

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK
APPLICATION **m** 2012210 BY BRITISH STEEL PLC
TO REGISTER THE MARK **HERITAGE GREEN**

AND

IN THE MATTER OF OPPOSITION
THERE TO UNDER OPPOSITION **m** 43721
BY IMPERIAL CHEMICAL INDUSTRIES PLC

TRADE MARKS ACT 1994

IN THE MATTER of trade mark
application m 2012210 by
British Steel PLC

5 and

IN THE MATTER OF opposition
thereto under opposition m 43721
by Imperial Chemical Industries PLC

DECISION

10 British Steel PLC applied on 24 February 1995 to register the mark HERITAGE GREEN in class 6 in respect of:

“Steel strip and steel sheet, all having a green coloured protective coating of plastics or paint”.

15 The application is opposed by Imperial Chemical Industries PLC (hereafter “ICI”). I summarise the grounds of opposition as follows:

Ž The opponent claims that the mark should be refused under section 3(3)(b) because it is of such a nature as to deceive the public.

20 Ž The mark in question is similar to the opponent’s registered trade mark and is to be registered for similar goods. Because of the likelihood of confusion on the part of the public, the application should be refused under section 5(2)(b).

Ž Having regard to the opponent’s reputation in their mark in the United Kingdom, use of the applicant’s mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of their mark. Consequently the application should be refused under section 5(3).

25 The relevant details of the opponent’s registered trade mark are as follows:-

<u>No</u>	<u>Class</u>	<u>Jrnl/Pge</u>	<u>Goods</u>
1090780	2	5341/0139	Paints; primers, enamels, sealing preparations and coatings, all in the nature of paint; lacquers; varnishes (other than insulating varnish); dyestuffs and colouring matters, none for laundry or toilet purposes; preservatives against corrosion, rust, and against deterioration of wood; glaziers' putty; mastics included in Class 2; preservatives (in the nature of paint) against damp; stabilizing solutions for paint; and paint thinners.

In response, the applicant filed a counterstatement admitting the existence of the opponent's prior registration, but denying each of the grounds pleaded.

Both parties seek an award of costs in their favour.

5 Both sides filed evidence in these proceedings, following which a hearing was held on 30 April 1998. At the hearing, the opponent was represented by Dr Peter Colley of Counsel, instructed by Withers and Rogers; the applicant was represented by Mr Iain Purvis of Counsel instructed by Fry Heath and Spence.

10 At the beginning of the hearing, Mr Purvis invited me to admit some further evidence on behalf of the applicant. He admitted that it did was not an important element of the applicant's case, and he was unable to provide a satisfactory explanation for why the evidence had not been filed earlier. Furthermore, the copy handed up to me at the hearing was a faxed copy of a signed, but unsworn declaration. Dr Colley protested that I should **not** accept this late evidence, and in the circumstances I refused to admit it into these proceedings.

Opponent's Evidence

15 This comprises one principal statutory declaration by Daryl Anne Fryer (Business Development Manager for the ICI Decorative Trade Business), and two declarations in reply to the applicant's evidence, by Gary John Russell and Huw David Owen.

20 Ms Fryer explains how her company came to develop the HERITAGE range of paints to suit a particular niche market. She exhibits a range of advertising material used by ICI to promote the new range, and describes how ICI realised that it must "... publicise the name "HERITAGE" as a guarantee of the provenance of the shades". In 1994, fifty thousand pounds (£50,000) was spent on the production and distribution of this literature.

25 Ms Fryer confirms that the HERITAGE range of paints was launched in the trade market in May 1994, and as a result of its rapid success, it was launched in the retail market later that year. Between August 1994 and January 1995 (inclusive), over two and a half thousand colour cards were requested by professional specifiers as a result of the advertising literature distributed.

30 Ms Fryer goes on to list thirty six (36) publications which either advertised or featured HERITAGE paints. Copies of extracts from these publications are exhibited at DAR-8. The publications include:

BBC Homes & Antiques	Daily Telegraph	Bournemouth Evening Echo
The Times Magazine	Bath Chronicle	Harpers & Queen
Ideal World	Sunday Telegraph	Country Living
Elle Decoration	Homeflair	Inspirations
35 Central Somerset Gazette	Woman & Home	Homes & Ideas

The total volume of HERITAGE paint sold in the period May 1994 to January 1995 inclusive was at least 144,000 litres. The value of sales (excluding VAT) was at least £720,000 and the number of cans of HERITAGE paint sold was at least 28,000. Ms Fryer explains a number of assumptions that were made when estimating these figures, but as the accuracy of the figures has not been questioned in these proceedings I do not need to repeat those assumptions here.

Ms Fryer also lists a number of specialist paint shops and trade stores which sold HERITAGE paints between May 1994 and January 1995. Again, I do not need to repeat them. They are given as examples only and they demonstrate that the paint was sold across the length and breadth of the United Kingdom.

From Ms Fryer's evidence, it is clear that there are three different groups of colours within the HERITAGE range. They are indicated as "Georgian", "Victorian" and "Edwardian/Art Deco". Within each group, there are several shades of green, some of which are identified by names (eg Brilliant Green, Lt Bronze Green, Deep Green etc) and some of which are identified by a colour code.

It seems to me that the final paragraph of Ms Fryer's declaration neatly sums up the opponent's reason(s) for opposing this application. The paragraph reads:

"Large amounts of skill, effort and expense have been deployed to ensure that the named shades of colour of "HERITAGE" paints are authentic. Both professional and amateur members of the public have been educated as to the importance of authentic shades when restoring period paintwork or attempting to create a period ambience. The "HERITAGE" name is a guarantee of such authenticity. If "HERITAGE" or "HERITAGE GREEN" were to be used with any shades of paint, the public would be deceived as to the nature of the paint in that they would believe it was a paint of an authentic period shade of colour."

Mr Russell's Evidence

Mr Russell is a specialist in the measurement and matching of colour. He works at the Research Laboratories of ICI Paints. He provides a very clear and helpful description of a particular system of measuring colour - the Natural Color System, or NCS. He says that he has measured the colour of a sample of British Steel's HERITAGE GREEN, and found that whilst it did not match precisely any of the shades of green in ICI's HERITAGE range, it was closest to ICI's HERITAGE Georgian "Grass Green". In Mr Russell's opinion, this could give rise to dissatisfaction if a specifier (or his client) chose the British Steel product thinking it would match the Georgian green of neighbouring surroundings.

Mr Owen's Evidence

Mr Owen is a professional architect with a number of relevant qualifications and experience of specifying a range of building materials, including steel sheet. In substance, he says:

"Prior to being asked to make this Declaration, I had not encountered British Steel's "Heritage Green" "Colorcoat" painted sheet steel, but if I had, I feel sure that I would have taken "Heritage" to imply some sort of historical connotation

and so I would have presumed that the “Heritage Green” paint colour would come from the “Heritage” range of paints because I know them to be of colours chosen for their historical significance.”

Applicant’s Evidence

5 This comprises a principal statutory declaration by Francis Barrie White (Section Manager - Market Development at Strip Products Division of British Steel), with supporting declarations by Derek John Higgs and Henry Horton Shipley. The applicant also filed further evidence under rule 13(7) by Messrs White and Shipley.

10 Mr White says that the name HERITAGE GREEN was chosen by British Steel in October 1994 as a trade mark for designating an organic coated dark green colour steel sheet to be added as one of six new colours to British Steel’s COLORCOAT range of pre-coated steel sheet products. He provides statistics showing how much steel has been sold under the mark, but as there were no sales prior to the material date (ie when the trade mark application was filed), there would appear to be little point in my reviewing the statistics in detail.

15 HERITAGE GREEN steel in coil or sheet form is sold by the applicants direct or through selected distributors to a limited number of profiling and panel making companies to be made into profiled sheets and panels which will generally be specified by architects and/or building contractors. No sales are made to the general public according to Mr White, and the market for his product does not overlap with the market for the opponent’s paint products.

20 Exhibited to Mr White’s declaration is a comprehensive guide to the use of the British Steel’s COLORCOAT products. From this guide, it appears that British Steel manufacture coated steel sheet in a range of twenty seven (27) colours under the trade mark COLORCOAT or COLORCOAT HP200. One of these twenty seven colours is “Heritage Green”. Other colours include Aztec Yellow, Wedgwood Blue, Goosewing Grey, Olive Green, Terracotta,
25 Jade, Tangerine Orange. Whether this would be considered “genuine use” in relation to the goods (for example, if the mark becomes registered and the registration is subsequently challenged) is not something that I need to consider in these proceedings.

Mr White’s further declaration (under rule 13(7)) updates the sales figures provided in his earlier declaration, covering the period from June 1996 to March 1998.

30 *Mr Higgs’ Evidence*

Mr Higgs is the Managing Director of Precision Metal Forming Limited (PMF). His company markets roof and wall cladding systems in a range of colours. They purchase pre-coated COLORCOAT HP200 steel sheets from British Steel for profiling and cutting to size.
35 Mr Higgs says that to the best of his knowledge and belief, no customer of PMF has been confused by the concurrent use by ICI and British Steel of the trade marks HERITAGE and HERITAGE GREEN respectively. He adds that such confusion is extremely unlikely because of the different nature of the products and the uses to which the products are put.

Mr Shipley's Evidence

Mr Shipley is a Registered Trade Mark Agent. Since August 1990 he has been the Patents Manager of British Steel plc. His evidence relates to a number of shopping expeditions he undertook to determine the extent of the opponent's use of its HERITAGE mark. The
5 relevance of Mr Shipley's evidence was not explained to me at the hearing, and neither is it apparent from the declaration itself. Mr Shipley concludes his declaration by saying that:

10 "It is clear that HERITAGE paints are widely available from do-it-yourself stores and other retail paint outlets throughout the country, and are advertised to the domestic market both for direct use and use through decorators serving the domestic market. Telephone support to the domestic customer is given with a dedicated telephone number for Heritage products."

Mr Shipley made a further declaration (under rule 13(7)) in which he reports the results of a search of registered and pending trade marks. He searched a CD-ROM listing of UK trade marks for marks containing the word "HERITAGE" and then manually selected those that
15 were in class 6 or any other class concerned with building products. However, it was accepted at the hearing that the state of the register is not an appropriate guide to the registrability of any given mark, and consequently I do not need to consider this evidence in any detail.

That completes my review of the evidence filed in these proceedings.

20 *Section 3(3)(b)*

I shall begin by considering the opposition under section 3(3)(b). The section reads:

"(3) A trade mark shall not be registered if it is

(a)

(b) of such a nature as to deceive the public (for instance as to the nature, quality or
25 geographical origin of the goods or service)."

Initially, the opponent's case under section 3(3)(b) was that steel sheet sold under British Steel's HERITAGE GREEN trade mark would deceive the public because the colour of the coating on the steel is not an accurate match with one of the colours in the opponent's HERITAGE range of paints. However, Mr Purvis submitted that section 3 is concerned with
30 **absolute** grounds for refusing a trade mark. Any confusion that might arise would be confusion with another registered trade mark and not the result of an inherent failure of the mark itself. I was aware that the Registrar has been over this ground several times in recent decisions under the Trade Marks Act 1994, and I indicated to Dr Colley at the hearing that there was nothing to be gained by arguing a 'relative grounds' issue under section 3.

35 Nevertheless, Dr Colley did come up with an alternative, and slightly more plausible argument under section 3(3)(b). Having examined a sample of British Steel's COLORCOAT HP200 in 'HERITAGE GREEN' (a sample which Mr Purvis kindly showed him at the hearing), Dr Colley observed that it was only green on one side - the other side being grey. Whilst I admire Dr Colley's ingenuity in producing such an argument so quickly, and in the heat of battle, I do
40 not believe it can support an opposition under section 3(3)(b). There is no evidence before me

to suggest that the public would be deceived if they were supplied with HERITAGE GREEN steel sheet which was only coloured green on one side. In the absence of evidence on the point, I am forced to rely upon my own knowledge and experience of coated or finished building products (eg facing bricks, kitchen units etc). The nature of the goods is such that if I needed a particular piece of building material to be coated or finished on both sides, I would instinctively check that this was the case. I cannot imagine that the position would be significantly different in relation to pre-coated steel sheet which is used for roofing or cladding of buildings. In summary, I do not believe the public would be deceived because the goods are green on only one side, and the opposition under section 3(3)(b) therefore fails.

This leaves the opponent with the task of climbing one of two mountains. Either they must establish, in relation to section 5(2), that paint and steel sheet are similar goods, or they must show that their mark HERITAGE has a reputation in the United Kingdom which would be damaged if British Steel continue to use a similar mark in relation to steel sheet - section 5(3). In the event, the opponent failed to scale either of these peaks for reasons which I shall now give in detail.

Section 5(2)(b)

This section 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.”

It was common ground at the hearing that the two marks in question, HERITAGE and HERITAGE GREEN, are similar. It remains for me to decide whether the goods in respect of which these marks are registered and proposed for registration are also similar. If they are, and only if they are, I must go on to determine whether there exists a likelihood of confusion on the part of the public. This is the correct approach according to Mr Justice Jacob in the “*Treat*” case¹, as both Mr Purvis and Dr Colley agreed.

As regards the question of similarity of goods, Jacob J says, at page 296 (line 25) of “*Treat*”:

“I think the sort of considerations the court must have in mind are similar to those arising under the old Act in relation to goods of the same description. I do not say this because I believe there is any intention to take over the conception directly. There plainly is not. But the purpose of the conception in the old Act was to prevent marks from conflicting not only for their respective actual goods but for a penumbra also. And the purpose of similar goods in the Directive and Act is to provide protection and separation for a similar sort of penumbra. Thus I think the following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;

¹British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281

- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- 5 (e) In the case of self-serve consumer items, where in practice they are respectively found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- 10 (f) The extent to which the respective good or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act of industry, put the good or services in the same or different sectors.

This is rather an elaboration on the old judicial test for goods of the same description¹⁷. It seeks to take account of present day marketing methods. I do not see any reason in principle why, in some cases, goods should not be similar to services (a service of repair might well be similar to the goods repaired, for instance). I do not pretend that this list can provide other than general guidance. The fact is that the Directive and hence our Act have introduced an area of uncertainty into the scope of registration which in many cases can only be resolved by litigation.”

Footnote reference

- 17 See per Romer J. in *Jellinek’s Application* (1946) 63 R.P.C. at p.70, approved by the House of Lords in *DAIQUIRI RUM Trade Mark* (1969) R.P.C. 600 at page 620.

British Steel seek registration of their mark in respect of steel strip and steel sheet, all having a green coloured protective coating of plastics or paint, in class 6. ICI’s registration covers paint and related products, eg mastic, putty. In their turn, Mr Purvis and Dr Colley took me through the relevant factors identified by Jacob J, suggesting how the facts in this case may be interpreted to suit their particular side of the argument. Notwithstanding the test(s) propounded by Jacob J, I do not see that I could find, as a matter of common sense, that paint or mastic is similar to steel strip or steel sheet — even when the steel has a green coloured protective coating of plastics or paint. A careful, step-by-step analysis of the position in the light of the criteria laid down in the “Treat” case only serves to confirm this in my view. Dr Colley relied quite heavily on the respective goods meeting in the hands of the architectural or decorative supplier. In his submission, the goods were also competing in the sense that they were alternative products for refurbishing old buildings. Mr Purvis described these particular submissions as being ‘fanciful’, and whilst I would not go that far, at times I had to acknowledge the creativity of Dr Colley’s imagination in mapping the facts of this case onto the “Treat” criteria in his attempt to show that the goods were similar.

In summary, and considering all the factors set out in the “Treat” test, I find no similarity between the goods covered by the opponent’s registration and those proposed for registration by the applicant. The opposition under section 5(2)(b) fails accordingly.

Counsel on both sides addressed me at some length on the matter of likelihood of confusion, but because of my finding in the matter of similar goods I do not need to decide the issue. In other circumstances I might have felt obliged to express an opinion nonetheless; for example, to assist an appellate court in the event that I am found to be wrong in relation to similar goods. However, the difference between the respective goods is so conspicuous to my mind that if I am found to be wrong on this point, then any opinion I might proffer regarding confusion would clearly be of no assistance to a higher authority.

Section 5(3)

I turn now to the opposition under section 5(3), which reads:

“(3) A trade mark which

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

I have already decided in relation to section 5(2) that the goods at issue are not similar, and, as I have already said, the similarity of the marks is not an issue between the parties. I must therefore go on to consider whether the opponent’s mark has a reputation in the United Kingdom, and if so, what is the extent of that reputation, and whether continued use of British Steel’s mark would, in the words of the statute, take unfair advantage of, or be detrimental to, the distinctive character or the repute of ICI’s trade mark.

Here, the opponent’s case depends on the efforts of ICI Dulux to promote their new HERITAGE range of paints between May 1994 (when the range was launched) and February 1995 (when the application in suit was filed). Dr Colley estimated from the readership figures given in Ms Fryer’s evidence that up to twenty eight million people could have come into contact with the HERITAGE mark during this period as a result of the exposure in the publications identified. In his submission this clearly established it as a mark with a reputation.

Mr Purvis, on the other hand, argued that the opponent’s mark possessed neither reputation nor distinctiveness. Using several passages from the opponent’s own evidence, he maintained that the word “HERITAGE” had **not** been used in a trade mark sense at all, but in a descriptive sense, and was always accompanied by the marks ICI and DULUX. He maintained that such use could not establish a reputation in such a short period of time. Referring to the words of Mr Justice Jacob in *Philips Electronics NV v Remington Consumer Products* (unreported at this time), Mr Purvis described the opponent’s HERITAGE mark as

another example of a “limping trade mark”. For the sake of convenience, I reproduce below the relevant passage from the *Philips v Remington* judgment:

5 “Philips also have the well known word trade mark “Philishave”. No one doubts that the registration of this valid, that it is very well known and that it is distinctive of Philips and none other. It has always been used for Philips shavers. The picture registered trade mark has never been used by Philips as the sole means of identification of trade source. It has never been trusted by Philips to do this job on its own, a matter plainly relevant in considering acquired distinctiveness. It is at best a “limping trade mark”, needing the crutch of “Philishave” in use.”

10 Continuing with this line of argument, Mr Purvis described the opponent’s mark as one that had “never been allowed out on its own”. He suggested that there was not one example in the evidence showing the opponent’s HERITAGE mark being relied upon to do the job of a trade mark by itself.

15 Neither Mr Purvis nor Dr Colley were able to suggest a suitable test for the degree of reputation that should be required in order to benefit from the enhanced protection offered by section 5(3) - ie in respect of dissimilar goods/services. It was accepted that some form of sliding scale is appropriate, as indicated by the words in section 5(3) “... shall not be registered if, or to the extent that, the earlier trade mark has a reputation ...”. In other words, the greater the reputation of a trade mark, the greater the penumbra of protection extends into areas of dissimilar goods.

20 According to Jacob J in *Philips v Remington*, the extent to which a trade mark owner relies upon a particular trade mark as the sole means of identification of trade source is a matter plainly relevant in considering acquired distinctiveness. To my mind, it is no less relevant in determining the trade mark’s reputation. Nevertheless, I would not regard it as a conclusive test for reputation. As Dr Colley reminded me, even in the case of an extremely well known trade mark, the trade mark owner is likely to use other, so-called, ‘house marks’. It would, he argued, be wrong to underestimate the reputation of a mark merely because the owner chose to apply one or more additional marks. I accept this argument up to a point. Where the evidence in these proceedings relates to the opponent’s **own** use of the mark HERITAGE, it is always accompanied by the marks ICI and/or DULUX; this, I accept, could be the case regardless of the reputation of HERITAGE as a trade mark. For example, few people would doubt the reputation of DULUX as a trade mark, yet in the opponent’s own exhibits, it is often accompanied by the mark ICI. However, exhibit DAR-8 to Ms Fryer’s declaration includes copies of thirty six extracts from a range of publications which refer to the opponent’s HERITAGE range of paints. As Mr Purvis pointed out, a number of these extracts do not use the HERITAGE name explicitly. Some, arguably, use it but in a descriptive rather than a trade mark sense. But more significantly, none of the extracts refer to the HERITAGE trade mark without further specifying the source of origin as ICI and/or DULUX. Dr Colley was challenged at the hearing to find, in his evidence, one example of the HERITAGE trade mark being used independently of ICI and DULUX, but he could not do so.

40 That the trade mark owner does not rely on the HERITAGE mark as the sole means of identification may not be entirely unusual. But in my opinion the fact that no-one else seems to use the mark HERITAGE without further qualifying the source of origin is much more

significant, and it suggests to me that the HERITAGE mark does **not** yet have a significant reputation. In the circumstances, I do not think that it is appropriate to regard the opponent's mark HERITAGE as having a sufficient reputation to benefit from the provisions of section 5(3). The opposition under section 5(3) fails accordingly.

- 5 The applicant, having been successful in these proceedings, is entitled to a contribution towards the costs of defending the application. I therefore order the opponent to pay to the applicant the sum of **£635**.

Dated this 8th day of May 1998

10 **Mr S J Probert**
Principal Hearing Officer
For the Registrar, the Comptroller-General