TRADE MARKS ACT 1994

IN THE MATTER OF Registration No. 2052776 in Class 6
in the name of LOUIS BERKMAN COMPANY

AND

IN THE MATTER OF an Application for a Declaration of Invalidity
by Eurocom Enterprises Limited

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The trade mark TCS is registered as of 25 October 1996 under number 2052776 in the name of Louis Berkman Company (the registered proprietor) in respect of Class 6, covering the following goods:

> Sheet metal; goods made of, or predominantly of, common metal; all for use in the building industry; metal building materials.

By an application dated 2 April 1997 Eurocom Enterprises Ltd of Ascot, Berkshire applied for a declaration of invalidity. The grounds of the application are in summary:

1.	**Under Sections 1(1) and 3(1)(a)**	Because TCS is a known acronym for terne coated steel and is therefore incapable of distinguishing the goods of one undertaking from those of other undertakings and should be declared invalid within the terms of Section 47(1).
2.	**Under Section 3(1)(b)**	Because the sign TCS is devoid of any distinctive character and should be declared invalid within the terms of Section 47(1).
3.	**Under Section 3(1)(c)**	Because the sign serves in the trade to designate the kind or quality of the goods and should be declared invalid within the terms of Section 47(1).
4.	**Under Section 3(6)**	Because the application was not made in good faith and should be declared invalid within the terms of Section 47(1) and Section 47(4).

The applicants filed a counterstatement denying the above grounds.

Both sides ask for an award of costs in their favour. Only the Applicants for a Declaration of Invalidity have filed evidence. Neither party has requested a hearing. Acting on behalf of the

Registrar and after a careful study of the papers I give this decision.

Applicants' Evidence

The Applicants for a declaration of Invalidity filed a statutory declaration dated 20 January 1998 by Francois Moal, their Managing Director. He comments as follows:

> "Terne coated stainless steel, or terne coated steel ("the goods"), has a highly specialised United Kingdom market. Terne coated steel, zinc and copper belong to the "fully supported metal roofing" speciality. The amount of work for all fully supported metals concerns 20 - 25 companies in the United Kingdom. The Metal Roofing Contractors Association, which is the relevant trade association, has 15 members. It is clear that terms which are very common within the particular trade could be less well-known outside it".

Terne coated steel is, he says, referred to as TCS. In support of this he exhibits the following:-

FM1 documents provided by Trainready Ltd referring to type 316 Terne Coated fully softened stainless steel roof as TCS. The goods are said to be manufactured by Lee Steel Strip Ltd.

FM2 a photocopy of the architectural plans for HM Prison Manchester by Austin Smith Lord in which the architect describes "TCSS Roof sheeting" and on the second page, "Terne coated stainless steel" is abbreviated to TCSS.

FM3 a document from Fellden Clegg Design relating to the Francis Close Hall Catering Building. Pages 2 and 3 of this document show roof sketches where TCSS is said to be used as a generic term.

FM4 a photocopy of a facsimile from John Seeley of Kershaw Mechanical Services Limited relating to a delivery of TCS goods.

Exhibit FM1, FM3 and FM4 are all dated from 1992 and 1993, with exhibit FM2 from June 1991, and are said to show that TCS has been generic since at least that time.

Mr Moal says his company sent a blank questionnaire to twenty companies, of which fourteen returned the completed questionnaires which are shown as exhibit FM5. Nine of the fourteen respondents are members of the Metal Roofing Contractors Association and five companies which are not members of that Association have also responded. Two of the companies have stated that the term TCS has been familiar to them since 1980, and each company stated that TCS is a generic term. An example of the questionnaire is shown as an annex to this decision.

As a result of all this Mr Moal concludes as follows:

> "It is my belief, which the above evidence shows is shared by many others within the trade, that TCS is a generic term and does not designate goods of any one particular origin. Registration of the term as a mark would therefore make ordinary trading practices impossible for metal roofers, for architects and for consultants. The term is in

constant use as a generic and its registration would greatly hinder the normal and fair use of the term in relation to the particular goods, terne coated steel or terne coated stainless steel".

That concludes my review of the evidence.

Decision

The application is made under Section 47(1) and Section 47(4) of the Trade Marks Act 1994, which read 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).
>
> Where the trade mark was registered in breach of subsection (1)(b), © or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.
>
> **47.- (4)** In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of invalidity of the registration

Turning first to the grounds founded under Section 47(1) made under Section 1(1) and Section 3(1)(a), (b), and (c). These relevant part of Section 3 reads 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,
>
> © 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)** ....
>
> Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), © 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.

Section 1(1) in turn reads:

> **1-(1)** In this Act "trade mark" means any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings.
>
> A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

The proprietors have not claimed that the mark has acquired a distinctive character as a result of the use they have made of it and I therefore have only the prima facie case to consider.

In a written submission, the applicants' trade mark attorneys referred to an earlier application made by the registered proprietors in these proceedings who had sought to register the same trade mark in respect of the same goods as in the registration which is the subject of these invalidation proceedings. The application, numbered 1411682 had been opposed by the applicants for invalidation. The Registrar's hearing officer in that case found the evidence sufficient to establish that the letters TCS were in common use in the trade in relation to the goods at issue by the relevant date, and consequently, to be neither adapted or capable of distinguishing for the purposes of Sections 9 and 10 of the Trade Marks Act 1938. A copy of the decision is shown as an annex to this decision.

Although the opposition proceedings were decided under the 1938 Act, it is well settled that the approach for registrablility under the 1994 Trade Marks Act is the same as under the 1938 Act, and that in essence, the requirements for registration under Section 3(1)(b) of the 1994 Trade Marks Act can be approximated to the threshold for registration under Section 10 of the 1938 Act (see AD200 trade mark case (1997) RPC 5 and the Messiah From Scratch trade mark application (As yet unreported).

The evidence filed in these proceedings is identical to that filed in the opposition proceedings. Having considered the material facts and the decision given in the opposition proceedings I find that there is nothing in the evidence which would lead me to a different conclusion to that reached by the hearing officer in the opposition, and accordingly, I find the application to be successful under Section 3(1)(b) of the 1994 Act.

Although I do not need to consider separately the ground set out under Section 3(1)(c), Section 3(1)(b) being wider in its ambit, I find that the evidence establishes that the mark applied for may serve, in trade, to designate a characteristics of goods, and that the application is also successful under Section 3(1)(c).

Having found that the mark may be regarded in the trade as a means of identifying the goods at issue, I do not see how it could be or become capable of distinguishing the goods of any one trader, and consequently, find the application to be successful under Section 3(1)(a) and Section 1(1)).

This leaves the matter of the grounds founded on Section 3(6) of the Act which reads as follows:

3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

In their statement of case, the applicants ask that the registration be declared invalid under Section 3(6) within the terms of Section 47(1) and Section 47(4). Section 47(4) does no more than provide an avenue by which the registrar himself may apply to the court for a declaration of invalidity of the registration and is not in itself a ground on which to base an application for a declaration of invalidity. It therefore follows that the ground founded on Section 47(4) must fail.

Section 3(6) does provide a ground for invalidation under Section 47(1). Although the evidence shows that the letters TCS were in use in the trade some considerable time before the application to register them as a trade mark by the now registered proprietors, there is nothing to suggest in that in making the application to register the term as a trade mark of their own the registered proprietors acted in bad faith. Accordingly, I find that the ground under Section 3(6) fails.

As the applicants have been successful they are entitled to a contribution towards their costs. I order the registered proprietor to pay the applicants for a declaration of invalidity the sum of £535.

Dated this 8 day of October 1999

Mike Foley
for the Registrar
The Comptroller General

THE TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 1411682
BY THE LOUIS BERKMAN COMPANY
TO REGISTER THE MARK TCS IN CLASS 6

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 46652
BY EUROCOM ENTERPRISES LIMITED

THE TRADE MARKS ACT 1938 (AS AMENDED) AND TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 1411682 BY THE LOUIS BERKMAN COMPANY TO REGISTER THE MARK TCS IN CLASS 6

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 46652 BY EUROCOM ENTERPRISES LIMITED

DECISION

On 5 January 1990 The Louis Berkman Company of West Virginia, United States of America applied under Section 17 of the Trade Marks Act 1938 to register the mark TCS for a specification of goods which reads "steel; sheet metal; metal building materials; goods made of, or predominantly of, common metal; all included in Class 6".

The application is numbered 1411682.

On 2 April 1997 Eurocom Enterprises Ltd of Ascot, Berkshire filed notice of opposition to this application. The grounds of objection are in summary:

(i) under Sections 9 and 10 in that the mark applied for is neither adapted to distinguish or capable of distinguishing the applicants' goods

(ii) under Section 11 in that the mark is calculated to deceive or cause confusion

(iii) under Section 68 in that it is not a trade mark within the meaning of the Act.

The opponents also ask the Registrar to refuse the application in the exercise of his discretion.

The applicants filed a counterstatement denying the above grounds.

Both sides ask for an award of costs in their favour. Only the opponents filed evidence. Neither party has requested a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

By the time this matter came to be decided the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

Opponents' Evidence

The opponents filed a statutory declaration dated 29 April 1998 by Francois Moal, their Managing Director.

He comments as follows:

> "Terne coated stainless steel, or terne coated steel ("the goods"), has a highly specialised United Kingdom market. Terne coated steel, zinc and copper belong to the "fully supported metal roofing" speciality. The amount of work for all fully supported metals concerns 20 - 25 companies in the United Kingdom. The Metal Roofing Contractors Association, which is the relevant trade association, has 15 members. It is clear that terms which are very common within the particular trade could be less well-known outside it".

Terne coated steel is, he says, referred to as TCS. In support of this he exhibits the following:-

FM1 - documents provided by Trainready Ltd referring to type 316 Terne Coated fully softened stainless steel roof as TCS. The goods are said to be manufactured by Lee Steel Strip Ltd.

FM2 - a photocopy of the architectural plans for HM Prison Manchester by Austin Smith Lord in which the architect describes "TCSS Roof sheeting" and on the second page, "Terne coated stainless steel" is abbreviated to TCSS.

FM3 - a document from Fellden Clegg Design relating to the Francis Close Hall Catering Building. Pages 2 and 3 of this document show roof sketches where TCSS is said to be used as a generic term.

FM4 - a photocopy of a facsimile from John Seeley of Kershaw Mechanical Services Limited relating to a delivery of TCS goods.

The above examples are all dated from 1992 and 1993 and are said to show that TCS has been generic since at least that time (in fact I note that FM2 actually carries an earlier date).

Mr Moal says that in view of the present proceedings his company sent a blank questionnaire to twenty companies and fourteen responded. Photocopies of the responses are exhibited at FM5. I should comment in passing that the original documents are said to have been filed in relation to parallel invalidity proceedings. Nine of the fourteen respondents are members of the Metal Roofing Contractors Association and five companies which are not members of that Association have also responded. Two of the companies have stated that the term TCS has been familiar to them since 1980, and each company stated that TCS is a generic term. An example of the questionnaire is at Annex A.

As a result of all this Mr Moal concludes as follows:

> "It is my belief, which the above evidence shows is shared by many others within the trade, that TCS is a generic term and does not designate goods of any one particular origin. Registration of the term as a mark would therefore make ordinary trading practices impossible for metal roofers, for architects and for consultants. The term is in constant use as a generic and its registration would greatly hinder the normal and fair use of the term in relation to the particular goods, terne coated steel or terne coated stainless steel".

That concludes my review of the evidence.

Although the opponents have based their case on a number of different grounds in practice the issue at the heart of this dispute is whether TCS is a generic term in the trade for the goods at issue or at least goods that would fall within the terms used in the applicants' specification. I will, therefore, begin by considering the matter under Section 9 and 10 but in the knowledge also that my findings under this head are likely to have a bearing on the other grounds as well.

Sections 9 and 10 read as follows:-

> "9. - (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-
>
> (a) the name of a company, individual, or firm, represented in a special or particular manner;
>
> (b) the signature of the applicant for registration or some predecessor in his business;
>
> (c) an invented word or invented words;
>
> (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
>
> (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.
>
> (2) For the purpose of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or

may be connected in the course of trade from goods in the case of which no such connection subsists, either generally, or where the trade mark is registered or proposed to be registered subject to limitations in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which -

(a) the trade mark is inherently adapted to distinguish as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

10(1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof".

The applicants have filed no evidence of their own so I have no information before me as to the precise goods of interest or what use, if any, they have made of the mark. I therefore have only the prima facie case to consider.

It seems to me that as a general principle it is not necessarily fatal to an applicants' case that his mark is composed of letters which may from his point of view have some underlying signification in relation to the goods or the character and quality of those goods. Where that signification is known only to the proprietor of the mark, is not required for legitimate reasons by either traders and does not convey any established meaning to the trade and public at large it is quite possible that a valid claim to registration can be made.

It is more difficult to see how any individual or organisation can claim that a mark distinguishes his goods from those of other traders where it has passed into the common language of the trade and no steps have been taken to assert and protect any possible trade mark rights.

In the absence of counter evidence from the applicants I will say at the outset that the opponents appear to have established a strong prima facie case against the mark TCS. They have demonstrated that a number of organisations are using TCS either in close association with the words terne coated steel (thus emphasising its significance as an abbreviation) or on its own in circumstances which suggest that the trade would understand full well that it was being used generically to indicate a type of product rather than as an indication of trade origin.

There are just a couple of points that call for further comment. I note that in practice two abbreviations are used TCS and TCSS indicating terne coated steel and terne coated stainless steel respectively. I do not think this detracts from the opponents' case. It is clear from the exhibits that the trade recognises and uses both forms. The second point is that the material date in these proceedings is the application filing date of 5 January 1990. Exhibits FM1 to 4 show dates between 1991 and 1993. It might, therefore, be said that these exhibits do not conclusively prove the case against the mark in January 1990 even allowing for the difficulties the opponents face in establishing the position retrospectively. I will return to this point in the context of the questionnaire evidence (exhibit FM5) which I now go on to consider.

The opponents say, and the applicants have not disputed, that the trade concerned (metal roofing) is concentrated in the hands of a limited number of companies, though I am not entirely clear whether this refers to manufacturers or installers/contractors. In any event the 20 companies circulated must presumably represent a significant proportion of the industry. A high percentage (70 per cent) of those circulated responded. I have some reservations about the questionnaire. The first question in particular should have been framed in more neutral terms. Also the respondents do not appear to have been asked to give their positions or experience nor have they confirmed their responses in statutory declarations of their own. Against this the applicants have not challenged any of this material or adduced evidence of their own to the contrary. In these circumstances I consider that I am entitled to draw my own conclusions from this evidence notwithstanding that in different circumstances it might have come under more critical scrutiny. The unanimous reaction of the respondents is that TCS means terne coated stainless steel. Of particular interest for present purposes however are the answers given to the second point "The term TCS has been familiar to us since the year..... approximately". Two replies indicated 1980 and a further six gave dates and periods which suggest the term has been in use since the early to mid 1980s. A further four gave later dates (1992 to 1995) and two gave no date at all.

I conclude from this that TCS was in use for some considerable time before the filing date of the application in suit. Taking the evidence as a whole the opponents have in my view established their case that TCS was in common use in the trade in relation to the goods at issue by the material date. It follows that it is neither adapted to distinguish the goods of the

applicants nor capable of so distinguishing for the purpose of Sections 9 and 10 respectively. The opposition succeeds in this respect.

Section 11 reads:

> **"11.** It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design".

The applicants' specification appears to embrace the sort of goods for which TCS is a wholly descriptive term. As terne coated steel appears to have specific applications in the trade and, in particular, features in building specifications it seems to me that confusion and deception must necessarily result if products of other than this type were offered. As no restriction or qualification of the trade mark specification has been offered to overcome this point the opposition also succeeds under Section 11.

Section 68 in so far as is relevant reads:

> "trade mark" means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section thirty-seven of this Act:"

In the light of my above findings I cannot see how TCS can perform the function of a trade mark for the goods in respect of which it is objectionable. The applicants have not indicated any other goods which might fall within the broad terms in their specification to which the objection would not apply. Section 68 is, of course, an interpretation Section of the Act but if the mark proposed cannot bring itself within the above definition it must also fail at the outset to meet the requirements of Section 17(1). The opponents also, therefore, succeed on this ground. For obvious reasons I do not need to consider separately any exercise of discretion.

As the opponents have been successful they are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £635.

Dated this 11 day of January 1999

M REYNOLDS
For the Registrar
The Comptroller General

ANNEX A

[redacted]

COMPANY : A + J Roofing Specialists Ltd.

We confirm receiving on a regular basis tender documentation where the term TCS is clearly used as a generic acronym for terne coated stainless steel.

YES ☑ NO ☐

The term TCS has been familiar to us, since the year 1980 approximately.

Within our company, the term TCS is used for any of the Terned/terne coated stainless steel commercially available.

YES ☑ NO ☐

DATE : 2/4/97

NAME : Bill Spencer

SIGNATURE :