

O/762/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3534758

BY MICHAEL WARD

FOR THE TRADE MARK:



HAVEN HERITAGE

IN CLASS 6

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 423025

BY WINDOW FABRICATION & FIXING SUPPLIES LIMITED

BACKGROUND AND PLEADINGS

1. Michael Ward (“the Applicant”) applied to register the trade mark shown on the cover page of this decision in the UK on 18 September 2020. It was accepted and published in the Trade Marks Journal for opposition purposes on 30 October 2020, for the following goods:

Class 06: Architectural Ironmongery; Door Handles; locks; Metal Figures.

2. On 1 February 2021, Window Fabrication & Fixing Supplies Limited, (“the Opponent”) opposed the application pursuant to section 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is raised against all of the goods applied for under the contested mark.

3. The opponent relies on UK registration 2060787 for the purposes of both section 5(2)(b) and section 5(3) grounds of opposition. The pertinent details of UK 2060787 are as follows:

Filed: 12 March 1996. **Registered:** 10 July 1996.

Class 6: Hinges.

For the mark: **HAVEN HINGE**

4. Use is claimed in respect of the goods under the earlier mark, and the opponent claims a reputation in those goods, for the purposes of section 5(3).

5. Under the section 5(4)(a) ground of opposition, the opponent relies upon the unregistered mark **HAVEN**, which it claims to have used throughout the UK since at least 1996 on the following goods: ‘Hinges; door hinges; sash plates; metal hardware; goods of metal; door fittings of metal; parts, fittings and accessories for the aforesaid goods’.

6. In its statement of grounds the opponent claims that under section 5(2)(b) the contested application should be refused entirely as there exists a likelihood of confusion, including a likelihood of association, between the marks, as they are highly

similar visually, aurally and conceptually. It also submits that the goods in issue are highly similar, if not identical.

7. Under section 5(3) the opponent claims that the contested mark should be refused entirely, as it is highly similar to the earlier registered mark and use of the contested mark will take unfair advantage of, and will be detrimental to, the distinctive character and reputation of the earlier mark. It asserts that use of the contested mark would allow the applicant to freeride on the opponent's well-consolidated reputation in the registered mark and this would therefore dilute the distinctive character of the opponent's mark. It submits that use of the applicant's mark would also cause damage to the opponent's strong reputation in the earlier registered mark.

8. Under the section 5(4) ground of opposition, the opponent states that it has goodwill in the **HAVEN** mark such that use of the sign covered by the application in respect of the goods covered by the application, would constitute a misrepresentation likely to deceive the relevant public as to the origin of the goods in question, resulting in damage to the opponent.

9. Given its filing date, the opponent's 2060787 UK registration is an earlier mark in accordance with section 6 of the Act and, as it had completed the respective registration process more than five years before the filing date of the contested application, it is subject to the proof of use provisions contained in section 6A of the Act.

10. In response the applicant submitted a counterstatement on 5 November 2021 in which it put the opponent to proof of use in respect of the earlier mark relied upon for the purposes of section 5(2)(b). It also requested proof of the claimed reputation the opponent relies on for the purposes of section 5(3) and the goodwill claimed in respect of the unregistered sign **HAVEN** for the purposes of section 5(4)(a). The applicant also explicitly denied all of the claims made by the opponent in respect of all three grounds of opposition.

11. The applicant is represented by Mathys & Squire LLP. The opponent is represented by Marks & Clerk LLP.

12. Neither party requested a hearing. The opponent filed evidence and written submissions in lieu, which will be summarized to the extent deemed necessary. This decision is taken following a careful perusal of the papers.

EVIDENCE

13. The evidence of the opponent comprises the witness statement of Mr Ben Penson which is dated 31 January 2022 and is accompanied by Exhibits 1 – 11. Exhibit 4 is the subject of a confidentiality order.

14. For the purposes of establishing proof of use of the earlier mark, as the contested application filing date is 18 September 2020, the relevant period is from 19 September 2015 to 18 September 2020.

15. In his witness statement, Mr Penson states that he is the Manufacturing and Technical Director at ERA Home Security Limited (“ERA”), a role he has held since 2010. He states that ERA is the holding company and sole shareholder of the opponent, Window Fabrication and Fixing Supplies Limited. Mr Penson states that ERA and the opponent are affiliated companies and the opponent has authorised ERA to use the earlier mark HAVEN HINGE for many years. He adds that the opponent is also the proprietor of the trade mark ‘Fab&Fix’ (UK registration 2365649).

16. Mr Penson states that the opponent was established in 1990 and specialises in the manufacture of hardware components. He asserts that Exhibit 2 shows that the opponent has a variety of product ranges including the “classic” range and the “heritage” range. Mr Penson claims that these terms are used as descriptive indicators of the style of the goods available in those ranges. He adds that “heritage” is a term widely used by numerous companies in the sector in relation to metal hardware goods to designate nature and style.

17. Mr Penson claims that the opponent has “designed and manufactured a range of hinges and their parts and fittings under the name HAVEN/HAVEN HINGE since at least 1996”. He states that as well as being available to purchase directly from the opponent, the HAVEN and HAVEN HINGE product range is also distributed and advertised by a number of third-party companies in the UK including Amazon, Lockstation, Duffells, and Handlesandhinges.co.uk.

18. Mr Penson sets out a range of information contained within the Exhibits provided, including sales, invoices and promotional activity. I will carefully assess all of this information and refer to the more pertinent elements throughout my decision.

19. Based on the contents of his statement and the Exhibits which accompany it, Mr Penson asserts that the opponent has made extensive use of the marks HAVEN and HAVEN HINGE “in relation to hinges for many years in the UK such that it has acquired a reputation and goodwill” in those marks.

20. Exhibit 1 comprises information from Companies House records relating to ERA and Window Fabrication & Fixing Supplies Limited (the opponent), establishing a link between the two undertakings.

21. Exhibit 2 is comprised a series of undated ERA webpages, which provides a narrative about the company and more than 30 years of experience in the decorative hardware industry. This information is largely focussed on the Fab&Fix brand and lists a Classic range and a Heritage range. I find no mention at all of the HAVEN mark within this exhibit.

22. Exhibit 3 comprises a number of pages from the ‘ERA Everywhere’ website (dated 12 Jan 2022) and shows that a search for ‘HAVEN’ reveals five results or hits including the following: ‘Haven Heavy Duty Door Hinge’, with an image of a hinge. Other results show Haven used in relation to hinge pin packs, door hinge sash pieces and plates, and door hinge frame pieces. I note that as well as this information being dated outside of the relevant period, a number of images of the products mentioned are blank, with the text “coming soon” in place of an actual image. This suggests to me that this information is relatively new to the website and therefore it is likely that they are new products, or that the website/webpages are in development.

23. Exhibit 4, which has been granted a confidentiality order, comprises financial and unit volume figures for the years 2012-2021, providing sales values per year in pounds sterling, and also unit sales volumes. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]
[REDACTED]
[REDACTED]. These figures can be said to be reasonably significant, however I suspect that the relevant UK market for such products is likely to be very large indeed. It is clear from the information provided under this exhibit, that sales of Haven Door Hinges have been continuous since early 2012 and have been reasonable, in terms of unit sales of those products.

24. Exhibit 4a comprises a number of sales invoices showing ERA as the retailer of Haven products. Mr Penson states that these invoices are merely a small selection, and that many more are available. The first invoice is dated 3 March 2015, which falls outside of the relevant period for proof of use. Other invoices are dated within the relevant period and show sales of Haven Hinge products to buyers in: Hull in February 2016 for £2712.80; Scarborough in February 2017 for £114.12 and February 2018 for £793.62; East Sussex in February 2019 for £513; Middlesboro in February 2020 for £3037.50. Other invoices, to customers in Wakefield and Gateshead, showing sales of Haven products, do not fall within the relevant period for proof of use.

25. Exhibit 5 comprises a catalogue of data sheets from ERA, with technical specification details for a range of Haven hinges. This information is undated.

26. Exhibit 6 comprises fitting instructions for HAVEN hinge products. This information is co-branded with the Fab&Fix mark in a number of places and is undated, although Mr Penson claims this information dates back to 2002.

27. Exhibit 7 comprises an ERA security document and a product guide from 2018. Haven hinges are briefly mentioned in the security document, and HAVEN HD door hinges are listed in the 2018 guide.

28. Exhibit 8 comprises a YouTube video from ERA, with over 26,000 views, on how to fit and adjust the HAVEN intelligent strength door hinge from Fab&Fix and ERA Home Security.

29. Exhibit 9 comprises a small number of extracts from the Wayback machine. The first is from 29 August 2018, showing the 'ERA EVERYWHERE' webpage displaying Haven hinge products for sale. Another extract from 24 July 2017 shows Haven hinge

products for sale. A further extract from 14 August 2016 shows Haven composite hinges for sale. Another from 28 October 2013 shows Fab&Fix offering Haven Composite Hinges for sale online.

30. Exhibit 10 comprises examples of the opponent's Haven hinge products being advertised by third parties online. This information is effectively undated, as only the print date of the pages provided is shown (being 13 January 2022). This information shows that in January 2022 the opponent's HAVEN hinge products were widely available from third parties and other distributors across the UK.

31. Exhibit 11 provides information about ERA attendance at a trade event called the FIT Show. The first two images in this exhibit show an ERA stand at the FIT Show in 2014. In the second image, a display board shows a number of products which it might be assumed ERA offers for sale. That image looks like this:



32. Exhibit 11 also provides screen shots from a YouTube video at the FIT show in 2017, titled 'ERA Home Security at FIT Show'. Finally, there is an extract from the 'ERA Everywhere' website discussing its presence at the 2019 FIT Show and offering a 'total-security' solution for customers' homes. This extract is focused on alarm

systems and 'DoorCam' products, and there is no mention of hinges, or of the mark HAVEN. Mr Penson states that the FIT Show is the UK's only dedicated event for the window, door, flat glass, hardware and components industry.

DECISION

Proof of Use

33. Relevant statutory provision: Section 6A:

“(1) This section applies where:

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

34. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark:

Ansul at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

35. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal

will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

36. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

37. Having considered the evidence of the opponent carefully and taking into account the relevant case law set out above, I conclude that the opponent has shown genuine use of the earlier mark on ‘Hinges’, which are the sole goods covered under the earlier registration relied upon.

38. The evidence largely centres on use of the mark by ERA. As outlined in *Ansul*, “genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark”. Mr Penson has established that ERA was authorised by the opponent to use the earlier mark relied upon. I find that the use shown in evidence is more than merely token and supports genuine commercial exploitation of the mark on the market for ‘Hinges’.

39. However it should be noted that, whilst I accept the opponent has, just, shown there to have been genuine use of the earlier mark on 'hinges', I have found there to be significant flaws in the opponent's evidence. A substantial part of the evidence is either undated or out of scope for the purposes of section 5(2)(b). There is no indication of market share, in a market that is likely to be extremely large; only a few examples of sales invoices have been provided; no indication of promotional and marketing expenditure has been given and, in some of the exhibits, there is no mention of the mark at all. All of the images in exhibit 11 for example show the name ERA and the mark Fab&Fix' being used, or on display many times, but the mark relied upon is not in evidence within that exhibit at all.

40. As a result of the genuine use shown of the earlier mark HAVEN HINGE on 'hinges' the opponent may rely on earlier UK mark 2060787, for the purposes of the opposition insofar as it pertains to the section 5(2)(b) ground.

Section 5(2)(b)

41. Section 5(2)(b) of the Act states:

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

(a) ...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

The principles

42. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case

C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:¹

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

¹ Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

43. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

44. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective users of the respective goods or services;
- (b) The physical nature of the goods or acts of services;

- (c) The respective trade channels through which the goods or services reach the market;
- (d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

45. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

46. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.²

² Paragraph 82

47. The goods in issue are:

Opponent's goods	Contested goods and services
Class 06: Hinges.	Class 06: Architectural Ironmongery; Door Handles; locks; Metal Figures.

48. The earlier goods are 'hinges', which are defined as "a piece of metal, wood, or plastic that is used to join a door to its frame or to join two things together so that one of them can swing freely".³

49. The contested 'architectural ironmongery' are metal articles for the house and garden, which may be decorative and/or functional, and will encompass goods such as hinges. Applying the principle outlined in *Meric*, these goods are identical.

50. The contested 'door handles' and 'locks' are goods of metal and other materials, which will be attached to, and used to open and close doors. These goods can be described as 'door furniture' which is defined as "locks, handles, etc, designed for use on doors".⁴ Whilst these goods do not share the same specific purpose as the earlier 'hinges' they may be produced by the same undertakings, will be consumed by the same public, and are generally sold in the same retail stores and areas/aisles in places such as DIY shops and online retail sites. These goods are not in competition and cannot be said to be complementary but will likely be perceived as falling within the same category 'door furniture'. These goods are similar to a low degree.

51. The contested 'metal figures' are likely to be artistic or decorative in nature. Whilst this is a somewhat vague term, I find that *Meric* does not apply here. In my mind the word 'figures' suggests that the goods on offer will be metallic objects in the form of animal or human figures intended to play a decorative role and will be entirely distinct from a hinge. These goods are considered to be dissimilar.

The average consumer and the purchasing process

³ <https://www.collinsdictionary.com/dictionary/english/hinge>

⁴ <https://www.collinsdictionary.com/dictionary/english/door-furniture>

52. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he was then) described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.⁵

53. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

54. The average consumer of the goods in issue will be both a member of the general public, who will pay at least an average degree of attention when purchasing goods such as door handles and locks, as the aesthetic appearance of e.g. a door handle and the quality or robustness of e.g. a lock or hinge, will be important in the selection process; and a professional consumer, buying on behalf of others who will pay a slightly higher degree of attention when making their choice. These goods will generally be a visual purchase either online or within traditional retail stores and DIY specialist retailers, but may involve word of mouth recommendation and an aural aspect to the selection.


Comparison of marks

55. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

⁵ Paragraph 60.

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

56. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Earlier Mark	Contested Mark
<p>HAVEN HINGE</p>	

Overall impression

57. The earlier mark comprises two words presented in standard typeface. Both words are five letters long and appear to hang together as a single unit due to the descriptive nature of the word HINGE. The first word HAVEN can be said to be the only distinctive element in the mark as the second word HINGE directly describes the goods provided under the mark. No single element can be said to be the more dominant or eye catching, however. The overall impression of the earlier mark is that of the words HAVEN HINGE as a totality, where the distinctiveness of the mark lies in the word HAVEN.

58. The contested mark is a complex mark comprising figurative elements and word elements. The term HAVEN HERITAGE is placed at the bottom of the mark in a

standard uppercase typeface and is of a reasonable size. As the only clearly verbal element, these words play a significant role in the mark. The figurative aspects of the contested mark comprise a pink square within which has been placed two letters H, which are presented in differing shades of grey, in uppercase and linked together. The lighter letter appears to be in front of and slightly below the darker letter. It is possible that these letters may be perceived as an aural element in the mark, although I think it unlikely that they would be articulated. The mark is co-dominated by two aspects, the larger device element containing the 'HH' combination, and the words HAVEN HERITAGE. Both elements can be said to be distinctive of the goods at hand, although accepting the opponent's submissions regarding the use and perception of the word HERITAGE, I find the word HAVEN in the two-word combination HAVEN HERITAGE, to be the far more distinctive element. The overall impression conveyed by the contested mark is that of the two co-dominant elements, which do not naturally form a single unit in my opinion.

Visual Comparison

59. Visually the marks share the word HAVEN almost identically in a standard, uppercase, typeface. They also share the letter H, as the initial letter of the second verbal element of each mark. In all other aspects the marks differ visually. The word HAVEN in the earlier mark comprises the initial element and exactly half of that mark. The same word in the contested mark, whilst placed at the bottom of the mark, has been found to be co-dominant (in combination with the word HERITAGE), due to the fact that consumers are generally drawn to verbal elements in a mark. As the first verbal element in the contested mark (possible enunciation of the letters HH notwithstanding), the word HAVEN catches the eye. Therefore, regardless of the visual differences between the marks, I conclude that they can be said to be visually similar, to at least a low degree.

Aural Comparison

60. The marks share the word HAVEN. The earlier mark also contains the word HINGE which has no counterpart in the contested mark, and the contested mark contains the word HERITAGE which equally has no counterpart in the earlier mark. I find it unlikely that the letters 'HH' in the contested mark will be enunciated at all. I find

it very likely that the word HINGE will almost always be articulated, given the nature of the word within the context of the goods, i.e. being entirely descriptive, and given the nature of the purchase process and the requirement generally for a consumer to indicate what kind of goods it is looking for in any discussion with a sales assistant. The use of the word HERITAGE may also be common given the submissions of the opponent, which I accept, that this word is used as a descriptor of a style or design in the products. Given the identical nature of the initial verbal elements and the shared 'H' beginning in the second elements HINGE and HERITAGE, I find the marks to be aurally similar to at least a medium degree.

Conceptual Comparison

61. The marks share the word HAVEN, which is a fairly common word that is likely to be understood by the relevant public in this matter. The word HAVEN is defined as “a place where people or animals feel safe, secure, and happy”.⁶ The opponent has asserted that HERITAGE is used in the trade and designates a certain style or appearance. I note that it is defined as “anything that has been transmitted from the past or handed down by tradition”.⁷ The word HINGE in the earlier mark has been considered previously and conveys a meaning that will be commonly understood. I find that the letters 'HH' and the figurative device in the contested mark will not convey any clear conceptual message. Given the shared concept in HAVEN and the different concepts conveyed by the words HINGE and HERITAGE, I find that the marks are conceptually similar to at least a medium degree.

Distinctive character of the earlier mark

62. The degree of distinctiveness of the earlier mark is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion⁸. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

⁶ <https://www.collinsdictionary.com/dictionary/english/haven>

⁷ <https://www.collinsdictionary.com/dictionary/english/heritage>

⁸ *Sabel BV v Puma AG*, Case C-251/95, § 24

63. “In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings” - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

64. Trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Further, the distinctiveness of a mark can be enhanced by virtue of the use made of it.

65. In this matter, whilst the opponent filed evidence and claimed enhanced distinctiveness through use made of its mark, I have concluded that the evidence, whilst sufficient to prove genuine use of the earlier mark, cannot be said to be enough to prove that the earlier mark HAVEN HINGE enjoys an enhanced degree of distinctive character. Reasonable length of use of a mark, which the opponent has shown for its mark since 2012, does not, in isolation, translate into enhanced distinctiveness. The level of sales of the opponent's goods across the period have been reasonable, however no third-party evidence has been provided to suggest that the opponent's goods are well-known or considered to be of high quality. Very little information relating to marketing or promotional activities or expenditure, have been provided either. Consequently, I determine that the use provided does not support enhanced distinctive character through use made of the mark prior to the filing date of the contested application. As a result, the opponent mark can only rely upon its inherent distinctive character.

66. I find that the earlier mark HAVEN HINGE has an obvious link to the goods at issue due to the inclusion of the word HINGE. However, the word HAVEN, whilst having a known meaning, has no clear connection to the goods at issue.

67. Given the definition of the word HAVEN in paragraph 61 above, it might be argued that in respect of hinges, the consumer will perceive an allusive quality in the products,

in the sense that a HAVEN hinge might provide extra safety and security. Whilst I accept that this is a possibility, I believe that there are many other words that would more likely be chosen to allude to or suggest such a quality in these goods. I therefore, I conclude that the opponent's mark is inherently distinctive to a medium degree.

Likelihood of confusion

68. There is no simple formula for determining whether there is a likelihood of confusion. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind.

69. It is clear then that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa (*Canon* at [17]). In making my assessment, I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

70. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms,

is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

71. These examples are not exhaustive but provide helpful focus.

72. I have concluded that some the goods at issue are identical, some similar to a low degree and some dissimilar. The competing marks have been found to be visually similar to at least a low degree and aurally/conceptually similar to at least a medium degree. The average consumer of the goods in issue will be members of the general public and professionals, who will select the goods primarily through visual means, though I have considered an aural component in the selection process as well. I have concluded that the level of attention exercised during the purchasing process will range from at least average to slightly higher than average, depending on the consumer group. I have found the opponent’s mark to have a medium degree of distinctive character.

73. For those goods found to be dissimilar, no likelihood of confusion can occur and, for the purposes of the opposition under section 5(2)(b) those goods will form no further part of my assessment.⁹

74. I have taken the factors in paragraph 72 into account in my assessment of the likelihood of confusion between the marks, and I come to the view that for the contested goods found to be identical and similar to a low degree, direct confusion will not occur. Although the marks share the distinctive word HAVEN, the additional verbal elements HINGE and HERITAGE and the figurative elements in the contested mark, are more than sufficient to ensure that the average consumer will not mistake one mark for the other.

75. Having concluded that direct confusion will not occur, I go on to consider the possibility of indirect confusion.

76. I remind myself of the comments set out above of Mr Purvis QC in *LA Sugar Limited*, where he identified categories that might support a claim of indirect confusion.

77. In this instance the common element between the marks (HAVEN) can be said to be identical and forms the only clearly distinctive verbal aspect in either mark. The additional elements found in the contested mark include the letters HH, which I believe will likely be perceived simply as the initial letters of the words HAVEN and HERITAGE. They also represent the initial letters of the words in the earlier mark HAVEN HINGE. It is my belief that the average consumer, including a professional consumer, will simply view the later mark as an extension of, or a sister mark to the HAVEN HINGE brand of the opponent. The additional features in the contested mark, such as the letters HH and the pink square border, will likely be assumed to be part of a design variation or brand evolution. Therefore, I find that indirect confusion will occur.

78. Having found that, for the goods considered to be identical and similar to a low degree indirect confusion will occur, the opposition, insofar as it is based on section 5(2)(b) has been partially successful.

79. I now move on to consider the section 5(3) ground of opposition.

⁹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Section 5(3)

80. Section 5(3) of the Act states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

81. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the

mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

82. An opposition based on section 5(3) of the Act can only be successful via the establishment of several individual elements, the cumulation of which must satisfy all elements of the claim. To be successful on this ground, the opponent must prove they hold a reputation for the earlier mark amongst a significant portion of the public.

Reputation

83. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

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

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

84. The opponent claimed to have a reputation for the goods on which it relied for the purposes of the section 5(2)(b) ground of opposition, namely ‘Hinges’. This was denied by the applicant and, following my assessment of the opponent's evidence, I find that the opponent has not proven that it enjoys a reputation for the goods claimed.

85. In its evidence, the opponent has provided no indication of market share and almost no indication of promotional or marketing activities undertaken to raise brand profile, aside from attendance at one specific trade show (FIT) during the relevant period. No financial figures have been provided to show the level of marketing and promotional activities that the opponent has undertaken in respect of the HAVEN HINGE brand. With no third-party evidence or testimony to support a claim of reputation, I conclude that the opponent has not shown that its earlier mark is known by a significant part of the public concerned by the products covered by that trade mark. That being the case, the opposition insofar as it is based on section 5(3) must fail.

86. I now move on to consider the section 5(4)(a) ground of opposition.

Section 5(4)(a)

87. Section 5(4)(a) of the Act states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met

...”

88. Subsection 4(A) is as follows:

“The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

89. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved if a claim of passing off is to succeed:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”¹⁰

Relevant Date

90. In *Advanced Perimeter Systems v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*, BL O/212/06:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”¹¹

91. The applicant has not claimed to have used the contested mark before the date of application and so the relevant date is 18 September 2020.

¹⁰ Page 406.

¹¹ Quoted in paragraph 43 of BL O-410-11.

Goodwill

92. The opponent must show that it had goodwill in a business at the relevant date of 18 September 2020 and that the sign relied upon, HAVEN, is associated with, or distinctive of, that business.

93. The opponent has claimed to have used the mark HAVEN throughout the UK since at least 1996 on the following goods: 'Hinges; door hinges; sash plates; metal hardware; goods of metal; door fittings of metal; parts, fittings and accessories for the aforesaid goods'.

94. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

95. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by BALI

Trade Mark [1969] R.P.C. 472). Thus, the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

96. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

97. In *Smart Planet Technologies, Inc. v Rajinda Sharm* [BL O/304/20], Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that

there would be substantial damage on the basis of the misrepresentation relied upon.”

98. I have already summarised the opponent’s evidence, and having considered it carefully, I conclude that there is no indication of the mark HAVEN being used prior to 2012. I also conclude that the evidence suggests that the scope of any use can only be said to have been on ‘hinges’.

99. Taking the evidence as a whole I conclude that it supports a finding of goodwill that is more than nominal, in respect of ‘hinges’. I come to this finding based on the evidence before me and application of the relevant case law set out above. It seems clear to me that at the relevant date, the mark HAVEN will have been known to a significant part of the relevant public. The opponent has shown that it has sold a substantial number of hinges since at least 2012, across the UK, with sales invoices in evidence showing that the opponent has sold its hinges to customers widely across the relevant territory.

100. Having found that the opponent holds goodwill in the unregistered sign ‘HAVEN’ in respect of ‘hinges’, I must now consider whether misrepresentation would occur.

Misrepresentation

101. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’[product]”

The same proposition is stated in Halsbury’s Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville*

Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

102. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

103. Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to found a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

104. Based on my earlier findings that the marks at issue are visually, aurally and conceptually similar and share the distinctive element HAVEN; that part of the contested goods have been found to be identical or similar to the opponent's ‘hinges’;

along with the closeness of the respective fields of activity including locks, handles and hinges, all of which have been found to fall within the category of 'door furniture'; I find that a substantial number of the opponent's customers or potential customers, will be misled into selecting the applicant's goods in the mistaken belief that they are goods originating from the opponent, and misrepresentation would therefore occur.

105. I do not, however, make the same finding in respect of the contested 'Metal figures' which have been found to be dissimilar to the opponent's goods. I find the respective fields of activity to be too far removed for misrepresentation to occur in respect of such goods.

Damage

106. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

"In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation."

107. In light of the aforesaid, I find that damage would occur in the diversion of sales of identical and closely linked goods from the opponent to the applicant. That being the case, the opposition insofar as it is based on section 5(4)(a) partially succeeds, for the following goods:

Class 6: Architectural ironmongery; door handles; locks.

Conclusion

108. The opposition under section 5(3) has failed. The opposition under section 5(2)(b) and section 5(4)(a) has been partially successful. Subject to an appeal to this decision, the contested application is refused for the following goods:

Class 6: Architectural ironmongery; door handles; locks.

109. The application may proceed to registration for the following goods:

Class 6: Metal figures.

COSTS

110. As the opponent has been largely successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Applying said TPN as a guide, I award costs to the opponent on the following basis:

Official fee	£200
Preparing the Notice of Opposition and filing the Counterstatement:	£400
Preparing evidence and written submissions in lieu:	£400
Total:	£1000

111. I hereby order Michael Ward to pay to Window Fabrication & Fixing Supplies Limited the sum of £1000. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of September 2022

**Andrew Feldon
For the Registrar**

REDACTED