

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF An Application under No 11284  
by Glamorock Coatings Limited for the Rectification,  
Invalidation or Revocation of Trade Mark Registration  
No 2030676 in the name of Polycell Products Limited**

**AND IN THE MATTER OF An Application under  
No 11477 by Polycell Products Limited for the invalidation  
of Trade Mark Registration No 904512 in the name of  
Glamorock Coatings Limited**

### **The Grounds For Application No 11284**

1. Polycell Products Limited (PPL) is the registered proprietor of the trade mark COVERTEX, which is registered in Class 19 for:

*"Non-metallic building materials; materials for coating walls and ceilings."*

2. The registration is effective from 16 August 1995 (the date of application for registration) although the mark was not placed on the register until 16 April 1996.

3. On 9 December 1999, Glamorock Coatings Limited (GCL) applied for the registration to be declared invalid under Section 47(2) of the Act.

4. The grounds for removal, as set out in the Form TM26, are essentially as follows:

*"(a) GCL are the registered proprietors of No 904512 COVERTEX registered as of 24 January 1967 in respect of "Coatings (in the nature of paint) for protective and decorative purposes.*

*(b) The mark subject of Registration No 2030676 is identical to the mark subject of Registration No 904512. The description of goods "materials for coating walls and ceilings" covered by No 2030676 is identical to the description of goods covered by Registration No 9045124. Registration is contrary to Section 5(1) of the Trade Marks Act.*

*(c) Insofar as the description "materials for coating walls and ceilings" are considered not identical to the goods of Registration No 904512, it is submitted that they are similar. Registration is contrary to Section 5(2)(a) of the Trade Marks Act, 1994."*

### **The Grounds For Application No 11477**

5. On 16 February 2000, PPL applied for the rectification, revocation or invalidation of

registration No 904512 in the name of GCL on the following grounds:

*"Registration No 904512 was granted in the name of Glamorock Limited and purportedly assigned to Rolleread (1988) Limited with effect as of 18<sup>th</sup> May 1992 ("the first assignment"). The registration was subsequently purportedly assigned from Rolleread (1988) Limited to Glamorock Coatings Limited on 12<sup>th</sup> June 1993 ("the second assignment").*

*A request was made to the Trade Marks Registry on 7<sup>th</sup> May 1999 to record both assignments against Registration No 904512. The first assignment was advertised in Journal No 6285, Page 8475 and the second assignment was advertised in Journal No 6287, Page 9406.*

*The Applicant has made efforts to trace the existence of Rolleread (1988) Limited through Companies House, but diligent enquiries have not revealed any information that a company named Rolleread (1988) Limited existed on 18<sup>th</sup> May 1992 when the first assignment was executed, or at any time. It is therefore submitted that both purported assignments recorded against Registration No 904512 are null and void.*

*The Solicitors for Glamorock Coatings Limited were asked in writing on 17<sup>th</sup> November 1999 to provide details of the existence of the company Rolleread (1988) Limited, including the company registration number, but no information regarding the company Rolleread (1988) Limited has been received.*

*The original proprietor of Registration No 904512, Glamorock Limited (Company No 578283), was dissolved on 26<sup>th</sup> April 1994.*

*In light of the above, the Applicant requests rectification of the Register by the removal of the recordal of the first and second assignments and the reinstatement of Glamorock Limited as the proprietor of the registration and/or a declaration of invalidity of the registration and that it be removed from the Register in its entirety. The Applicant also requests an award of costs in its favour.*

*The Applicant submits that there has been no genuine use of the mark of Registration No 904512 in the United Kingdom during the past five years by the proprietor or with his consent, in relation to the goods for which it is registered, and there are no proper reasons for non-use, contrary to Section 46(1)(a) or (b) of the Trade Marks Act 1994.*

*In particular the Applicant submits that to the extent that the Registered Proprietor (or its predecessors) has used COVERTEX at all, such use was not in respect of "coatings in the nature of paint for protective and decorative purposes" but was in respect of a dissimilar product or products primarily comprising stone particles and so properly falling within Class 19."*

6. Both sides seek an award of costs.

7. The parties subsequently filed evidence. The proceedings were not consolidated but both

applications were heard on 19 September 2001, when GCL was represented by Ms H Whelbourn of Trade Mark Owners Association and PPL was represented by Dr P Colley of Counsel, instructed by Boulton, Wade and Tennant.

### **Rectification, Invalidation and/or Revocation of Registration No 904512**

8. PPL's grounds of attack all relate to matters which occurred after the date of registration of this mark. The application for invalidation must therefore be rejected as misconceived.

9. The application for rectification must be dealt with before the application for revocation because of non-use because it is crucial to determine who the proprietor of the mark was during the relevant period before considering whether he can benefit from any use shown.

10. Section 64(1)-(3) of the Act is as follows:

*"64.-(1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:*

*Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.*

*(2) An application for rectification may be made either to the registrar or to the court, except that -*

*(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and*

*(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.*

*(3) Except where the registrar or the court directs otherwise, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made."*

11. In response to PPL's claim that the assignments to and from Rolleread (1988) Limited were null and void because there was no such company at the relevant dates, GCL filed a statutory declaration by Patrick Joseph Kelly, the Director of GCL, exhibiting a copies of affidavits by Nicholas Giles White and Cecil Arthur Jones. Mr White is a solicitor at Brabner Holden Banks Wilson. He says that he was instructed by Mr Pat Kelly of GCL to ensure the recordal of an assignment of two UK registered trade marks from Glamorock Coatings Limited (GL) to Rollaread (1988) (RL) Limited and further on to GCL. He identifies one of these marks as COVERTEX registered under No 904512. Mr White continues:

*"I drafted an affidavit that was signed by Cecil Arthur Jones a director of GL on 27<sup>th</sup> April 1999 ("the Affidavit") in order that he may clarify that the intention of GL and RL by an invoice dated 18<sup>th</sup> May 1992 ("the Invoice") was to transfer the entire assets of GL, including the Two Registered Trademarks, to RL. There is now produced and*

*shown to me, marked "NGW 1" a true copy of the Affidavit.*

*It has now come to my attention that the Invoice, the intention of which was to facilitate the assignment of the Two Registered Trademarks to RL, contains a typographical error in that the name of the assignee company was spelt Rollerread (1988) Ltd as opposed to its correct spelling of Rollaread (1988) Limited. There is now produced and shown to me, marked "NGW 2" a true copy of the Invoice.*

*It has also come to my attention that a letter of assignment dated 12<sup>th</sup> June 1993 ("the Assignment"), the intention of which was to assign, the Two Registered Trademarks from RL to GCL contains a typographical error in that the name of RL on the letter headed paper is spelt Rolleread (1988) Limited as opposed to its correct spelling referred to in paragraph 3 above. There is now produced and shown to me, marked "NGW 3" a true copy of the Assignment."*

12. Exhibit NGW 1 is a copy of an affidavit dated 27 April 1999 by Cecil Arthur Jones corresponding to Mr White's description of it.
13. Exhibit NGW3 is a copy of a letter of assignment dated 12 June 1993 transferring the trade mark COVERTEX from Rollerread (1988) Ltd to GCL. The letter is signed by P J Kelly and P M Kelly as Director and Secretary of Rollerread (1988) Limited.
14. Exhibit NGW4 is a copy of a Certificate of Incorporation on Change of Name showing that a company called ROLLAREAD (1988) Limited came into being on 10 November 1988.
15. Dr Colley submitted that the assignments to and from RL were null and void because no company called ROLLERREAD (1988) Ltd existed at the time of the first and second assignments. The result was that registration No 904512 should be reverted to stand in the name of Glamorock Limited. As this company had since been dissolved the assets, including the trade mark, were bona vacantia.
16. According to Section 72 of the Act, the registration of a person as proprietor of a trade mark is prima facie evidence of the validity of the original registration and of any subsequent assignment or transmission of it. The onus is therefore on PPL to displace this prima facie presumption of validity.
17. The evidence of Richard Edward Sutherland-Harris (a Trade Mark Attorney with Boulton Wade and Tennant) sets out the results of enquiries of Companies House into the existence of Rollerread (1988) Limited. These enquiries failed to locate the existence of a company of that name. Neither side has suggested the existence of a company called ROLLERREAD (1988) LTD. This evidence is enough to require GCL to present a case in response. GCL has done this. The evidence of Messrs Kelly, White and Jones is that there was a clerical error in the assignment documents. The company variously described as ROLLERREAD (1988) Ltd and ROLLERREAD (1988) Ltd was in fact ROLLAREAD (1988) Ltd. Evidence of the existence of this company is presented and not challenged.
18. Mr White's explanation of the error appears entirely plausible. There is no conceivable

reason to deliberately transfer a trade mark to or from a non-existent company. I therefore accept GCL's explanation.

19. In the circumstances I do not believe that I should grant PPL's application for rectification unless the error in question is incapable of correction. Dr Colley initially suggested it was because the assets of GL had become bona vacantia. However, in the end I understood him to accept that if the intention of GL had been to transfer ownership of the COVERTEX mark to Rollaread (1988) Ltd, the property in question would not have passed to the Crown upon the dissolution of GL because it was effectively being held in trust. Consequently, the clerical error is correctable (I understand that the details of the assignments have now been corrected following an application from GCL under Section 64 of the Act) and PPL's application for rectification must be refused.

20. PPL's second line of attack is under Section 46(1)(b) of the Act. The relevant provision is as follows:

*"46.-(1) The registration of a trade mark may be revoked on any of the following grounds-*

- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;*
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;"*

21. PPL's application does not specify a specific five year period during which it is alleged that no relevant use of the mark took place. The application, which is dated 16 February 2000, refers to "the past five years". In the absence of any other indication I take this to mean the five years ending on 15 February 2000, the day immediately preceding the making of the application.

22. There is no dispute that GCL has used the mark during this period. PPL says that the goods in respect of which the mark has been used do not fall within the specification of the registered trade mark, namely, "Coatings (in the nature of paint) for protective and decorative purposes." The onus is upon GCL to show what use it has made of its mark (Section 100).

23. PPL relies upon the evidence of Caroline Anne Davies (an in-house Trade Marks Consultant at ICI - PPL's parent company), Richard Edward Sutherland-Harris (a Trade Mark Attorney at Boulton, Wade & Tennant), Jacqueline Margaret Lake (a Director of Farncombe International Ltd - commercial investigators), and Derick F Deamer (a Chemist employed by ICI and formerly by PPL).

24. Ms Davies describes how she obtained a sample of GCL's COVERTEX product and gave it to PPL for analysis. Exhibit CAD1 to her statutory declaration consists of an analysis report

on GCL's COVERTEX product completed by a Dr R.S. Charnock, who describes himself as Technical Director, PDC Products, ICI Decorative Europe.

25. Dr Charnock states that:

- (i) The product is a decorative wall or ceiling covering product which provides a heavy textured finish;
- (ii) The product can be used internally or externally;
- (iii) It comes in plastic containers of 25kg;
- (iv) It is composed of a water based co-polymer resin binder containing natural aggregates;
- (v) The base material is granite/marble which gives the product its texture and "sand-like" appearance;
- (vi) The product has a thick "paste-like" consistency;
- (vii) Its thick consistency requires the product to be applied using a trowel technique, although it can also be applied by a spray technique.

26. Mr Sutherland-Harris' evidence repeats but does not add to the above.

27. Ms Lake provides hearsay evidence of conversations between two of her colleagues (David Lake and Steven Shepherd) and Mr Pat Kelly of GCL. Again this adds nothing of any substance to the points summarised above, other than that Mr Kelly is reported to have told Mr Lake that the formulation of COVERTEX had not changed over the years.

28. Dr Deamer provides definitions of "paint" from a UK Paint Research Association based on BS 2015:1965, extracts from J.H. Goodier's 'Dictionary of Painting and Decorating from 1987, extracts from Collins English Dictionary and a reference from a website called "[www.dictionary.com](http://www.dictionary.com)".

29. Dr Colley submitted that the most relevant of these was the reference from 1965, which is just a couple of years before the date of registration under attack. This is the most contemporary reference but I have not been shown the document from which it comes (which appears to be a specific British Standard) and I cannot therefore tell whether the one line definition I have been given is general in nature or of specific significance to the standard in question.

30. The 1987 reference defines paint as:

*"A substance consisting of finely powdered insoluble materials, chiefly pigments, suspended in a liquid binding medium, which is applied in liquid form and which when exposed to air or under the influence of heat has the power of changing to a dry*

*adherent film."*

31. The other references are more recent but are broadly consistent with the above.

32. Dr Deamer says that he analysed the COVERTEX product of GCL and found it to consist of:

Aggregate (stone)	77%
Polymer Emulsion	18%
Water and Additives	5%

- whereas a typical emulsion paint would be composed of:

Pigments	30%
Polymer Emulsion	40%
Water and Additives	30%.

33. Dr Deamer says that in tests, trowel application gave the best results. Brush application was not possible unless the product was mixed very thoroughly; then the product could be layered on in a sweeping action.

34. Dr Deamer concludes that the product cannot be characterised as a paint either by reference to its composition or its possible modes of application.

35. GCL relies upon a statutory declaration and witness statement by Mr P J Kelly of GCL, and a witness statement by Ms H Whelbourn of Trade Mark Owners Association.

36. Mr Kelly exhibits various product information relating to the COVERTEX product from which I note that:

- (i) It is described as a "*decorative natural stone aggregate wall finish*";
- (ii) The product comes in twelve standard colours, although further colours can be achieved by blending;
- (iii) The applied thickness should not exceed 3mm;
- (iv) The product can be applied by trowel to small areas but spray application appears to be the means of application to larger areas, and this seems to be the principal means of application.

37. Mr Kelly notes that most paints use different granule sizes that vary from product to product depending on the texture to be achieved. In his view the COVERTEX coating is in the nature of a paint. He says it can be applied with a stiff brush.

38. Ms Whelbourn provides an extract from Collins Paperback Dictionary which defines "paint" as "*a coloured substance, spread on a surface with a brush or roller that forms a hard*

*coating*". Naturally, she urges that GCL's product falls within this definition.

39. It will be apparent from the above that there is no dispute that GCL's product is a decorative coating. The point in dispute is whether it is in the nature of a paint.

40. Dr Colley also questioned whether GCL's goods were covered by a registration in Class 2. However, as that also depends upon whether the goods are in the nature of a paint, the class number raises no additional point on this occasion.

41. In determining whether GCL's COVERTEX product is in the nature of a paint, I bear in mind that words in specifications should be given their natural meaning, subject to the context within which they appear: Beautimatic v Mitchell (2000) FSR 267 at 275. In this connection I believe it is significant that the qualifying words within the specification state the goods to be "*in the nature of a paint*" rather than to be a paint as such. Dr Colley submitted that there was no difference. I disagree. A product may be in the nature of a paint because it shares the essential character of a paint without necessarily conforming with the technical definition of a paint.

42. Dr Colley urged me to give particular weight to the evidence of Dr Deamer having regard to the guidance in Kerly (13<sup>th</sup> Edition) 9-59, that one should have regard to how the product is considered for the purposes of the trade.

43. However, having regard to the fact that:

- (i) Dr Deamer's experience is in the area of developing and testing of paints rather than the distribution and sale of paints or coatings; and
- (ii) he is not an independent witness;

- I do not believe that his evidence sheds much light on whether those who trade in the type of products that GCL sells under the name COVERTEX would regard it as being "*in the nature of a paint*". Further, I do not regard his comparative analysis of GCL's product and one particular type of paint (an emulsion) as particularly helpful. It may well be the case that there are other types of paint (such as masonry paint) which would have more in common with GCL's goods.

44. GCL's product appears to be a substance consisting of finely powdered insoluble materials. These materials are not pigments but coloured aggregates. The aggregates are suspended in a liquid binding medium and, in order to be applied by a spray, must be at least in a semi-liquid form. The influence of air or heat has the effect of changing the substance to form a dry adherent coating. The coating is, however, likely to be thicker than that which would naturally be described as a "film".

45. It is clear from GCL's product literature that colour is an important aspect of its decorative function. In that respect it shares an essential characteristic of paint. It is, however, thicker than most paints. I do not believe that this can be decisive. Some paints come in solid form. The essential characteristic of paint is that it is applied in liquid form.



Mr Kelly says that the product can be applied with a stiff brush. That may be possible but it is clear from the evidence that that is not a normal means of application. The product can however, like a paint, be applied with a spray.

46. Taking all these factors into account, I am prepared to accept that whilst GCL's product is not a paint, it shares enough of the essential characteristics of a paint to fall within the qualification "*in the nature of a paint*".

47. The ground of attack under Section 46(1)(b) therefore fails insofar as GCL has shown use of the mark during the relevant period in relation to wall coatings (in the nature of paint) for protective and decorative purposes.

48. I find it convenient to consider GCL's application to invalidate PPL's registration of COVERTEX in Class 19 for:

Non-metallic building materials; materials for coating walls and ceilings

- before considering whether GCL's use is sufficient to support the continuation of its own registration of the mark in the form in which it currently stands.

#### **Invalidation of Registration No 2030676**

49. GCL's grounds of invalidation are based upon Sections 5(1) and 5(2) of the Act, which are as follows:

*"5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.*

*5.-(2) A trade mark shall not be registered if because -*

*(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or*

*(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."*

50. It is common ground that the respective trade marks are identical. The first matter which I therefore need to determine is whether the goods for which the earlier mark is protected are identical to any of the goods in the specification of the later trade mark.

51. In this respect, Ms Whelbourn referred to the decision of Mr Justice Laddie in Altechnic's Trade Mark Application (2001) RPC 736, in which he decided that classification is primarily a

matter of convenience in administration, and what is of real importance in determining the rights of the parties is the specifications of goods or services. If that is correct the description "*materials for coating walls and ceilings*" in PPL's Class 19 specification must include the goods for which the earlier mark is registered in Class 2 and, to that extent at least, the registration of the later mark must have been contrary to Section 5(1).

52. I understand that Mr Justice Laddie's decision is the subject of an appeal to the Court of Appeal which has been heard, but not yet determined. In these circumstances I should be reluctant to say for certain that the differences in classes have no effect. However, as PPL plainly does not regard its own goods as being in the nature of a paint, I intend to proceed on the footing that PPL's specification can, if necessary, be modified to avoid a potential Section 5(1) objection. In this connection I note that Section 47(5) states that where grounds for invalidation exist in respect of some goods but not others, a registration shall only be declared invalid to the extent necessary to remove those goods.

53. This brings me to the Section 5(2) ground. Given that the marks are identical, the likelihood of confusion must depend primarily upon the degree of similarity between the goods. The strength of the earlier trade mark could also be relevant for the reasons set out by the ECJ in Canon v MGM 1999 ETMR1.

54. Taking the last point first, I do not believe that the trade mark COVERTEX has an exceptionally distinctive character. It is comprised of the word COVER, alluding to its covering purpose, conjoined with the suffix TEX, which alludes to "texture". The mark is capable of protection but does not merit a wide penumbra of protection.

55. Mr Kelly has provided evidence on behalf of GCL in which he claims that GCL's product has been in use since 1967. However, the scale of the use has not been specified (other than through a handful of invoices) and appears small. There is no evidence of widespread promotion. Consequently, it is not safe to conclude that the inherent distinctiveness of GCL's mark has been significantly enhanced through use and promotion.

56. It is common ground that in determining the extent of the similarity between the respective goods, I should have regard to the objective considerations set out by Jacob J. in TREAT 1996 RPC 281, and summarised in Kerly (13<sup>th</sup> Edition) on pages 241/2. These are:

- (i) The uses of the respective goods or services;
- (ii) The users of the respective goods or services;
- (iii) The physical nature of the goods or acts of service;
- (iv) Trade channels through which the goods or services reach the market;
- (v) In case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (vi) The extent to which the respective goods and services are in competition with each other.

57. At this point the parties differed as to the correct approach. Ms Whelbourn submitted that I should compare the terms in the respective specifications. Dr Colley urged me to focus

on the goods in respect of which the parties had used their marks.

58. Kerly has the following to say on the point (at 8-25):

*"It is suggested that the correct approach is to consider a normal and fair use of the mark the subject of the application and, where the earlier mark is a registered mark which has not been used, a normal and fair use of that mark too. Where the earlier mark has been used, it is still appropriate to consider a normal and fair use of it and, in the absence of argument or evidence to the contrary, the way in which the proprietor has used it can be said, at the very least prima facie, to be the paradigm case of its use in a normal and fair manner."*

59. This view appears to be based on decisions of Neuberger J. in Premier Brands v Typhoon 1999 FSR 757 and of the Court of Appeal (under the 1938 Act) in Open Country (2000) RPC 477.

60. I can see the force in the argument that a party should not normally be permitted to avoid having its own use of its registered trade mark considered as an example - the paradigm example - of normal and fair use of that mark. However, I do not believe that this means that when faced with a situation where both marks are in use, one should just throw the specifications away and substitute the goods in respect of which there has been actual use of the marks.

61. Comparing the respective specifications of goods, I do not believe that there can be any doubt that *"coatings (in the nature of paint) for protective and decorative purposes"* incorporates similar goods to *"materials for coating walls and ceilings"*, (even if the latter are considered to be in the nature of a building material rather than a paint). In particular, decorative products in the nature of a building material, such as pebble dash, which would serve a broadly similar purpose to GCL's product, be used by the same users, have some physical similarities and be available through similar trade outlets. PPL's specification includes pebble dash.

62. PPL's actual product is described in its product literature and in press articles contained in the late evidence of Caroline Anne Davies of ICI Group Intellectual Property (I admitted paragraphs 1 and 6 of her declaration and exhibit CAD2 thereto following a request made just before the hearing).

63. It seems from this evidence that PPL classifies its product under the heading "ceilings" treatments. This description appears both in its promotional material and on the packaging of its products. PPL's product is a specialist treatment designed to cover over unwanted textured ceilings and produce a smooth finish. It is not decorative. It comes in one colour (whiteish), which would probably be finished with a coat of paint or possibly plaster.

64. When I asked Ms Whelbourn whether these grounds are similar to her client's goods she responded:

*"I think it is fair to say in practice the respective products are very different from one*

*another. They have different purposes, they have different natures, and they have different channels of trade. In practice, in a commercial sense, in terms of the register and what has been accepted for registration in both cases, that is not the case."*

65. So the difference between the goods for which the marks are registered, as compared with the actual goods of the respective parties, is crucial to the outcome of the case.

66. Consistent with this approach, Ms Whelbourn indicated that GCL would not maintain its objection to the registration of PPL's mark if PPL's specification were re-worded to clearly distinguish its goods from those of GCL.

67. Dr Colley's preferred approach to the Section 5(1) and (2) attack suggests that PPL also recognises the importance of the difference between the actual goods of the parties and those in the registered specifications.

68. Where one finds a situation whereby the respective goods may be regarded as identical, or at least closely similar, based upon the respective specifications, but both parties accept that their actual goods are dissimilar, one is inevitably driven to question whether the respective specifications are too wide.

#### **Partial Revocation of Registration No 904512**

69. Returning to PPL's application to revoke GCL's mark for non-use, I noted earlier that GCL had shown relevant use of its mark for wall coating (in the nature of paint) for protective and decorative purposes. In Pomeco Ltd v Reed Consumer Books Ltd (2000) FSR 734, Jacob J. noted that:

*"The problem is that some of the language for specifications of goods is apt to be extremely wide. Indeed, "printed matter" in this case is extremely wide. I think it is inevitable that at times one would have to "dig deeper". Even taking the specification considered by Neuberger J for a "domestic container", one can think of quite different sorts of domestic container: a hat box, a snuff box, a jewellery box, a plastic thing you put inside the fridge. Wide words can cover what are commercially quite different sorts of articles. So if one were to show use for just one of that sort, it would be commercially nonsense to maintain the registration for all goods caused by the wide words.*

*That is not to say the court will cut the registration right down to things like red tea caddies. But if non use in respect of a significant subset of a wide general description is established, then I see no reason why the court should not eliminate that subset from the specification."*

70. Pumfrey J. took a similar approach in Daimler Chrysler AG v Alavi (2001) RPC 813 (see paragraphs 71-73).

71. On the basis of my finding so far, I believe that GCL's registration should be partly

revoked under Section 46(5) of the Act so that it remains registered only for "wall coatings (in the nature of paint) for protective and decorative purposes" in Class 2.

**Partial Invalidation of Registration No 2030676**

72. If that is the true scope of protection of the earlier mark I believe that PPL's registration in Class 19 is free from objection under Section 5(1) and 5(2) in respect of:

"Coatings for covering textured ceilings and producing a smooth surface (none being in the nature of a paint)."

73. I believe that these are accurate descriptions of the goods of the parties, which both sides appear to accept are not similar goods. I have not overlooked the fact that GCL's goods could be used on ceilings and PPL's goods could be used on walls. However, in neither case would this be the normal use of the respective goods and the parties themselves describe their goods as wall and ceiling coatings, respectively. I see no reason to believe that the trade would classify the goods any differently.

74. The onus is upon GCL to show that PPL's registration is wholly or partly invalid. I believe that GCL has discharged that onus to the extent indicated above.

**Costs**

75. Both applications have partly succeeded and partly failed. In the circumstances I make no order as to costs.

**Dated this 06 Day of December 2001**

**Allan James  
For the Registrar  
The Comptroller General**