

O-121-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2502081
BY GRAFTON MERCHANTING GB LIMITED
TO REGISTER A SERIES OF TRADE MARKS IN CLASSES 2, 6, 7, 8, 17, 19,
35 & 39**

AND

**OPPOSITION THERETO (NO 98908) BY
NORTHERN TOOL & EQUIPMENT CO INC**

TRADE MARKS ACT 1994

In the matter of application 2502081 by Grafton Merchating GB Limited to register a series of trade marks in classes 2, 6, 7, 8, 17, 19, 35 & 39

and

opposition thereto (no 98908) by Northern Tool & Equipment Co Inc

The background and the pleadings

1) Grafton Merchating GB Limited (“Grafton”) filed its application for a series of six trade marks on 10 November 2008. The application was published in the Trade Marks Journal on 2 January 2009. The six trade marks, together with the goods and services for which registration is sought, are set out below:



Class 02: Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colourants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.

Class 06: Metal building products; tubes, pipes; fencing nails; window frames; locks, padlocks; garage doors; pipe fittings for plumbing; nails, screws.

Class 07: Power operated tools.

Class 08: Hand tools; contractors tools, namely spades, forks, trowels, hammers, saws, picks, pick axes.

Class 17: Thermal insulating materials.

Class 19: Non metallic building materials; cement, plasterboard; timber and timber products; sheet materials; rain water pipes, soil pipes; tiles, blocks; glass.

Class 35: The bringing together, for the benefit of others, of non-metallic building materials, metallic building materials, power tools, hand tools, paints, varnishes, lacquers, preparations used for the protection against corrosion, apparatus for lighting, heating, refrigerating, cooking, drying, ventilating, water supply and sanitary purposes, thermal insulating materials; enabling consumers to conveniently view and purchase such goods via retail outlets, via a printed catalogue or via the Internet.


Class 39: The packaging, storage and distribution of non-metallic building materials, metallic building materials, power tools, hand tools, paints, varnishes, lacquers, preparations used for the protection against corrosion, apparatus for lighting, heating, refrigerating, cooking, drying, ventilating, water supply and sanitary purposes, thermal insulating materials.

2) On 2 April 2009 Northern Tool & Equipment Co Inc (“NTE”) opposed the registration of Grafton’s application. It opposes only two of the six trade marks contained in the series, namely, those that contain the word NORTHERN. It opposes these marks in respect of all of the goods and services sought to be registered. The opposition is under sections 5(2)(b), 5(3) & 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Some of the earlier marks relied upon by NTE are subject to the requirement to prove that they have been used¹, others are not. The specifications of the earlier marks varies as do the goods/services relied upon under section 5(2)(b) and, also, the goods/services which are said to be identical/similar to Grafton’s goods/services. The table in the annex to this decision sets out the details of NTE’s earlier marks and the grounds and claims made in respect of them. For summary purposes, the earlier marks/signs are:

(a) UK registration 2218684 for the mark: NORTHERN;

(b) Community trade mark (“CTM”) registration 1739796 for the mark: NORTHERN;

(c) CTM registration 1740273 for the mark: NORTHERN;

(d) UK registration 2218687 for the mark: 

¹ The requirements relating to proof of use are contained in section 6A of the Act, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004.



(e) UK registration 2218674 for the marks:



(f) CTM registration 1739408 for the mark:



(g) CTM registration for the mark:



(h) CTM registration 6935613 for the mark: NORTHERN INDUSTRIAL

3) All of the marks except for G & H are subject to proof of use. All of the marks are relied upon under sections 5(2)(b) and 5(3) of the Act. Signs corresponding to marks A & E are relied upon under section 5(4)(a). All of the marks have dates of filing prior to that of Grafton's application and, therefore, they all qualify as earlier trade marks as defined by section 6 of the Act. Two of the marks (D & E) have, though, expired since NTE lodged its opposition – I will come back to this issue later. There was a suggestion at the hearing that mark F had also expired, but, the official records of the Office for Harmonization in the Internal Market (Trade Marks and Designs) show that the mark is registered, renewal having taken place in January of this year. Whilst the mark may have had an expired status at the time of the hearing and whilst it was renewed only subsequent to the hearing, the factual position is that it is a registered mark and can, therefore, be relied upon.

4) Grafton filed a counterstatement denying the grounds of opposition. Grafton asked NTE to provide proof of use in respect of its earlier marks and to its claims of reputation/goodwill. A key aspect of the defence is that Grafton considers the word NORTHERN in its mark to be non-distinctive because it is a word that refers merely to geographical location.

5) Both sides filed evidence. A hearing then took place at which Grafton were represented by Ms Claire Hutchinson of Grant Spencer LLP and NTE were represented by Mr Thomas Elias, of Counsel, instructed by HLBBshaw.

The evidence

NTE's evidence - witness statement of Rob White dated 3 December 2009

6) Mr White is a trade mark attorney at HLBBshaw, NTE's representatives in this matter. His evidence contains no real evidence of fact. It is merely submission. I do note one point from it, though, namely that in relation to NTE's claims of use, reputation and goodwill, the claim to have been using the respective signs since the 1980s is corrected. Whilst the signs have apparently been used by NTE in the US since the 1980s, use in the UK has only been made since around 2000 by Northern Tool & Equipment Company (UK) Limited ("NTE UK") with, it is stated, the consent of NTE.

RTE's evidence - witness statement of Nick Hodge dated 4 December 2009

7) Mr Hodge is NTE UK's managing director. He explains that his evidence comes from his own personal knowledge or from NTE UK's records. He also explains that he is authorized to speak on behalf of NTE UK and also NTE. He explains that NTE UK and NTE share common ownership with the same majority shareholder.

8) Much of Mr Hodge's evidence consists of catalogue extracts and other similar material said to show the various earlier marks in use. I do not intend to summarise all of this material here but will return to it when considering the proof of use requirements and when dealing with any other aspects of this decision where such evidence may be relevant. I do, though, note the following:

- That NTE UK was incorporated in September 1999 and has operated in the UK since January 2000.
- That NTE UK is a mail order company selling tools and equipment for the home, office and workplace for individuals and businesses. Mr Hodge says that NTE UK is one of the leading UK companies in this area. NTE UK distributed 2 million catalogues in 2008 alone and by the end of 2008 it had 200,000 mail order customers on its database.
- NTE UK also trades online (through www.northerntooluk.com) and through a retail office in Portsmouth.
- Mr Hodge states that NTE UK is known as *NORTHERN TOOL & EQUIPMENT LIMITED* or *NORTHERN TOOL & EQUIPMENT*, *NORTHERN TOOLS* or just *NORTHERN*. A reference is made to "survey evidence" which is included in Mr Hodge's evidence. I will come back to this "survey" later.

- NTE UK's turnover has climbed from just under £6.5 million in 2001 to over £9.5 million in 2008 (the figures are calculated August to July of each year). Advertising expenditure has fluctuated during the same period but it has always been either just below or just over £2 million per year. The turnover and expenditure figures are said to relate to NTE UK's "house marks" as per its various registrations and as per its uses in catalogues etc.
- I will detail the content of the catalogues etc. later, but I note that some use has been made in respect of "drywall care products and materials". This is highlighted by Mr Hodge because the words DRYWALL AND INSULATION appear in Grafton's marks.

Grafton's evidence – witness statement of Tony Newcombe dated 29 April 2010

9) Mr Newcombe is the Marketing Manager of Buildbase, a "trading brand" of Grafton. His evidence focuses on the word NORTHERN. He explains that Grafton chose to use this word purely as a geographical indicator. He highlights the other marks in the series which also contain geographical indicators (SOUTHERN & NATIONWIDE). He states:

"The focus of the business's activity is described by the terminology "Drywall and Insulation" with the prefixes being purely a customer geographical indication to the relevant sales and logistics operation."

10) Mr Newcombe states that the general public will be very familiar with the geographical term "northern". To support this he refers to four exhibits, the content of which appears to have been produced by Grafton's representatives, Grant Spencer LLP. The exhibits are, in summary:

Exhibit TN1: This consists of prints taken from the website of Companies House showing company names that start with the word northern (details of some starting with southern are also provided). Mr Newcombe has not counted them, nor have I. They number in the many hundreds if not thousands. Some of these companies have, though, been dissolved or removed from the Companies Register.

Exhibit TN2: This consists of a list of trade marks that contain the word NORTHERN. The list includes CTMs, UK marks and International marks which have designated the UK for protection. 480 marks are listed across all classes (not just those relevant to the dispute here). Some are no longer in force.

Exhibit TN3: This consists of various dictionary extracts for the word northern. I do not need to repeat them in full as it is fair to say that the common definition is of being in or situated in the North.

Exhibit TN4: This consists of prints of websites which use the word NORTHERN. They include: Northern Shakespeare Company (a map shows that they are located in the northern part of England), a northern England map, Northern Ballet School (based in Leeds), NMC Northern Music Co (based in West Yorkshire), The Northern Business Forum (based in the North East of England), Northern England Falconry Club, Northern Rail and the Northern Rail Cup which appears to be based in Northern England (I note, though, that the company refers to itself as “Northern” and “Northern Rail”), Northern Bank (based in Northern Ireland), Northern Constabulary (the most northerly police force in the UK), Northern College (near Barnsley), The Northern Ireland Office, Northern Drenay (part of NHS North East), The Northern Echo (a publication circulated in the North East and in North Yorkshire), Northern Stage (a theatre company in the North East of England), The Northern Way (an initiative run in the cities of the North of England), The Northern Scot (a Scottish newspaper) and the Royal Northern College of Music.

The proof of use provisions

11) As stated in paragraph 3, save for registrations G & H, the proof of use provisions apply to NTE’s earlier marks. The relevant legislation reads:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(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), (b) 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

...

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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...”

12) Section 100 is also relevant which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

13) It is clear from the evidence of Mr Hodge that it is not NTE that has used the marks but, instead, NTE UK. Taking this into account, it must be shown that NTE UK has genuinely used marks A-F with the consent (as per section 6A(3)(a) of the Act) of NTE in the UK (earlier marks A, D & E) or in the EC (earlier marks B, C & F) in the relevant period of 3 January 2004 to 2 January 2009.

14) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely: the judgments of the European Court of Justice (“ECJ”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). It is also worth noting the Court of Appeal’s (“COA”) judgment ([2006] F.S.R. 5) in the latter of these cases when it had to apply the guidance given by the ECJ. From these judgments the following points are of particular importance:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*La Mer* (COA), paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*La Mer* (COA), paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*La Mer* (COA), paragraph 44).

Use with consent?

15) I will firstly deal with the issue of whether the use by NTE UK is with the consent of NTE. Ms Hutchinson stated that no evidence of NTE having consented to the use of its marks by NTE UK had been supplied. She argued that the evidence of Mr Hodge that both companies shared common ownership with the same majority shareholder was not enough to make this point good. Whilst Mr White used the word "consent" in his witness statement, Ms Hutchinson argued that he is just a trade mark attorney and is not in a position to provide evidence as to whether there exists a consensual relationship. Mr Elias, on the other hand, felt that the evidence clearly set out the relationship between NTE and NTE UK and that Mr White had explained that NTE UK were using the marks with the consent of NTE. He also referred to some of the material in Mr Hodge's evidence. On paginated page 142 there is an advertisement for NTE UK which contains a welcome note from Don Katula (he is described as "founder" but

whether this is of NTE, NTE UK or both is not clear). The welcome note includes the text:

“We’ve been providing top quality products at low prices in the U.S. for 20 years, and we’ve opened for business here [in the UK] to give you the same great deals!”

16) In relation to consent (in relation to marketing of goods) the ECJ in *Makro Zelfbedieningsgroothandel CV and others v Diesel SpA* Case C-324/08 stated:

“35 In the light of the foregoing, the answer to the question referred is that Article 7(1) of Directive 89/104 must be interpreted as meaning that the consent of the proprietor of a trade mark to the marketing of goods bearing that mark carried out directly in the EEA by a third party who has no economic link to that proprietor may be implied, in so far as such consent is to be inferred from facts and circumstances prior to, simultaneous with or subsequent to the placing of the goods on the market in that area which, in the view of the national court, unequivocally demonstrate that the proprietor has renounced his exclusive rights.”

17) In view of the above, consent can be inferred from the facts and circumstances of a case. It is also clear that NTE need not have exercised any control over NTE UK’s use. In *Einstein* (BL O/068/07) Mr Geoffrey Hobbs QC (sitting as the Appointed Person) stated:

“39. In the present case, I hold that it was necessary for the Registrar to be satisfied that Hornby Street Limited used the trade mark **EINSTEIN** with the consent of the Proprietor in relation to ‘casual outer clothing for men in Class 25’ during the relevant 5 year period, but unnecessary (for the reasons I have given at length above) for the Registrar to be satisfied that the Proprietor effectively controlled Hornby Street Limited’s use. The evidence noted in paragraphs 4 and 19 above is weak, but sufficient in the absence of cross-examination or evidence to the contrary to prove the required consent. The relevant companies can, so far as the evidence goes, be regarded as ‘economically linked’ entities by reason of their common ownership and there was, according to the evidence, authorisation from the Proprietor sufficient to ensure non-infringement by Hornby Street Limited. I am therefore satisfied that this is not a case which tests the limits of the concept of consent from the point of view of Community law.”

18) The weak evidence referred to by Mr Hobbs in the *Einstein* case consisted of a statement that the use had been by a “sister” company with the permission of the proprietor and, also, further evidence in which it was stated that the user of the mark was connected to the proprietor in that the same shareholders owned

100% of both companies together with a positive statement that the use was with consent.

19) In the case before me there is no specific statement from Mr Hodge other than the claim to economic connection by way of the same person (who is not identified) being the majority shareholder in both NTE and NTE UK. There is no evidence from any person employed by NTE, but I note that Mr Hodge confirms that he is authorised to speak on behalf of NTE as well as his company NTE UK. I place no real weight on the reference to consent by Mr White – this is not simply because he is a trade mark attorney as opposed to an officer of NTE/NTE UK, but more to do with the fact that he is merely giving a commentary on what Mr Hodge has said and that, in his view, use with consent is demonstrated. As in the *Einstein* case the evidence is somewhat weak. However, it is still possible to infer consent based on all of the facts and circumstances. There has been no call for cross-examination or no counter evidence filed. I also have the advertising evidence referred to above from which it is clear that NTE UK is, in reality, the UK arm of NTE. It appears to be an extension of the US business but conducted under a UK company. Ms Hutchinson is, of course, correct in that that they are separate legal entities and the fact that they share the same name is not particularly significant per se. But taking the totality of the evidence into account, it is a reasonable and fair inference that NTE have consented to the use by NTE UK. **The use is with consent as per section 6A(3)(a) of the Act and may be relied upon.**

What use has been made of the registrations

20) The trade marks cannot be lumped together in terms of use. Use must be considered separately in relation to each one; in *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-234/06 P the ECJ stated:

“86 In any event, while it is possible, as a result of the provisions referred to in paragraphs 81 and 82 of the present judgment, to consider a registered trade mark as used where proof is provided of use of that mark in a slightly different form from that in which it was registered, it is not possible to extend, by means of proof of use, the protection enjoyed by a registered trade mark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation on the former.”

21) For the purpose of the assessment, I will go through the catalogues etc. to ascertain what marks have been used and in respect of what. When referring to pages numbers I am referring to the pagination added to the evidence. It should be borne in mind that the relevant period in which genuine use must be established is the five year period ending on the day on which Grafton's application was published i.e. 3 January 2004 to 2 January 2009.

Registrations A to C – use of the word NORTHERN

22) In terms of actual use of the word mark NORTHERN per se, this is extremely limited. There is an advertisement that featured in *The Journal* in September 2007. It is headed with a mark similar to mark G. Underneath this, in large print, are the words: “2006 NORTHERN ANNUAL CLEARANCE SALE”. There is also an extract from a catalogue that states “Northern Offers Next Day Delivery”, but this was published before the relevant period (in the year 2000) so does not assist. The only other uses that can be identified are in terms and conditions text, for example, there is a reference on page 60 under “warranties on merchandise” stating that “Products not manufactured by Northern are warranted by the manufacturer...”.

23) Although Mr Elias referred to the above examples at the hearing, his primary argument was focused on the use of the word NORTHERN as the dominant and distinctive element of the other forms of use set out in the evidence (as per NTE’s composite marks). However, being able to rely on the use of other registered marks to support the use of NORTHERN per se flies in the face of what the ECJ stated in *Il Ponte Finanziaria SpA*. Those uses which correspond to NTE’s other registered marks cannot, therefore, be relied upon. However, in case I am wrong on that, and also because some forms of use do not correspond exactly to the registered marks, I will still consider whether any alternate forms of use are acceptable. To that extent, I note that the relevant case-law focuses on the alteration of distinctive character. For example, the Court of Appeal dealt with what I will describe as the use of “variant marks”² in *Bud/Budweiser Budbrau* [2003] RPC 25. Of relevance are the statements of Lord Walker of Gestingthorpe where he stated:

“43. ...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry: ‘Bare ruin’d choirs, where late the sweet birds sang’ is effective whether or not the reader is familiar with Empson’s commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of ‘whose

² I use this expression simply as shorthand. An acceptable “variant mark” would be use of a mark in a form differing in elements but which does not alter the distinctive character of the mark from the form in which it was registered.

eyes? - registrar or ordinary consumer?' is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgement, to analyse the 'visual, aural and conceptual' qualities of a mark and make a 'global appreciation' of its likely impact on the average consumer, who: 'Normally perceives a mark as a whole and does not proceed to analyse its various details.' The quotations are from para [26] of the judgement of the Court of Justice in Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I- 3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance."

Also of relevance are the comments of Sir Martin Nourse; he stated at paragraph 12:

"Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements...."

24) I also take note of the comments of Mr Arnold QC (sitting as the Appointed Person) in *NIRVANA Trade Mark* (O/262/06) and in *REMUS trade mark* (O/061/08). In these cases Mr Arnold undertook a thorough analysis of the relevant case law, including judgments of the ECJ and the GC, and he then put forward the following questions, the answers to which will assist in determining whether a variant form of use represents an acceptable variant (the text is from *NIRVANA* but it is also adopted in *REMUS*):

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the subquestions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all...."

25) The above case-law deals with the section 46(2) concept of variant marks. This is equally applicable in the context of proof of use, bearing in mind the analogous provision set out in section 6A(4)(A) of the Act. In terms of variant marks, I also note that Ms Anna Carboni (sitting as the Appointed Person) in *Orient Express* (BL O/299/08) considered that the question as to whether an element of a composite mark was an independent and distinctive element was an unnecessary addition to the variant mark test – she stated:

“71. But I do not regard his comment about the words maintaining an “independent distinctive role” within the composite mark as being a necessary step in the process. It seems to me that, whether or not the word element of a composite mark has an “independent distinctive role” may be relevant to the question of whether section 46(2) needs to be considered at all, but it is superfluous to the test laid down in *BUD* or the guidance given in *NIRVANA* and *REMUS*.”

26) However, she added that such a question may have relevance on the basis that an independent and distinctive element could, depending on the facts, be use of that element *per se*. Ms Carboni stated:

“78. If there is a place for the concept of one trade mark having “an independent distinctive role” within another, this is where it belongs. The essence of the argument is that there are some “composite marks” in which one or more elements within them have an independent distinctive role and therefore that use of the composite mark should be considered use of the element within it as well. In the context of section 46, there would be no need to resort to sub-section 46(2) in such a case, as use of the composite mark would include use of the registered element *per se*.

79. The term “composite mark” in this context is perhaps misleading. Most people would not describe the repeated words BUD-BUDVAR-BUDWEISER as a composite mark, but would see them – as the Court of Appeal said – as separate marks presented adjacent to each other. Similarly, the CFI in Case T-29/04 *Castellblanch SA v OHIM* [2005] ECR II-5309 spoke of “joint affixing of separate marks or indications on the same product”, giving the example in the context of wine products of the name of the winery and the name of the product, and said that “joint use of those elements on the same bottle does not undermine the function of [one of them] as a means of identifying the products in issue”.

80. In *Nestlé*, the ECJ concluded that an inherently non-distinctive trade mark could acquire distinctive character through use under article 3(3) of the Directive, whether it was used (i) on its own, or (ii) “as part of a registered trade mark”, or (iii) “as part ... of a component of a registered trade mark”, or (iv) as “a separate mark in conjunction with a registered trade mark”. The only question of importance was whether, as a result of

the use in each case, the relevant class of persons actually perceive the relevant goods or services as originating from a given undertaking.


81. The underlying issue in that case was whether the use of HAVE A BREAK ...HAVE A KIT KAT could have resulted in the element HAVE A BREAK acquiring distinctive character. The question in a non-use context would be whether the use of HAVE A BREAK ... HAVE A KIT KAT would amount to use of the registered trade mark HAVE A BREAK for the purpose of defending a revocation action.

82. I would expect the answer to be that it could do so in theory, but subject to proof on the facts that consumers perceive HAVE A BREAK to be used as an indication of origin, irrespective of the appearance of the additional words. It would be for the proprietor to overcome the practical difficulties of proving this state of affairs. I do not see why the theory should be any different in the case of a logo that contains both words and graphical elements, though the practical difficulties would be at least as great.



83. This is a difficult area, and one which has already been discussed in some detail by Richard Arnold QC in *REMUS*. Luckily, I do not need to take the argument any further in this case because it is too far from a situation where the submission could be made good on the facts. It is clear from my analysis in paragraph 74 above that I do not agree with the proprietor's contention that the words ORIENT EXPRESS would be perceived as being used independently within the Logo. Additional evidence might have persuaded me of that, but none was available. The Hearing Officer was thus right to treat the case as one to which section 46(2) applied, and I have already made my decision in relation to that.

27) In terms of the various marks shown in the catalogues etc. that contain the word NORTHERN as an element, these include:

i) Use of a domain name e.g. "Place your catalogue order online at www.NorthernToolUK.com" or just "NorthernToolUK.com" on its own in contact details/bottom of catalogue pages;

ii) Use of: . Some uses have the ® symbol next to the word NORTHERN (see, for example, page 47 of Mr Hodge's evidence);

iii) Use of: ;

- iv) Use of:  Again, I note that in some cases NORTHERN is followed by the ® symbol (see, for example, page 35 of Mr Hodge's evidence);
- v) Use of:  logo as per pages 52, 60 and 88 of Mr Hodge's evidence.

28) In terms of the variant mark test (as set out by Mr Arnold QC), the differences between the word NORTHERN and the various signs above are plain to see. In terms of distinctive character, the distinctiveness of the mark as registered resides in the word itself. For reasons that I will come on to later, the word has, from an inherent point of view, a weak degree of distinctive character. In my view, the forms of use in ii-v above have a significantly greater degree of distinctiveness than that possessed by the word alone. Even if the word NORTHERN is the dominant and distinctive element of the marks as used, the word does not dominate the marks to the extent that the other elements are reduced to insignificance (as per Sir Martin Nourse's comments in *Bud*). The form of use in i) above is of a domain name. Setting aside questions as to whether a domain name used in marketing material has the capacity to be considered as genuine use of a trade mark, the use itself still alters the distinctive character of the word NORTHERN alone. It gives the mark as a whole a different concept. **In my view, none of the used marks can be relied upon as an acceptable variant of the word mark NORTHERN.**

29) In terms of whether the use of the word NORTHERN in the composite uses represents, effectively, use of an individual mark, the uses in i), iii) & v) are so inextricably linked to the overall context and/or presentation of the mark as a whole that I do not consider the argument to have merit here. There is, at the least, a greater argument in relation to marks ii) & iv). That being said, Ms Hutchinson argued that the words still form part of the fabric of the mark as opposed to being a self-standing trade mark. Mr Elias did little to depart from his dominant distinctive element argument. In relation to mark ii), it strikes me that whilst the word NORTHERN is to the right of the device element, it is also presented above other words, those words spread in such a way so as to fit exactly underneath it. The overall presentation brings to mind a single trade mark as opposed to the word NORTHERN as a separate trade mark. The same applies to mark v). Although in some forms of use a ® symbol is used alongside the word NORTHERN, this does not separate that element off as an individual trade mark from the other elements. The symbol would instead be taken as an indication of registration against the mark as a whole – this is the factual position in any event. Whilst it could be argued that the unifying feature of the marks is the word NORTHERN, neither form of use is accompanied to any material extent

by any outward facing indication to the public that NORTHERN is a trade mark per se. The use is of a number of different device and word marks.

30) I referred earlier to a “survey”. I hesitate to use the word “survey” as it has no statistically relevant basis. The questionnaire used is also as leading as it comes. Mr Elias did not attempt to rely on it as a survey per se, but more as simply evidence from the trade. Four witness statements are provided from people in the trade, Mr Slawson, Mr Hamilton, Mr White and Mr Riches. They were all sent a questionnaire and after answering the questions, a witness statement was produced on their behalf. It is not clear whether further questionnaires were sent out. Many more may have been issued but the results may have been unfavourable and so ignored. I simply do not know. That being said, even for the witness statements provided, I note that despite a list of all the trade marks relied upon in the pleadings being depicted and a question asked as to whether any of the marks were recognised as the trade marks of a particular company, not a single witness indicated that the word NORTHERN per se was a trade mark so recognised. Furthermore, even when the witnesses were asked how they would refer to the company or by what name the company is known only one of the four answered with NORTHERN. The other answers were NORTHERN TOOLS or NORTHERN TOOLS & EQUIPMENT. Taking all this into account there is little to support the proposition that the uses have resulted in NORTHERN per se being perceived as a trade mark. **I do not consider that the use of the word NORTHERN as part of the composite uses constitutes use of the trade mark NORTHERN per se.**

31) In terms of the use of the word NORTHERN alone, the use in terms and conditions text is not, in my view, of such a nature so as to have created or maintained a share of the market under that mark. This is not genuine use. The only other evidence is from the catalogue which included the text “2006 NORTHERN ANNUAL CLEARANCE SALE”. This strikes me as simply a convenient short-hand for the mark (of the retailer) depicted on the same page and this one instance of use within the relevant five year period cannot be said to constitute genuine use which creates or preserves a market share under the word NORTHERN alone. It is not, therefore, being used in a way that would constitute genuine use. This is particularly so when taken against the weight of all the other evidence which stays away from using NORTHERN on its own.

32) In conclusion, my finding is that NTE has not shown genuine use of trade marks A-C (consisting of the word NORTHERN on its own). The consequence of this is that these marks cannot be relied upon in relation to the grounds of opposition under sections 5(2) and 5(3) of the Act, the use conditions set out in section 6A(3) not having been met.

33) I will begin by going through the catalogues etc. in order to identify where the mark has been used and in relation to what. I have identified the following:

Page 32 – a catalogue page under the category “metal fabrication & pipe tools” where the mark is used in respect of the following goods: pipe benders, pipe threaders, parts benders. Other products on the same page are either presented alongside third party brands or have no branding at all. Further examples of use in connection with these types of goods can be seen on page 39 where the mark is also used in respect of a threading set.

Page 33 – a catalogue page under the category “wagons” where the mark is used in respect of a number of wagons for carrying loads. Such wagons are trolley type wagons for carrying loads. One other wagon on this page is presented alongside a third party brand. Similar use of the mark in connection with these goods is also shown on page 42.

Page 37 – a catalogue page under the category “sandblasting” where the mark is used in respect of a sandblaster and a sandblasting cabinet. There are other sandblasters, cabinets and sandblasting apparatus on this page which are unbranded.

Page 38 – a catalogue page under the category “hand tools” where the mark is used in respect of pipe wrenches, pliers, riveters, magnetic pick-up tools and a tool tray, calipers, pincers, pliers, snips, cutters and a bar set. Some unbranded products also appear on this page.

Page 63 – a catalogue page under the category “automotive” where the mark is used in respect of grease guns, an oil draining cart, a drum pump, a gear puller set, a car body repair set, a rotary hand pump and various other pumps. Two other products on this page are unbranded.

Page 66 – a catalogue page under the category “ground care” where the mark is used in respect of a pruning saw and foliage clears. Most of the other products on this page are third party branded, another is unbranded.

Page 69 – a catalogue page under the category “ac winches & hoists” where the mark is used in respect of an electric hoist. Other products have third party brands, three are unbranded.

Page 143 – use of the mark in relation to an hydraulic riveter. Other goods on this page are either unbranded or third party branded.

Page 145 – use of the mark in respect of a sandblaster, a pallet jack, an atv/motorcycle lift and an air impact wrench.

Page 146 – a catalogue page under the category “hoists” where the mark is used in respect of load binders, a chain hoist, a cable hoist/puller, a lever chain hoist, a pulley hoist, an electric hoist and an adjustable trolley (that fits on to beams).

Page 149 – a catalogue page under the category “automotive” where the mark is used in respect of a power pack, a battery booster and a battery booster with a light and compressor. Other products on this page are either unbranded or third party branded.

Page 152 – Further use in the sandblasting category as per page 37.

Page 155 – Further use in relations to wagons (as per page 33), but also a mower trailer and a trailer barrow.

34) In relation to the above uses, there is no issue concerning the form of the mark used. It matches the form as registered. In terms of whether the use constitutes genuine use, it must be observed that the turnover figures provided by Mr Hodge relate to the business as a whole under its various marks. From the context of the evidence it is reasonably clear that the business is primarily that of a retailer. No separate figures are provided in relation to the volume of sales of any particular goods which are branded with NTE’s mark(s). Nevertheless, it does not appear to be the case that the goods sold (or at least offered for sale) have been one-offs. The use is certainly not one that can be described as token use merely to preserve the registration. It is genuine in that sense. In terms of being warranted in the economic sector concerned, it must be borne in mind that mark D is a UK registration and mark F is a CTM registration. The use must be warranted in the UK and the EU respectively. Mr Elias argued that there was no real distinction between the UK and CTM marks - in his skeleton argument it was stated:

“Use in the UK is uncontentious. In relation to use in the Community, use in one country is sufficient (*ILG Ltd v Crunch Fitness International Inc* [2008] ETMR 17, a decision of OHIM Fourth Board of Appeal, at [11]). This is supported by the decision of the ECJ in *Pago International v Tirol Milch* (Case C-301/07) in respect of the requirement for establishing a “reputation in the Community” (see [27]-[30]).”

35) Ms Hutchinson did not argue to the contrary. However, despite the cases referred to by Mr Elias, there must still be some doubt given that there has never been a ruling from a court of binding precedent on the exact issue itself. A relevant judgment may come later this year because I am aware that a set of questions relevant to this issue have been referred to the ECJ by the Dutch Court

of Appeal in *One!*. Rather than suspend this case to await the outcome of that reference, I will proceed on the basis that if the use presented is sufficient for the purposes of genuine use in the UK then it will also be sufficient in the context of the EC. If though, in the final scheme of my decision, NTE succeeds solely on the basis of the CTM for which genuine use is an issue, I will suspend the implementation of my decision to await the guidance from the ECJ.

36) In terms of genuine use, despite the problems outlined in paragraph 34, the consistent use of the mark in question on a range of products is enough to establish genuine use. The test is not a quantitative one but a qualitative one. **The mark(s) have been genuinely used in the relevant period.**

37) In his evidence, Mr Hodge provided a table (page 139 of his evidence) highlighting the various marks used and highlighting the goods/services for which he considered them to have been used, identifying the pages of his exhibits which justify the various goods/services. The claims in relation to marks D & F relate to the broad terms “machines and machine tools”, “power tools” and “hand tools”. His commentary in relation to the specific exhibits he refers to provides various statements as to what goods the mark(s) are being used on. Whilst all of this is noted, it is considered that the claims are too ambitious. For example, Mr Hodge states that Exhibit NH6 shows use in relation to “machines and machine tools, power tools, hand tools and pipes and tubes of metal” but the exhibit itself simply relates to metal fabrication and pipe tools and wagons. I will, therefore, work on the basis of the goods for which I have found use as per paragraph 33 above. The mark in question appears to be the one that NTE UK uses most often on the goods that it brands. There is a question as to whether unbranded goods depicted in the catalogues can be taken as use in relation to its retailing mark(s) (a question I will return to) but in relation to this mark I do not see this as an issue. I should add that on the various pages where this mark is used, the page also contains other unbranded goods. I do not consider that use of the mark on certain goods on a page can be extended to those which are unbranded. NTE UK has gone to the trouble of marking which products are sold under this sign so it would be counterintuitive to consider that it must also be regarded as use in relation to those goods which do not carry the mark. The mark has been used in the following categories (I use NTE UK’s categorization from its catalogues) in relation to the following goods:

- Metal fabrication and pipe tools – hydraulic pipe bender, electric pipe threaders, pipe threading sets, parts benders, electric threaders.
- Wagons – various wagons, lawn barrow, trailer barrow, utility wagon/trailer.
- Sandblasting – a sandblaster and a sandblasting cabinet.

- Hand tools – pipe wrenches, pliers, riveters, magnetic pick-up tools and tool tray, calipers, pincers, pliers, snips, cutters, bar set.
- Automotive – grease guns, an oil draining cart, a drum pump, a gear puller set, a car body repair set, a rotary hand pump and various other pumps, a power pack, a battery booster and a battery booster with a light and compressor.
- Ground care – a pruning saw and foliage clears.
- Ac winches & hoists - electric hoists.
- No category – a hydraulic riveter, a pallet jack, an ATV/motorcycle lift and an air impact wrench.
- Hoists – load binders, a chain hoist, a cable hoist/puller, a lever chain hoist, a pulley hoist, an electric hoist and adjustable trolley (that fits on to beams).

38) It is necessary to decide upon a fair description for the goods for which genuine use has been shown and which falls within the parameters of the specification. The description must not be over pernickety³. It is necessary to consider how the relevant public (which for these goods would be both DIYers and members of the various trades) are likely to describe the goods⁴. The GC in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* held:

“43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the

³ See *Animal Trade Mark* [2004] FSR 19.

⁴ See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32.

goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

I also note the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed

in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

39) I set out below the goods for which mark F is registered⁵. I have also struck-through those goods for which no use has been shown:

Class 07: Machines and machine-tools; ~~motors, engines and gear boxes (except for land vehicles); machine coupling and transmission components (except for land vehicles); pressure washers; water pumps; air compressors; air brushes; cement mixers; chainsaws; vacuum cleaners; winches; winching machines; shredder machines; chipper machines; power and air hammers; pumps; gears (other than for land vehicles); lawnmowers; wind turbines; log splitters; agricultural and landscape equipment; sandblasting tools; sanders; screwdrivers; welders; metal fabrication equipment; metal presses; metal benders; shears; lathes; oil filters; oil drain systems; riveters; tile cutters; edgers; trimmers; spray guns; spreaders; rollers; cultivators; lawn sweepers; lawn aerators; tillers; chainsaws; valves; power tools; air tools; electric hand drills; drill bits; drill bit sets; sharpening machines; meat grinders; lifting apparatus; ratchets; and parts and fittings for all of the aforesaid.~~

Class 08: Hand tools and implements (hand-operated); wrenches; ~~hammers; jacks; riveters; screwdrivers; tile cutters; lathes; socket sets; pliers; vises; vise grips; grinding wheels; blade sharpening instruments; blades; drills; chisels; saws; hand-operated cement mixers; clamps; cutlery; side arms; razors; and parts and fittings for all of the aforesaid.~~

Class 12: ~~Vehicle accessories; motors and engines for land vehicles; gear boxes; tyres; go-karts; accessories for go-karts; motor cycles; seats for vehicles; steering wheel spinners for vehicles; carts; pedal cars; covers for boats and cars; towing accessories; trolleys; trailers; and parts and fittings of all the aforesaid.~~

40) Once the struck-through terms are removed, this leaves (including broad terms that could be said to encompass some of the used goods):

Class 07: Machines and machine-tools; water pumps; winches; winching machines; pumps; agricultural and landscape equipment; sandblasting tools; metal fabrication equipment; metal benders; oil drain systems; riveters; power tools; air tools; lifting apparatus; and parts and fittings for all of the aforesaid.

Class 08: Hand tools and implements (hand-operated); wrenches; riveters; pliers; saws; and parts and fittings for all of the aforesaid.

Class 12: Carts; trolleys; trailers; and parts and fittings of all the aforesaid.

41) In terms of the goods on which I have found use and which could fall in class 7, these are limited to: metal fabrication and pipe tools such as pipe benders and pipe threaders, parts benders and electric threaders; sandblasting tools; some of

⁵ Mark F has a slightly wider specification than mark D – it additionally includes “machines” and “pressure washers” in class 7.

the automotive tools which could be powered rather than hand operated; the electric pruning saw; the winches and hoists; other powered tools such as riveters, jacks and lifts; pumps which could be used for pumping water out of barrels; oil drainage systems. Most of these items are specifically listed in the reduced class 7 specification and can, therefore, be retained. In terms of the broad terms, I do not consider the nature of the products offered under the mark to be capable of proper sub-categorisation as “machines and machine tools”. This term covers such a wide range of goods and, in any event, the goods sold fall within their own individual sub-categories (as per the catalogue categories). This term may not be retained. In terms of “agricultural and landscape equipment”, the only relevant term that falls within its ambit is the powered pruning saw. For such a limited form of use, against such a breadth of protection offered by that broad term, I do not consider it appropriate for retention. In terms of “metal fabrication equipment” whilst this category is wider than the use shown, it is not an overly broad sub-category for the type of use demonstrated - this may be retained. Power tools and air tools are broad terms but a number of types have been shown in use (including the powered saw which is not specifically listed individually in class 7 in the specification) – I consider it appropriate that these terms may be retained. “Lifting apparatus” is also a broad term but this seems a reasonable sub-category for the various hoists and winches shown in the evidence.

42) In relation to class 8, the only broad term is “hand tools and implements”. A variety have been shown in the evidence and it is a recognisable sub-category of goods. The other items are specifically listed and have been shown in the evidence.

43) In relation to class 12, various wagons (as described earlier), trailers etc. have been shown. I believe the three terms retained above to constitute a fair description of the use shown. Whilst I note that in Mr Hodge’s table he does not refer to class 12, I do not take this as an admission of non-use. It is the job of the tribunal to decide upon a fair specification for the use shown and class 12 goods have been demonstrated in the evidence.

44) In relation to all three classes, the various parts and fittings may also be retained as even though there is no specific evidence that parts and fittings have been offered, it is reasonable and fair for them to be retained in the specification. The final specification for which this earlier mark(s)⁶ may be considered in the proceedings is:

Class 07: Water pumps; winches; winching machines; pumps; sandblasting tools; metal fabrication equipment; metal benders; oil drain systems; riveters; power tools; air tools; lifting apparatus; and parts and fittings for all of the aforesaid.

⁶ This applies to both marks D & F because the additional terms in mark F cannot be relied upon, therefore, the final specifications which may be relied upon are the same.

Class 08: Hand tools and implements (hand-operated); wrenches; riveters; pliers; saws; and parts and fittings for all of the aforesaid.

Class 12: Carts; trolleys; trailers; and parts and fittings of all the aforesaid.



Registration E – use of the trade marks

45) As with the previous registration, I will begin by going through the evidence to identify where the marks have been used and in relation to what goods/services. I will not at this point differentiate between the two different marks in the series, but will come back to any differences between them and the use shown if necessary.

Page 32 – at the bottom of the catalogue page (so not in relation to particular goods) a mark similar to the above is used but the background to the N device is all black and the words in the bottom section read “Tool & Equipment Co (UK) Ltd.”. This also appears at the bottom of pages 37, 38, 39, 45, 66 & 69;

Page 35 – at the top of “master catalogue 133” there is a mark similar to the mark in question but with “(UK) Ltd.” added to the bottom section. The same mark appears on page 36. The products listed on these two pages are third party brands or are unbranded (the unbranded goods are a night camera, a work-stand and a heavy load truck). The mark also appears on the front cover of catalogue 131 (page 41) where some third party branded and some unbranded products appear (the unbranded goods are an air impact wrench and a space heater);

Page 44 – use of the mark on the front cover of catalogue 140 but, again, with “(UK) Ltd.” added. The same mark is also used as a brand in relation to a generator shown on the front cover. Other, what appear to be third party brands, are shown in relation to other products. It is unclear if one product (a spotlight) is third party branded or non branded;

Page 77 – the mark with “(UK) Ltd” appears in a photograph in a newspaper called *The News*. The article appeared in July 2004. The article relates to an open day run by “Northern Tool & Equipment”, the article later refers to this entity as “Northern Tool”;

Page 90 – Whilst it is difficult to see, this appears to be the mark with “(UK) Ltd” added on a generator on a table at a trade stand;

Pages 94-97 – a photograph of a trade stall at an outdoor show with the mark with “(UK) Ltd” added on banners etc;

Page 107 – use of the mark in the heading of a webpage (again with “(UK) Ltd” added). The page was printed on 29/10/2009. The featured product is a pump but it contains a third party brand;

Page 141 – use of the mark (albeit slightly different colouring and with “(UK) Ltd” added) on the front page of a catalogue. Then on page 142 use of the mark with the same colouring as registered, but still with “(UK) Ltd” added;

Page 143 – use of the mark with “(UK) Ltd” added on the top page of a catalogue. The products listed are either unbranded (parts bender, patio heaters) or have third party branding, or are branded with registrations D & F;

Page 145 - use of the mark (albeit slightly different colouring and with “(UK) Ltd” added) on the front page of a catalogue;

Page 148 - use of the mark (albeit slightly different colouring and with “(UK) Ltd” added) on the front page of a catalogue;

Page 151 – use of the mark with “(UK) Ltd” added on the top page of a catalogue. The products shown are unbranded (a warehouse fan, a garden roller, a workshop crane, a ladder and a magnet that fits to a forklift truck).

Page 154 – use of the mark with “(UK) Ltd” added on the top page of a catalogue. The products shown are unbranded (a hydraulic press) or third party branded (a lawn mower, a heater and a water pump);

46) One of the key aspects of the proof of use assessment in relation to these earlier marks is whether they are used purely as a retailing mark or whether it is use in relation to goods. The significance of this stems from the fact that the mark itself is not registered for any retailing service but only for various goods. In relation to goods, the only product on which the mark has been directly branded is a generator. However, generators do not appear in the registration’s specification nor would such a product fall within any of the broad terms in the class 7 specification. The argument on behalf of NTE is that the use of the mark on catalogue pages where those pages contain unbranded products means that the use would be taken as trade mark use in relation to those unbranded products. Whether this is a true reflection of the position is a factual one based on the evidence. The evidence in these proceedings shows that NTE UK sells some products that are third party branded, some products that are branded with its own brand (see the assessment made in relation to marks D & F and also the

use made of the Northern Industrial Tools circular logo) and some products on which no brand is displayed.

47) Whilst it may be a reasonable inference to draw that unbranded products will be taken as those of the retailer if all of the products in a catalogue are unbranded, this is not the factual position in these proceedings. In the case before me NTE UK has gone to the trouble of highlighting in its catalogues that certain of the products being retailed are its own products. Other products (a good proportion of them) are marked with third party brands. In view of this, there is doubt as to whether the unbranded goods will be taken to be those of NTE UK. The perception of such use is certainly not clear. It may be that the goods supplied are those of NTE UK or they may be those of other manufactures. I simply do not know. This is the doubt that remains and will remain with those who encounter the catalogues etc. The claim that the unbranded goods will be perceived as the goods of NTE UK is, therefore, conjecture. It is not a safe inference that can be drawn. The evidence also contains invoices and catalogue pages that correspond to the goods invoiced. However, where the mark under discussion here is depicted (page 66 & 69) the invoiced goods are included within a box on the catalogue page containing marks D/F. Such use will be taken as use of mark D/F and not the mark under discussion. For all these reasons, I do not consider that the use can be taken as use in relation to the goods. It is, in my view, purely retailing use. That means, at the very most, this earlier mark has only been used in relation to one product, generators in class 7. Given that generators are not covered by the specification then such use cannot assist. **My finding is that NTE has not shown genuine use of trade mark E in respect of any of the goods for which it is registered. The consequence of this is that this mark cannot be relied upon in relation to the grounds of opposition under sections 5(2) and 5(3) of the Act, the use conditions set out in section 6A(3) not having been met.**

Section 5(2)(b) of the Act

48) This section reads:

“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.”

49) In reaching my decision I have taken into account the guidance provided by the ECJ in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). As these proceedings involve composite marks, is it is useful to highlight the latter of the above cases where the ECJ stated:

“41. It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42. As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

This principle has been highlighted in numerous judgments since then⁷.

⁷ See, for example, *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-498/07 P (paragraphs 59-62).

50) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods/services are similar, other factors are relevant including:

The nature of the average consumer of the goods/services in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of "imperfect recollection";

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc.*).

Summary of earlier marks

51) In view of my earlier findings, the only marks upon which NTE may rely are:

Marks D & F⁸:  in respect of:

Class 07: Water pumps; winches; winching machines; pumps; sandblasting tools; metal fabrication equipment; metal benders; oil drain systems; riveters; power tools; air tools; lifting apparatus; and parts and fittings for all of the aforesaid.

Class 08: Hand tools and implements (hand-operated); wrenches; riveters; pliers; saws; and parts and fittings for all of the aforesaid.

⁸ Class 12 is not listed because NTE relies only on classes 7 & 8 under section 5(2)(b).

Mark G  **NORTHERN**
TOOL + EQUIPMENT in respect of:

Class 07: Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.

Class 08: Hand tools and implements (hand-operated); cutlery; side arms; razors.

Class 35: Advertising; business management; business administration; office functions; retail store services, on-line retail services, mail order catalog services and telephone shop at home services, all featuring hand tools; electric power tools; air-powered tools; machinery; hydraulic pumps and parts and accessories therefor; hydraulic presses and parts and accessories therefor; gas engines and generators and parts and accessories therefor; diesel engines and generators and parts and accessories therefor; electric motors and parts and accessories therefor; air compressors and parts and accessories therefor; inverters; wind turbines; log splitters, log wedges and parts and accessories therefor; logging equipment and parts and accessories therefor; agricultural and landscape equipment and parts and accessories therefor; construction equipment and parts and accessories therefor; skid-steer loaders and parts and accessories therefor; forklifts and parts and accessories therefor; electrical equipment and parts and accessories therefor; solar lights and panels; material handling equipment and products and parts and accessories therefor; fuel transfer equipment and parts and accessories therefor; lubrication equipment and parts and accessories therefor; kerosene, propane and electric heaters; chainsaws; pet and pest control products; lawn and garden products; work clothing; gloves; tarpaulins; garages, canopies, shelters and sheds; air compressors, parts and accessories; parts washers; sandblasting tools and accessories; welders and welding parts and accessories therefor; industrial, commercial and industrial lighting products; metal fabrication equipment and parts and accessories therefor; painting products; propane products; outdoor, camping, hunting and recreational products and clothing products therefor; two-way radios; go-karts and parts and accessories therefor; all terrain vehicle and recreational vehicle products, parts and accessories therefor; automotive products, parts and accessories therefor; water pumps and parts and accessories therefor; pressure washers, and parts and accessories therefor; tires, maintenance and testing equipment; trailers, and parts and accessories therefor; food processing equipment and parts and accessories therefor; towing accessories; cleaning supplies; motor oil; storage products; duffel bags, utility bags and tool and equipment holders and holsters; gauges; winches; vehicle lifts; casters; straps, tie-downs and tow straps.

Mark H⁹: **NORTHERN INDUSTRIAL** in respect of:

Class 07: Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.

Class 08: Hand tools and implements (hand-operated); cutlery; side arms; razors.

52) For reasons that will become apparent later, I will make my assessments in respect of marks G & H.

⁹ Class 11 is not listed because NTE do not rely on this class under section 5(2)(b).

Comparison of goods

53) Given the pleaded case under section 5(2) in terms of goods/services similarity, and given that the proof of use assessment has resulted in marks A, B, C & E no longer being relevant, the net result is that I only need to consider goods/services similarity in respect of classes 7, 8 & 35 of the applied for mark. All relevant factors relating to the goods/services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ 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.”

54) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (a) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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.”

55) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

56) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product/service is, as a practical matter, regarded for the purposes of the trade”¹⁰ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning¹¹. However, I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

57) Finally, when comparing the respective goods/services, if a term clearly falls within the ambit of a term in the competing specification then identical goods/services must be considered to be in play¹² even if there may be other goods/services within the broader term that are not identical.

58) I will go through the applied for goods/services class by class:

¹⁰ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

¹¹ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

¹² See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM)* Case T-133/05 (“*Gérard Meric*”).

Class 07: Power operated tools.

59) Marks G & H both cover the following goods in class 7.

“Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.”

60) Both earlier marks also cover hand tools in class 8.

61) The applied for goods cover any form of tool that is powered. I have little difficulty envisaging that this could include machine tools. Machine tools are normally powered. **The goods of the applied for mark fall within the ambit of the earlier marks’ specification and are, thus, considered to be identical.** The applied for goods would also be highly similar to hand tools in class 8 given the intended purpose, uses, channels of trade etc.

Class 08: Hand tools; contractors tools, namely spades, forks, trowels, hammers, saws, picks, pick axes.

62) As stated above, both earlier marks cover hand tools. **All of the applied for goods are hand tools and, thus, fall within the ambit of the earlier marks’ specifications. The goods are identical.**

Class 35: The bringing together, for the benefit of others, of non-metallic building materials, metallic building materials, power tools, hand tools, paints, varnishes, lacquers, preparations used for the protection against corrosion, apparatus for lighting, heating, refrigerating, cooking, drying, ventilating, water supply and sanitary purposes, thermal insulating materials; enabling consumers to conveniently view and purchase such goods via retail outlets, via a printed catalogue or via the Internet.

63) Mark H is only relied upon in classes 7 & 8. Mark G is registered for these classes but also in respect of class 35. The services in class 35 read:

Advertising; business management; business administration; office functions; retail store services, on-line retail services, mail order catalog services and telephone shop at home services, all featuring hand tools; electric power tools; air-powered tools; machinery; hydraulic pumps and parts and accessories therefor; hydraulic presses and parts and accessories therefor; gas engines and generators and parts and accessories therefor; diesel engines and generators and parts and accessories therefor; electric motors and parts and accessories therefor; air compressors and parts and accessories therefor; inverters; wind turbines; log splitters, log wedges and parts and accessories therefor; logging equipment and parts and accessories therefor; agricultural and landscape equipment and parts and accessories therefor; construction equipment and parts and accessories therefor; skid-steer loaders and parts and accessories therefor; forklifts and parts and accessories therefor; electrical equipment and parts and accessories therefor; solar lights and panels; material handling equipment and products and parts and accessories therefor; fuel transfer equipment and parts and accessories therefor; lubrication equipment and parts and accessories therefor; kerosene, propane and electric

heaters; chainsaws; pet and pest control products; lawn and garden products; work clothing; gloves; tarpaulins; garages, canopies, shelters and sheds; air compressors, parts and accessories; parts washers; sandblasting tools and accessories; welders and welding parts and accessories therefor; industrial, commercial and industrial lighting products; metal fabrication equipment and parts and accessories therefor; painting products; propane products; outdoor, camping, hunting and recreational products and clothing products therefor; two-way radios; go-karts and parts and accessories therefor; all terrain vehicle and recreational vehicle products, parts and accessories therefor; automotive products, parts and accessories therefor; water pumps and parts and accessories therefor; pressure washers, and parts and accessories therefor; tires, maintenance and testing equipment; trailers, and parts and accessories therefor; food processing equipment and parts and accessories therefor; towing accessories; cleaning supplies; motor oil; storage products; duffel bags, utility bags and tool and equipment holders and holsters; gauges; winches; vehicle lifts; casters; straps, tie-downs and tow straps.

64) Both the applied for specification and the earlier mark's (mark G) specification cover the retailing of particular goods. I identify below the goods being retailed in the applied for mark and whether it has a counterpart in the retailing service of the earlier mark:

- i) "Non-metallic building materials, metallic building materials" – these terms are not listed in the goods being retailed under the earlier mark. The goods retailed, generally speaking, are forms of equipment used by DIYers or professional tradesman. The only terms that could arguably include building materials would be "lawn and garden products". The products could, arguably, include building materials for the garden. Whilst I bear this in mind, this would stretch (beyond the rationale in Avnet) the meaning of the term too far. Building materials, even if they may be used in the garden, would not be described as garden products. The highpoint of the retail service comparison, therefore, resides in the fact that both services relate to the retailing of things used by builders etc albeit that one relates to building products whereas the other relates to equipment used to undertake the activity. The users of the services are the same. The purpose is similar in that both relate to a retail service to provide builders etc with the tools/equipment to do their job. The method of use of the service is similar. The channels of trade overlap as I believe it common for service providers in this field to offer both building materials and equipment. **Overall, I consider there to be a reasonably high degree of similarity between the services.**
- ii) "Power tools, hand tools" – the retail service of the earlier mark includes the retailing of power tools and hand tools. **The services are, therefore, identical.**
- iii) "Paints, varnishes, lacquers, preparations used for the protection against corrosion" – the retail service of the earlier mark includes the retailing of "painting products". Painting products would include the

paint itself as well as the tools for painting. **The services are identical in terms of the retail of paint compared to the retailing of paint products.** Varnishes and lacquers are extremely similar to paints, they are likely to be sold in close proximity to each other and have a highly similar purpose and nature. A retailer of paint is also likely to retail varnishes and lacquers. **I consider the retail of paint products to be highly similar to the retail of the listed varnishes, lacquers and other preparations.**

- iv) “Apparatus for lighting” - the retail service of the earlier mark includes the retailing of “industrial, commercial and industrial lighting products” and also “solar lighting”. **As both services cover the retailing of equipment for lighting then they must be held to be identical.**
- v) “Heating” – the retail service of the earlier mark includes the retailing of “kerosene, propane and electric heaters”. **As both cover the retailing of equipment for heating, the services are identical.**
- vi) “Refrigerating, cooking, drying, ventilating” - the retail service of the earlier mark includes the retailing of “electrical equipment and parts and accessories therefor”. All of the goods retailed under the applied for service could be electrical in nature and, as such **identical services are in play.** Even if I am wrong on that and I have interpreted the earlier mark’s specification too widely, “drying and ventilating goods” are highly similar to heating goods (which are covered by the retail services of the earlier mark) and the consequent retailing of the respective goods must be similar to a high degree. In relation to cooking and refrigerating, the earlier mark covers the retailing of outdoor and camping equipment which would include goods for refrigerating and cooking and, therefore, identity exists on this basis.
- vii) “Water supply and sanitary purposes” - the retail service of the earlier mark includes the retailing of water pumps. Water pumps are often used in water supply and sanitary apparatus. **As both cover the retailing of equipment for the same purpose then the services are identical.**
- viii) “Thermal insulating materials” – these goods are not retailed under the earlier mark but they are, again, likely to be used by builders. In view of this, my reasoning in relation to the retail of building materials applies equally here. **I consider the respective services to have a reasonably high degree of similarity.**

65) I should add, for the sake of completeness, that I see nothing in the earlier marks goods classes that puts NTE in any better position in terms of goods/service similarity. I should, though, record my views in case NTE is in a better position arguing that there exists a likelihood of confusion on the basis of mark H rather than mark G. The goods covered by its specification reads:

Class 07: Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.

Class 08: Hand tools and implements (hand-operated); cutlery; side arms; razors.

66) The propensity for the above goods to be regarded as similar to a retail service stems from there being a complementary relationship. In addition to the case-law already referred to I note that in *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-116/06* the GC considered the similarity between retail services and the goods that are sold by the retailer:

“57 Thus, notwithstanding the incorrect finding of the Board of Appeal to the effect that the services and goods in question have the same nature, purpose and method of use, it is indisputable that those services and goods display similarities, having regard to the fact that they are complementary and that those services are generally offered in the same places as those where the goods are offered for sale.

58 It therefore follows from all of the foregoing that the goods and services in question resemble each other to a certain degree, with the result that the finding in paragraph 24 of the contested decision that such a similarity exists must be upheld.”

67) To the degree that the above goods are those the subject of the retailing service of the applied for mark then I consider, on the basis of the above case-law, that there is a reasonable degree of similarity. However, this applies only in relation to the retailed goods in category ii) above. The other goods being retailed with reference to the applied for mark are not the subject of the above goods specifications of the earlier mark and, so, there can be no real complementary relationship.



The average consumer

68) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is being considered (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). In terms of the goods

and services, the bulk of them are aimed at providing the tools/materials (including the retail of them) for building and other similar trades. This could relate to both the professional tradesperson or a DIYer. Both types of consumer are likely to pay a reasonable degree of attention to the goods they are purchasing. The precise nature of the goods will be of importance so as to ensure that it is fit for purpose. The reliability of the products will also be important, so they are certainly not grab and go purchases. The frequency of purchase is likely to vary between individual items. In general, they are unlikely to be highly infrequent purchases. All things considered, the purchase of the goods may be slightly more considered than the norm when one is considering power tools etc in class 7 (which are likely to be of a higher cost and purchased less frequently than the other goods), but only of a standard, reasonably considered process in respect of the other goods. In terms of the services, the retailer will often play second fiddle to the goods that are being sold. It is the goods themselves that take on most importance. That being said, the service is not akin to the retailer of day to day consumer items, neither is a visit to such a service provider likely to be an impulse event. I consider that a normal/reasonable degree of attention, no higher or lower than the norm, is likely to be displayed. It seems safe to assume that in terms of the goods and services, the selection will be a visual one. The goods may be selected from a catalogue, a website or a physical retail premises. These modes of selling will bring the retailer's trade marks to the consumer's attention in a similar way. That being said, aural similarity is still of importance and will not be ignored completely.

Comparison of marks

69) The competing marks, for ease of reference, can be seen in the table below:

Grafton's marks	NTE's marks (G & H)
	<p>(G) </p> <p>(H) NORTHERN INDUSTRIAL</p>

70) 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 proceed to 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. It would be wrong, therefore, to artificially dissect the

trade marks, although, it is necessary to take into account any distinctive and dominant components.

71) I will begin with an assessment of the dominant and distinctive elements of the respective marks. Grafton's mark contains the word NORTHERN, an outline of Great Britain ("GB") within a circle, and the words DRYWALL & INSULATION. The word NORTHERN flows around (3/4 of the way) the circle in which the map is contained. The words DRYWALL & INSULATION are super-imposed over the top. Although the words DRYWALL & INSULATION may be the element with the most visual impact on account of its size and proportion, the words will strike both average consumers as a non-distinctive element. The outline of the GB map has a slightly abstract feel but it will still clearly be seen for what it is and is something that possesses little by way of distinctiveness. The word NORTHERN is the subject of much of Grafton's evidence. It has filed significant amounts of evidence showing that it is a common word in trade marks and in company names. It has supplemented this with evidence showing the word NORTHERN in use in a number of different contexts. However, the distinctiveness and the subsequent impact such an element will have on the average consumer depends a lot on context. For example, when used in expressions such as Northern Ireland or Northern England Falconry Club the word performs purely a descriptive role whereas in other forms of use, Northern Rail for example, there is so little else in the name of that company that the word may perform a dual role. A trade mark (or in this case an element of it) can send an informative message but, at the same time, may also be capable of being understood as having trade mark meaning. In other words, a trade mark may play a dual role. An analogous finding can be seen in the judgment of the ECJ in *Audi AG v OHIM* (Case C-398/08 P).

72) The context of the mark as a whole is that the word NORTHERN is not qualifying anything. It stands alone. It does not identify what aspect of geography it relates to. It could be the northern part of a city, a county, a country (England), the UK (Scotland being the northernmost country), Europe or the hemisphere. I agree that the word's distinctiveness must be low, but in the context of the mark presented I come to the conclusion that it does play a distinctive role, particularly when the other elements in the mark have so little by way of distinctiveness. In terms of the other elements, the other verbal element, as already discussed, has no distinctiveness. The map of GB in a circle has a degree of stylisation but this is extremely limited (it is, after all, a map of the territory in which the services/goods are supplied), more limited in distinctiveness than the word NORTHERN. My finding is that the word NORTHERN is the dominant and distinctive element. The map of GB in a circle is a distinctive element but of an extremely weak degree. Grafton's submission at the hearing was that, effectively, none of the elements of the mark were distinctive per se but that the mark as a whole was distinctive when they were put together. For the reasons assessed, I reject this submission. Whilst the mark as a whole may be more distinctive than

any of its individual components, the word NORTHERN is still its dominant and distinctive element and it plays an independent role in the mark¹³.

73) In terms of NTE's marks, NORTHERN plays a more prominent visual role. It is the first word in NORTHERN INDUSTRIAL and it also plays a significant role in the composite mark. The N in the device element of the composite mark is likely to be perceived as the N from NORTHERN. This at least re-enforces that NORTHERN plays a key role in the mark. The words "INDUSTRIAL" and "TOOL + EQUIPMENT" are descriptive terms in respect of the goods/services. There is nothing else in the NORTHERN INDUSTRIAL mark and I do not consider the word NORTHERN to be a purely geographic descriptor – the word NORTHERN in NORTHERN INDUSTRIAL is that mark's dominant and distinctive element. In terms of the composite mark, whilst the device element is certainly more distinctive, the overall presentation of the mark means, in my view, that the word NORTHERN and the device element play equal roles within in. Both are dominant and distinctive elements.

74) In terms of the visual comparison, whilst there are some clear and obvious points of difference in terms of the additional elements in the respective marks, there is also a clear and obvious point of similarity in terms of the shared word NORTHERN, an element which I have said constitutes the/a dominant and distinctive element of all the marks. There is, therefore, a degree of similarity, but on account of the visual differences, such similarity must be assessed as being of only a modest degree. The degree of similarity with NTE's composite mark is less than the degree of similarity with NTE's NORTHERN INDUSTRIAL mark. I consider there to be a moderate degree of visual similarity with NORTHERN INDUSTRIAL and a low to moderate degree of visual similarity with NTE's composite mark.

75) In terms of aural similarity, the points of difference are less given that the respective devices will not form part of the likely pronunciation. Furthermore, the other verbal elements in the respective marks (DRYWALL & INSULATION, INDUSTRIAL and TOOLS + EQUIPMENT) do not play distinctive roles in the marks. On account of all this, I consider there to be a reasonably high degree of aural similarity between the marks.

76) In terms of concept, for a conceptual meaning to be relevant it must be one capable of immediate grasp¹⁴. A conceptual difference can counteract, to a degree, visual and aural similarities. There is no reason why this cannot operate in reverse so that conceptual similarity or identity can strengthen the overall

¹³ For sake of clarity, I should add that Grafton's mark has been assessed without reference to the other marks in the series which may otherwise have conditioned the perception of the average consumer. It cannot be assumed that the average consumer will encounter all of the marks in the series – he or she may only ever encounter one of them.

¹⁴ This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHIM* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

similarity. To my mind the concept most likely to be recalled from Grafton's mark is the concept underpinning the word NORTHERN. Whilst it has the additional concept underpinning the outline of GB, as stated above, NORTHERN is the dominant and distinctive element and as such greater emphasis will be placed on this element and any concept that underpins it. The same can be said in respect of NTE's marks given the non-distinctiveness of those mark's additional elements and that in respect of the composite mark its other distinctive element is a device element which is unlikely to form any real concept in the mind of the average consumer. The concept of all the marks focuses on the word NORTHERN. The net effect of all this is that, overall, the degree of similarity of the respective marks must be pitched at a moderate (the composite mark) to reasonable (NORTHERN INDUSTRIAL) level.

Distinctiveness of the earlier marks

77) The degree of distinctiveness of the earlier mark is an important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In terms of inherent qualities I have already discussed the distinctiveness of the word NORTHERN. It is low in distinctiveness. In terms of NORTHERN INDUSTRIAL then, from an inherent point of view, the mark as whole has only a low degree of distinctiveness as the word INDUSTRIAL adds so little. The composite mark has more inherent distinctiveness on account of the additional device element. It has at least a reasonable degree of distinctiveness from an inherent perspective.

78) In terms of the use of the marks, the evidence shows no real use of the mark NORTHERN INDUSTRIAL alone. The distinctiveness of this mark is not, therefore, enhanced. There is, though, use¹⁵ of the composite mark. The mark has appeared on various leaflets, catalogues and invoices. However, the exhibits appear only to show use from 2006 onwards, not a particularly significant length of time prior to Grafton's date of application. It appears from the context of the evidence that it is a retailing mark. However, I identified earlier that the average consumer could be a DIYer or a professional tradesperson. Mr Hodge confirms that NTE UK target both. There is, though, no split between the two types of average consumer in respect of the sales, catalogue distribution etc. This is important because an enhanced reputation could apply to one or other of the average consumers or, indeed, to both. There is no indication as to market share in respect of either group. Weighing these factors against the use demonstrated, I do not consider that an enhanced reputation has been established for either. In terms of the DIYer, a member of the general public, such a group is so wide that the evidence is not supportive of an enhanced degree of distinctiveness being present. In terms of the professional tradesperson, without knowing what

¹⁵ As with the consent issue, I consider it appropriate that NTE may rely on the use made of its marks by NTE UK.

proportion of sales/catalogue distribution etc relates to this group, and without any context against which any of this can be measured, the claim is conjecture. It is not a safe inference to make. The earlier mark is, though, reasonably distinctive on account of its inherent qualities.

Conclusions on the likelihood of confusion

79) It is clear that all the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. It must also be borne in mind that confusion does not necessarily need to be direct (mistaking one mark for the other) but can be indirect in terms of the average consumer believing that the goods/services offered under the respective marks are the responsibility of the same or an economically linked undertaking¹⁶.

80) In terms of the opposition against the applied for marks in classes 7 & 8 then I consider NTE's best prospect of success to be in respect of its NORTHERN INDUSTRIAL mark. To that extent, I have found that the goods are identical, the marks to be visually similar to a moderate degree, to be aurally similar to a reasonably high degree and for there to be a conceptual similarity based on the word NORTHERN which strengthens the overall degree of similarity. The earlier mark, though, is of only a low degree of distinctiveness, as is the point of similarity between the respective marks. There is also the fact that a slightly higher than normal degree of consideration may be applied when the purchase of the goods in class 7 is being considered which could counteract the effects of imperfect recollection. Taking all of the above into account, it is my finding that there is a likelihood of confusion. The average consumer (be it DIYers or professional tradespeople) may notice that the marks are not the same, but the concepts underpinning them and the similarity based on the word NORTHERN, with that word constituting the dominant and distinctive element, will result in the average consumer believing that the goods are the responsibility of the same or an economically linked undertaking. The marks have been fully considered as wholes (as the case-law referred to earlier requires me to), but for the reasons identified I believe that the common presence of the word NORTHERN will not be put down to a mere coincidental usage of a geographical descriptor, but it will in my view be put down to economic connection.

81) In terms of the opposition against the applied for marks in class 35 then I consider NTE's best prospect of success to be in respect of its composite mark.

¹⁶ This is a relevant form of confusion – see *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*.

To that extent, I have found the services to be identical, or similar to a reasonably high degree. I have found there to be a low to moderate degree of visual similarity, a reasonably high degree of aural similarity and for there to be a conceptual similarity based on the word NORTHERN which strengthens the overall degree of similarity. The earlier mark is also reasonably distinctive. The use of the service provider represents a degree of consideration no higher or lower than the norm. Taking all of the above into account, it is my finding that there is a likelihood of confusion. Again, whilst the marks are only visually similar to a low to moderate degree, and although the visual impression is what counts more, the fact that the word NORTHERN forms the/a dominant and distinctive element of both marks and the fact that the concept underpinning this word is shared means that the average consumer will put the common presence of the word NORTHERN down to economic connection rather than co-incidence.

82) There is a likelihood of confusion in respect of the goods and services in classes 7, 8 and 35 of the opposed marks.

83) In view of the above findings it is not necessary to consider whether NTE would also have succeeded in respect of marks D & F. In any event, marks D & F are further away (in terms of the mark to mark comparison) than mark H so the position is not improved here. Furthermore, there is the added complication that mark D has expired since the opposition was launched and, therefore, it is not necessary to deal with whether it may still be relied upon.

Section 5(4)(a) of the Act

The law

84) Section 5(4)(a) of the Act reads:

“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 of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

85) There are three elements (often referred to as “the classic trinity”) to consider in a claim for passing-off, namely: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position quite succinctly when he stated:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. 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 trade description, or the individual features of labeling 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 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.”

86) In relation to goodwill, this was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage 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.”

87) It is also noteworthy from the relevant case-law that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature¹⁷. However, being a small player does not prevent the law of passing-off from being relied upon - it can be used to protect a limited goodwill¹⁸.

The material date

88) Dates are important in passing-off cases. They can have a significant impact on any claim. In terms of the material date, in the judgment of the GC in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07 it was stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

89) The material date is, therefore, the date of filing of the trade mark in question, namely 10 November 2008. NTE must have been able to succeed in a passing-off claim and possessed a protectable goodwill at such a date. The position at an earlier date may also be relevant. It could establish a senior user status, or that there has been common law acquiescence or that the status quo


¹⁷ *Hart v Relentless Records* [2002] E.W.H.C. 1984

¹⁸ See, for instance, *Stannard v Reay* [1967] F.S.R. 140, *Teleworks v Telework Group* [2002] R.P.C. and *Stacey v 2020 Communications* [1991] F.S.R. 49).

should not be disturbed as the parties have a concurrent goodwill¹⁹. However, Grafton have not claimed that it has used its mark to any material extent prior to its application so this aspect does not require further consideration.

The claims pleaded



90) NTE claims to have a goodwill associated with the signs  and also a goodwill associated with the word NORTHERN per se. In both cases NTE claims that the use of the opposed marks is liable to be prevented in classes 6, 7, 8, 17, 19 & 35. The goodwill claimed in said to be associated with “all”. This was highlighted at the hearing as a deficient pleading by Grafton. NTE’s position can be seen in the following exchange:

THE HEARING OFFICER: Sorry, you are saying, therefore, that the 5(4)(a) reference to “all” is sort of a corresponding reference to the earlier mark under 5(2).

MR. ELIAS: Exactly so where it is set out only in the preceding couple of pages of the TM7. I accept that it could have been and should have been pleaded better but I do not think it is realistic to say that it simply cannot be considered because it is not clear what is being alleged. I think it is clear what is being alleged.

91) In view of the above, the claim to goodwill relates to what is covered by the earlier mark(s). In terms of the composite signs (corresponding to mark E), the earlier mark covers only goods. I found that no use had been made of it for any of the goods covered by the earlier mark. In view of the pleading and my earlier findings, I do not see that NTE are any better off under section 5(4)(a) than it was under section 5(2)(b) of the Act. NTE could, of course, be in a better position in respect of the word NORTHERN per se. However, whilst the question regarding variant marks is a quite different question to whether a word is associated with a business’s goodwill, I come to the same conclusion. Whilst the word NORTHERN has been used in respect of various signs which include that word, it is not clear from the evidence that the goodwill attaches to the word per se. The “survey evidence”, as already mentioned, does little to assist NTE’s claim. In view of this, I reject the ground of opposition under section 5(4)(a) of the Act.

92) I should also add that there was a question as to whether NTE was the owner of any goodwill in the UK given that the use has been made by NTE UK. I am far from satisfied that NTE would be the owner. Even if NTE UK is an off-

¹⁹ See, for instance: Croom’s Trade Mark Application [2005] R.P.C. 2 and Daimlerchrysler AG v Javid Alavi (T/A Merc) [2001] R.P.C. 42.


shoot of NTE, the business itself is conducted and controlled by NTE UK. I would, though, have been slow to reject completely the opposition on this ground alone and I may have invited NTE UK to be joined as an opponent²⁰. Given the circumstances and my finding in the preceding paragraph it is not necessary to do so. **The ground of opposition fails under section 5(4)(a) of the Act.**


Section 5(3)

The claims pleaded

93) NTE's pleaded case under section 5(3) relies on the following:

- i) Marks A-C for the word NORTHERN, but these marks may not be relied upon in view of my earlier findings.

- ii) Marks D & F  where a reputation is claimed in respect of all the goods for which it is registered. The claim must, though, be considered as restricted due to my earlier proof of use findings.

- iii) Mark E , but these marks may not be relied upon in view of my earlier findings.

- iv) Mark G  where a reputation is claimed in respect of all the goods for which it is registered.

- v) Mark H, NORTHERN INDUSTRIAL, where a reputation is claimed in respect of all the goods for which it is registered.

94) In all cases all of the goods and services sought to be registered in respect of the opposed marks are the subject of NTE's claims.

²⁰ A similar course of action was followed by Professor Ruth Annand (sitting as the Appointed Person) in *Tao Asian Bistro* (BL O-004-11).

Reputation

95) In order to succeed under this ground the earlier mark(s) must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 *Chevy* the ECJ stated:

“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.”

and

“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.”

96) In respect of marks D & F, any reputation possessed by these earlier marks must relate to goods. Whilst I have found that the marks have been used in relation to goods, it must be noted that NTE has provided no evidence to demonstrate what proportion of its turnover relates to its own branded goods compared to its retailing activity. On the face of it, the retailing activity is the primary focus of the business. I am, therefore, far from satisfied that these earlier marks have been used to the degree sufficient to establish the requisite reputation. The ground of opposition in relation to these earlier marks is dismissed.

97) In relation to mark H, NORTHERN INDUSTRIAL, as observed earlier, there is little by way of use of this trade mark. The ground of opposition must similarly be dismissed.

98) Marks A-C & E cannot be relied upon, so that leaves mark G. I have already dealt with this mark in relation to distinctive character and found that it was not safe to assume that the mark had been used to a degree from which it could be inferred that an enhanced degree of distinctiveness was present in the mark. I cannot see how NTE can be any better off in terms of demonstrating a reputation. Without a proper breakdown of the sales figures/catalogue distribution etc between the consumer groups, and without any context against which to measure, it is difficult to find that the earlier mark has a reputation in accordance with the guidance set out in *Chevy*. My finding is that the earlier mark does not have the requisite reputation and the ground of opposition must be dismissed on this basis. I will though, in case I am wrong, go on to give my views on the other aspects of this ground. To that extent any reputation is more likely to exist in relation to the professional tradesperson.

Will a link be made?

99) In addition to having a reputation, a link must be made between the respective marks. In *Adidas-Salomon*, the ECJ stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

100) In *Intel Corporation Inc v CPM (UK) Ltd (C-252-07)* (“*Intel*”), the ECJ provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”

101) I only intend to consider the position from the perspective of those goods and services where NTE has not yet succeeded. Those goods and services are in classes 2, 6, 17 & 19 (which could all loosely be described as types of materials for building etc and goods such as paint) and in class 39 in respect of:

“The packaging, storage and distribution of non-metallic building materials, metallic building materials, power tools, hand tools, paints, varnishes, lacquers, preparations used for the protection against corrosion, apparatus for lighting, heating, refrigerating, cooking, drying, ventilating, water supply and sanitary purposes, thermal insulating materials.”

102) In my view a link will not be made. NTE's reputation is in respect of the retailing of equipment not building materials/paint. So the application of the applied for marks in respect of such goods is a further step away. Whilst there may be an overlap in terms of consumer, I assessed the overall degree of similarity as only being modest and that there was only a low to moderate degree of visual similarity. If the reputation is present it is difficult, without full market context, to assess the strength of that reputation. I do not think it appropriate to infer a high reputation. The points of similarity reside in a weak element. Whilst I have found a likelihood of confusion where identical/reasonably similar goods/services are considered, the various factors here would not even combine to cause a link. I come to the same view in respect of the services in class 39, the packaging, storage and distribution services are a step away and the various factors assessed above would not combine to create a link.

103) Even if I am wrong on the above, any link made must lead to one of the heads of damage set out in section 5(3). Although NTE also plead that Grafton's marks would be detrimental to its reputation (often referred to as “tarnishing”), or to its distinctive character (often referred to as “dilution”) I consider that the strongest pleading, on the face of it, relates to the taking, without due cause, of an unfair advantage (often referred to as “free-riding”). In *Case C-487/07, L'Oreal SA and others v Bellure NV and others* the ECJ defined what is meant by “unfair advantage”:

"41 As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It 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.

50 In the light of the above, the answer to the fifth question is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by

that use to ride on the coat-tails of the mark with a reputation 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."

104) NTE has to establish not only that there would be an advantage, but also that it is unfairly taken. It is to be noted that the ECJ refers to the third party seeking to take advantage, ie a conscious decision being made. The question of the unfair aspect was considered by Lloyd LJ in *Whirlpool Corporations and others v Kenwood Limited* [2009] EWCA Civ 753 :

"136. I do not consider that Kenwood's design involves anything like a transfer of the image of the KitchenAid mark, or of the characteristics which it projects, to the goods identified by Kenwood's sign (see *L'Oréal v Bellure* paragraph 41). Of course, as a newcomer in a specialist market of which KitchenAid had a monopoly, and being (necessarily) in the basic C-shape of a stand mixer, the kMix would remind relevant average consumers, who are design-aware, of the KitchenAid Artisan. That, however, is a very different phenomenon, in very different commercial circumstances, from the situation considered in *L'Oréal v Bellure*. I find the Court's judgment instructive, but it does not seem to me to lead to the conclusion in favour of Whirlpool for which Mr Mellor contends. On the contrary, having rejected his radical submission that the word "unfair" could just as well have been left out of the article, it seems to me that the decision points away from, rather than towards, liability under the article on the facts of the present case. It is not sufficient to show (even if Whirlpool could) that Kenwood has obtained an advantage. There must be an added factor of some kind for that advantage to be categorised as unfair. It may be that, in a case in which advantage can be proved, the unfairness of that advantage can be demonstrated by something other than intention, which was what was shown in *L'Oréal v Bellure*. No additional factor has been identified in this case other than intention."

105) This matter was also considered by Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch):

"160. Thus something more than mere advantage is required. It must be an unfair advantage. Lloyd LJ seems to state that an advantage is rendered unfair if it is intended. He also leaves open the possibility that unintended advantage may have a sufficient quality of unfairness about it to qualify."

(Also see *Datacard Corporation v Eagle Technologies Limited* [2011] EWHC 244 (Pat) at paragraphs 294 and 295.)

106) There is nothing to suggest any intention on the part of Grafton. Indeed, its evidence is that the mark was designed, and the word NORTHERN used, in order to send a geographical message. NTE did not ask to cross-examine Grafton's witness on this. An argument was put forward at the hearing that an intention may have come later given that having had sight of NTE's objection Grafton could easily have decided on a different mark but which still sent a geographical message, therefore, persisting with the application demonstrated an intent. This is nothing more than speculation and must be rejected. The matter must also be assessed at the date of application and not later. No other factor beyond intent has been identified. I therefore reject the free-riding argument on this aspect alone.

107) In terms of the tarnishing argument, the claim that Grafton's goods and service may be inferior is, again, mere speculation. This claim is dismissed. Furthermore, the claim to dilution is also weak and there is no evidence to suggest that the capacity of NTE's mark to perform its distinguishing function will be diminished, particularly one that will have any form of economic effect²¹ on the relevant public of NTE's service. **The ground under section 5(3) is dismissed.**

Conclusion

108) The opposition succeeds in classes 7, 8 & 35 but fails in relation to everything else.

Costs

109) Given the partial success/failure of the parties, I consider it appropriate that the parties bear their own costs.

Dated this 31 day of March 2011

**Oliver Morris
For the Registrar,
The Comptroller-General**

²¹ As per the explanation in *Intel*.

ANNEX

Earlier mark/sign & grounds relied upon	Relevant dates ²²	Specification
<p>A) UK registration 2218684 for the mark: NORTHERN</p> <p>s. 5(2)(b). Only the goods in classes 6, 7, 8, 17 & 19 are relied upon. Proof of use applies - statement of use matches goods relied upon. Identical/similar goods said to be contained in Grafton's classes 6, 7, 8, 17 & 19</p> <p>s. 5(3). Reputation claimed in respect of all goods. Proof of use applies – statement of use is in respect of all goods. The ground is said to relate to all of the goods and services in Grafton's application.</p> <p>s. 5(4)(a) also to apply on account of the use of the word NORTHERN. Opposition only against classes 6, 7, 8, 17, 19 & 35</p>	<p>Filing date: 5/1/2000</p> <p>Registration: 26/01/2001</p> <p>Use claimed from "around 1980s, nationwide"</p>	<p>Class 03: Cleaning, polishing, scouring and abrasive preparations and substances; abrasive cloth and paper; sandpaper; degreasing fluid; cleaning solvents; and detergents.</p> <p>Class 04: Industrial oils and greases; lubricants; fuels; pump oil; and pressure washer oil.</p> <p>Class 05: Pharmaceutical, veterinary and sanitary preparations; plasters; materials for dressings; adhesive tapes for medical purposes; bandages; disinfectants; preparations for destroying vermin; fungicides, herbicides; and first aid kits and boxes.</p> <p>Class 06: Metal building materials; transportable buildings of metal; non-electric cables and wires of common metal; ironmongery; small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; oil drainage containers; metal trunks; wild animal traps; metal screws; anvils; metal boxes; metal bins; castors of metal; metal compost bins; metal fencing; metal lock bolts; metal key rings; and parts and fittings for all of the aforesaid.</p> <p>Class 07: Machine tools; motors, engines and gear boxes (except for land vehicles); machine coupling and transmission components (except for land vehicles); water pumps; air compressors; air brushes; cement mixers; chainsaws; vacuum cleaners;</p>

²² Some of the earlier marks also have International priority dates, but as they do not improve NTE's position (all the marks qualify as earlier marks by virtue of their dates of filing) the details have not been listed.

		<p>winches; winching machines; shredder machines; chipper machines; power and air hammers; pumps; gears (other than for land vehicles); lawnmowers; wind turbines; log splitters; agricultural and landscape equipment; sandblasting tools; sanders; screwdrivers; welders; metal fabrication equipment; metal presses; metal benders; shears; lathes; oil filters; oil drain systems; riveters; tile cutters; edgers; trimmers; spray guns; spreaders; rollers; cultivators; lawn sweepers; lawn aerators; tillers; chainsaws; valves; power tools; air tools; electric hand drills; drill bits; drill bit sets; sharpening machines; meat grinders; lifting apparatus; ratchets; and parts and fittings for all of the aforesaid.</p> <p>Class 08: Hand tools and implements (hand-operated); wrenches; hammers; jacks; riveters; screwdrivers; tile cutters; lathes; socket sets; pliers; vises; vise grips; grinding wheels; blade sharpening instruments; blades; drills; chisels; saws; hand operated cement mixers; clamps; cutlery; side arms; razors; and parts and fittings for all of the aforesaid.</p> <p>Class 09: Scientific, surveying, photographic, cinematographic, optical, weighing, measuring and safety apparatus, electrical apparatus, equipment and instruments all relating to pressure washers, water pumps, log splitting, air compressors, power tools, material handling, metal fabrication, welding, winches, hoists and chargers, calculators; radios; plugs; electronic pest control equipment; surveillance systems; security cameras; tape measures; measuring</p>
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		<p>scales; magnifying glasses; binoculars; telescopes; thermometers; solar batteries; solar battery chargers; traffic cones; warning triangles; goggles; face shields; electronic pens, calculators; battery charging apparatus; fuses; fire-extinguishing apparatus; protective helmets; and parts and fittings for all of the aforesaid.</p> <p>Class 10: Surgical, medical, dental and veterinary apparatus and instruments; hearing protectors; orthopaedic articles; and ear protectors.</p> <p>Class 11: Apparatus for heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; kerosene, propane and electric heaters; fans; lighter gas; cooking apparatus; sprayers; solar panels; outdoor fireplaces; cooking utensils; and parts and fittings for all of the aforesaid.</p> <p>Class 12: Vehicle accessories; motors and engines for land vehicles; gear boxes; tyres; go-karts; accessories for go-karts; motor cycles; seats for vehicles; steering wheel spinners for vehicles; carts; pedal cars; covers for boats and cars; towing accessories; trolleys; trailers; and parts and fittings of all the aforesaid.</p> <p>Class 16: Paper, cardboard and printed matter; catalogues; adhesives for stationery or household purposes; paint brushes; plastic materials for packaging (not included in other classes); self help books; stamps; and wrapping paper.</p> <p>Class 17: Flexible pipes, not of metal; cling wrap; adhesive tape; water hoses and protective packing materials.</p> <p>Class 18: Leather and</p>
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		<p>imitation leather goods; rucksacks; bags; tool bags; and tool belts.</p> <p>Class 19: Building materials (non-metallic); non-metallic rigid pipes for building; non-metallic transportable buildings; garden sheds (wood); fencing; building frames; pond liners; and greenhouses.</p> <p>Class 20: Furniture; work benches; seats; castors (not of metal); patio and outdoor furniture; storage cabinets; saw horses; compost bins (plastic/wood); and inflatable mattresses.</p> <p>Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith); brushes (except paint brushes); articles for cleaning purposes; steelwool; dustpans; cleaning cloths; sprinklers; watering cans; dustbins; bins; funnels; bird feeders; and waste bins.</p> <p>Class 22: Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); aviaries; camouflage nets; and canopies.</p> <p>Class 25: Clothing; footwear; and headgear.</p> <p>Class 27: Carpets; rugs; mats and matting; linoleum; and other materials for covering existing floors.</p> <p>Class 28: Games and playthings; model cars; gymnastic and sporting articles not included in other classes.</p>
<p>(B) Community trade mark ("CTM") registration 1739796 for the mark: NORTHERN</p> <p>s. 5(2)(b). Only the goods</p>	<p>Filing date: 4/7/2000</p> <p>Registration date: 21/3/2002</p>	<p>Class 03: Cleaning, polishing, scouring and abrasive preparations and substances; abrasive cloth and paper; sandpaper; degreasing fluid; cleaning solvents; and detergents.</p> <p>Class 04: Industrial oils and</p>

<p>in classes 6, 7, 8, 17, 19 & 35 are relied upon. Proof of use applies - statement of use matches goods and services relied upon. Identical/similar goods and services said to be contained in Grafton's classes 6, 7, 8, 17, 19 & 35.</p> <p>s. 5(3). Reputation claimed in respect of all goods and services. Proof of use applies – statement of use is in respect of all goods and services. The ground is said to relate to all of the goods and services in Grafton's application.</p>		<p>greases; lubricants; fuels; pump oil; and pressure washer oil.</p> <p>Class 05: Pharmaceutical, veterinary and sanitary preparations; plasters, materials for dressings; adhesive tapes for medical purposes; bandages; disinfectants; preparations for destroying vermin; fungicides, herbicides; and first aid kits and boxes.</p> <p>Class 06: Metal building materials; transportable buildings of metal; non-electric cables and wires of common metal; ironmongery; small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; oil drainage containers; metal trunks; wild animal traps; metal screws; anvils; metal boxes; metal bins; castors of metal; metal compost bins; metal fencing; metal lock bolts; metal key rings; and parts and fittings for all of the aforesaid.</p> <p>Class 07: Machines and machine-tools; motors, engines and gear boxes (except for land vehicles); machine coupling and transmission components (except for land vehicles); pressure washers; water pumps; air compressors; air brushes; cement mixers; chainsaws; vacuum cleaners; winches; winching machines; shredder machines; chipper machines; power and air hammers; pumps; gears (other than for land vehicles); lawnmowers; wind turbines; log splitters; agricultural and landscape equipment; sandblasting tools; sanders; screwdrivers; welders; metal fabrication equipment; metal presses; metal benders; shears; lathes; oil filters; oil drain systems; riveters; tile cutters; edgers; trimmers;</p>
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		<p>spray guns; spreaders; rollers; cultivators; lawn sweepers; lawn aerators; tillers; chainsaws; valves; power tools; air tools; electric hand drills; drill bits; drill bit sets; sharpening machines; meat grinders; lifting apparatus; ratchets; and parts and fittings for all of the aforesaid.</p> <p>Class 08: Hand tools and implements (hand operated); wrenches; hammers; jacks; riveters; screwdrivers; tile cutters; lathes; socket sets; pliers; vises; vise grips; grinding wheels; blades sharpening instruments; blades; drills; chisels; saws; hand operated cement mixers; clamps; cutlery; side arms; razors; and parts and fittings for all of the aforesaid.</p> <p>Class 09: Scientific, surveying, electric, photographic, cinematographic, optical, weighing, measuring and safety apparatus, equipment and instruments; calculators; radios; plugs; electronic pest control equipment; surveillance systems; security cameras; tape measures; measuring scales; magnifying glasses; binoculars; telescopes; thermometers; solar batteries; solar battery chargers; traffic cones; warning triangles; goggles; face shields; electronic pens, calculators; battery charging apparatus; fuses; fire-extinguishing apparatus; protective helmets; and parts and fittings for all of the aforesaid.</p> <p>Class 10: Surgical, medical, dental and veterinary apparatus and instruments; hearing protectors; orthopaedic articles; and ear protectors.</p> <p>Class 11: Apparatus for heating, steam generating, cooking, refrigerating, drying,</p>
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		<p>ventilating, water supply and sanitary purposes; kerosene, propane and electric heaters; fans; lighter gas; cooking apparatus; sprayers; solar panels; outdoor fireplaces; cooking utensils; and parts and fittings for all the aforesaid.</p> <p>Class 12: Vehicle accessories; motors and engines for land vehicles; gear boxes; tyres; go-karts; accessories for go-kart; motor cycles; seats for vehicles; steering wheel spinners for vehicles; carts; pedal cars; covers for boats and cars; towing accessories; trolleys; trailers; and parts and fittings of all the aforesaid.</p> <p>Class 16: Paper, cardboard and printed matter; catalogues; adhesives for stationery or household purposes; paint brushes; plastic materials for packaging (not included in other classes); self help books; stamps; and wrapping paper.</p> <p>Class 17: Flexible pipes, not of metal; cling wrap; adhesive tape; water hoses and protective packing materials.</p> <p>Class 18: Leather and imitation leather goods; rucksacks; bags; tool bags; and tool belts.</p> <p>Class 19: Building materials (non-metallic); non-metallic rigid pipes for building; non-metallic transportable buildings; garden sheds (wood); fencing; building frames; pond liners; and greenhouses.</p> <p>Class 20: Furniture; work benches; seats; castors (not of metal); patio and outdoor furniture; storage cabinets; saw horses; compost bins (plastic/wood); and inflatable mattresses.</p> <p>Class 21: Household or kitchen utensils and containers (not of precious metal or</p>
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		<p>coated therewith); brushes (except paint brushes); articles for cleaning purposes; steelwool; dustpans; cleaning cloths; sprinklers; watering cans; dustbins; bins; funnels; bird feeders; and waste bins.</p> <p>Class 22: Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); aviaries; camouflage nets; and canopies.</p> <p>Class 25: Clothing, footwear, headgear.</p> <p>Class 27: Carpets, rugs, mats and matting; linoleum and other materials for covering existing floors.</p> <p>Class 28: Games and playthings; model cars; gymnastic and sporting articles not included in other classes.</p> <p>Class 35: Mail order services; the bringing together for the benefit of others of a variety of goods enabling customers to conveniently view and purchase those goods.</p>
<p>(C) CTM registration 1740273 for the mark:</p> <p>NORTHERN</p> <p>s. 5(2)(b). All services relied upon. Proof of use applies - statement of use matches services relied upon. Identical “retail services for the sale of related goods” in class 35 of Grafton’s application.</p> <p>s. 5(3). Reputation claimed in respect of all services. Proof of use applies – statement of use is in respect of all</p>	<p>Filing date: 5/7/2000</p> <p>Registration date: 3/4/2002</p>	<p>Class 35: Mail order services; the bringing together for the benefit of others of a variety of goods enabling customers to conveniently view and purchase those goods.</p>


<p>services. The ground is said to relate to all of the goods and services in Grafton's application.</p>		
<p>(D) UK registration (2218687 for the mark:</p> <p><i>NORTHERN</i> <i>Industrial</i> <i>TOOLS</i></p> <p>s. 5(2)(b). Only the goods in classes 7 & 8 are relied upon. Proof of use applies - statement of use matches goods relied upon. Identical/similar goods in classes 7 & 8 of Grafton's application.</p> <p>s. 5(3). Reputation claimed in respect of all goods. Proof of use applies – statement of use is in respect of all goods. The ground is said to relate to all of the goods and services in Grafton's application.</p>	<p>Filing date: 5/1/2000</p> <p>Registration date: 15/12/2000</p>	<p>Class 07: Machine tools; motors, engines and gear boxes (except for land vehicles); machine coupling and transmission components (except for land vehicles); water pumps; air compressors; air brushes; cement mixers; chainsaws; vacuum cleaners; winches; winching machines; shredder machines; chipper machines; power and air hammers; pumps; gears (other than for land vehicles); lawnmowers; wind turbines; log splitters; agricultural and landscape equipment; sandblasting tools; sanders; screwdrivers; welders; metal fabrication equipment; metal presses; metal benders; shears; lathes; oil filters; oil drain systems; riveters; tile cutters; edgers; trimmers; spray guns; spreaders; rollers; cultivators; lawn sweepers; lawn aerators; tillers; chainsaws; valves; power tools; air tools; electric hand drills; drill bits; drill bit sets; sharpening machines; meat grinders; lifting apparatus; ratchets; and parts and fittings for all of the aforesaid.</p> <p>Class 08: Hand tools and implements (hand-operated); wrenches; hammers; jacks; riveters; screwdrivers; tile cutters; lathes; socket sets; pliers; vises; vise grips; grinding wheels; blade sharpening instruments; blades; drills; chisels; saws; hand operated cement mixers; clamps; cutlery; side arms; razors; and parts and fittings for all of the aforesaid.</p> <p>Class 12: Vehicle accessories; motors and engines for land vehicles; gear</p>

		boxes; tyres; go-karts; accessories for go-karts; motor cycles; seats for vehicles; steering wheel spinners for vehicles; carts; pedal cars; covers for boats and cars; towing accessories; trolleys; trailers; and parts and fittings of all the aforesaid.
<p>(E) UK registration 2218674 for the marks:</p>  <p>s. 5(2)(b). Only the goods in classes 6, 7, 8, 17 & 19 are relied upon. Proof of use applies - statement of use matches goods relied upon. Identical/similar goods in classes 6, 7, 8, 17 & 19 of Grafton's application.</p> <p>s. 5(3). Reputation claimed in respect of all goods. Proof of use applies – statement of use is in respect of all goods. The ground is said to relate to all of the goods and services in Grafton's application.</p> <p>s. 5(4)(a) also to apply on account of the use of signs corresponding to those above. Opposition only against classes 6, 7, 8, 17, & 19.</p>	<p>Filing date: 5/1/2000</p> <p>Registration date: 17/11/2000</p> <p>Use claimed from "around nationwide" 1980s,</p>	<p>Class 03: Cleaning, polishing, scouring and abrasive preparations and substances; abrasive cloth and paper; sandpaper; degreasing fluid; cleaning solvents; and detergents.</p> <p>Class 04: Industrial oils and greases; lubricants; fuels; pump oil; and pressure washer oil.</p> <p>Class 05: Pharmaceutical, veterinary and sanitary preparations; plasters; materials for dressings; adhesive tapes for medical purposes; bandages; disinfectants; preparations for destroying vermin; fungicides, herbicides; and first aid kits and boxes.</p> <p>Class 06: Metal building materials; transportable buildings of metal; non-electric cables and wires of common metal; ironmongery; small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; oil drainage containers; metal trunks; wild animal traps; metal screws; anvils; metal boxes; metal bins; castors of metal; metal compost bins; metal fencing; metal lock bolts; metal key rings; and parts and fittings for all of the aforesaid.</p> <p>Class 07: Machine tools; motors, engines and gear boxes (except for land vehicles); machine coupling and transmission components (except for land vehicles); water pumps; air compressors; air brushes; cement mixers;</p>

		<p>chainsaws; vacuum cleaners; winches; winching machines; shredder machines; chipper machines; power and air hammers; pumps; gears (other than for land vehicles); lawnmowers; wind turbines; log splitters; agricultural and landscape equipment; sandblasting tools; sanders; screwdrivers; welders; metal fabrication equipment; metal presses; metal benders; shears; lathes; oil filters; oil drain systems; riveters; tile cutters; edgers; trimmers; spray guns; spreaders; rollers; cultivators; lawn sweepers; lawn aerators; tillers; chainsaws; valves; power tools; air tools; electric hand drills; drill bits; drill bit sets; sharpening machines; meat grinders; lifting apparatus; ratchets; and parts and fittings for all of the aforesaid.</p> <p>Class 08: Hand tools and implements (hand-operated); wrenches; hammers; jacks; riveters; screwdrivers; tile cutters; lathes; socket sets; pliers; vises; vise grips; grinding wheels; blade sharpening instruments; blades; drills; chisels; saws; hand operated cement mixers; clamps; cutlery; side arms; razors; and parts and fittings for all of the aforesaid.</p> <p>Class 09: Scientific, surveying, photographic, cinematographic, optical, weighing, measuring and safety apparatus, equipment and instruments; calculators; radios; plugs; electronic pest control equipment; surveillance systems; security cameras; tape measures; measuring scales; magnifying glasses; binoculars; telescopes; thermometers; solar batteries; solar battery chargers; traffic cones; warning triangles; goggles; face shields; electronic pens,</p>
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		<p>calculators; battery charging apparatus; fuses; fire-extinguishing apparatus; and parts and fittings for all of the aforesaid.</p> <p>Class 10: Surgical, medical, dental and veterinary apparatus and instruments; hearing protectors; orthopaedic articles; and ear protectors.</p> <p>Class 11: Apparatus for heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; kerosene, propane and electric heaters; fans; lighter gas; cooking apparatus; sprayers; solar panels; outdoor fireplaces; cooking utensils; and parts and fittings for all of the aforesaid.</p> <p>Class 12: Vehicle accessories; motors and engines for land vehicles; gear boxes; tyres; go-karts; accessories for go-karts; motor cycles; seats for vehicles; steering wheel spinners for vehicles; carts; pedal cars; covers for boats and cars; towing accessories; trolleys; trailers; and parts and fittings of all the aforesaid.</p> <p>Class 16: Paper, cardboard and printed matter; catalogues; adhesives for stationery or household purposes; paint brushes; plastic materials for packaging (not included in other classes); self help books; protective helmets; stamps; and wrapping paper.</p> <p>Class 17: Flexible pipes, not of metal; cling wrap; adhesive tape; water hoses and protective packing materials.</p> <p>Class 18: Leather and imitation leather goods; rucksacks; bags; tool bags; and tool belts.</p> <p>Class 19: Building materials (non-metallic); non-metallic rigid pipes for building; non-</p>
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		<p>metallic transportable buildings; garden sheds (wood); fencing; building frames; pond liners; and greenhouses.</p> <p>Class 20: Furniture; work benches; seats; castors (not of metal); patio and outdoor furniture; storage cabinets; saw horses; compost bins (plastic/wood); and inflatable mattresses.</p> <p>Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith); brushes (except paint brushes); articles for cleaning purposes; steelwool; dustpans; cleaning cloths; sprinklers; watering cans; dustbins; bins; funnels; bird feeders; and waste bins.</p> <p>Class 22: Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); aviaries; camouflage nets; and canopies.</p> <p>Class 25: Clothing; footwear; and headgear.</p> <p>Class 27: Carpets; rugs; mats and matting; linoleum; and other materials for covering existing floors.</p> <p>Class 28: Games and playthings; model cars; gymnastic and sporting articles not included in other classes.</p>
<p>(F) CTM registration 1739408 for the mark:</p> <p>NORTHERN <i>Industrial</i> TOOLS</p> <p>s. 5(2)(b). Only the goods in classes 7 & 8 are relied upon. Proof of use applies - statement of use matches goods relied upon. Identical/similar goods in classes 7 & 8 of</p>	<p>Filing date: 4/7/2000</p> <p>Registration date: 21/8/2001</p>	<p>Class 07: Machines and machine-tools; motors, engines and gear boxes (except for land vehicles); machine coupling and transmission components (except for land vehicles); pressure washers; water pumps; air compressors; air brushes; cement mixers; chainsaws; vacuum cleaners; winches; winching machines; shredder machines; chipper machines; power and air hammers; pumps; gears (other</p>

<p>Grafton's application.</p> <p>s. 5(3). Reputation claimed in respect of all goods. Proof of use applies – statement of use is in respect of all goods. The ground is said to relate to all of the goods and services in Grafton's application.</p>		<p>than for land vehicles); lawnmowers; wind turbines; log splitters; agricultural and landscape equipment; sandblasting tools; sanders; screwdrivers; welders; metal fabrication equipment; metal presses; metal benders; shears; lathes; oil filters; oil drain systems; riveters; tile cutters; edgers; trimmers; spray guns; spreaders; rollers; cultivators; lawn sweepers; lawn aerators; tillers; chainsaws; valves; power tools; air tools; electric hand drills; drill bits; drill bit sets; sharpening machines; meat grinders; lifting apparatus; ratchets; and parts and fittings for all of the aforesaid.</p> <p>Class 08: Hand tools and implements (hand-operated); wrenches; hammers; jacks; riveters; screwdrivers; tile cutters; lathes; socket sets; pliers; vises; vise grips; grinding wheels; blade sharpening instruments; blades; drills; chisels; saws; hand operated cement mixers; clamps; cutlery; side arms; razors; and parts and fittings for all of the aforesaid.</p> <p>Class 12: Vehicle accessories; motors and engines for land vehicles; gear boxes; tyres; go-karts; accessories for go-karts; motor cycles; seats for vehicles; steering wheel spinners for vehicles; carts; pedal cars; covers for boats and cars; towing accessories; trolleys; trailers; and parts and fittings of all the aforesaid.</p>
<p>(G) CTM registration 4119475 for the mark:</p>  <p>s. 5(2)(b). Only the goods</p>	<p>Filing date: 16/11/2004</p> <p>Registration date: 1/3/2006</p>	<p>Class 07: Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.</p>

<p>and services in classes 7, 8 & 35 are relied upon. Proof of use does not apply. Identical/similar goods/services in classes 7, 8 & 35 of Grafton's application.</p> <p>s. 5(3). Reputation claimed in respect of all goods and services. The ground is said to relate to all of the goods and services in Grafton's application.</p>		<p>Class 08: Hand tools and implements (hand-operated); cutlery; side arms; razors.</p> <p>Class 35: Advertising; business management; business administration; office functions; retail store services, on-line retail services, mail order catalog services and telephone shop at home services, all featuring hand tools; electric power tools; air-powered tools; machinery; hydraulic pumps and parts and accessories therefor; hydraulic presses and parts and accessories therefor; gas engines and generators and parts and accessories therefor; diesel engines and generators and parts and accessories therefor; electric motors and parts and accessories therefor; air compressors and parts and accessories therefor; inverters; wind turbines; log splitters, log wedges and parts and accessories therefor; logging equipment and parts and accessories therefor; agricultural and landscape equipment and parts and accessories therefor; construction equipment and parts and accessories therefor; skid-steer loaders and parts and accessories therefor; forklifts and parts and accessories therefor; electrical equipment and parts and accessories therefor; solar lights and panels; material handling equipment and products and parts and accessories therefor; fuel transfer equipment and parts and accessories therefor; lubrication equipment and parts and accessories therefor; kerosene, propane and electric heaters; chainsaws; pet and pest control products; lawn and garden products; work clothing; gloves; tarpaulins;</p>
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		garages, canopies, shelters and sheds; air compressors, parts and accessories; parts washers; sandblasting tools and accessories; welders and welding parts and accessories therefor; industrial, commercial and industrial lighting products; metal fabrication equipment and parts and accessories therefor; painting products; propane products; outdoor, camping, hunting and recreational products and clothing products therefor; two-way radios; go-karts and parts and accessories therefor; all terrain vehicle and recreational vehicle products, parts and accessories therefor; automotive products, parts and accessories therefor; water pumps and parts and accessories therefor; pressure washers, and parts and accessories therefor; tires, maintenance and testing equipment; trailers, and parts and accessories therefor; food processing equipment and parts and accessories therefor; towing accessories; cleaning supplies; motor oil; storage products; duffel bags, utility bags and tool and equipment holders and holsters; gauges; winches; vehicle lifts; casters; straps, tie-downs and tow straps.
<p>(H) CTM 6935613 for the mark:</p> <p>NORTHERN INDUSTRIAL</p> <p>s. 5(2)(b). Only the goods in classes 7 & 8 are relied upon. Proof of use does not apply. Identical/similar goods in classes 7 & 8 of Grafton's</p>	<p>Filing date: 26/5/2008</p> <p>Registration date: 20/2/2009</p>	<p>Class 07: Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.</p> <p>Class 08: Hand tools and implements (hand-operated); cutlery; side arms; razors.</p> <p>Class 11: Apparatus for lighting, heating, steam generating, cooking,</p>

<p>application.</p> <p>s. 5(3). Reputation claimed in respect of all goods. Proof of use does not apply. The ground is said to relate to all of the goods and services in Grafton's application.</p>		<p>refrigerating, drying, ventilating, water supply and sanitary purposes; portable work lights, fluorescent work lights, halogen work lights, halogen shop lights, rechargeable LED work lights; light bulbs.</p>
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