

O/384/18

TRADE MARKS ACT 1994

**TRADE MARK REGISTRATION No. 3099156
IN THE NAME OF THRISLINGTON CUBICLES LTD**

AND

**APPLICATION FOR INVALIDATION No. 501639
BY VENESTA WASHROOM SYSTEMS LIMITED**

AND

**TRADE MARK REGISTRATION No. 3114320
IN THE NAME OF VENESTA WASHROOM SYSTEMS LIMITED**

AND

**APPLICATION FOR INVALIDATION No. 501569
BY THRISLINGTON CUBICLES LTD**

Background and pleadings

1. Thrislington Cubicles Ltd (“Thrislington”) applied on 16th February 2017 for registered trade mark 3114320 (“the 320 mark”) – **Façade Flush** – to be declared invalid under s.47(2) of the Trade Marks Act 1994 (“the Act”).

2. At that time the 320 mark was registered in the name of Grant Westfield Ltd. It has since been assigned to Venesta Washroom Systems Ltd (“Venesta”), which is now the other party to these proceedings.

3. The 320 mark was applied for on 22nd June 2015 and registered on 2nd October 2015. It is registered in class 11 in relation to:

“Toilet cubicles; bath cubicles; cubicles for showers; cubicles [enclosures (Am.)] (shower -).”

4. Thrislington’s application for invalidation is based on its ownership of earlier trade mark 3099156 (“the 156 mark”) – **Flush**. This mark was applied for on 13th March 2015 and registered on 5th June 2015. The 156 mark is registered in class 19 in relation to:

“Non metallic cubicles; partitions not of metal; non-metallic panelling systems included in this class, non-metallic cladding systems and non-electric and non-metallic ducting systems; non-metallic roofing systems; non-metallic doors, non-metallic windows, non-metallic casings, frames and surrounds for doors and windows; parts and fittings for all the aforesaid goods.”

5. Thrislington claims that (a) the respective marks are similar, (b) that the respective goods are identical or similar, and (c) that there is a likelihood of confusion on the part of the public, including the likelihood of association. Consequently, registration of the 320 mark was contrary to s.5(2)(b) of the Act.

6. Grant Westfield Ltd applied on 26th April 2017 for Thrislington’s 156 mark to be declared invalid under s.47(1) of the Act. It claimed that registration of the mark was

contrary to s.3(1)(b) and/or (c) of the Act. I note that the pleaded case included the following.

“The challenged mark denotes the desirable characteristic of building materials (and products made up of these materials) being flush - i.e., “even or level, as with a surface; forming the same plane” [per dictionary.com] (e.g.- the building materials are flush with each other, and/or flush with any existing fixture into which the building materials are incorporated etc).

In the particular context of bathroom facilities such as those built from the “Non metallic cubicles” and other goods specified in the challenged registration, this characteristic of being flush is customarily offered by traders as part of high end, executive ranges of bathroom facilities in commercial premises like office buildings. Consequently, the descriptor 'flush' has laudatory meaning which is desirable to consumers and has a higher monetary value attached to it in trade.”

7. The parties filed counterstatements denying the respective grounds for invalidation. I note that Thrislington (a) accepted that the dictionary meaning set out in Grant Westfield Ltd's application is one of the meanings of 'flush', (b) denied that such a meaning could be applied to the goods covered by the 156 mark, e.g. it denied that 'flush cubicle' made any sense, (c) claimed that the meaning of 'flush' was too vague for there to be a “direct and specific relationship” between the mark and the registered goods, and (d) claimed that it had made widespread and substantial use of the mark such that it had acquired [further] distinctive character through use.

8. The proceedings were consolidated.

Representation

9. Venesta is represented by Scintilla Intellectual Property Ltd. Thrislington is represented by Cameron Intellectual Property. Neither side asked to be heard, preferring a decision to be made from the parties' evidence and written submissions.

The evidence

10. Grant Westfield Ltd filed a witness statement by Ms Sarah McLean dated 15th September 2017 (with 14 exhibits). Ms McClean is a director of the company. Her evidence is directed at the case for invalidating the 156 mark on grounds of lack of distinctiveness/descriptiveness.

11. Thrislington responded to this evidence with a witness statement by Mr Jeff Orme dated 16th January 2018 (with 9 exhibits). Mr Orme is a director of the company.

12. Venesta (which had by then taken over ownership of the 320 mark from Grant Westfield Ltd) filed a brief witness statement by Mr Peter McBride (with 2 exhibits) dated 11th April 2018. Mr McBride is a Chartered Patent Attorney at Scintilla IP.

13. Ms McClean's evidence consists mainly of examples of the parties themselves, and of third parties, using FLUSH in an apparently descriptive manner in relation to washroom fittings, including panels and cubicles. Exhibit SM2 to her statement consists of excerpts from Thrislington's website obtained on 20th April 2017. She points out that the washroom cubicles advertised on that site were described as having various characteristics including:

- "flush-fitting panels"
- "Rebated doors to ensure a flush finish"
- "Doors close to a completely flush finish"

14. In the same exhibit, Ms McClean provides an excerpt from a third party website in which Thrislington's 'Ribbon' range of washroom cubicles are described as having a "Flush Façade."

15. Exhibit SM3 to Ms McClean's statement shows that Grant Westfield Ltd's 'Façade Flush' range of washroom cubicles is advertised as having "rebated...edges for a smooth flush finish."

16. Exhibits SM4 to SM12 of Ms McClean's statement consist of numerous examples of competitors using 'flush' descriptively in relation to washroom and toilet cubicles and/or parts for such goods. For example, TBS Fabrications' UK website describes "a wide range of flush cubicles." The website innovationwashrooms.co.uk advertised its cubicles with a claim that "the flush cubicle is a clean, flush faced cubicle design." The UK website of ALM products described "Flush Wall Cubicles." Similar uses are shown on the websites of Dunham Washrooms (UK), Bushboard Washrooms (UK), Excelsior Cubicles (UK), Venesta (UK), Amwell Systems and Maxwood Washrooms.

17. Ms McClean also provides¹ various page views from Google UK. She says that these show that if you enter FLUSH CUBICLE as a search term, Google's autocomplete function suggests "flush cubicle system" and "flush toilet cubicles" as search terms. She makes similar points about FLUSH PARTITIONS, FLUSH PANEL, FLUSH CLAD, FLUSH DOORS and other related terms. According to Ms McClean, these suggestions are based on commonly used search terms.²

18. So far as Thrislington's use of FLUSH is concerned, Ms McClean draws attention to an advertorial which appeared in *The Architect's Journal* on 23rd May 2017. This advertorial referred to "*Thrislington's newly launched Flush and Mojo cubicle ranges.*" Ms McClean points out that, contrary to Thrislington's claim to have made substantial use of FLUSH as a trade mark, this suggests that the brand was only launched in or around May 2017.

19. Mr Orme claims that Thrislington is a leading designer and manufacturer of washroom products. He says that the FLUSH mark "*has been used widely across the UK and goods have been supplied to high-profile customers.*" In support of this claim he exhibits:

- A sub-contract agreement dated 28th October 2014 between Thrislington and Galliford Try Construction (UK) Ltd in relation to works carried out for

¹ As exhibit SM13

² There is no evidence of this. Consequently, I have not taken this evidence into account.

Jaguar Land Rover.³ I note that the FLUSH mark is not shown anywhere in this document.

- A page from a sub-contract agreement between Thrislington and Miller Construction (the former name of Galliford Try Construction (UK) Ltd) with an appendix describing a “K32 Flush” with an accompanying description of a “Flush Cubicle Specification” dated 24th July 2014.⁴
- Another page from what appears to be the same sub-contract document with an appendix which appears to offer to supply and fix a “WC cubicle (flush range)” for £1178.40.⁵
- A quotation letter dated 8th May 2014 addressed to an unidentified “Estimating Department” offering to supply 80 “Flush Cubicles” for use in an extension to Jaguar Land Rover’s site at Gaydon.⁶
- A quotation letter dated 17th June 2015 addressed to Robson Construction Ltd offering to supply 25 “Flush Veneer Cubicle doors” in relation to works at Holkham Hall and a resulting order dated 22nd July 2015.⁷
- A quotation letter dated 9th February 2017 addressed to ITS Interiors Ltd offering to supply 28 “Flush Veneer Cubicles” in relation to works at Northminster House and a resulting order dated 23rd February 2017.⁸

20. With regard to Ms McClean’s claim that Thrislington’s FLUSH range had only just gone of sale in May 2017, Mr Orme denies this. According to him, the reference to the product being “newly launched” in 2017 related to the fact that Thrislington had not previously advertised the product, and also that the product had been redesigned “*over the years.*”

21. It is only necessary to mention one aspect of Mr McBride’s evidence in reply on behalf of Venesta. He supplied a copy of Thrislington’s website and pointed out that FLUSH was not a product name listed on the website in April 2018.

³ See exhibit JO1

⁴ See JO2

⁵ See JO3

⁶ See JO4

⁷ See JO5 & 6

⁸ See JO8 & 9

Venesta's application for Thrislington's 156 mark to be declared invalid

The law

22. The relevant parts of section 47(1) of the Act are as follows.

“47(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).”

(2) – (4)

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

23. Section 3(1) of the Act is as follows:

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

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

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

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

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

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

24. I will start by examining the ground for invalidation based on s.3(1)(c) of the Act. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was conveniently summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*⁹ as follows:

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

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

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

⁹ [2012] EWHC 3074 (Ch)

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

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

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

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of

any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

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

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

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

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

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

25. It is submitted on behalf of Thrislington that although the ordinary meanings of the word FLUSH may be relevant to the parties’ common industry, it has no interest in preventing other traders using the word as an adjective. According to Thrislington, the word is not descriptive of the particular goods covered by the 156 mark. In this connection, my attention has been drawn to the judgment of the General Court in *Ford Motor Co. v OHIM*.¹⁰ The court stated that in order to fall within the exclusion set out in article 3(1)(c) of the EU Trade Mark Regulation (corresponding to s.3(1)(c) of the Act), “*there must be a sufficiently direct and specific relationship*” between the mark and the goods for the public to perceive, without further thought, a description of the goods in question. Thrislington submits that there is no such relationship between the word FLUSH and the goods covered by the 156 mark.

26. Venesta disputes this.

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27. The relevant average consumer appears to be a consumer of building products, such as cubicles, windows, doors and parts of/fittings for such goods. This could include members of the general public, but more often (particularly in the case of cubicles) will be business buyers selecting goods for installation in their own businesses, or those of a third party. Such a consumer is likely to pay at least an average degree of attention when selecting the goods at issue.

28. There does not appear to be any dispute that one of the meanings of FLUSH is “even or level, as with a surface; forming the same plane.” I see no reason why the visible parts of cubicles, windows, doors, partitions, panelling systems etc. are unlikely to be offered for sale with flush-fitting fronts, profiles, etc. In its counterstatement, Thrislington disputed that a ‘flush cubicle’ made any sense. However, the evidence shows that third parties describe such goods as ‘flush cubicles’ and that Thrislington describes its own washroom cubicles as having “*flush-fitting panels*” and/or that its “*Doors close to a completely flush finish.*” In these circumstances, it is not tenable for Thrislington to argue that ‘flush-fitting’ is not a characteristic of, at least, some of the goods at issue. In my view, ‘flush-fitting’ may serve, in trade, to designate a characteristic of, at least, cubicles, windows, doors, partitions & panelling systems. It does not matter whether the characteristic concerned is best described as being the *kind* of goods, or the *quality* of goods, or some “*other*” characteristic of the goods.

29. The question then reduces to whether relevant average consumers of the goods at issue would attribute the same meaning to ‘flush’ as to ‘flush-fitting’. As I have already noted, there are examples in evidence of competitors using ‘flush cubicles’ descriptively. This suggests that these parties expect relevant consumers to immediately understand what the word ‘flush’ means in relation to cubicles. In any event, the relevant dictionary meaning of the word ‘flush’ is hardly obscure, particularly to those in the building industry. I have no doubt that its descriptive meaning would be immediately understood when used in relation to cubicles. The same applies to windows, doors, partitions & panelling systems. As the evidence shows, it is often the interaction of the various parts of such goods which produces the required ‘flush’ finish. I therefore find that the descriptive meaning of the word extends to parts and fittings for cubicles, windows, doors, partitions & panelling

systems, including non-metallic casings, frames and surrounds for doors and windows.

30. What about *non-metallic cladding systems and non-electric and non-metallic ducting systems; non-metallic roofing systems*? Venesta's evidence does not appear to be directed at these goods, probably because they are quite different to the goods covered by its own 320 mark. However, in each case it appears possible for the goods to be marketed as having a flush finish, or creating one once installed. In these circumstances, I find that the dictionary meaning of 'flush' mentioned above is sufficient to establish that the word is capable of being used, in trade, as a viable description of the flush-fitting characteristic of these goods too. That is sufficient for me to conclude that registration of the 156 mark was contrary to s.3(1)(c) of the Act in relation to all the goods for which it is registered.

31. In view of my finding under s.3(1)(c) of the Act, I find it unnecessary to examine the s.3(1)(b) ground for invalidation.

32. This brings me to the question of whether, as Thrislington claims, the 156 mark had acquired a distinctive character through use by the date of the application for invalidation on 26th April 2017. The CJEU provided guidance in *Windsurfing Chiemsee*¹¹ about the correct approach to assessing the acquisition of distinctive character through use. The guidance is as follows:

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

¹¹ Joined cases C-108 & C-109/97

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

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

33. The answer in this case is straightforward. It is not even clear whether, or to what extent, Thrislington has used FLUSH as a trade mark (as opposed to a mere description). Further, even if it has been used as a mark, there is no evidence as to the market share acquired prior to the relevant date. The geographical extent of the use claimed appears very limited. And according to Thrislington itself, it had not advertised goods under the mark FLUSH prior to May 2017, i.e. after the relevant date. In these circumstances I have no hesitation in holding that the mark had not acquired a distinctive character to a significant proportion of the relevant UK public by the relevant date.

34. This means that Venesta’s application to invalidate the 156 mark succeeds. In accordance with s.47(6) of the Act the registration will be treated as never having existed.

Thrislington's application to invalidate Venesta's 320 mark

35. As Thrislington's application to invalidate the 320 mark is based solely on the existence of the earlier 156 mark, which has been declared invalid, it follows that the application to invalidate the 320 mark must be rejected.

36. However, for the sake of completeness, I will briefly consider what would be the position if I have wrongly extended the grounds for invalidating the 156 mark to *non-metallic cladding systems and non-electric and non-metallic ducting systems; non-metallic roofing systems*. I find that Thrislington's application would have failed to the extent that it was based on the registration of the earlier 156 mark in relation to these goods. This is because they are manifestly dissimilar to the goods covered by the 320 mark in class 11. Consequently, even if I had reached a different conclusion as to the applicability of the s.3(1)(c) based ground for invalidating the 156 mark in relation to these goods, it would not have affected the outcome of Thrislington's application to invalidate the 320 mark.

Outcome

37. Venesta's application to invalidate trade mark 3099156 is wholly successful.

38. Thrislington's application to invalidate trade mark 3114320 fails.

Costs

39. As Venesta has been successful it is entitled to a contribution towards its costs. I assess these as follows.

£500 for filing an application to invalidate the 156 mark and considering Thrislington's counterstatement;

£200 for considering Thrislington's application to invalidate the 320 mark and filing a counterstatement;

£1000 for considering Thrislington's evidence and filing evidence in support of its application to invalidate the 156 mark;

£300 for filing written submissions.

40. I therefore order Thrislington Cubicles Ltd to pay Venesta Washroom Systems Ltd the sum of £2000. This sum to be paid within 21 days of the end of the period allowed for appeal.

Dated this 22nd day of June 2018

**Allan James
For the Registrar**