

# TRADE MARKS ACT, 1996

## Decision in Hearing

IN THE MATTER OF two applications for registration of trade Marks (Nos. 224096 and 226170) and in the matter of opposition thereto.

**MASONRY FIXING SERVICES LIMITED**

**Applicant**

**UNIFIX LIMITED**

**Opponent**

### Applications for registration

1. On 28 January, 1997, Masonry Fixing Services Limited, an Irish company of Unit 75, Cherry Orchard Industrial Estate, Ballyfermot, Dublin 10, made application (No. 1997/00344) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the trade mark shown below in respect of a specification of goods in Classes 1, 6, 7, 8, 17 and 20 that was amended in the course of the examination of the application to read as indicated below.



Class 1: *Chemicals used in industry; chemicals and chemical products for use for fastening materials for use in building; adhesives used in industry; adhesive substances made from synthetic resins.*

Class 6: *Common metals and their alloys; metal building materials; wall plugs, anchors, connection anchors, all made of either common metals or their alloys; ironmongery, small items of metal hardware.*

*Class 7: Machines and machine tools; cutting machines.*

*Class 8: Hand tools and implements (hand operated); cutting tools.*

*Class 17: Wall plugs, anchors, connection anchors all made of rubber or rubber substitutes, all included in Class 17.*

*Class 20: Wall plugs, anchors, connection anchors all made of plastics, all included in Class 20.*

2. On 15 May, 2002, the Applicant made a further application (No. 2002/01001) to register the word UFIX as a trade mark in respect of the same specification of goods in Classes 1, 6, 7, 8, 17 and 20.
3. The applications were accepted for registration and advertised accordingly under Nos. 224096 and 226170, respectively, the former in Journal No. 1950 on 4 September, 2002 and the latter in Journal No. 1965 on 2 April, 2003.
4. Notices of opposition to the registration of the marks pursuant to Section 43 of the Act were filed on 3 December, 2002 and 6 June, 2003 by Unifix Limited, a British company of Bridge House, Grove Lane, Smethwick, Warley, West Midlands, B66 2SA, England. The Applicant filed counter-statements on 7 March and 25 August, 2003. Evidence was subsequently filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
5. The opposition to both applications became the subject of a hearing before me, acting for the Controller, on 12 April, 2007. The parties were notified on 11 May, 2007 that I had decided to uphold the opposition and to refuse registration of the marks. I now state the grounds of my decision and the materials used in arriving thereat in response to a request filed by the Opponent pursuant to Rule 27(2) on 8 June, 2007.

### **Scope of the opposition**

6. The opposition to both applications is based on the Opponent's trade mark UNI-FIX, which is registered with effect from 13 April, 1970 under No. 77326<sup>1</sup> in respect of the following goods in Classes 6, 7, 8 and 20:

Class 6: *Nails of hardened steel; screws of common metal; plugs included in Class 6.*

Class 7: *Drilling machines, drills included in Class 7 and parts and fittings included in Class 7 for all of the aforesaid goods.*

Class 8: *Hand tools, hand instruments and drill bits for use with hand tools, all being goods included in Class 8.*

Class 20: *Fixing plugs of plastic for use in ceilings, floors, wall and in the like surfaces.*

7. On the basis of that registration and its claimed use of the trade mark UNI-FIX, the Opponent raises objection against the present applications under Section 8(4)(a), Section 10(2)(b) and Section 10(3) of the Act.
8. Grounds of opposition under Sections 6, 8(1)(a), 8(1)(b), 8(1)(c), 8(4)(b) and 37 of the Act were also raised in the notices of opposition but these were not subsequently substantiated in any way by the Opponent and were formally relinquished at the hearing.

### **The evidence<sup>2</sup>**

#### *Rule 20*

9. Evidence submitted by the Opponent under Rule 20 consisted of a statutory declaration (and Exhibits RF1 and RF2) dated 2 February, 2004 of Francis Glover, its Managing Director. He says that -

---

<sup>1</sup> The notices of opposition filed also refer to Registration No. 78534, UNI-FIX HAMMER SET, registered in respect of goods in Class 6 but that registration was not renewed in 2006 and no reliance was placed on it at the hearing.

<sup>2</sup> review of the evidence confined to matters or relevant fact or claimed fact

- the trade mark UNI-FIX has been used in the State by the Opponent or its predecessors in title in relation to a wide range of fixing products, including pipe clips, screws, plastic anchors, drill bits, cable clips, cavity fixings, anchors, frame fixings, masonry nails, sealants, fillers and adhesives, abrasives, professional power tools and hand tools since at least March, 1970,
- the trade mark is used widely on brochures, manuals and price lists and has been used throughout the entire territory of the State,
- turnover in goods sold under the trade mark for the period 1997-2003 amounted to approximately €2.3 million.

*Rule 21*

10. Evidence submitted by the Applicant under Rule 21 consisted of a statutory declaration (and Exhibits GC1 – GC6) dated 23 August, 2004 of Gerard Carroll, its Managing Director. He says that -

- the Applicant has been trading with a German fixing company called Upat since 1982 and is well known in the market for its sales of Upat products,
- in 1997, the Applicant decided to sell additional products, which it did not source from Upat, and commissioned the design of a trade mark for same, leading to its adoption of the trade marks UFIX and UFIX device, the “U” in the device being similar to the “U” in the Upat name,
- the trade marks UFIX and UFIX device have been used in Ireland since at least April, 1997 in relation to various goods, including silicones, building adhesives, steel nails, washered steel nails, metal expansion and metal expansion anchors,
- turnover in goods sold under the trade mark UFIX for the period June, 2001-July, 2004 amounted to approximately €450,000,

- the Applicant is a direct sales organisation whose sales representatives call to, and make sales directly to, the end users of its products,
- it has branches in Dublin, Cork and Belfast with sales representatives working throughout the entire island of Ireland and its goods are available through its branches, trade counters and direct to end users via its direct sales team,
- the Applicant has never encountered any confusion between its trade mark UFIX and the Opponent's UNI-FIX, which name would be used to designate a single or "one fixing" and is quite different in meaning to the Applicant's trade mark.

#### *Rule 22*

11. Evidence submitted by the Opponent under Rule 22 consisted of a further statutory declaration dated 10 February, 2005 of Francis Glover. The only averment of fact in that declaration that I regard as relevant is that, contrary to Mr. Carroll's assertion, the name UNI-FIX alludes to a unified building fixing system and has been marketed on that basis.

#### *Request for leave to file further evidence refused*

12. On 22 April, 2005, the Applicant sought leave to file further evidence under Rule 23 in response to certain of the statements made in the Opponent's evidence under Rule 22. The Opponent objected to that request and, having received written submissions on the matter from both parties, the Controller informed them that he proposed to refuse the request, subject to the Applicant's right to be heard. The Applicant did not seek a hearing and the refusal of leave to file further evidence therefore became final.

#### **The hearing**

13. At the hearing the Opponent was represented by Mr. Shane Smyth, Trade Mark Agent of F.R. Kelly & Co. and the Applicant by Ms. Mary Rose O'Connor, Trade Mark Agent of Cruickshank & Co.

14. Mr. Smyth argued the case in support of the opposition on the basis of the identity or very close similarity of the respective goods and the close similarity of the respective marks. In this latter regard, he asserted that the concept evoked by each of the respective marks is determined by the word “FIX” and that that word and concept are not qualified in any obviously meaningful way by the addition of either prefix, U or UNI. Conceptually, therefore, the marks are not readily distinguishable, especially in the context of the goods in question, in relation to which the word FIX has a clear meaning. The evidence is to the effect that the Opponent’s earlier mark has been used extensively over a long period of time and any use of the marks propounded for registration must inevitably be detrimental to its reputation and liable to be prevented by means of an action for passing off.
15. In response, Ms. O’Connor denied that the words UFIX and UNI-FIX have similar meanings. In her submission, UFIX would be understood by the average consumer as conveying the message, “you fix”, and thus importing a reference to the do-it-yourself category of goods on which the mark is used. That is quite different to UNI-FIX, which Ms. O’Connor claimed would be interpreted as “a single fixing”, as asserted in the Applicant’s evidence. She also pointed to the fact that not all of the goods covered by the applications for registration are similar to those in respect of which the Opponent’s mark is protected, noting, for example, that the Class 1 specification of goods of the applications included a wide range of goods, many of which would be quite different to those in which the Opponent trades.

### **Grounds of decision**

#### *Section 8(4)(a) – use of marks prohibited by law*

16. Section 8(4)(a) of the Act provides that a trade mark shall not be registered if or to the extent that its use is prohibited in the State by any enactment or rule of law or by any provision of Community law. The “rule of law” relied upon by the Opponent to ground its objection under this Section is the law of passing off, in that it contends that, in the light of its prior use of its trade mark UNI-FIX, the use of the marks propounded for registration would be liable to be prevented by virtue of an action for passing off and would have been liable to be so prevented as of the respective filing dates of the applications for registration (the relevant dates).

Such an objection arises under Section 10(4)(a) of the Act, which is specifically concerned with marks the use of which *is liable to be prevented* by virtue of any rule of law, including the law of passing off. Section 8(4)(a), on the other hand, is concerned with marks the use of which *is prohibited* by law and an objection under that Section may only be sustained if a specific legal prohibition on the use of the relevant trade mark is identified. The Opponent has not identified any such legal prohibition on the use of the Applicant's trade marks and the objection under Section 8(4)(a) must be dismissed accordingly. While the notices of opposition include a general objection under Section 10 of the Act, they do not specifically particularise an objection under Section 10(4)(a) based on passing off and I do not accept that they encompass such a specific objection. Nor was any application made to amend the notices of opposition so as to include an objection under Section 10(4)(a). Accordingly, the Opponent's raising of an argument based on that Section must be regarded as invalid.

*Section 10(2)(b) – likelihood of confusion*

17. Section 10(2)(b) of the Act prohibits the registration of a trade mark if, because it is similar to an earlier trade mark and would be registered for goods or services in respect of 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 of the later trade mark with the earlier trade mark. The likelihood of confusion must be appreciated globally having regard to all of the relevant factors, including the degree of similarity between the respective trade marks and the respective goods/services, the degree of distinctiveness of the earlier trade mark, the nature of the goods/services and the likely perception of the average consumer of them, who must be treated as being reasonably observant and circumspect but who rarely has the chance to make a direct comparison of the trade marks and must rely instead on the imperfect picture of them that he keeps in his mind<sup>3</sup>.

*The respective trade marks*

---

<sup>3</sup> As per various decisions of the European Court of Justice, including Sabel BV –v- Puma AG and Rudolf Dassler Sport (Case No. C-251/95), Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc. (Case No. C-39/97), Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case No. C-342/97)

18. In the present case, the marks to be compared are the Opponent's earlier trade mark UNI-FIX and the marks propounded for registration, UFIX (word mark) and UFIX device. Although the representation filed with the application for registration of the latter mark is very indistinct, the exhibits accompanying the Applicant's evidence show that the word UFIX can be fairly clearly seen in that mark in use and I regard that word as being the dominant element of the mark as it is by that word that the average consumer would identify the mark, first and foremost. The figurative element of the mark is both prominent and inherently distinctive but it is unlikely, in my opinion, that it would have as great an impact in the mind of the average consumer as would the verbal element, UFIX. In terms of the impression formed by the mark in the mind of the consumer and therefore likely to be recalled by him subsequently, I think the verbal element is of paramount importance. So, while not disregarding the figurative element of Trade Mark No. 224096, I have focussed more on the comparison between the words UNI-FIX and UFIX. In comparing those words, I have considered the visual, aural and conceptual similarities and differences between them, bearing in mind, however, the primary significance of the overall impressions created by them, having regard to the fact that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

19. On the whole, I would say that the words UNI-FIX and UFIX display a fairly high degree of similarity. The shared character string, U-F-I-X, the opening U and the terminal FIX combine to give the words a similar look and sound which is offset to only a slight degree by the inclusion of the additional syllable in the middle of the Opponent's UNIFIX. Conceptually, the message given by both words is created by the shared element, FIX, which has an obvious meaning in relation to most of the goods in question. That word is identifiable as a separate element of the Opponent's mark, UNI-FIX, by virtue of the hyphenation of same. Its separate identity and meaning are preserved also in the Applicant's mark, UFIX, because the addition of the opening U does not qualify or conceptually affect FIX in an obviously meaningful way. In this regard, I do not accept the submission made at the hearing on the part of the Applicant to the effect that its mark will be understood by the average consumer as meaning "you fix". There is no evidence to support that contention and, in my opinion, it is not an obvious interpretation to



place on the word. While UNI-FIX may be interpreted by the average person as implying a single or universal fixing, that does not significantly alter the basic concept evoked by the mark, i.e., of or relating to fixing or securing, and that same essential concept is found in the marks seeking registration also.

*The respective goods*

20. The goods in respect of which the Opponent's earlier trade mark is protected are hardware items that are normally supplied to the end user through general hardware or DIY stores. The specifications of goods covered by the applications for registration also include a range of items that may be similarly designated and which would be retailed through the same trade channels. It is the case that the specifications of goods of the applications are cast in fairly broad terms and may be understood as also including goods outside of the general hardware field. However, the Applicant's evidence is to the effect that its trade is in relation to the latter goods and I think it is unnecessary for me, for the present purposes, to speculate as to the entire range of goods that may be included within designations such as "*chemicals used in industry*", "*adhesives used in industry*", "*common metals and their alloys*", and "*machines and machine tools*". The fact is that the specifications of goods of the applications include goods that are the same as those in respect of which the Opponent's earlier trade mark is protected; the specifications have not been amended in response to the opposition to remove those identical goods; and nor would any such amendment be consistent with the specific trading undertaken by the Applicant under its trade marks, as shown in its evidence. In the circumstances, I am satisfied that it is correct to assess the likelihood of confusion between the marks in the context of the specific goods that are common to both the earlier trade mark and the applications for registration, namely, general hardware items, including, in particular, nails, screws, wall plugs and related fastening and fixing materials.

*The average consumer and the circumstances of the trade*

21. Goods of that nature are used primarily by tradespeople but also by DIY enthusiasts and persons generally engaged in routine household maintenance and repair. They are often sold loose, i.e., unboxed, in hardware and DIY stores and, in many cases, are chosen by the end-user more by reference to their functional

qualities than to the particular brand name under which they are marketed. Of course, retailers who deal in such goods must rely on trade marks to identify and distinguish brands that they have come to trust and the likelihood of confusion arising between the goods of different undertakings may usefully be appreciated from the point of view of such persons also. In general, it seems to me that there is a lesser likelihood of confusion on the part of hardware retailers than there would be in the case of the ultimate users of these goods as the former may be expected to take extra care in ordering and to be familiar with their suppliers and the brands used by them. Nevertheless, the likelihood of such persons falling into confusion because of the use of very similar trade marks in relation to the same products cannot be ruled out, particularly when account is taken of the very wide range of stock carried by the average hardware retailer and the large number of suppliers that most would buy from. In the case of the end-users of the goods in question and assuming the selection and purchase by them of packaged goods displayed for sale, i.e., where the consumer sees the relevant trade marks, a greater likelihood of confusion may be expected as the average person is unlikely to be as alive to minor differences between brands and may rely on a rather cursory glance at the trade mark to identify a brand that he associates with the desired qualities of reliability and durability.

#### *Likelihood of confusion*

22. Having regard to all of the foregoing factors, I have decided that, on the whole, the use of the marks propounded for registration in relation to the goods in question would give rise to a likelihood of confusion on the part of the relevant consumers, including those involved in the retailing sector, having regard to the existence of the earlier trade mark relied on by the Opponent. In my opinion, the relatively high degree of similarity between the respective marks is sufficient to create a likelihood of confusion between them and the other factors to be taken into account, including the nature of the goods, the behaviour of the relevant consumers and the circumstances of the trade, do not operate to displace or reduce that likelihood. While Ms. O'Connor, for the Applicant, laid stress on the fact that the Opponent did not adduce any evidence of actual confusion between the parties' goods notwithstanding that both have been available on the market here for some years, I am not persuaded by that fact that there is no likelihood of such

confusion. The Applicant's evidence is to the effect that it is a direct sales organisation and the potential for confusion between its goods and those of other undertakings *at the point of sale of the goods by the Applicant* is reduced accordingly. That does not mean that there is no likelihood of confusion in the course of the ordinary trade in goods of this kind and nor is it the case that any confusion that may have occurred would necessarily have come to the notice of the Opponent. In my opinion, confusion is more likely than not if the respective marks are used in a normal and fair manner in relation to the goods in question and I have decided, therefore, to uphold the opposition under Section 10(2)(b) of the Act and to refuse the applications for registration.

*Section 10(3)(a) – unfair advantage*

23. Section 10(3) of the Act that a trade shall not be registered if it is similar to an earlier trade mark, which has a reputation in the State (or in the European Community, in the case of a Community Trade Mark) and if the use of the trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark. The first thing to be determined in assessing an objection to registration grounded on this Section is whether the earlier trade mark relied upon by the Opponent has the requisite reputation. In the present case, the Opponent has given evidence of over 30 years of use of its trade mark and average turnover in goods sold under the mark of almost €400,000 per year for the period 1997-2003. While that evidence is impressive as to the use of the Opponent's trade mark, it does not, in my opinion, provide a basis for concluding, on the balance of probabilities, that the mark had acquired a reputation prior to either of the relevant dates for the purposes of these proceedings such as would ground an objection under Section 10(3). There is no evidence, for example, of the extent of the market share held by goods sold under the mark or any testimony from persons in the trade and unconnected with the Opponent to the effect that the trade mark had become particularly well-known or of high repute. In the circumstances, I find that the Opponent has not established a basis for objection against the present applications under Section 10(3) of the Act and I dismiss the opposition under that Section accordingly.

Tim Cleary  
Acting for the Controller

12 June, 2007