

O-009-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2484048
BY ROBERT MCBRIDE LIMITED TO REGISTER THE TRADE MARK**



IN CLASS 3

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO. 98138
BY EXPRESS CLEANING SUPPLIES LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No. 2484048
by Robert McBride Limited to register the trade mark**



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**IN THE MATTER OF Opposition thereto under No. 98138
by Express Cleaning Supplies Ltd**


BACKGROUND

1) On 4 April 2008, Robert McBride Limited (“McBride”), of Middleton Way, Middleton, Manchester, M24 4DP applied under the Trade Marks Act 1994 (“the Act”) for registration of the above shown mark in respect of the following goods in Class 3:

“Bleaching, cleaning, scouring, polishing, abrasive and laundry preparations; washing preparations, detergents.”

2) The application was published in the Trade Marks Journal on 25 July 2008 and on 27 October 2008, Express Cleaning Supplies Ltd. (“Express”) of Unit 14, 190 Malvern Common, Poolbrook Road, Worcestershire, WR14 3JZ filed notice of opposition to the application. The grounds of opposition are in summary:

- a) McBride’s mark is identical or similar with an earlier mark belonging to Express and is in respect of identical or similar goods or services. The mark therefore offends under Section 5(2)(a) and Section 5(2)(b) of the Act. Express relies on two earlier marks, the relevant details of which are reproduced below:

Mark Details	Specification of goods and services
<p>2389697A</p>  <p>Filing Date: 16 April 2005</p> <p>Registration Date: 7 March 2008</p>	<p>Class 7</p> <p>Cleaning machines, including dust exhausting installations for cleaning purposes, dust removing installations for cleaning purposes, cleaning machines utilising steam, drying machines, washing machines, high pressure washers, rinsing machines, sweeping machines, wax polishing machines, polishing machines, tools; parts and fittings for the aforesaid machines; motors and engines (except land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand operated; incubators for eggs; vacuum cleaners.</p> <p>Class 9</p> <p>Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire extinguishing apparatus; computer software (including software downloadable from the Internet).</p> <p>Class 35</p> <p>Advertising; business management; business administration; office functions.</p> <p>Class 41</p> <p>Education; providing of training; entertainment; sporting and cultural activities; providing of training online.</p>
<p>2389697B</p> <p>I-CLEAN</p> <p>Filing and registration dates as above</p>	<p>As above</p>

b) The application offends under Section 5(4)(a) of the Act because Express has unregistered rights in two signs it uses in the course of trade that correspond to those shown above. Express claims that its signs have been used in the UK since at least as early as April 2005.

3) The applicant subsequently filed a counterstatement denying Express' claims and putting it on notice to provide evidence of goodwill to substantiate a claim for passing off.

4) Both sides filed evidence in these proceedings and Express also filed written submissions. Both sides ask for an award of costs. The matter came to be heard on 11 November 2010 when Express was represented by Simon Malynicz of Counsel instructed by Barker Brettell LLP and McBride represented by Keith Hodgkinson of Marks & Clerk LLP.

Opponent's Evidence

5) This is in the form of a witness statement by Robert M D Boxall, Managing Director of i-Clean Systems Limited. He explains that this company formed part of Express and that he is also managing director of Express. In 2006, i-Clean Systems became a limited company in its own right and it has used the i-Clean mark with the full consent of Express.

6) Mr Boxall explains that Express' earlier marks were used in the UK at least as early 2005 and that they have been used continuously since and in relation to "consultancy for the management of cleaning services, including the selection and application of associated cleaning equipment and chemicals". He explains that "i-Clean is [...] a framework of services that help customers manage the cleaning process from end to end regardless of whether the service is being delivered directly or through a third party. As part of this service, [his company] has developed an award winning software application that can produce the most accurate site specific schedules and financial analysis available to determine a client's cleaning requirements [...]."

7) At Exhibit A, he provides literature showing the nature of the services provided under the earlier marks. This literature is in the form of an undated brochure (but some of the inserts carry copyright notices dated either 2007 or 2008) outlining the services provided under the i-Clean mark, as identified in the previous paragraph, and also provides a series of case studies featuring customers such as Hampshire County Council, The Royal Hospital for Neuro-disability, Worcestershire's health trusts and London City Hall. One other item is provided. It appears to be a copy of a two page article entitled "Efficiency as Standard" from an unidentified and undated periodical. It is an article under the banner "Software" about Express' i-Clean's modular software system designed to increase efficiency of cleaning projects.

8) Mr Boxall states that both earlier marks have been used extensively throughout the UK and that i-Clean is currently the only cleaning management system which has received full endorsement from the British Institute of Cleaning Science (BICSc), being the largest independent professional and education body within the cleaning industry.

9) Mr Boxall provides turnover figures relating to the sale of goods and provision of services under the earlier marks. These are subject of a Confidentiality Order and are as follows:

Year	Turnover (£)
2005/6	
2006/7	
2007/8	

10) At Exhibit D, Mr Boxall provides examples of various promotional materials. The first bundle of items includes undated single page information sheets about i-Clean services with titles such as “Tender Management – specialist evaluation of cleaning service provision”, “Pre-Survey – improve standards and reduce costs” and “Module 1 Specify – Setting the standards”. Also included is a four page document entitled “i-Clean Systems Ltd – Nominal Activity”, dated 9 March 2009. This provides details of promotional activities recorded as, for example, “cleaning matters ad”, “fac man journal” and “google adwords”. There are a total of 228 entries within a date range of 25 June 2006 to 9 February 2009. Copies of advertisements are also provided that appear in publications such as “Facilities Management UK” and various news items about the company in trade publications. A number of press articles with hand written dates ranging from the last quarter of 2006 to January 2007 announce that the former director of the CBI, Sir Digby Jones, joined i-Clean as a non-executive director.

11) Exhibit D also contains copies of pages from i-Clean’s own website. Mr Boxall explains that it has been operated since 2006 and the number of visitors each year, to this website, is as follows:

Year	No. of hits
May – Dec 2006	3393
2007	9919
2008	14,515
Jan – Feb 2009	2691

12) Express also provides additional exhibits as part of written submissions provided by its representative Barker Brettell LLP, dated 29 April 2009. Whilst not in the accepted format, I will summarise them here. They consist of a series of Internet extracts all dated 28 April 2009 illustrating the following:

- That a number of cleaning or washing machine producers also produce ranges of cleaning or washing preparations. The extracts relate to the

following brands: *Rug Doctor, Dyson, Hoover, Hotpoint, Vax, Bissell and Miele*;

- A company called *Dirt Devil* providing both cleaning machines and preparations, but it is unclear if this is a specialist cleaning retailer or whether it is a cleaning machine producer;
- A number of retail websites provided by “real world retailers” selling both cleaning and washing machines as well as cleaning preparations. These are *Homebase, Debenhams, John Lewis, Sainsburys, Focus DIY, Littlewoods* and *Argos*.

Applicant’s Evidence

13) This is in the form of a witness statement, dated 10 June 2010, by Heather Mills of Marks & Clerk LLP, McBride’s representatives in these proceedings. Ms Mills provides four exhibits:

- Exhibit HW1 contains two examples of McBride’s use of its mark on containers containing cleaning solutions.
- Exhibit HW2 consists of three Internet extracts allegedly showing “generic use of the mark i-Clean”. The first is a product available on Amazon.co.uk entitled “Monster® iClean Screen Cleaner”. The second is from the same source and showing containers of the same product. The final extract is from iclean.org.uk promoting a company called “iCLEAN Cleaning Services Ltd”. “iCLEAN” appears in the text on a number of occasions when referring to the company.
- Exhibit HW3 is a copy of a search result obtained from the Marquesa trade mark search system illustrating that 349 marks covering Class 3 goods incorporate the word “clean”.
- Exhibit HW4 is a definition of the word “clean”, obtained from the Collins English Dictionary, identifying “1. Without dirt or other impurities, unsoiled”.

Opponent’s Evidence in reply

14) This is in the form of a witness statement, dated 5 August 2010, by Julia A. House of Barker Brettell LLP, Express’ representatives in these proceedings. This consists exclusively of a critique of Ms Mills’ evidence. I will not detail this here but I will bear it in mind.

DECISION

Section 5(2)(a) and Section 5(2)(b)

15) At the hearing, Mr Malynicz confirmed that Express did not intend to pursue the grounds of opposition based upon Section 5(2)(a) and I do not intend to comment further on these grounds.

16) Section 5(2)(b) reads:

“(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.”

17) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

18) Express relies upon two registered marks and these qualify as earlier marks as defined by Section 6 of the Act. Further, as they both completed registration procedures less than five years before the publication of McBride’s mark they do not fall foul of the proof of use provisions set out in Section 6A of the Act.

19) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) in determining whether similarity between the goods or services covered by two marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) 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; 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; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

Comparison of goods

20) In assessing the similarity of goods, it is necessary to apply the approach advocated by case-law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

‘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.’

21) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

22) At the hearing, Mr Malynicz stated that he considered Express’ best case to be in respect of a limited number of its Class 7 goods and abandoned the opposition in respect of Express’ other goods. The goods relied upon by Express are included in the table below where I list the goods to be compared:

Express’ Goods	McBride’s Goods
<i>Cleaning machines, [...], washing machines, [...] wax polishing machines, polishing machines, [...] parts and fittings for the aforesaid machines</i>	<i>Bleaching, cleaning, scouring, polishing, abrasive and laundry preparations; washing preparations, detergents</i>

23) Express’ goods are all types of apparatus for use in cleaning, washing or polishing. McBride’s goods are all substances with the same purpose. As such, they are different in terms of nature but similar in terms of purpose. Their methods of use may be different, for example, *cleaning machines* will be

operated by the user and involve some level of technical application whereas a cleaning preparation may merely be applied by cloth to a surface. On the other hand, *cleaning preparations* may be specifically formulated for use with a cleaning machine and, in such circumstances, there will be a close connection between the machine and the preparation, in the sense that the machine is indispensable or important for the use of the preparation, leading customers to think that the responsibility for both the machines and the preparations lies with the same undertaking. This would lead to a conclusion that the respective goods are "complementary" in the sense articulated by the General Court (GC) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*. The same argument applies in respect of *washing machines/washing preparations* and *polishing machines/polishing preparations*.

24) Express provided material on this complementarity point as part of written submissions. At the hearing, Mr Hodkinson specifically stated that he did not wish to challenge the admissibility of this and I will make no more of it here. Whilst not being determinative in any way, this material does lend some support to the conclusion I reached in the previous paragraph. It illustrates that a number of cleaning machines producers also provide cleaning preparations. This material was obtained over a year after the filing date of McBride's mark, but refer to established brands such as *Dyson* and *Hoover* and I am prepared to accept that this evidence is indicative of the activities of these traders at the time McBride filed its application. Cleaning goods are not an area of rapid innovative change and I take the position in 2009 to be essentially the same as in 2008. The material illustrates seven producers of cleaning or washing machines also providing a range of cleaning products. This does at least illustrate that there is some overlap in trade channels.

25) The material also illustrates that a number of online retailers sell both cleaning machines and cleaning preparations. This is less supportive of my view that there is some overlap or trade channels. The online offerings from the likes of *Sainsburys*, *John Lewis* and *Homebase* are similar to their real world equivalents where they sell a wide range of products, but just because a shop sells, for example, tomatoes and candles, it does not mean that these goods share any similarity.

26) Mr Hodkinson argued that none of the material assists Express because as it relates to very well known names and that the conclusions drawn by the consumer upon being exposed to cleaning products and washing machines may differ dependent on whether the mark is well-known or not. However, the material illustrates that there are at least seven manufacturers offering cleaning preparations for sale. This suggests to me that the practice is reasonably wide spread. Further, whilst I am prepared to take judicial notice of the fact that brands such as *Hoover* and *Dyson* are household names, the material also shows other brands, such as *Rug Doctor*. There is no material or evidence before me to

demonstrate that such brands are also household names and it is not appropriate to accept so on judicial notice.

27) Taking all of the above into account, and acknowledging the overlap in respect of intended purpose and in, at least, part of the respective trade channels there is clearly some similarity between the respective goods, even if this is not particularly high.

The average consumer

28) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods and services at issue. In respect of Express' cleaning, washing and waxing machines, the average consumer will be those persons whether retail consumers or traders who have a need to clean, wash or wax something. Generally, the cost of such machines will be more than for everyday consumer goods and, as such, the purchasing act will be more considered than the norm but not necessarily involving the highest level of consideration.

29) The average consumer of McBride's goods will be the same as for Express' goods, namely retail consumers and traders with a cleaning need. However, McBride's goods will generally be of lower value and are likely to be purchased on a more regular basis, possibly as part of regular supermarket shopping trips. As such, the level of consideration is likely to be lower than that of Express' goods.

Comparison of marks

30) For ease of reference, the respective marks are:

Express' mark	McBride's mark
	

31) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23).

32) Express' case is not appreciatively different in respect of its unstylised mark and I will therefore compare its word and device marks with McBride's mark. From a visual perspective both marks share the letter "i" and the word "clean" separated by a hyphen. In Express' marks, the dot over the "i" is slightly stylised in that it is slightly enlarged when comparing it with the "arm" of the letter. It is also in a different colour in its first mark and a lighter shade in the second of Express' marks as are the dashes between the letter "i" and the word "clean". The "dot" in McBride's mark is consistent with the style of the arm of the letter "i". Another point of difference is that the word "clean" in Express' mark is in lower case, whereas in McBride's mark it is in capital letters. Express' mark also includes a "swoosh" type device in the same colour/shade as the dot of the letter "i". McBride's mark includes a disc shaped background. Whilst the respective devices are different, Express' swoosh is suggestive of an edge of a disc, providing an increased level of similarity that may not be obvious from a written description. Taking account of these differences and similarities, I conclude that the respective marks are visually highly similar.

33) From an aural perspective, the marks are identical, both pronounced with the two syllables "EYE CLEEN".

34) Conceptually, the device elements do not influence the marks and as the letter and word elements are identical, it follows that any conceptual identity possessed by one will also be possessed by the other. The relevance of the letter "i" in both marks is not clear. It may be a reference to "Internet", to "interactive" or to the first person singular, but it is not obvious that it refers to any of these or to anything else. The word "clean", on the other hand, has a direct and obvious meaning relevant to all the respective goods. The conceptual identity of both marks is therefore of a cleaning product codified, for some unknown reason, by the letter "i". Therefore, to the degree that the respective marks have a conceptual identity, it is identical in both marks.

35) Taking account that I have found the respective marks share a high level of visual similarity and that they are aurally and conceptually identical leads me to conclude that the respective marks share a high level of similarity overall.

Distinctive character of the earlier trade mark

36) I have to consider whether Express' marks have a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of them. They both consist of the letter "i", the word "clean" and swoosh-type device. Whilst the word "clean" is a clear inference to a characteristic of the goods, taking the marks, as a whole, they do not send any clear message and therefore have a moderate degree of inherent distinctive character.

37) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. This was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

38) As Mr Boxall himself explained in his evidence, Express’ earlier marks have been used in respect of “consultancy for the management of cleaning services...” and possibly in respect of a software application. However, these goods and services are not relied upon by Express, as explained by Mr Malynicz at the hearing. I therefore conclude that the distinctiveness of Express’ marks is not enhanced through use.

Likelihood of confusion

39) McBride points to the fact that the word “clean” has a very low level of distinctiveness in respect of the relevant goods, citing the 349 times it is used as part of a trade mark for Class 3 goods. I note this, as do I note that I must adopt the global approach advocated by case-law. In doing so, I recognise that the word “clean” is only one element of two composite marks.

40) McBride also claims that the term “i-Clean” is a generic term and provides some Internet extracts to support this. All three of these extracts shows “i-Clean” being used as part of a product name or as the name of a cleaning services

company. It is far from clear that the use is generic, as McBride claim. As such, I am not persuaded by this evidence.

41) I have found that the respective marks share a high level of similarity, with Express' marks having a moderate degree of inherent distinctive character that is not enhanced through use. There is some similarity between the respective goods, but this is not particularly high. The average consumer of McBride's goods may be the same as for Express' goods, but the purchasing act will be more considered in respect of Express' goods. Taking all of these factors into account and also that marks are rarely recalled perfectly, with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27), I conclude that the consumer is likely to assume that goods sold under the one mark originate from the same or linked undertaking as those goods sold under the other mark.

42) Express is therefore successful in its opposition based upon Section 5(2)(b) of the Act.

Section 5(4)(a)

43) As a result of Express' success in respect of its grounds based upon Section 5(2)(b) of the Act, it case cannot be improved, however, for the sake of completeness, I will comment briefly on the grounds based upon Section 5(4)(a). That section reads as follows:

“5.-(4) 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”.

44) The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents' goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

45) The relevant date for determining the opponent's claim, in the absence of any competing earlier claim on the part of the applicant, will be the filing date of the application in suit, that is to say 4 April 2008. The earlier right must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104 on which the UK Act is based).

46) I must first assess if the opponent has acquired any goodwill and, if so, what is the extent of this goodwill at the relevant date. In his evidence, Mr Boxall stated that Express' earlier marks were used in the UK at least as early 2005 in relation to "consultancy for the management of cleaning services". Turnover figures are also provided to support this claim. This evidence is sufficient to demonstrate that, by the relevant date, Express had goodwill in respect of these services.

47) Having reached this conclusion, I must go on to consider if there has been misrepresentation and whether any such misrepresentation is such as to cause damage to Express. In this respect, I am mindful of the comments of Morritt L J in the Court of Appeal decision in *Neutrogena Corporation and Anr. V Golden Limited and Anr.* [1996] RPC 473 when he confirmed that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of the opponent's customers or potential customers would be misled into purchasing the applicant's products in the belief that it was the opponent's. Further, Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL, stated that the opponent must show that "he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill".

48) In the current case, both Express' and McBride's marks contain the letter and word "i-Clean" together with respective devices that I have already found to be reminiscent of "disc" type shapes. However, there is no evidence before me that it is common in the trade for cleaning consultants to also produce own branded cleaning preparations. As such, I conclude that a case for misrepresentation has not been made out because it is unlikely that a substantial number of Express' customers or potential customers will assume that McBride's business is the same or linked to Express' business.

49) In summary, I find that Express' opposition fails in respect of its Section 5(4)(a) grounds, however, as it is successful in respect of its Section 5(2)(b) grounds, the opposition is successful and McBride's mark is refused for all goods.

COSTS

50) The opposition having succeeded, Express is entitled to a contribution towards its costs. I award costs on the following basis:

Filing fee & preparing statement	£500
Preparing and filing evidence	£600
Considering evidence	£350
Preparing for and attending the hearing	£600
TOTAL	£2050

51) I order Robert McBride Limited to pay Express Cleaning Supplies Ltd. the sum of £2050. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17 day of January 2011

**Mark Bryant
For the Registrar,
the Comptroller-General**