

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

**IN THE MATTER OF APPLICATION NO 1488886
BY PENTECH INTERNATIONAL INC
TO REGISTER THE MARK GRIPSTIX IN CLASS 16**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO 38398 BY THE GILLETTE COMPANY**

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by Pentech International Inc
to register the mark GRIPSTIX in Class 16**

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**IN THE MATTER OF Opposition thereto
under No 38398 by the Gillette Company**

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DECISION

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On 27 January 1992 Pentech International Inc of New Jersey, United States of America applied under Section 17(1) of the Trade Marks Act 1938 to register the mark GRIPSTIX in Class 16 for a specification of goods comprising “writing instruments; pens; pencils, and markers”.

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The application is numbered 1488886.

On 1 February 1994 The Gillette Company of Boston, United States of America filed notice of opposition to this application. The grounds of opposition are in summary:

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- i under Sections 9 and 10 of the Act in that the mark applied for is descriptive of and non-distinctive for stick pens with a particular type of grip.
- ii under Section 11 by reason of the opponents’ use of and reputation in what they term their GRIP family of registered marks.

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Details of the marks referred to above are as follows:

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NO	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
1296702	FLEX-GRIP	16	5951/8581	Writing and drawing instruments; parts and fittings and containers included in Class 16 for all the aforesaid goods; inks and ink refills for pens.

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	NO	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
5	1507065	FLEXGRIP PLUS	16	6059/0244	Writing and drawing instruments; parts, fittings and containers for all the aforesaid goods; inks and ink refills, all for pens; all included in Class 16.
10	1522052	DYNAGRIP	16	6021/2393	Writing instruments and drawing instruments; markers; inks; refills for pens; pencil lead refills; parts, fittings, cases, holders and containers for writing instruments and drawing instruments, for markers, for pen refills and for pencil lead refills; printed matter, books, periodical publications; stationery; office requisites (other than furniture); materials fluids and thinners for use in the correction of errors and for making amendments; adhesive materials (stationery); artists' materials, paint brushes; all included in Class 16.
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Numbers 1507065 and 1522052 were applications at the time opposition was filed but have since progressed to registration.

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

The applicants filed a counterstatement denying these grounds and making a number of observations on the opponents' claims, the state of the register and the marks themselves. I will deal with these issues in the body of the decision.

Both sides seek an award of costs in their favour.

Both sides filed evidence in these proceedings and the matter came to be heard on 22 April 1998 when the opponents were represented by Mr C Morcom of Her Majesty's Counsel instructed by Gillette Management Inc and the applicants were represented by Mr D Alexander of Counsel instructed by Stevens, Hewlett & Perkins, their Trade Mark Agents.

By the time this matter came to be heard, 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.

5 Opponents' evidence

10 The opponents filed a statutory declaration dated 31 March 1995 by Andrew James Redpath, the Assistant Secretary of The Gillette Company. He has been employed by his company for 27 years. He is also a Director of Gillette U.K. Ltd, a wholly owned subsidiary responsible for the manufacture and/or marketing of products in this country.

15 Mr Redpath says that his company first became involved with writing and drawing instruments in September 1955 through the acquisition of a Californian Corporation named Frawley Corporation. Frawley Corporation had introduced in the early 1950s, a ball point pen under the trade mark PAPER MATE and by virtue of that acquisition, his company acquired all rights in and to the trade mark PAPER MATE.

20 In addition to trade marks referred to in the summary of grounds the opponents are proprietors of FLEXGRIP ULTRA (No 1567238). Mr Redpath exhibits (AJR1) copies of Trade Mark Journal advertisements and a filing receipt in support of this. Collectively he refers to these registrations and applications as the GRIP marks. He says that the trade mark FLEXGRIP has been used since early 1988 within the United Kingdom and throughout the world and the trade mark DYNAGRIP has been used since 1992, also in the United Kingdom and throughout the world, both on a very extensive scale in relation to writing and drawing
25 instruments. He exhibits (AJR2) a table representing sales by volume and value from 1988 to 1994 for products bearing the 'GRIP MARKS'. The precise details are the subject of a confidentiality order but have been communicated to the applicants in these proceedings. Sales of products under the GRIP marks have extended throughout the United Kingdom. An extensive list of major towns and cities is given in support of this claim. The goods have
30 been extensively promoted. Advertising and promotional expenditure for PAPERMATE and "liquid paper products" is given for the years 1990 to 1994 in Exhibit AJR3 (AJR3 is also the subject of a confidentiality order). Mr Redpath says that it is not possible to breakdown the figures to show expenditure on GRIP mark products alone as it is not uncommon for entire ranges of goods to be advertised at any one time. He goes on to produce (AJR4) specimens
35 of product packaging, leaflets and advertising material illustrating the manner in which the GRIP marks are used. These items are said to have been in use between 1988 and 1994.

40 Mr Redpath makes a number of observations on the issue of confusion (I take these into account in reaching my decision) and claims in relation to the goodwill and reputation attaching to his company's GRIP marks. Dealing with the applicants' mark he says that the word 'STICK' or its phonetic equivalent is commonly used within the stationery trade to describe slim barrelled non-retractable pens. He exhibits (AJR5) photocopies from stationery journals and magazines where writing instruments have been described as 'STICKS'.

Mr Redpath says he is advised that the mark applied for consists of the ordinary English word 'GRIP' and the phonetic equivalent of the non-distinctive word 'STICK' conjoined, the whole being descriptive of and non-distinctive for a stick pen with a particular grip.

5 Pens sold on behalf of his company, bearing the mark FLEXGRIP, are sold to customers, packaged and labelled as 'FLEXGRIP STICK'. Mr Redpath exhibits (AJR6) specimens of packaging which illustrate FLEXGRIP products with the descriptive suffix 'STICK'. I add here that the mark PAPERMATE is shown prominently on the packaging and the mark on the actual pen exhibited is PAPER MATE FLEXGRIP.

10 Mr Redpath also exhibits (AJR7) a statutory declaration dated 30 March 1995 by Alan William McIntyre, the Marketing Manager for Europe for Gillette Management Incorporated, who is responsible for the sale of PAPERMATE and liquid paper products. Mr McIntyre comments as follows:

15 "Several pens are manufactured by my company where the type of pen has been referred on both the packaging and labelling as a 'Stick', for example PAPERMATE'S FLEXGRIP STICK Ballpen and the PAPERMATE '2000' STICK. I am also aware that at least two of my company's main competitors BIC and
20 STAEDTLER also supply products which refer to non-retractable pens with a slim barrel as 'STICK' pens or a phonetic equivalent.

It is my belief that within the Stationery Trade and invariably with the purchasing public that the word 'STICK' when used on packaging or labelling of writing
25 instruments or on the item itself is regarded as describing the type of pen being purchased and is not considered to be incorporated in the name of the product itself. I have based such beliefs on my experience and knowledge of the stationery trade.

30 My company markets a full range of FLEXGRIP pens, which includes, FLEXGRIP Stick, FLEXGRIP Retractable, FLEXGRIP Roller and FLEXGRIP Highlighter. The trade mark FLEXGRIP is followed by what product in the range the pen is, the stick pen is therefore known as the 'FLEXGRIP Stick'."

Mr Redpath concludes from this that the word STICK is the common description for certain
35 types of pens. As a result he says that his company's mark FLEXGRIP sold as FLEXGRIP STICK wholly incorporates the term GRIP STICK which is phonetically equivalent to the proposed mark GRIPSTIX. He believes that confusion and deception of the public would result.

40 Applicants' evidence (Rule 50)

The applicants filed a declaration dated 3 December 1996 by Jan Verkade, the Director of the European office of Pentech International Inc in Holland. He has been employed by his
45 company since 1 July 1992. He makes his declaration on the basis of facts within his own knowledge, company records and information provided by his United Kingdom trade mark attorneys. He confirms that he has a competent command of the English language.

Mr Verkade says that his company coined the mark GRIPSTIX in early 1985. First use in commerce was in the United States in July 1985. In the following month a trade mark application was made which became United States Trade Mark Registration No 1567054. The company applied to register GRIPSTIX in the United Kingdom on 27 January 1992 and first used GRIPSTIX in the United Kingdom on 19 June 1993 on what he calls “fashion pencils”. The range has not expanded to include other writing instruments.

The pencils are sold to the UK public in two forms, loose and “carded”. Loose pencils sell for between 30p and 50p each. Carded pencils sell for between £1.49 and £2.99. Mr Verkade exhibits (JV1 to JV4) trade brochures showing how the goods are sold along with a carded pack of GRIPSTIX pencils.

Mr Verkade says that the pencils are sold by his company’s UK distributors to retail stores including WH Smith, John Lewis Partnership, Menzies and Makro Cash & Carry. The company does not keep records of the various towns and cities in the United Kingdom where the goods are sold.

Since 19 June 1993 wholesale sales of GRIPSTIX pencils to UK distributors have been as follows:

YEAR	SALES US\$
1993	1430.04
1994	1134.12
1995	3702.24
1996 (Year to Date)	1739.52

The company does not directly advertise any of its products in the United Kingdom but in 1995 his company had a stand and exhibited at the Statindex Spring Fair at the NEC in Birmingham. An extract from the exhibitors’ guide book in confirmation of this is at JV5.

Turning to Gillette’s claims Mr Verkade says that he does not accept that they have a “family” of GRIP marks and suggests that such a claim is inconsistent with the statement that the word GRIP is an ordinary English word. He exhibits (JV6) reference material supplied to him by his trade mark attorney showing, it is said, all the UK trade marks lodged by Gillette in Class 16. He also denies that the word STICK is used in a purely descriptive way in the trade by reference back to the opponents’ exhibits. He suggests that the word STIC is used by another company, BIC, (in Exhibit AJR5) in such a way as to indicate that it has brand name significance and that Staedtler’s use of the word is in relation to a product which is described in the text as a ball-point pen. He concludes that Mr Redpath’s evidence does not establish that the word STICK or the phonetic equivalent is used interchangeably with the words “pens” or “ballpens” nor does it establish any use in relation to pencils.

Mr Verkade goes on to deal with the issue of confusion and points out that Mr Redpath does not point to any instances of actual confusion. Nor is he personally aware of any instance of confusion. He offers a number of observations on the likelihood of confusion (or rather the

absence of it in his view). I bear his comments in mind in reaching my decision. He then comments in detail on what he perceives as weaknesses in the evidence of use adduced by the opponents. In essence he considers the information to be generalised and unreliable particularly as it suggests that entire ranges of goods are advertised together.

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Mr Verkade claims that Gillette has not used or tried to register GRIP on its own. He considers that this would have been consistent with the claims they are making. Instead he says they have chosen to register different GRIP names in combination.

10 Finally, in relation to Mr Redpath's declaration, he points out that his company's use of their mark is on "fashion pencils" whereas Gillette use their mark on conventional ball-point pens. For this reason and because of the graphics appearing on his company's goods he does not believe that there will be confusion. He says that Gillette's registered mark is FLEXGRIP, not FLEXGRIP STICK and there has been no attempt to register the latter and only
15 inconsistent use of the word STICK with FLEXGRIP. He therefore rejects the conclusions that Mr Redpath seeks to draw.

Opponents' evidence in reply (Rule 51)

20 The opponents' reply evidence comes in the form of a further statutory declaration, dated 6 June 1997, by Andrew James Redpath. He firstly comments on the applicants' evidence of use and suggests that their United Kingdom sales are minimal. His comments in all run to some 11 pages of detailed comment. I do not think I need record every point in the evidence summary but I confirm that I take into account all the points made in reaching my own
25 conclusions. Briefly Mr Redpath

- comments on the applicants' exhibits
- says that it was not his company's intention to seek a monopoly in the word GRIP per se. It merely serves as an identifier for a family of marks which
30 incorporate the word GRIP to form distinctive totalities. He maintains his view about the non distinctive and descriptive nature of the applicants' mark.
- offers comments on the elements ULTRA and PLUS in his company's
35 FLEXGRIP marks.
- makes further observations on STICK/STIX and the issue of confusion.
- reiterates his claim that his company uses its family of GRIP marks in relation
40 to a range of writing instrument and that they do not wish to see their trade mark rights eroded by descriptive marks.
- in relation to other GRIP marks in Class 16 (referred to in the applicants' counterstatement) he says that there is no evidence that they are in use in
45 relation to writing instruments.

- confirms the sales figures contained in his own earlier declaration and exhibits.
- denies Mr Verkade's claim that the different method of advertising of the respective products will avoid confusion.
- deals with Mr Verkade's comments in relation to the word STICK and denies that his company have sought to monopolise the word.
- refers to the applicants' conduct in trade mark matters in the United Kingdom and other jurisdictions which in his view demonstrates their "overt competitiveness and mala fides". He exhibits (AJR1 and 2) copy correspondence and undertakings received from Pentech in relation to these activities.

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That completes my review of the evidence, but before turning to the grounds of opposition I must deal with a request by Mr Morcom on behalf of the opponents that the statement of case which accompanied the opposition be clarified to show that the opponents also wished to oppose under Section 12(1) of the Act. He pointed to the fact that the opponents' registered marks were mentioned in the statement and thus it was reasonably clear that the ground under Section 12(1) was intended.

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Mr Alexander objected to the addition of a new ground at this late stage in the proceedings. He pointed to the fact that only Section 11 was clearly identified in the Pleadings and while it was clear that an objection was also being made under Sections 9 and 10 of the Act, no such conclusion could be identified in relation to Section 12(1) of the Act. As matters stood he was only prepared to argue the grounds which were clearly identified in the Pleadings.

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Having carefully considered the matter I decided that the Section 12(1) ground could not be added at this late stage in the proceedings. These proceedings have been in train since February 1994 so there has been ample opportunity for the opponents to amend the Pleadings if they so wished. As they have not done so earlier it would be unreasonable to allow an additional ground to be added at the hearing, particularly as the applicants or their professional advisors had had no prior warning.

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It is also appropriate at this stage to note Mr Morcom's useful concession that the opponents would not be pursuing their opposition based on a family of GRIP marks. Clearly that is the right approach since the opponents do not have in fact a family of such marks.

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At the outset Mr Morcom also made clear that his clients' opposition would be based only on their FLEXGRIP mark and that he would not be arguing the case with reference to the DYNAGRIP mark.

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I will deal firstly with the grounds based on Sections 9 and 10 of the Act. These sections 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:-

- 5 (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;
- 10 (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;
- 15 (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.
- 20

(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.

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(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
- 35 (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 the limitations, in relation to use within the extent of the registration.

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(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.”

Conflicting views have been advanced as to whether the applicants’ mark GRIPSTIX is either adapted to distinguish or capable of distinguishing for the purposes of the above sections.

The opponents say in their evidence that the mark is made up of the words GRIP and STIX, the latter being the phonetic equivalent of STICKS. They go on to give their views on the potential significance of these elements in the context of the goods at issue. It is necessary, therefore, to consider the particular criticisms that are made about the applicants’ mark both in terms of the individual elements and the totality.

I should say at the outset that, in dealing with the word GRIP the opponents have in their evidence found themselves facing in two directions. On the one hand for a successful finding under Sections 9 and 10 they need to demonstrate that the word is meaningful whilst for Section 11 purposes they themselves lay claim to a family of marks based on the word whilst conceding that they do not seek a monopoly in the word itself. That matter is now somewhat resolved by Mr Morcom’s concession that the claim to a family of GRIP marks is not being pursued.

What then does the evidence establish about the significance or otherwise of the word GRIP. The following extracts drawn from the exhibits to both parties’ evidence indicate the basis for the opponents’ concerns (my emphasis in each case):

“All Flexgrip pens have a unique rubberised barrel for easier, more comfortable writing and a ringed grip area for added writing control.”

“Dynagrip 30 refillable ballpen has a unique cushioned gripping section for added writing comfort. This helps to prevent writers cramp and tiredness.”

(Opponents’ evidence - Exhibit AJR4).

“The only pencils with finger grips.”

“GripStix are easy to grip because your fingers fit right into the notches. You have more control of your writing.”

(Applicants’ evidence - Exhibit JV4).

It thus appears that a number of features have been developed to make the handling of writing instruments easier and more comfortable. As can be deduced from the above extracts, the applicants' pencils have contoured notches and the opponents' pens have rubberised or cushioned barrels to provide grip. I, therefore, consider that the word does no more than indicate a functional or convenience feature of the goods in question.

The second element of the mark is STIX which it is said, is the phonetic equivalent of STICK or STICKS. Mr Verkade says in his declaration that he does not believe the word STICK is used in a purely descriptive way in the trade. He adds that his company uses the word on pencils and observes that there is nothing in the evidence to suggest that the word is used in relation to pencils. I comment in passing that, whilst the applicants refer to the fact that they use the mark on pencils rather than pens, their proposed specification of goods covers writing instruments at large. The opponents on the other hand, say that the word STICK or its phonetic equivalent is commonly used in the stationery trade to describe slim barrelled non-retractable pens. The evidence, though not overwhelmingly conclusive, appears to show that both the applicants and other traders use the word adjectively to describe a type of pen. There is further support for this view in the extract from the Stationery Trade Review. I, therefore, accept that the word has descriptive significance in the trade and is also used in promotional advertising though it is not clear what, if anything, it means to the purchasing public.

Given the view I have come to that the words GRIP and STICK, taken individually, have some descriptive significance in relation to the goods applied for, the question arises as to whether the combination creates a word which is adapted to distinguish or capable of distinguishing for the purposes of Section 9 and 10 respectively.

In relation to "stick" pens which incorporates a gripping facility of some kind I cannot see that the mark qualifies for registration. It may be that the combination of words in the form presented does not conform to normal usage in so far as "grip" exists either as a noun or verb and does not sit entirely comfortably with the second element of the mark. But it is well established that, to quote from Lloyd-Jacob J's words in the Torq-Set case (1959 RPC 344), "the Registrar or the Court is not in anyway bound by strict grammatical usage, for the test is intended to relate to the conditions obtaining in industry and commerce". For the same reason it does not assist the applicants that their mark incorporates a phonetic equivalent form, that is to say STIX rather than STICK or STICKS. However it must be acknowledged that on the basis of the material before me the objections against the mark do not seem to apply with equal force in relation to pencils and it, therefore, seems to me that the mark has some capacity to distinguish in respect of such goods albeit that pens are a closely related product to pencils. I will return to this at the end of my decision as Mr Alexander helpfully indicated during his submissions that the applicants would be prepared to restrict their application to "Pencils" since this reflects their actual and intended use of the mark applied for.

I turn now to the ground based on Section 11 of the Act. This section reads as follows:

"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.”

5 The established test for objections under this section is set down in Smith Hayden & Co Ltd’s application (Volume 1946 63 RPC 101) as adapted by Lord Upjohn in the BALI trade mark case [1969] RPC 496. Adapted to the matter in hand these tests may be expressed as follows:

10 Having regard to the user of the opponents’ mark FLEXGRIP, is the tribunal satisfied that the mark applied for, GRIPSTIX, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

15 By way of general comment on the evidence filed in this case it seems to me that both parties use their respective marks in conjunction with what I take to be their housemarks, PAPERMATE (and device) in the case of the opponents and PENTECH in the case of the applicants. Whilst the trade mark significance of the subordinate marks is made clear by trade mark references, the presence of housemarks in normal usage is a major factor to be borne in considering the issue of likelihood of confusion.

20 The opponents have provided evidence of use of their marks. The applicants for their part have commented on the generalised nature of the turnover and advertising figures supplied and suggest that they represent composite figures for a range of goods and are imprecise so far as the territorial coverage involved. Mr Redpath, in his second declaration for the
25 opponents, denies that the figures relate to markets other than the United Kingdom and reaffirms that the turnover reflects sales of all branded products containing the word GRIP. It would in any event not be altogether surprising if advertising covered a range of products rather than individual items. Promotional activity is no doubt driven by the commercial requirements of marketing products and not the needs of trade mark proceedings. Having
30 given careful consideration to the material filed I accept that the opponents can claim use of, and a reputation in, the mark FLEXGRIP albeit that the mark is normally used in conjunction with the PAPERMATE housemark.

35 I have already accepted on the basis of the evidence filed that GRIP carries a descriptive significance in relation to the goods and the opponents themselves concede that they cannot seek a monopoly in the word per se. In these circumstances it cannot be open to a party to claim a monopoly in an element which should be available for others to use. In support of his submissions on this point Mr Alexander referred me to the F.W. Waide & Co Ltd case in which there was a dispute concerning the alleged confusing similarity of the words
40 “ANCHOLA” and “ANCHOVETTE” both of which were to be used in relation to products made from or containing anchovy. In that case the Registrar said at page 322:

45 “I do not think that anyone can claim the monopoly of the prefix “Ancho”, which is clearly connected with the word “Anchovy”. The words, therefore, have to be looked at as a whole, and the suffixes in these two cases are widely different both in spelling and in sound.”

I must nevertheless consider for Section 11 purposes whether confusion is likely to arise if the applicants use their mark GRIPSTIX in a normal and fair manner given the user established by the opponents of the mark FLEXGRIP. As the only common element between the marks is the descriptive word GRIP it is in my view unlikely that this element would be of particular significance from the point of view of distinguishing between the marks. Considering the marks as wholes I have come to the view that there is no significant likelihood of confusion. However there is a further point to consider as the opponents say that they use their FLEXGRIP mark on stick pens. What Mr Redpath actually says in his first declaration is that “Pens sold on behalf of my company, bearing the mark FLEXGRIP, are sold to customers, packaged and labelled as ‘FLEXGRIP STICK’.” As a result he says there is a risk of confusion with products sold under the mark GRIPSTIX. He exhibits an example of packaging showing his company’s mark in use with what he terms the descriptive suffix STICK. For ease of reference a copy is at Annex A. It can be seen from this that the packaging bears the PAPERMATE (and device) mark in bold lettering and beneath it the mark FLEXGRIP. The word STICK appears in much smaller plain type. In my view it is doubtful whether the word STICK would be seen as part of the trade mark at all. Rather I think it would be seen as a qualifying description indicating that the package contains a so-called stick pen. In the absence of other more convincing evidence on the point I do not regard Mr Redpath’s claim as being substantial. It follows that it does nothing to alter my underlying views on the respective marks. The opposition under Section 11, therefore, fails.

Finally there is the matter of the Registrar’s discretion. The opponents referred in their reply evidence to the applicants’ conduct in a number of countries. At the hearing Mr Morcom indicated that he did not propose to pursue these issues. I see no reason for an exercise of discretion in the circumstances of this case and in the light of what I propose below.

I concluded above that the mark at issue does not qualify for registration in respect of the full range of goods contained in the specification applied for. The evidence does not, however, show that the trade uses the word STICK in relation to pencils and it seems to me, therefore, that the mark is acceptable in Part A of the Register for a suitably limited specification. Bearing in mind that pencils at large would include mechanical or propelling pencils which share some of the visual and production characteristics of pens I take the view that the applicants should not be granted a monopoly which might embarrass other traders in this area. These concerns do not appear to have the same relevance in the context of wood-case pencils which are in practice the goods on which the applicants use their mark.

Accordingly if the applicants file a Form TM21 within one month of the end of the appeal period for this decision amending the specification to

“Wood-case pencils included in Class 16”

the application may proceed to registration. If they refuse to do so the application will be refused.

If the application is amended in the manner indicated above the opponents will have achieved a significant reduction in the specification applied for. In these circumstances I take the view that they are entitled to a proportion of the costs that would normally accompany a successful action. If, therefore, the application is amended as indicated I order the applicants to pay the opponents the sum of £600. If the applicants refuse to amend the specification, however, the application will be refused and the opponents will be free to apply for a full award of costs of £735, based on the normal scale.

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Dated this 30th day of April 1998

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N A HARKNESS
Assistant Registrar of Trade Marks
For the Registrar
the Comptroller General

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Annex A

