingerkeeper.co.uk".
- MB4: A search on Google dated 15 November 2019 against the term DOOR FINGER GUARD which is said to reveal results from 1 January 2013 -1 January 2018. This shows a number of different companies offering different products which all protect fingers from getting trapped in doors under a variety of names such as "door finger guard", "Fingershield door finger guard" and "finger alert door guard".
- MB5: Screenshots from companies which use the descriptive terms "finger guard", "door guards" or "door finger guards". Ms Body makes no comment on this exhibit.
- MB6: A screenshot which is said to explain the differences between the applicant's mark and the descriptive term "door finger guards". This claims the applicant's product does not need to be screwed to the door, it cannot implode into the hinge cavity jamming the door and it can be removed to get at the hinges.

9) The third witness statement, dated 27 November 2019, is by Mr Webb who has provided evidence in this case. He states that he is not aware of any other party using the instant mark. He states that the hinge shield product is sold under the mark FINGER PROTECTOR and logo in respect of the product for domestic and light commercial doors whilst the larger version for heavy commercial doors is sold under the DOOR FINGER PROTECTIOR and amended logo device. He states that the applicant has sold £8million worth of goods under the mark DOOR FINGER PROTECTOR between its introduction (2007) to February 2018. He states that this represents 456,000 units. He claims that the applicant has spent approximately £435,000 promoting the brand in *Hertfordshire Supplies* magazine (circulation 18,000 per annum), in *Jo Frost* magazine in July 2011 and in *Care and Nursing Essential* magazine in 2011/2012 (circulation 7,000 per annum). They also advertised once at a West Ham United football match in August 2013. The company attends exhibitions in the UK although only two have a date attached "Barking and Dagenham Chamber of Commerce Business Expo 2013/2014

and Essex Chamber of Commerce Business Expo in 2017. He states that the product has been installed in various Tesco stores, as well as TGI Friday and McDonald's restaurants. He provides tables of number for "clicks" and "impressions" on the company website but these are not put into context and such numbers are notoriously unreliable and open to manipulation. He provides the following exhibits:

- SRW2: Undated photographs of both products installed on doors. These show the mark in suit and also FINGER PROTECTOR used on doors both with a logo device.
- SRW3 & 5: Undated examples of promotional literature for FINGER PROTECTOR and logo device.
- SRW4: Three letters, dated 2007, from clients regarding FINGER PROTECTOR and logo products.
- SRW6: These are said to be examples of orders from people using the FINGER PROTECTOR mark. The first email correspondence is from someone in India and is dated August -October 2018; the second email is dated 27 November 2018 and the client refers to Hinge Pin Finger Protectors; the third email dated 5 July 2018 places an order for "58 x Finger Protector HC".
- SRW7: Copies of three delivery notices to McDonalds for the supply of seven Finger Protectors all dated 25 January 2011.
- SRW8: Photographs of the award won in 2000 by Finger Protector (UK) Ltd for the design of the FINGER PROTECTOR product.
- SRW9: Photos of awards for innovation won in 1999 and 2000 issued in respect of FINGER PROTECTOR.
- SRW10: Two photographs of the company attending an exhibition at the Essex Chamber of Commerce on 6 June 2018 which shows the instant mark used with a logo device.
- SRW11: A letter from McDonalds Restaurants Ltd in London, dated 28 May 2004 stating that the FINGER PROTECTOR product is approved for use in McDonalds restaurants in the UK.

- SRW12: Undated examples of product literature for FINGER PROTECTOR used with a logo device.
- SRW13: This is said to be google adwords displays for FINGER PROTECTOR. These are undated.
- SRW15: Copies of advertisements from various magazines mentioned above, and also leaflets most of which feature the mark in suit and the logo device.
- SRW21: Copies of sixty-eight invoices between 2013 and 2018 which show sales of “Door Finger Protectors”
- SRW22: A photograph of membership certificates on a wall showing that the applicant company is a member of Essex Chamber of Commerce, British Safety Council, ROSPA and Essex Wildlife Trust.

OPPONENT’S EVIDENCE IN REPLY

10) The opponent filed a witness statement, dated 28 January 2020, by Mr Yeomans who has provided evidence earlier in this case. He states that he carried out a number of Internet searches using the archive website WAYBACK MACHINE. The searches are all dated January 2020 unless otherwise specified, although in his statement Mr Yeomans cites the date that the product was first available on Amazon, but there is no evidence that the name or packaging was the same then. The results are provided in his exhibits which are as follows:

- DY1: An article, dated June 2017, about the invention of the first “door finger protection system” called “Fingersafe” in 1992.
- DV2: An internet search showing the term DOOR FINGER PROTECTOR in a descriptive manner being used by a number of companies during the period 2016-2018. It is clear that the term FINGER PROTECTOR is even more widely used, as are FINGER PROTECTION and other variants around the theme. It is also clear that a company called DOORTech has a product called DOOR FINGER PROTECTOR albeit this is slightly different in design as it

appears to shut doors more slowly allowing trapped fingers to be released before substantial damage is done.

- DY3: This shows a company (Fingerguards) advertising its product. It also uses the tag “Door finger protector”.
- DY4: Another example from Amazon of the Baby First “Finger Protector set”. This is an eleven-piece set design to be used on a variety of furniture items to prevent injuries to babies’ fingers. The set is advertised as containing a “door finger protector”. Virtually identical to DY3 of his earlier statement.
- DV5: This is virtually identical to DY2 of his earlier statement.
- DY6: A product offered on Amazon from a company called Beautiful Beginings and called “door finger protector”.
- DY7: Virtually identical to DY5 from his earlier statement.
- DV8: A print out from 27 February 2017 which shows a company called BITS4DOORS advertising its own range of FINGER PROTECTORS.
- DY9: A print out from Screwfix, dated 8 September 2017, offering as a category “finger protectors” alongside other groupings such as “window hinges” and “gate hinges”.
- DY10: A print out, dated 11 April 2016, for a product called “Strand FP200 Finger Protection device” which states underneath “Finger protectors are an economical safety measure to prevent the accidental trapping of fingers between the hinged edge of the door and the door frame”.
- DV11: A Google search for “door finger hinge protector” shows a product called this available form www.achdistribution.com.
- DY12: Pages from the website of “ironmongeryandmore.com” stating it has a range of “door finger protectors” from a number of companies.

- DY13: Virtually identical to DY4 above.
- DV14: Identical to DY4 from his earlier statement.
- DY15: Identical to DY6 above.
- DY16-20: An internet search shows four different company websites offering Door Finger Protector products under a variety of brands for sale in the UK.

DECISION

11) The grounds of opposition are based upon section 3(1)(b), (c) & (d) which read:

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

- (a) signs which do not satisfy the requirements of section 1(1),
- (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.”

12) I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b): *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25].

“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).”

13) The position under the above grounds must be assessed from the perspective of the average consumer, who is deemed to be reasonably observant and circumspect: *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. The relevant public will vary depending on the particular goods and services concerned. However, in this case, it is clear that the goods are designed to prevent injury by ensuring that fingers, particularly young children’s fingers, cannot get trapped in the door jamb. The relevant public will consist of both members of the general public and professional users such as schools, restaurants etc. The applicant contends that it only uses the instant mark upon products which can be linked to provide the same protection on commercial doors, but the applicant’s literature shows use on school doors which appear to be similar in size to certain domestic doors. From the evidence there does not appear to be a domestic / industrial divide, the same marks seem to be used upon similar products which simply vary in size. The importance of preventing injury, but also in ensuring that the product does not jam a door means that at least a medium degree of attention will be paid to the selection of the goods in the instant case. I accept that a slightly higher degree of attention will be paid by professional users (such as restaurateurs or nursery school owners).

14) I will first consider the ground of opposition under section 3(1)(c). Section 3(1)(c) prevents the registration of marks which are descriptive of the goods and services, or a characteristic of them. 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 set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“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]."

15) It is important to bear in mind the principles behind section 3(1)(c) which is to keep descriptive signs relating to one or more characteristics of the goods free for use by all traders offering such goods. As set out in the case law above, it is not necessary that the sign in question actually be in use in a way that is descriptive for it to fall foul of section 3(1)(c). If the sign can be used descriptively

then that is sufficient. The applicant is seeking to register “safety fittings for doors and windows” and it is clear from the evidence filed by the applicant that the product is intended to stop fingers being trapped between the door and the door frame. It is also apparent from the evidence that other traders use the terms “finger protector” and “door finger protector” to describe a variety of items designed to prevent doors from shutting quickly or at all or designed to fill the gap between the door and the frame thereby stopping anyone putting their fingers into the gap left when a door is open. Given that these are finger protectors for doors I can quite understand why other traders want to describe their products in this manner. Looking at the words individually, “door” plainly describes the place where the goods will be fitted; “protector” describes the purpose of the goods and “finger” describes the subject of the protection. There is nothing in the combination “Door finger protector” which is ungrammatical or unusual in terms of syntax. Therefore, the mark as a whole clearly describes the intended purpose of the goods. I also note that in its TM8 the applicant simply stated that it had acquired a reputation. In its written submissions the applicant criticised the opponent’s evidence but did not advance any arguments as to why its mark did not describe the intended purpose of the goods in question. **The ground of opposition under section 3(1)(c) succeeds.**

16) I now turn to section 3(1)(b). The general principles under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

17) The opponent contends that DOOR FINGER PROTECTOR is devoid of any distinctive character and is merely a description of the purpose of the safety barrier product. Where a mark is descriptive for certain goods or services, it necessarily lacks the required distinctiveness to avoid objection under section 3(1)(b). Given that the "safety fittings" sought to be registered are intended to protect fingers from being injured by the door upon which the fitting is attached it is difficult to see how the instant mark possesses any distinctiveness. When one considers that other traders are actively using the same wording to describe their products it is clear that the mark offends against section 3(1)(b). Again, I note the absence of any contentions either on the TM8 or the written submissions of the applicant other than a simple denial that the mark in suit offends against any of the sections of the Trade Marks Act. **The ground of opposition under section 3(1)(b) succeeds.**

Acquired Distinctiveness

18) The mark was initially refused by the UKIPO and only accepted on the basis of acquired distinctiveness. I therefore turn to consider this aspect. I have to determine whether the applicant has established acquired distinctiveness for the goods it seeks to register which for ease of reference are:

- In Class 6: Safety fittings of metal for doors and windows; parts and fittings therefor.
- In Class 19: Safety fittings of synthetic plastics for doors and windows; parts and fittings therefor.

19) The Court of Justice of the European Union provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97, about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

20) The opponent contends that the market for the applicant's products is substantial. Indeed, the applicant's own marketing materials state that the goods are suitable for use in 'schools, restaurants, hotels, public buildings and in the home...". The expenditure on marketing is very low and the product has been advertised in publications with small circulations. Nor is it clear whether the advertising included the logo device which is a feature of most of the literature said to have been distributed. Further, as the opponent points out, no details have been provided as to what was sent, to whom and when. The Applicant has not submitted any independent evidence that addresses the issue of distinctiveness, such as statements from chambers of commerce and industry or other trade and professional associations. Much of the evidence supplied shows the sign DOOR FINGER PROTECTOR being used in conjunction with distinctive elements (i.e. in logo form). Such evidence cannot be relied upon to demonstrate that consumers have been educated so that they would rely on the words DOOR FINGER PROTECTOR alone to determine the commercial origin of the goods in question. Regarding the invoices supplied the opponent comments "The Applicant does not use the TM sign alongside references to DOOR FINGER PROTECTOR on the invoices, so it cannot be said that consumers would see it as a trade mark. Interestingly, on the invoices the Applicant does use the TM sign alongside its SAFETY ASSURED logo which features prominently in the top right hand corner of the invoice and so it is submitted that it is that logo that functions as a trade mark on the invoices." The opponent continues:

"17. In fact, the invoices are really no more than evidence of use. Just because the Applicant has used the sign, does not mean that consumers would see it as denoting trade origin. In *Bach and Back Flower Remedies Trade Mark* {2000} RPG 213 at para 49 it was stated that: "... use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality".

And:

"19. We also wish to cite the judgment in the case of *British Sugar PLC and James Robertson and Sons Ltd* [1996] RPC 281 ('Treat') in which it was stated that:

"I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that "use equals distinctiveness". The illogicality can be seen from an example: no matter how much use a manufacturer made of the word "Soap" as a purported trade mark for soap the word would not be distinctive of his goods. He could

use fancy lettering as much as he liked whatever he did would not turn the word into a trade mark. Again, a manufacturer may coin a new word for a new product and be able to show massive use by him and him alone of that word for the product. Nonetheless the word is apt to be the name of the product not a trade mark. Examples from old well known cases of this sort of thing abound. The Shredded Wheat saga is a good example. Lord Russell said: "A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else".

21) The opponent contends that the evidence it has submitted demonstrates that the sign DOOR FINGER PROTECTOR is currently in use by multiple entities and therefore is not a term which should be monopolised by virtue of a trade mark registration. Lastly, the opponent states that the evidence supplied falls a long way short of proving that a significant proportion of the relevant class of persons are able to identify the goods for which protection is being sought as originating from the Applicant because of the sign DOOR FINGER PROTECTOR alone; that particular combination of words must be kept free for use by all. It sums up by stating "As mentioned above, evidence of use does not equate to evidence of acquired distinctiveness."

22) As I have said previously in this decision, the applicant, for the most part, confined itself in its written submissions to commenting upon the opponent's evidence. However, it does state the following:

"It is clear from the evidence provided by the Applicant during the examination of the Application that the Applicant has over many years built up and held a substantial reputation in relation to health and safety goods under the mark DOOR FINGER PROTECTOR. The Applicant submits that the mark DOOR FINGER PROTECTOR has acquired distinctiveness over the years as it has been widely advertised and products bearing the mark widely sold in the United Kingdom. Furthermore, the products sold under the mark remain one of the few solutions in the safety field recognised by UK Trade Professional Associations. Therefore, the Applicant submits that the relevant consumers recognise DOOR FINGER PROTECTOR as a Trade Mark capable of differentiating the relevant goods sold under their mark from those sold by another undertaking. Accordingly, at the filing date of the application a high proportion of relevant consumers identify all of the goods covered in Classes 6 and 19 of the application for DOOR FINGER PROTECTOR as originating from the Applicant.

Therefore, the Applicant submits in light of their long and continued use to the mark DOOR FINGER PROTECTOR it has acquired secondary meaning. So it is suitable for registration under Sections 3(1)(b) and (c) and the objections of the Opponent should be rejected.”

23) Most of the applicant’s evidence relates to use of the mark FINGER PROTECTOR not the instant mark. I understand that the applicant sought to register this trade mark but it was refused by the UKIPO. Whilst the applicant has shown sales of its safety equipment, it has provided scant evidence of use of the words “door finger protector” solus in a trade mark manner. Most of the use shown was these words with a substantial logo element, although I am not entirely convinced that even the presence of this logo would make a registrable trade mark. There is clear evidence of other traders using the words in a descriptive manner as it does neatly sum up the product and what it does. The applicant has not shown that its mark is widely known and recognised as a trade mark, certainly there is no independent evidence. The advertising and attendance at exhibitions all seem to be concentrated in one local area, and even then, the methods of advertising have restricted the number of people likely to have seen it. The advertising also seems to have included the logo device. The relevant public, as noted above, consists of members of the general public and owners of restaurants, schools, nurseries etc. in fact anyone who owns a property which has a door. **I do not, therefore, consider that the applicant has established that its marks have acquired distinctiveness amongst a significant proportion of the relevant public throughout the UK in relation to its goods in classes 6 & 19.**

24) Given the above findings I do not need to consider the ground under section 3(1)(d).

CONCLUSION

25) The opposition under section 3(1)(b) & (c) are completely successful and so the application is completely rejected.

COSTS

26) The opponent has succeeded in full and is entitled to a contribution towards its costs.

Preparing a statement and considering the other side’s statement	£200
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Expenses	£200
Providing evidence and considering the evidence of the other party	£900
Providing submissions	£400
TOTAL	£1,700

27) I order Safety Assured Limited to pay Planet GDZ AG the sum of £1,700. This sum to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of April 2020

**George W Salthouse
For the Registrar,
the Comptroller-General**