

BL O/0459/23

TRADE MARKS ACT 1994

**TRADE MARK APPLICATION No. 3705372
BY MORALT AG**

AND

**OPPOSITION No. 432938
BY HALSPAN LIMITED**

Background and pleadings

1. This is an opposition by Halspan Limited (“the Opponent”) to an application filed on 30 September 2021 by Moralt AG (“the Applicant”) to register the trade mark shown below:



2. The application is filed in respect of goods and services in classes 17, 19, 20 and 40 of the Nice Classification. The full list of goods and services is reproduced at Annex A.

3. The Opponent’s grounds of opposition are based on sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994 (“the Act”). Under section 3(1)(b) the Opponent claims that the phrase “THE CORE OF THE DOOR” is descriptive and therefore non-distinctive with the triangle device being “insufficiently distinctive to assist”. Under section 3(1)(c) the Opponent claims that “THE CORE OF THE DOOR” describes “characteristics of the goods and services, namely products and services to do with door cores”. The Opponent explains that “core” describes the inside or most important part of something and states that the triangle device is “insufficiently distinctive to assist”. Under section 3(1)(d), the Opponent states that the word “core” is a term of art as cores of doors can be sold separately and are important in terms of, for example, fire safety. Under this ground, the Opponent repeats that the triangle device is “insufficiently distinctive to assist”.

4. The Applicant filed a counterstatement denying each of the claims and submitting that the dominant element in the application is the double triangle device. In addition to this, the Applicant submits that the verbal element “THE CORE OF THE DOOR” is not immediately descriptive of the claimed goods and services and in any event,

many of the goods and services have no direct relationship to doors. The Applicant put the Opponent to proof of its claims.

Representation and papers filed

5. The Applicant is represented by Cameron Intellectual Property Ltd. The Opponent is represented by Murgitroyd & Company.

6. The Opponent filed evidence in these proceedings, comprising the witness statement of Andrew Wallace, Managing Director of the Opponent company, Halspan Limited. Mr Wallace introduces five exhibits, number AW1 to AW5, which aim to show use of the term “core” in the context of doors. The Applicant did not submit evidence. Neither side requested a hearing and both sides filed submissions in lieu of a hearing. This decision is taken following a careful analysis of the papers.

The relevant date

7. The trade mark application was made pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union. This provision allows those who had pending EU Trade Marks at the end of the transition period to file a comparable UK application and claim the filing or priority date of the earlier EUTM as the priority date for the UK application. The applicant had a relevant pending EUTM (EU18277015), which claimed priority from German application (DE3020201010121). The Applicant filed its UK trade mark application within the nine month period allowed for doing so. Therefore, in accordance with section 6(2A) and paragraph 25 of Schedule 2A of the Act, the applicant is entitled to rely on the priority date applied to its EUTM as the priority date for its UK application for the purpose of establishing “which rights take precedence”. This means that the priority date of the EUTM, which was 23 January 2020, is the relevant date for determining priority vis-à-vis any conflicting third party trade mark applications. However, the relevant date for determining whether the trade mark is subject to refusal on the absolute grounds set out in section 3 of the Act is the actual filing date of the application in the UK and not the priority date as alleged by the Applicant. Therefore, the relevant date for the purposes of this opposition is 30 September 2021 (“the relevant date”).

Decision

8. 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 Act relied upon in these proceedings are derived from retained EU law. That is why this decision continues to refer to the case law of the EU courts.

9. The relevant sections of the Act are as follows:

3. - (1) The following shall not be registered –

(a) [...]

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

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

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

Section 3(1)(c)

10. I find it convenient to start by assessing the Applicant's mark under section 3(1)(c) of the Act. While section 3(1)(b) and 3(1)(c) are distinct grounds, the only basis of the Opponent's case under section 3(1)(b) is that the Applicant's mark is descriptive. Therefore, if the section 3(1)(c) ground succeeds, or fails, the same outcome will apply in respect of section 3(1)(b).

11. The case law under article 7(1)(c) of the EU Trade Mark Regulation (which corresponds to section 3(1)(c) of the Act) was set out by Arnold J. (as he was then) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* (with most case notes omitted) as follows:

“91. The principles to be applied under article 7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o.* (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...

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.

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.

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.

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. 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.

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.

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, 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.”

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.¹”

12. Later on in *Starbucks*, Arnold J (as he then was) held that a descriptive word with a minor figurative embellishment was, as a whole, devoid of any distinctive character. The mark at issue was:



Arnold J found that:

“116. Taking all of the evidence into account, I conclude that the CTM is precluded from registration by art.7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative

¹ See *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Kononklijke Nederland NV v Benelux-Merkenbureau* (C-363/99) [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].

elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of art.7(1)(b) .

117. I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place.”

13. In *PutterScope* BL O/096/11, the Appointed Person considered the following mark:



Of the mark Mr Ian Purvis KC said:

“8...Although I agree that it necessary for the purpose of explanation to break down the mark into its component parts, one must be aware of the danger that such an iterative approach may be unfair to the applicant. Each individual part of a mark may be non-distinctive, but the sum of the parts may have distinctive character – see *Satelliten Fernsehen GmbH v OHIM* [2005] ETMR 20 [SAT 1], at paragraph 28. Ultimately the decision making tribunal must stand back from the detailed breakdown of the mark and envisage how the entire trade mark would be understood by the public when applied to the goods of the specification. Would the average consumer consider that it was a trade mark indicating goods from a

particular source or would they consider that it simply indicated the function of the goods?”

14. In FLYING SCOTSMAN, the Appointed Person considered the following mark:



In this case, Mr Geoffrey Hobbs KC stated:

“The case for allowing registration can be summarised as follows: the sign operates by attaching the made-up name for a locomotive to an image which represents the locomotive emblematically; the image is emblematic to a degree which shows that the sign is not being used simply and solely as an indication of content or character in relation to the goods concerned; moreover it personalises the sign in a manner which is apt to result in it being seen as a ‘fingerprint’ of the involvement of a particular economic undertaking; the average consumer’s perceptions of the sign as a whole would accordingly be origin specific even in relation to goods of the kind I am required to envisage.”

15. Having set out the relevant law and legal principles, I now take stock in light of the claims and evidence in this case. My task here is to decide whether, on 30 September 2021, when the Applicant applied for its trade mark, the mark was



descriptive of a characteristic of the goods and services covered by the application. This position must be assessed from the

perspective of the average consumer, who is deemed to be well informed, reasonably observant and circumspect.²

16. I agree with the parties that the average consumer of the goods and services will include both the general public and specialist public. In terms of the degree of attention paid, I agree with the Applicant that this will be moderate for certain goods and services but higher for those aimed at a professional public, for example, the wide array of raw materials and semi-finished goods that would be used in manufacturing.

17. The mark at issue is comprised of two elements, the first being the verbal element "THE CORE OF THE DOOR". To the left of this is the second element, which is a device of two overlapping triangles, where a black triangle is overlaid with a smaller white triangle. I consider the words in the mark to be the dominant element. Although the device element is a relatively simple combination of two geometric shapes, I consider that its proportionately large size, in comparison to height of the words, means that it contributes to the overall impact of the mark.

18. In deciding whether the Applicant's mark contravenes section 3(1)(c), I will first consider whether the verbal element is descriptive. I will then consider what impact the device element plays before assessing the mark as a whole.

19. In its statement of grounds, the Opponent contends that "THE CORE OF THE DOOR" describes that the goods and services are related to door cores, with "core" being the inside, or most important part of something. In his witness statement, Mr Wallace states that "core" in relation to doors is a term of art denoting "the basic and most important part of a door, minus all the finishes and fittings". All but one exhibit in the evidence brought by Mr Wallace refers to the different types of "cores" used in the manufacture of doors, with each type having different thermal, durability, security, acoustic or fire safety qualities:

² *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

Timber Door Core: Definitions

Types, Properties and Performance of Timber Door Core

British and European Standards related to doors tend not to make reference to the term "solid core" "hollow core" or "semi-solid core" commonly used by the timber industry when describing their door products. This Guide provides a standard definitions for each of these terms. These definitions are as follows;

3

Physical Security Elements

Thomas Norman CPP, PSP, CSC, in Integrated Security Systems Design (Second Edition), 2014

Solid Core

Solid core doors are wooden doors that are fully filled with wood or wood composite materials inside a frame of wood. Solid core doors are often used in commercial applications, particularly in high-rise office building corridors. These are mostly applied to tenant suite doors rather than on the main fire corridor, where hollow metal doors are more common due to their lower cost and often higher fire rating. Solid core doors are in common use for the interior doors of Class A office buildings.

4

Metal Door Cores

Even metal doors have many **different types of door cores** but the five most common ranging from most expensive to least expensive are temperature rise, steel stiffened, polyurethane, polythene and honeycomb.

5



Severecore™
Severe Duty Door Core

TRIED & TESTED

Severecore™ is a solid three layer particle board, achieving severe duty under the classification standard BS EN 12400:2002.

6

20. At Exhibit AW4, Mr Wallace provides a page from an online brochure of the timber distributor, Latham Timber, showing different brands of doors. Mr Wallace

³ Exhibit AW1.

⁴ Exhibit AW2.

⁵ Exhibit AW3.

⁶ Exhibit AW5.

highlights that the products shown include the Applicant’s “Moralt” branded goods and the Opponent’s “Halspan” branded goods:

Door Blank Brands

10

(/CON:
US#EQ

Flamebreak



(/products/door-blanks/brands/flamebreak)

Flamebreak

(/products/door-blanks/brands/flamebreak)

Flamebreak

Moralt



(/products/door-blanks/brands/moralt)

Moralt

(/products/door-blanks/brands/moralt)

Moralt

Halspan Door Blanks



(/products/door-blanks/brands/halspan)

Halspan Door

Blanks

(/products/door-blanks/brands/halspan)

Egger



(/products/door-blanks/brands/egger)

Egger

(/products/door-blanks/brands/egger)

Egger

21. Though two of the Exhibits (AW4 and AW5) are undated, and exhibit AW3 was obtained from a website after the relevant period, Exhibit AW1 features a copyright date of 2014 and the relevant article within Exhibit AW2 bears the date 2013. In my view, the evidence collectively shows that the internal structure, or “core”, is a primary factor in the makeup of a door as it dictates the purpose for which, and/or location where a door can be used.

22. With regards to how the goods are sold to consumers, there is limited evidence showing that internal structures of doors are marketed as “door cores”. There is one reference in Exhibit AW3 to a chip board door core:



Strebord FD30 Solid Chipboard Door Cores

SHOP NOW

The “SHOP NOW” logo gives the appearance that chipboard door cores are available for sale, however, the Opponent has not provided the page accessed via this link. A second reference to goods sold as “door cores” appears in Exhibit AW4

where the goods displayed are referred to as a “Severe Duty Door Core” and are described in the advertisement as “a three layer particle board, achieving severe duty under the classification standard BS EN 12400:2002.” Elsewhere in the evidence, the basic structure of a door is described as a “door blank” (Exhibit AW4) and Exhibit AW3 indicates that doors are not sold primarily by core type but by their style or purpose, for example, “internal doors; oak doors; glazed doors; laminate doors; French doors; fire doors; Victorian doors”. I am nevertheless alive to the fact that a mark does not actually need to be in use at the time of the application in order for it do fall foul of section 3(1)(c), and also that it is irrelevant that there may be more usual signs for designating the characteristics of the goods or services.

23. In framing the section 3(1)(c) ground, the Opponent has filed very brief comments in its statement of grounds and submissions in lieu of a hearing, only stating that “THE CORE OF THE DOOR” is clearly descriptive in relation to goods and services connected to doors. Section 3(1)(c) refers to marks which may serve in trade to designate a characteristic of the goods or services, the provision lists examples of such characteristics, these being 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. The Opponent does not define the characteristic, or characteristics, that it considers the trade mark to designate, however, the characteristics of kind, quality and intended purpose would appear to be relevant to the case the Opponent is making.

24. The Application covers a wide range of goods and services, the totality of which are opposed in these proceedings. In its submissions in lieu of a hearing, the Opponent states that the “term “door” is used sparingly in the Applicant’s specification and is effectively hidden by the surrounding text. Terms like “board”, “sheets” and “panel”, which afford similar cover, appear more frequently.” In the same submissions, the Opponent provides a list of what it calls “directly described” goods, which all include the word “door” in their description. I consider that beyond the goods in the Opponent’s “directly described” list, there is a wide variety of other goods which could be used in the manufacture of doors and services which could concern the manufacture of doors. In addition to these goods and services, there is

an array of goods and services which have no obvious connection to doors, and no connection is described by the Opponent, I consider these to be:

Class 17: Flexible pipes, tubes, hoses and fittings therefor (including valves), and fittings for rigid pipes, all non-metallic; Microporous synthetic sheets for the manufacture of protective clothing, protective work clothing, rainproof clothing, Microporous synthetic strips for the manufacture of protective clothing, Self lubricating cast nylon for use in manufacture, Synthetic fibres, other than for textile use, Viscose sheets, other than for wrapping and packaging, viscose sheets (semi-finished products), yarns made from ceramic fibres, other than for textile purposes; Finished or semi-finished products, adapted for a specific use, included in this class, namely Shock-absorbing and packaging materials, Vibration dampers, Coverings, Gaskets, Rubber suspensions, Membranes and semi-processed synthetic filtering materials, Clutch and brake linings, Tire restoration and repair materials, Anti-corrosion tape, Foam for flower arrangements; Glass tapes and strips, Marking tape, Rubber pouches, Protective articles of rubber, Protective asbestos screens, Rubber bands, Threads of plastic for soldering, Stoppers of plastics, Statues and works of art, Namely decorative badges of mica, Decorative articles [badges] made of rubber, Figurines made from rubber; Packing materials; Flexible pipes, tubes and hoses, not of metal; Parts and accessories for all the aforesaid goods, included in this class.

Class 19: Wall and ceiling lining elements of wood; Structures and transportable buildings, not of metal; Unprocessed and semi-processed materials included in the class, not specified for use, In particular pitch, Tar, Asphalt and bitumen, Stone, rock, clay and minerals; Statues and works of art made of materials such as stone, concrete and marble, included in the class; Rigid pipes, not of metal, for building; Asphalt; Pitch; Tar; Bitumen; Monuments, not of metal; Parts and accessories for all the aforesaid goods, included in this class.

Class 20: Bed bases; Countertops; Furniture and furnishings; Parts for furniture; Mouldings of wood being furniture parts; Parts of furniture, boxes and windows; Lath sheets and laminated sheets being furniture parts; All the aforesaid goods with or without surface treatment or surface finishing; Furniture parts; Sheets

(laminated sheets), mainly consisting of synthetic materials and bonded with other materials (including wood, aluminium foil, insulating materials) for furniture manufacturing; Furniture moldings; Goods, not of metal, namely mooring buoys, valves, fasteners, spindles, clamps, fans, clack valves, identification bracelets, moulds and shapers, pennant holders, dowels, protectors and support devices, spools, reinforcing materials, rings, rods, saw horses, mats for sinks, spacer rings, intermediate layers for vats, staircase fittings, spiral springs; Staple adaptors, staves, Posts and masts, Suction cups, overhead rail systems, Tags, Tension rollers, parts for tents, paper towel holders, Trays, Fastening materials, connecting parts and mounting brackets for cables or wires, Fastening materials, connecting parts and mounting brackets for pipes; Statues, figurines, works of art and ornaments and decorations, made of materials such as wood, wax, plaster or plastic, included in the class; Animal housing and beds; Unprocessed and semi-processed materials, included in this class and not adapted for any specific use, namely yellow amber, parts of animals, meerschaum, parts of plants; Containers, and closures and holders therefor, non-metallic; Ladders and movable steps, non-metallic; Displays, stands and signage, non-metallic; Mirrors (silvered glass); Picture frames; Containers, not of metal, for storage or transport; unworked or semi-worked bone, horn, whalebone or mother-of-pearl; Shells; Meerschaum; Yellow amber; Parts and accessories for all the aforesaid goods, included in this class.

Class 40: Food and beverage treatment; Preservation of food; Preservation of drink; Energy production; Recycling and waste treatment; Recycling of waste and trash; Printing, and photographic and cinematographic development; Printing; Duplication of audio and video recordings; Air and water conditioning and purification; Slaughtering; Rental of equipment for energy production; Rental of objects in connection with the providing of the aforesaid services, included in this class; Consultancy and information in relation to the aforesaid services, included in this class.

25. The above goods include items such as “flexible pipes, tubes, hoses and fittings therefore”; “Microporous synthetic sheets for the manufacture of protective clothing” and “clutch and brake linings” in Class 17; “Statues and works of art made of

materials such as stone, concrete and marble”; “rigid pipes, not of metal, for building”; and “Asphalt” in Class 19; “Bed bases”; “Furniture moldings”; “mooring buoys” in Class 20; and “Preservation of food”; “Printing”; and “Slaughtering” services in Class 40. I consider that these goods, and the others listed above have no obvious relationship to doors and the Opponent has provided no submissions to explain a relationship. With no relationship to doors, the “CORE OF THE DOOR” has no descriptive meaning and I find that the opposition fails in respect these goods and services.

26. The remaining goods and services are:

Class 17: Semi-finished goods (laminated plates), consisting mainly of synthetic materials and bonded with other materials (including wood, aluminium foil, insulating materials), including for vehicle construction; Acoustical insulation barrier panels, Special insulation sheets based on mineral fibres and wood fibres; Panels (composite panels), mainly of plastic bonded with other materials (including wood, aluminium foil, insulation materials), including for the construction of machines for insulation; Acoustical insulation barrier panels, Special insulation sheets based on mineral fibres and wood fibres; Coating material, decorative foils and moulded laminated material of plastic or made using plastic, Being semi-finished products; Insulating materials and fillers for materials of wood and furniture parts; Sheets and panels (composite panels), mainly of plastic, bonded with other materials (including wood, aluminium foils, insulating materials), including for insulation in vehicle construction; Acoustic boards, special insulating boards with a mineral fibre and wood fibre base; Door fittings, namely, Door seals, Insulating materials for doors, fillers for doors; Assembly accessories for doors, namely, Sealing compounds for joints, Caulks, Assembly foam; Seals, sealants and fillers; Insulation and barrier articles and materials; Unprocessed and semi-processed materials, not being designed for a specific use, included in this class, namely polyester, Mineral fibers, Semi-worked plastic substances, Elastomers, Cellulose, fibres impregnated with synthetic resins, Synthetic and composite materials, Namely carbon fibre, Cellulose acetates, fibreglass and glass wool, Cast nylon for use in manufacture, Chemical fibres not for textile use; Microporous synthetic sheets for use in manufacture; Resins in extruded form; Semi-worked

plastic substances; Finished or semi-finished products, adapted for a specific use, included in this class, namely moulds, Connections, Spacers, Adhesive films; Fixing film, Decorative plastics films being semi-finished products; Unprocessed and semi-processed rubber, gutta-percha, gum, asbestos, mica and substitutes for all these materials; Plastics and resins in extruded form for use in manufacturing processes; Sealing materials; Insulating materials; Parts and accessories for all the aforesaid goods, included in this class.

Class 19: Wood, Namely, Plywood, Veneering, Plywood boards, Blockboard, Sawn timber, Laths and laminated sheets and sawn timber; Mouldings, including curved, being semi-finished goods, Slabs, Prefabricated doors, all the aforesaid goods being of wood and wood particles or Fibres; Wood chips and Wood fibre materials; Chipboard; Wood fibre materials; Curved mouldings being semi-finished goods made of wood, chipboard and wood fibreboard; Wooden doors and windows, Woodwork, Door cases and Door leaves of wood; All the aforesaid goods with or without surface treatment or surface finishing; Doors, door skins, Door cases, Door frames and combinations of the aforesaid goods; All the aforesaid goods for the interior and exterior; Doors and wall elements relating thereto for fire protection; Functional door panels and functional door frames for various applications or with the properties of smoke protection, fireproofing, sound proofing, burglar resistance, protection against radiation, bullet resistance, moisture proofing, wet room proofing, with or without protection against electromechanical, climatic, chemical, biological, electromagnetic constraints; All the aforesaid goods, varnished or unvarnished, of wood, wood materials, plastic (including decorative foils and laminates), glass, metal, mineral and/or textile materials or of combinations of the aforesaid materials; Slabs and Panel-shaped materials; Rods, profiles, edges and elements of wood, wooden composites, paper and cardboard, minerals and plastics, for furniture manufacturing and interior decorating; Veneering; Panels and panel-shaped materials, mainly of wood and derived timber products, also in combination with paper, melamine resin paper, plastic and/or plastic foils, minerals and mineral or glass fibres and mineral or glass wood, in particular wood panels, hardboard, chipboard, laminated board, plywood and wood core plywood panels in worked and unworked form, unprocessed, coated, veneered and/or with thin chipboard or thin MDF covers;

Parts for manufacturing panels (composite panels), namely intermediate layers therefor; Sheets and panels (composite panels), consisting mainly of wood or wood materials, bonded with other materials (including aluminium foil, insulating materials), including for furniture manufacturing and vehicle construction; Sheets and panels (composite panels), consisting mainly of plastic, bonded with other materials (including aluminium foil, insulating materials), including for furniture manufacturing and vehicle construction, Not of metal; House door blanks, in processed and unprocessed form, mainly of wood and wood materials, including in combination with other materials, in particular polyurethane foam, insulating materials, metal and/or steel; Multilayer chipboard, including with a covering layer for protection against grinding dust; Building materials and building elements (non-metallic), in particular of wood and Materials of wood, Including in combination with paper and plastic foil, mineral materials and mineral or glass fibres and mineral or glass wool, in particular unprocessed, coated and veneered wood panels, hardboard, chipboard, laminated board, plywood panels and blockboard in processed and unprocessed form, window sills; Wood veneers; Sheets mainly of wood and wood-derived goods, including in combination with paper, melamine resin paper, synthetic materials and/or plastic foil, mineral substances and mineral and/or glass fibres and mineral and/or glass wool, in particular raw, coated and veneer wood sheets, hardboard panels, chipboard, laminate and plywood panels and wood core plywood in processed and unprocessed form and / or Timber boarding, Boards made of wood particles, Boards made of wood particles; Laminate and plywood panels and wood core plywood in processed and unprocessed form, covered with thin chip coverings or thin MDF coverings; Intermediate layers for the manufacturing of composite panels; Sheets (laminated sheets), mainly consisting of wood or wood-derived goods and bonded with other materials (including aluminium foil, insulating materials); Front door blanks in processed and unprocessed form, mainly of wood and wood-derived goods, including combined with other materials, in particular polyurethane foam, insulating materials, metal or steel; Doors, gates, windows and window coverings, not of metal; Unprocessed and semi-processed materials included in the class, not specified for use, Wood and artificial wood; Materials, not of metal, for building and construction; Parts and accessories for all the aforesaid goods, included in this class.

Class 20: Assembly accessories for doors, namely brackets, Spacers, Spacer wedges, Junction clips, Caps, All the aforesaid goods not of metal; Parts of door frames of wood; All the aforesaid goods with or without surface treatment or surface finishing; Panels and Sheet materials, Rails, profiles, Edges and elements of wood, Wood-derived goods, Paper and cardboard, Mineral substances and synthetic materials for manufacturing furniture and home decor products, In particular raw, coated and veneered planks of wood, Compressed sheets, Chip board, Laminate and plywood panels and wood core plywood in processed and unprocessed form and / or planks of wood, Compressed sheets, Chip board, Laminate and plywood panels; Sheets (laminated sheets), mainly consisting of wood or wood-derived goods and bonded with other materials (including aluminium foil, insulating materials) including for furniture manufacturing and vehicle construction; Sheets manufactured using wood or woody plant parts; Goods, not of metal, namely locks and keys, door, gate and window fittings, connectors and connections, handles and rails, joints, hooks and hangers; Parts and accessories for all the aforesaid goods, included in this class.

Class 40: Material processing, treatment and transformation, namely surface finishing, decorative coatings and decorative lamination, including with veneers, of construction materials, building materials, panels, panel materials, sheets, sheet materials, strips, rails, elements and furniture parts; Custom manufacture and assembly services; Rental of equipment for the treatment and transformation of materials, and for custom manufacturing; Rental of objects in connection with the providing of the aforesaid services, included in this class; Consultancy and information in relation to the aforesaid services, included in this class.

27. With only a very brief explanation of the descriptive meaning of “THE CORE OF THE DOOR,” applied to all goods and services under the mark, the task of assessing the descriptive nature of the verbal element is difficult.

28. Understanding the verbal element in the most literal sense of it referring to the middle part of the door, it is not clear to me that consumers would perceive it as describing a characteristic of the goods. The evidence has shown that the centre

part of a door is referred to as its core and that the form of this core is important for its function. "THE CORE OF THE DOOR" does not inform the consumer of what the core is (e.g. chipboard door core, severe duty door core), nor does it describe the nature of the door, which the evidence shows are sold by reference to their function, for example, fire door, exterior door.

29. The verbal element in the mark comprises five words, with the repeated definite article "THE" and rhyme between "CORE" and "DOOR". I consider this to be an unusual construction in relation to the goods, which are usually sold by reference to their function, or the material they are made from (chipboard, composite). I consider that the general public and the professional public, paying a moderate, or higher degree of attention would understand the verbal element as a play on words, suggesting that the goods are somehow related to doors, but that the average consumer would be unlikely to perceive a descriptive message.

30. Considering the verbal element with a more general understanding of the word "CORE" as referring to the essence or main part of something, I will consider the possibility that it may be understood as a promotional statement on any goods and services related to doors. Through this understanding, the mark could be seen as referring to the quality of the goods, with the implication being that the provider of the goods and services recognises its offering as the central, most important element of a door and so provides high quality goods and services.

31. Though the Opponent states that the words in the mark refer to the "most important part of something," the argument concerning the general understanding of "CORE" is not further developed in the Opponent's submissions. Within this construction, the repetition of the definite article "THE" and the rhyming words "CORE" and "DOOR" also have an impact. In my view, it takes a number of steps to see the mark as designating a quality of the goods and I consider it unlikely that the phrase would be understood as a descriptive in the sense of the goods and services relating to the most important part of the door. An assessment of the verbal element under section 3(1)(b) as a non-distinctive slogan (for reasons other than its descriptive nature) might have led to a different outcome under section 3(1)(b), however, this argument was not put forward by the Opponent.

32. Up to this point, I have considered the descriptive meaning of the phrase in the mark. I now turn to consider the double triangle device element, and the mark as a whole. I consider the device to be something more distinctive than the “simple geometric shape” as defined by the Opponent. The device is two triangles, one larger and in black and the second in white, half of which is overlaid on the black triangle. I agree with the Applicant’s submission that the device is “not related to doors or cores and so it does not reinforce the image of a door or a core”.

33. In its submissions in lieu of a hearing, the Opponent refers to the case of *SELENIUM-ACE*, T-312/03 where the figurative element in the mark was larger in size than the descriptive words and the General Court confirmed the Board of Appeal’s finding that:

“... where a trade mark is composed of verbal and figurative elements, the former should, in principle, be considered more distinctive than the latter, because the average consumer will more easily refer to the goods in question by quoting their name than by describing the figurative element of the trade mark.

[...]

it is reasonable to assume that the average consumer will perceive the verbal element as the trade mark and the figurative element as a decorative element.”

34. The Opponent also refers to the Ex Parte decision BLO/273/19 *RED JASMINE TEA*. In both cases referred to by the Opponent, the verbal element in the marks were deemed descriptive. The Opponent has not in my view made the case that the verbal element in the Applicant’s mark is descriptive, so it does not follow that the mark considered as a whole is descriptive.

35. As the Appointed Person confirmed in decision in *PutterScope*, I must stand back from the detailed breakdown of the mark and envisage how the entire trade mark would be understood by the public when applied to the goods and services of the specification. In my assessment, I have concluded that the verbal element in the mark would be unlikely to be seen as descriptive on the goods and services. The

device is a particular arrangement of two triangles, which has an impact in the mark due to its size, and has no descriptive meaning in respect of the goods and services (and none is described by the Opponent).

36. Considering the mark as a whole, I find that the average consumer would see the



mark as a trade mark indicating goods from a particular source.

Even if the verbal element in the mark were descriptive, I consider the device “personalises the sign in a manner which is apt to result in it being seen as a ‘fingerprint’ of the involvement of a particular economic undertaking.”⁷ The device element has no descriptive meaning in respect of the goods and has sufficient impact within the mark as a whole to mean that the mark does not fall foul of section 3(1)(c).

Outcome under section 3(1)(c)

37. The opposition under section 3(1)(c) fails. As the section 3(1)(b) objection was based on upon the claimed descriptive nature of the mark, the opposition under section 3(1)(b) also fails.

Section 3(1)(d)

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

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411,

⁷ FLYING SCOTSMAN.

paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

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

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

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

39. The enquiry is not whether the mark is descriptive of a characteristic of the services, although that could also apply to a mark which falls foul of section 3(1)(d). It is whether the mark (as opposed to the individual words) was customary in the current language of the UK or was customary in the bona fide and established practice of the trade in the UK (i.e. in the trade the subject of the opposed goods) at the date of application. Proving this requires the filing of evidence of fact supporting the claim. It cannot be proved by supposition. The opponent has not provided any evidence of the mark in use by third parties in the UK (or anywhere) prior to the

relevant date. There is no basis for a finding that the mark was customary in the current language or in the bona fide and established practices of the trade to designate the goods.

Outcome under section 3(1)(d)

40. The opposition under section 3(1)(d) fails

Outcome

41. The opposition fails and subject to any successful appeal, the application can proceed to registration.

Costs

42. The Applicant has defended the opposition and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016.

Considering the Opponent's statement of grounds and preparing a counterstatement	£300
Considering the Opponent's evidence	£500
Preparing submissions in lieu of attending the hearing	£400
TOTAL	£1,200

43. I order Halspan Limited to pay Moralt AG the sum of £1,200. This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th day of May 2023

Charlotte Champion

For the Registrar

Annex A

Class 17: Semi-finished goods (laminated plates), consisting mainly of synthetic materials and bonded with other materials (including wood, aluminium foil, insulating materials), including for vehicle construction; Acoustical insulation barrier panels, Special insulation sheets based on mineral fibres and wood fibres; Panels (composite panels), mainly of plastic bonded with other materials (including wood, aluminium foil, insulation materials), including for the construction of machines for insulation; Acoustical insulation barrier panels, Special insulation sheets based on mineral fibres and wood fibres; Coating material, decorative foils and moulded laminated material of plastic or made using plastic, Being semi-finished products; Insulating materials and fillers for materials of wood and furniture parts; Sheets and panels (composite panels), mainly of plastic, bonded with other materials (including wood, aluminium foils, insulating materials), including for insulation in vehicle construction; Acoustic boards, special insulating boards with a mineral fibre and wood fibre base; Door fittings, namely, Door seals, Insulating materials for doors, fillers for doors; Assembly accessories for doors, namely, Sealing compounds for joints, Caulks, Assembly foam; Flexible pipes, tubes, hoses and fittings therefor (including valves), and fittings for rigid pipes, all non-metallic; Seals, sealants and fillers; Insulation and barrier articles and materials; Unprocessed and semi-processed materials, not being designed for a specific use, included in this class, namely polyester, Mineral fibers, Semi-worked plastic substances, Elastomers, Cellulose, fibres impregnated with synthetic resins, Synthetic and composite materials, Namely carbon fibre, Cellulose acetates, fibreglass and glass wool, Cast nylon for use in manufacture, Chemical fibres not for textile use; Microporous synthetic sheets for the manufacture of protective clothing, protective work clothing, rainproof clothing, and for use in manufacture, Microporous synthetic strips for the manufacture of protective clothing, Self lubricating cast nylon for use in manufacture, Synthetic fibres, other than for textile use, Viscose sheets, other than for wrapping and packaging, viscose sheets (semi-finished products), yarns made from ceramic fibres, other than for textile purposes; Resins in extruded form; Semi-worked plastic substances; Finished or semi-finished products, adapted for a specific use, included in this class, namely moulds, Shock-absorbing and packaging materials, Vibration dampers, Coverings, Gaskets, Rubber suspensions, Connections, Spacers,

Membranes and semi-processed synthetic filtering materials, Adhesive films, Clutch and brake linings, Tire restoration and repair materials, Anti-corrosion tape, Foam for flower arrangements; Fixing film, Glass tapes and strips, Marking tape, Rubber pouches, Protective articles of rubber, Protective asbestos screens, Rubber bands, Threads of plastic for soldering, Stoppers of plastics, Statues and works of art, Namely decorative badges of mica, Decorative articles [badges] made of rubber, Figurines made from rubber, Decorative plastics films being semi-finished products; Unprocessed and semi-processed rubber, gutta-percha, gum, asbestos, mica and substitutes for all these materials; Plastics and resins in extruded form for use in manufacturing processes; Sealing materials; Packing materials; Insulating materials; Flexible pipes, tubes and hoses, not of metal; Parts and accessories for all the aforesaid goods, included in this class.

Class 19: Wall and ceiling lining elements of wood; Wood, Namely, Plywood, Veneering, Plywood boards, Blockboard, Sawn timber, Laths and laminated sheets and sawn timber; Mouldings, including curved, being semi-finished goods, Slabs, Prefabricated doors, all the aforesaid goods being of wood and wood particles or Fibres; Wood chips and Wood fibre materials; Chipboard; Wood fibre materials; Curved mouldings being semi-finished goods made of wood, chipboard and wood fibreboard; Wooden doors and windows, Woodwork, Door cases and Door leaves of wood; All the aforesaid goods with or without surface treatment or surface finishing; Doors, door skins, Door cases, Door frames and combinations of the aforesaid goods; All the aforesaid goods for the interior and exterior; Doors and wall elements relating thereto for fire protection; Functional door panels and functional door frames for various applications or with the properties of smoke protection, fireproofing, sound proofing, burglar resistance, protection against radiation, bullet resistance, moisture proofing, wet room proofing, with or without protection against electromechanical, climatic, chemical, biological, electromagnetic constraints; All the aforesaid goods, varnished or unvarnished, of wood, wood materials, plastic (including decorative foils and laminates), glass, metal, mineral and/or textile materials or of combinations of the aforesaid materials; Slabs and Panel-shaped materials; Rods, profiles, edges and elements of wood, wooden composites, paper and cardboard, minerals and plastics, for furniture manufacturing and interior decorating; Veneering; Panels and panel-shaped materials, mainly of wood and

derived timber products, also in combination with paper, melamine resin paper, plastic and/or plastic foils, minerals and mineral or glass fibres and mineral or glass wool, in particular wood panels, hardboard, chipboard, laminated board, plywood and wood core plywood panels in worked and unworked form, unprocessed, coated, veneered and/or with thin chipboard or thin MDF covers; Parts for manufacturing panels (composite panels), namely intermediate layers therefor; Sheets and panels (composite panels), consisting mainly of wood or wood materials, bonded with other materials (including aluminium foil, insulating materials), including for furniture manufacturing and vehicle construction; Sheets and panels (composite panels), consisting mainly of plastic, bonded with other materials (including aluminium foil, insulating materials), including for furniture manufacturing and vehicle construction, Not of metal; House door blanks, in processed and unprocessed form, mainly of wood and wood materials, including in combination with other materials, in particular polyurethane foam, insulating materials, metal and/or steel; Multilayer chipboard, including with a covering layer for protection against grinding dust; Building materials and building elements (non-metallic), in particular of wood and Materials of wood, Including in combination with paper and plastic foil, mineral materials and mineral or glass fibres and mineral or glass wool, in particular unprocessed, coated and veneered wood panels, hardboard, chipboard, laminated board, plywood panels and blockboard in processed and unprocessed form, window sills; Wood veneers; Sheets mainly of wood and wood-derived goods, including in combination with paper, melamine resin paper, synthetic materials and/or plastic foil, mineral substances and mineral and/or glass fibres and mineral and/or glass wool, in particular raw, coated and veneer wood sheets, hardboard panels, chipboard, laminate and plywood panels and wood core plywood in processed and unprocessed form and / or Timber boarding, Boards made of wood particles, Boards made of wood particles; Laminate and plywood panels and wood core plywood in processed and unprocessed form, covered with thin chip coverings or thin MDF coverings; Intermediate layers for the manufacturing of composite panels; Sheets (laminated sheets), mainly consisting of wood or wood-derived goods and bonded with other materials (including aluminium foil, insulating materials); Front door blanks in processed and unprocessed form, mainly of wood and wood-derived goods, including combined with other materials, in particular polyurethane foam, insulating materials, metal or steel; Doors, gates, windows and window coverings, not of metal; Structures and transportable buildings,

not of metal; Unprocessed and semi-processed materials included in the class, not specified for use, In particular pitch, Tar, Asphalt and bitumen, Stone, rock, clay and minerals, Wood and artificial wood; Statues and works of art made of materials such as stone, concrete and marble, included in the class; Materials, not of metal, for building and construction; Rigid pipes, not of metal, for building; Asphalt; Pitch; Tar; Bitumen; Monuments, not of metal; Parts and accessories for all the aforesaid goods, included in this class.

Class 20: Bed bases; Countertops; Assembly accessories for doors, namely brackets, Spacers, Spacer wedges, Junction clips, Caps, All the aforesaid goods not of metal; Furniture and furnishings; Parts for furniture; Mouldings of wood being furniture parts; Parts of furniture, boxes and windows and door frames of wood; Lath sheets and laminated sheets being furniture parts; All the aforesaid goods with or without surface treatment or surface finishing; Panels and Sheet materials, Rails, profiles, Edges and elements of wood, Wood-derived goods, Paper and cardboard, Mineral substances and synthetic materials for manufacturing furniture and home decor products, In particular raw, coated and veneered planks of wood, Compressed sheets, Chip board, Laminate and plywood panels and wood core plywood in processed and unprocessed form and / or planks of wood, Compressed sheets, Chip board, Laminate and plywood panels; Furniture parts; Sheets (laminated sheets), mainly consisting of wood or wood-derived goods and bonded with other materials (including aluminium foil, insulating materials) including for furniture manufacturing and vehicle construction; Sheets (laminated sheets), mainly consisting of synthetic materials and bonded with other materials (including wood, aluminium foil, insulating materials) for furniture manufacturing; Sheets manufactured using wood or woody plant parts or Furniture moldings; Goods, not of metal, namely mooring buoys, locks and keys, door, gate and window fittings, valves, fasteners, spindles, clamps, connectors and connections, fans, clack valves, handles and rails, joints, hooks and hangers, identification bracelets, moulds and shapers, pennant holders, dowels, protectors and support devices, spools, reinforcing materials, rings, rods, saw horses, mats for sinks, spacer rings, intermediate layers for vats, staircase fittings, spiral springs; Staple adaptors, staves, Posts and masts, Suction cups, overhead rail systems, Tags, Tension rollers, parts for tents, paper towel holders, Trays, Fastening materials, connecting parts and mounting brackets for cables or wires, Fastening

materials, connecting parts and mounting brackets for pipes; Statues, figurines, works of art and ornaments and decorations, made of materials such as wood, wax, plaster or plastic, included in the class; Animal housing and beds; Unprocessed and semi-processed materials, included in this class and not adapted for any specific use, namely yellow amber, parts of animals, meerschaum, parts of plants; Containers, and closures and holders therefor, non-metallic; Ladders and movable steps, non-metallic; Displays, stands and signage, non-metallic; Mirrors (silvered glass); Picture frames; Containers, not of metal, for storage or transport; unworked or semi-worked bone, horn, whalebone or mother-of-pearl; Shells; Meerschaum; Yellow amber; Parts and accessories for all the aforesaid goods, included in this class.

Class 40: Material processing, treatment and transformation, namely surface finishing, decorative coatings and decorative lamination, including with veneers, of construction materials, building materials, panels, panel materials, sheets, sheet materials, strips, rails, elements and furniture parts; Custom manufacture and assembly services; Food and beverage treatment; Preservation of food; Preservation of drink; Energy production; Recycling and waste treatment; Recycling of waste and trash; Printing, and photographic and cinematographic development; Printing; Duplication of audio and video recordings; Air and water conditioning and purification; Slaughtering; Rental of equipment for the treatment and transformation of materials, for energy production and for custom manufacturing; Rental of objects in connection with the providing of the aforesaid services, included in this class; Consultancy and information in relation to the aforesaid services, included in this class.