

DECISION OF THE TRADE MARKS REGISTRY

TRADE MARKS ACT 1994

APPLICANTS: STARBRITE CHEMICALS LIMITED

APPLICATION N^o. 2160755

CLASSES 2, 3 AND 21

AND

OPPONENTS : STAR BRITE INTERNATIONAL CORPORATION

OPPOSITION N^o. 49828



TRADE MARKS ACT 1994

IN THE MATTER OF trade mark
Application No. 2160755 in the name of
StarBrite Chemicals Limited

and

Opposition thereto No. 49828 by
Star Brite International Corporation

BACKGROUND

Trade mark in issue

1. Application No. 2160755 was applied for on 11th March 1988. The two marks in the series are:



The applicants claim the colours blue and yellow as an element of the second mark in the series.

Specification of goods and services

Class 2: “Car body, wheel and tyre paints and dyes; thinners, thickeners and solvents for all the aforesaid goods.”

Class 3: “Cleaning, polishing, dressing, scouring and abrasive substances; abrasive polishes; cutting compounds; cutting polishes; conditioners; degreasers; disinfectants; dry cleaning preparations; fresheners; glazes; glass cleaning preparations; glue and tar removers; leather cleaning preparations and waxes; polishing preparations; shampoos; soaps; toilet cleaners; washing-up liquids; waxes; thinners, concentrates, additives and solvents for the preparation of the aforesaid preparations; all for use on land vehicles or in the catering trade.”

Class 21: “Polishing and cleaning utensils; buckets; brushes; chamois leathers for cleaning and wiping; dispensers for cleaning and polishing preparations; mops; mop heads; polishing and cleaning cloths; polishing and cleaning gloves; scouring pads; sponges; all for use in connection with land vehicles or in the catering trade.”

History

2. As to recent events, the application was accepted, published and opposed by Star Brite International Corporation (the opponents). The grounds of opposition set out in the statement of case are as follows: ss. 5(1), 5(2)(a) and (b), 5(4)(a) and 3(6). S. 5(4) was abandoned at the hearing.
3. The opponents refer to the following registrations, which are earlier marks for the purposes of s. 5(2):

Mark	Number	Date of application	Goods/services
	1412916	25.01.90	“Cleaning and polishing preparations; protective coating preparations; all for use on marine vehicles; all included in Class 3.”
STAR BRITE	CTM 371500	11.11.96	Class 3: “Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; cleaning, polishing and protective coating preparations for application to marine vehicles, land vehicles and aeroplanes; cleansers for use in marine lavatories and chemical lavatories.”

4. There is a history of actions between the parties which I will briefly summarise here. (From now on I will refer to the opponents as SBI and the applicants as SBC).
5. In 1990 SBI sought to register mark No. 1412916 for “Cleaning and polishing preparations; protective coating preparations; all for use on marine vehicles, land vehicles and aeroplanes; cleansers for use in marine lavatories and chemical lavatories all included in Class 3”. The current applicants (SBC) opposed and, following opposition proceedings (No. 38953), a decision by the Hearings Officer Mr. Mike Knight (under the old 1938 Act) restricted the specification as above.
6. In 1993 SBC applied to register mark No. 1544798, identical to the first in the series of the application here, for “Cleaning, polishing, dressing, scouring and abrasive preparations and substances; soaps; all not being for use on marine vehicles; all for sale in the South East of England; all included in Class 3.” The application was opposed by SBI, again, under the Old Act (No. 43880). Following a decision by Mr. Mike Reynolds (BL O/343/99) the mark was eventually registered, but for “Cleaning, polishing, dressing, scouring and abrasive preparations and substances; soaps; all for automotive use or for use in the food and catering

trade; and all for sale in the South East of England; all included in Class 3 but not including any of the aforesaid goods for use in relation to recreational vehicles or mobile homes”.

7. This matter represents the most recent skirmish between the parties, but the first time they have ‘crossed-swords’ under the new Act. The application represents an expansion of SBC’s rights on their existing registration - which SBI clearly resists.

HEARING

8. The matter came before me at a hearing on 29th November 2002 at which Laurence Shaw represented SBI and Andrew Norris of Counsel, instructed by Fry Heath and Spence, represented SBC.

EVIDENCE

9. This consists of the following:

SBI’s evidence in chief		
Ann Elizabeth Roome	Agent for SBI	Statutory Declaration dated 7 th March 2000 exhibiting earlier evidence filed in oppositions Nos. 38953 and 43880 and also giving details of use.
SBC’s evidence in chief		
Michael Richard Hutchins	Agent for SBC	Statutory Declaration dated 7 th June 2000 exhibiting evidence filed during acceptance and earlier evidence filed in opposition No. 43880 and bundle of invoices.
Michael Richard Hutchins 2 nd Declaration	Agent for SBC	Correcting first declaration
SBI’s evidence in reply		
Mark Richards	Professional Searcher	Witness statement dated 25 th April 2002 saying that the Yellow Pages archives do not show use of the SBC’s mark

The Opponents’ (SBI’s) Evidence

10. Exhibit AERO1, of Ms. Roome’s Statement, is a copy of a declaration filed by Peter Dornau in earlier opposition proceedings No. 38953 in relation to the opponent’s mark No. 1412916.

This evidence has been summarised in the decision of Mr. Knight in relation to that case and I adopt the summary as follows:

“Mr Dornau says that he is the President of Star Brite International Corporation a company incorporated in February 1989 and he has been President since that date.

Mr Dornau goes on to say that Star Brite International is engaged in the manufacture and sale of a wide variety of maintenance and cleaning products for use in marine, land vehicle and aeroplane industries. He further says that Star Brite International sells all its products in the UK, the USA and elsewhere under the trade mark STAR BRITE which was first used in the United Kingdom by his corporation and its predecessors in business in 1979. At PGD1, he submits an illustrative sample of papers showing the mark as used in the United Kingdom in the period 1979-80. The first sample is described in the declaration as a letter, but which is a copy of an invoice addressed to Epping Motor and Marine Group Ltd at Ilford, Essex, but also marked ‘Shipped to Correctcraft’, with an address in Orlando, Florida. This document appears to be dated 10 January 1979. The second sample is labelled ‘Invoice’ and is marked to both ‘Ship and Bill’ to Smith Aviation Service Ltd, Wellesbourne, Mountford, Aerodrome, Wellesbourne, Warwick, England, it is dated 3rd December 1980. The third sample is marked ‘Ship and Bill’ to T.T.L. Services of Edgware, Middlesex, it is dated 19 August 1980 and appears to be for the sum of either \$ or £2,257.

Mr Dornau goes on to say that the trade mark STARBRITE is used on a wide variety of goods in the United Kingdom, which he lists. The list includes degreasing agents, diesel and gasoline fuel additives, engine degreasers, lubricants, anti-rust preparations, oil absorbent pads, thread lubricants, sealants for electrical connections. Other items in the list appear to be more specifically for marine use. At PGD2, he submits brochures which he says illustrate goods sold under the mark in the United Kingdom and on which the mark is clearly visible. These are photocopies. The cover of the first brochure says STAR BRITE No 1 in RV/MH Care Products and gives a Florida address. There is no obvious date on the brochure and it is marked ‘Printed in the U. S.A.’ Nor are there any prices given. A number of the products again appear to be for marine use but they also include a tyre cleaner, colour restorers, which appear to have a picture of a land vehicle on the packaging, a ‘wax ’n wash’ product, a ‘bug and tar remover’, car polish, rug and upholstery cleaners etc., all of which appear to be for use in relation to motor vehicles. The cover of the second brochure is marked STAR BRITE No. 1 in Marine Care Products, again with the Florida address. Again this has no date and has no price information.

Mr Dornau says that his company sells goods in the United Kingdom, both directly from the US and via British distributors. At PGD3 he submits a bundle of papers showing both types of sale. The first of these, dated 24 August 1989, is addressed to Cypher Components Co Ltd in London and is for liquid electrical tape, the second appears to be a copy of an invoice dated 19 August 1980 already submitted to T.T.L Services of Edgware, Middlesex, but there is no indication as to what the goods were, beyond the descriptor ‘Poly System’. The next is the invoice to Smith Aviation dated 3 December 1980 and is for aircraft polish; the fourth is dated 30 March (year illegible), but Mr Dornau says in his Statutory Declaration that it is 1983, and is to P S Squires at Oakhampton, Devon and is for Instant Shine and Auto Pre-Pack. 20 units of Instant Shine appear to have been shipped at a unit cost of £26.30 and one Auto Pre-Pack at a unit cost of £45.50. The next invoice is

dated 10 April 1979 and is addressed to Chamois Export F.M. Meyer Ltd, at Horsham, West Sussex, and is said to be of samples of auto cleaning solution of no commercial value. The next invoice is dated 21 May 1979 and is to Fletcher International Sportsboats Ltd and is for 2 cases of Marine Polish at a total value of £277.97. The next invoice is dated 1981 to IDM Beauty Fashion Limited of Brentford, England, and is for one Marine Mini Pre-Pack at a cost of £26. I note the cost is outweighed by the Air Parcel Post charge of £32. The final invoice is dated 30 April 1984, is to Mr Ralph James of Leicester, is for 6 Diamond Shine Kits, 10 Instant Diamond Shine and one Rust Shield. The total value on the invoice is illegible. Mr Dornau goes on to list four companies which he says are his company's main distributors in the United Kingdom. They are: Sowester of Dorset, Plastimo Manufacturing of Hampshire, Mark Dowlands Marine of Dorset, and H Burdens of Northamptonshire. He says these distributors sell the full range of products sold under his mark in the United Kingdom. He adds that while his company has not kept full records of all sales to the United Kingdom, because these are handled by the United Kingdom distributors, he can give estimated sales of goods by Sowester of Dorset. These are listed below:

YEAR

1986-87	2,500
1987-88	10,000
1988-89	37,300
1990-91	43,400
1991-92	30,000
1992-93	unavailable
1993-94	83,000
1994-95	67,000

thereafter use after date of application.

At PGD4, Mr Dornau submits copies of invoices to his British distributors. and a printout illustrating sales to the United Kingdom in the period 1992-5. These start from 4 June 1986 and, insofar as they are legible (several are not), appear all to be addressed to South Western Marine and to be for goods for marine application.

Mr Dornau goes on to say that the goods sold under his mark have been advertised in the relevant press by his Corporation's distributor and at PGD5, he says he offers an illustrative sample showing how the goods have been promoted in the United Kingdom. The advertisements appear to have been in the Marine Press and Mr. Dornau goes on to say that his goods have been promoted at the London Boat Show and The Sandown Park Marine Trade Show.

Mr Domau sets out the various registrations which his company owns in other jurisdictions. I note that, with the exception of the United States of America, none of these registrations is earlier than 1990."

11. Exhibit AERO2 is the same evidence from Mr. Dornau which was given in opposition, as evidence in reply, to proceedings No. 43880 in relation to the applicants' mark No. 1544798. The following extract is from the decision in that case:

“Mr Dornau filed a further declaration dated 22 June 1998. In this declaration Mr Dornau says that his companies’ United Kingdom trade mark application no 1412916 has now proceeded to registration with the following specification of goods: “Cleaning and polishing preparations; protecting coating preparations; all for use on marine vehicles.” Mr Dornau states that in addition to his company’s use of the mark STAR BRITE on goods for use on marine vehicles his company has used the mark on other goods from a date prior to the date of this application. As an example he refers to the fact that his company has used the mark STAR BRITE on aircraft polish in the United Kingdom since at least 1980. He refers to his previous declaration dated 31 July 1995 and exhibit PDG01 which is a copy of an invoice to Smith Aviation Services, Wellsbourne, Warwick. He says that the company continues to sell aircraft polish in the United Kingdom and at PDG02 he refers to brochures of Transair Pilot Shop dated 1992 and 1996, both contain an advert for STAR BRITE “super silicone aircraft polish”. He says that Transair Pilot Shop is the largest Pilot Supplies Company in Europe and has been selling Starbrite aircraft polish in the United Kingdom since at least 1981. Mr Dornau says that his company sells goods under the mark STAR BRITE for use on recreational vehicles and motor homes in the United Kingdom and has done so since at least 1987. At PDG03 he exhibits a bundle of papers which he says show evidence of use of the mark STAR BRITE on goods for use on recreational vehicles and motor homes. The first of these is a letter from Recreation Associates Ltd of Merseyside and is dated 9 April 1987. The penultimate paragraph of the letter refers to StarBrite RV lines which in the declaration Mr Dornau refers to as an abbreviation for recreational vehicle. Reference is made to contact and discussions with three major distributors. The second document is said to set out the commission paid to Recreation Associates Ltd for the sale of Star Brite recreational vehicle and motor homes products in 1987. The document is dated 22 July 1987 and indicates 10% commission for an Ernie Schlesener. He is the signatory of the letter dated 9 April 1987 from Recreation Associates Ltd. However, this company is not mentioned in this second document and although a figure of either \$ or £1584.85 is given as the amount of cash received no indication is given as to the nature of the goods to which this commission relates. The third, fourth and fifth documents are brochures. The cover of these all say STAR BRITE No 1 in RV/MH Care Products and give a Florida address. One brochure is the same as that referred to at PGD02 in Mr Dornau’s earlier declaration. The three brochures are undated but a note has been taped to one showing 91 and to another showing 93. In his declaration Mr Dornau asserts that the three brochures are dated 1991, 1993 and 1994 and that all three were sent to United Kingdom distributors.

The sixth and seventh documents are also brochures, the covers of which say BURDENS LEISURE and are dated 96 and 97. The address given for the company H. Burden Ltd is Northamptonshire. Both brochures contain references to various Star Brite products. For the period 1995 to date, Mr Dornau gives a figure of approximately US\$ 405,547 in relation to sales of goods under the mark STAR BRITE in the United Kingdom for use in the recreational vehicle, motor home and aircraft market. He also says that there are other sales to the United Kingdom by US distributors but he cannot be sure of the exact number of such sales. Mr Dornau states that earlier sales figures are not available as they were not kept when they changed their computer system.”

Exhibit AERO3 is the Registrar’s decision in this earlier matter. Exhibit AERO4 is the registration certificate in respect of CTM 371500, SBI’s earlier mark.

12. Ms. Roome concludes by saying that SBI not only have registered rights in class 3 in the UK, but have also made extensive use of the mark STAR BRITE in relation to the class 2 and 21 goods of the application and similar goods. Exhibit AERO5 consists of copy pages from the their brochures dating from 1992 – 1999.

The applicants' (SBC's) evidence

13. Michael Richard Hutchins is SBC's trade mark attorney and has filed a Statutory Declaration dated 7th June 2000. Exhibit MRH1 is an office copy of an unsigned statutory declaration by Glenn Warriner, a director of the applicant, which was filed during the pre-acceptance examination in support of SBC's contention that the application was the subject of honest concurrent use. The statutory declaration says that the mark has been used continuously since April 1988. Exhibit GW5 consists of copies of letters dated respectively 26th January 1989 and 16th May 1989 setting out quotations for Starbrite products. Annual turnover figures are quoted as follows:

July 1988 – 31/10/1988	£99,684.00
1/11/1988 – 31/10/1989	£231, 020.00
1/11/1989 – 31/10/1990	£328,426.00
1/11/1990 – 31/10/1991	£348,437.00
1/11/1991 – 31/10/1992	£336,452.00
1/11/1992 – 31/10/1993	£365,884.00
1/11/1993 – 31/10/1994	£463,403.00
1/11/1994 – 31/10/1995	£500, 481.00
1/11/1995 – 31/10/1996	£545,635.00
1/11/1996 – 31/10/1997	£682,553.00
1/11/1997 – 31/10/1998	£544,558.00

14. Mr. Warriner says that the mark and star device have been used on products for customers in Hampshire, Sussex, Surrey, Kent, Greater London, Middlesex, Essex, Wiltshire, Berkshire, Oxfordshire, Devon, Jersey, Cheshire, West Midlands, North Yorkshire, Tyne and Wear, Lancashire, Scotland and Wales. Products have also, apparently, been sold to a number of large national car rental companies. There is a 'representative' selection of invoices exhibited as GW6 from 1989 – 1998. He confirms that the mark has been used in advertisements in the Yellow Pages and local newspapers. There has been extensive promotion; from first launch to date advertising has been in excess of £100K. A dedicated team of sales representatives are also involved in promotion of products under the mark.
15. Exhibit MRH2 is a copy of a Statutory Declaration dated 21st March 1997, also by Glenn Warriner, filed in opposition proceedings No. 43880 in relation to SBC's application 1544798. I adopt the summary of this evidence given in the Registrar's decision in this case (BL O/343/99):

“The applicants filed a statutory declaration dated 21 March 1997 by Glen Warriner. Mr Warriner states that he a Director of StarBrite Chemicals Limited, a position that he has held since 1988.

Mr Warriner says that StarBrite Chemicals was established as a Limited Company on 24

December 1987 for the purpose of marketing and selling a range of cleaning and polishing products primarily intended for the motor trade. He states that the company commenced trading in 1988 and was originally based at Beaumont House, 177 Arthur Road, Wimbledon Park, SW19 8 AE. He goes on to state that as a result of expansion the company moved in March 1990 to its current address, Fontigarry Business Park, Reigate Road, Sidlow, Reigate Surrey RH2 8QH.

Mr Warriner goes on to say that the company currently markets over 80 products. At GW1 he exhibits a Product Guide in which he says the majority of the company's product range is shown. The cover of the guide says "Product Guide STAR BRITE - A comprehensive range of quality cleaning products for automotive, industrial and business usage." The guide contains a range of products including *inter alia* products for pressure washers, automotive vehicle wash range, polishes and waxes, dressings and cleaners. The majority of the products appear to be for use on the interior and exterior of motor vehicles but there are also products under the heading "Janitorial" for more general cleaning use, hand care products and various cleaning products including washing up liquid, bleach, tile cleaner and hand cleaner. Mr Warriner goes on to say that the company's products are primarily directed at the motor trade and food manufacturing trade but that their products are increasingly being used in other trades.

At GW2 he submits a bundle of copies of labels for various products sold by StarBrite Chemicals Limited under the STAR BRITE trade mark. The labels are undated but Mr Warriner points out that these are examples of labels used before their move to their new premises in March 1990. The address shown on the labels is the company's Wimbledon Park address. The labels relate to a range of products for use in *inter alia* 'car washing machines' and 'high pressure water cleaning machines' but also 'GLASS-BRITE SPRAY' for 'cleaning glass', 'FAB-BRITE SUPER CONCENTRATE' for use in 'soil extracting cleaning machines', 'DETERGENT SANITISER' suitable for 'use on any washable surface...such as.. walls, floors, tiles...', 'ANTISCALE' 'an efficient water softening compound'. Other labels relate to products for use in carpet cleaning machines, cleaning aluminium clad vehicles, rubber cleaner for cleaning vehicle tyres, lacquer remover for removing protective films from motor vehicles, spot cleaners, tar & glue remover, brake cleaner, and a range of waxes for use on motor vehicles, toilet cleaner etc. At GW3 he exhibits a range of more recent labels again covering a range of cleaning and polishing products.

Mr Warriner says that they have been using the trade mark continuously since they commenced trading in April 1988. By way of example at GW4 he exhibits copies of letters dated 26 January 1989 and 16 May 1989. The letter dated 26 January 1989 is to C.C.S. with an address in Crawley. It sets out a range of their products together with the price for each product. The second letter dated 16 May 1989 is to Mr A New at an address in Thames Ditton. This again sets out a range of products together with their prices. Mr Warriner then sets out the total annual turnover for products sold under the "STARBRITE" and star device trade mark as follows:

July 1988 to 31.10.1988 £99,684
01.11.88 to 31.10.89 £231,020
01.11.89 to 31.10.90 £328,426
01.11.90 to 31.10.91 £348,437

01.11.91 to 31.10.92 £336, 452 15
01.11.92 to 31.10.93 £365,884
(7 months to 30.06.1993) £237,121
*01.11.93 to 31.10.94 £461,403
01.11.94 to 31.10.95 £500,481
01.11.95 to 31.10.96 £545,635 20
*thereafter use is after the date of the application.

Mr Warriner says the mark has mainly been used in the south-east of England, Hampshire, Sussex, Surrey, Kent, Middlesex, Essex, Wiltshire, Berkshire, Oxfordshire and Greater London but also includes Powys and Devon. In a second statutory declaration Mr Warriner attaches at GW5, an exhibit of a bundle of invoices for the years 1989 - 1997 which he states are merely representative of his company's sales over that period. In accordance with rule 127 of the Trade Marks and Service Marks Rules 1986 a direction was sought that GW5 should be kept confidential to the Registrar and to the agents for the opponent. Such a direction was given.

Mr Warriner states that he first became aware of the opponents' trade mark application no 1412916 shortly after its publication in the Trade Mark Journal on 30 June 1993. He says that his company filed an opposition to that application. Neither he nor any other member of his company, nor any customers with whom he has spoken on the matter have come across any instances of the opponents' company selling products for use in the motor and catering trades. He concludes by stating that to his knowledge, the opponents, Star Brite International Corporation have never approached his company or their customers, concerning the use of the 'STARBRITE' name.'

16. Exhibit MRH4 is a bundle of invoices from 1989 through to 1997.
17. Mr. Hutchins has provided a second Statutory Declaration dated 29th October 2001 in which he seeks to exhibit a copy of Mr. Warriner's signed declaration together with exhibits as well as containing formal corrections to his earlier declaration.

The opponents' evidence in reply.

18. This consists of a Witness Statement dated 25th April 2002 by Mark Richards of Bilgrey Samson Ltd. He is a professional searcher who was asked to establish whether the mark the subject of the application had appeared in Yellow Pages. He says he searched the BT archives for the period 1988 – 1998 and located entries for Star Bright Chemicals Ltd (two words and the spelling inconsistent with the mark) during the years 1995 – 1999.

LAW

19. The relevant sections of the Act are:

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

“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.

(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.”

APPLICATION OF THE LAW

20. The bad faith ground, and that under s. 5(1), are considered below. Cases relevant to s. 5(2) are now well known, being: *Sabel BV v Puma AG* [1998] ETMR 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] ETMR 1 and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77, and can be summarised as follows:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd*, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and *vice versa*; *Canon*, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel*, paragraph 26;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of

confusion simply because of a likelihood of association in the strict sense; *Marca*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon*, paragraph 29.

DECISION

Section 3(6) – Bad Faith

21. In his skeleton argument, and before me, Mr. Shaw particularised his section 3(6) objection by saying that Mr. Warriner had misled the registry in his Statutory Declaration filed in support of the application during the examination stage. Specifically, Mr Warriner had said in paragraph 9 of his declaration that the mark ‘STARBRITE’ and star device ‘has been used in advertisements in the Yellow Pages publication and local newspapers.’ Evidence in reply – the Statement by Mr. Richards - showed that, having searched the BT archive, this was not the case. In Mr Richard’s evidence, the exhibits show SBC’s name is printed as ‘Star Bright’ (a misspelling), but no use of the mark is made. Thus, says Mr. Shaw, Mr. Warriner had misled the registry; his evidence could not be relied upon; his behaviour had fallen well below the standard expected of honest business practice and, *ergo*, the application was made in bad faith. In support, Mr. Shaw cited: *Road Tech Computer v Unison* [1996] FSR 816, *Gromax Plasticulture v Don and Low Nonwovens* [1999] RPC 367 and *Mickey Dees (Nightclub)* [1998] RPC 359.
22. By way of response in his skeleton, Mr. Norris argued that the ‘.. mistake is accepted by Mr. Warriner but it does not establish that the application is made dishonestly.’ In fact, the basis of Mr. Norris’ whole reply to this ground was one of an assumption of an error on behalf of Mr. Warriner. I rather believe that this amounts to evidence: there has been no sworn statement by Mr. Warriner explaining the discrepancy – as to whether it was a mistake or otherwise. It would not have taxed Mr. Warriner - or his legal representatives - excessively to put in such statement, yet none was produced. I must regard the discrepancy as unexplained.
23. The reference in *Gromax* is to the following, on page 379:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”
24. I note also the following from a decision of Mr. Simon Thorley Q.C., appearing as the Appointed Person in *R. v. Royal Enfield Trade Marks* [2002] R.P.C. 24, at paragraph 31:

“31 An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be

made (see Lord Denning M.R. in *Associated Leisure v. Associated Newspapers* [1970] 2 Q.B. 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v. Garrett* (1877-78) L.R. 7 Ch.D. 473 at 489). In my judgment precisely the same considerations apply to an allegation of lack of good faith made under section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference.”

Bad faith has been found to include, *inter alia*, dishonesty (BL 0/183/01), recklessness and lack of intention to use (BL 0/043/02). All are forms of commercial fraud – which must be distinctly proved. I cannot conclude that this has been achieved here.

25. First, there is also the crucial question, under s. 3(6), as to whether *the application* is made in bad faith. Whilst I accept Mr Shaw’s submission at the hearing that the question of bad faith does not have to be determined by what is said, or not said, on the Form TM3, the fact is, as Mr. Norris made clear, the application was made to broaden SBC’s protection. What Mr. Warriner said cannot be taken to cast a shadow on the motive for, or morality of, filing the application in the first place.
26. Next, I did not see that the findings of the Mark Richards’ Witness Statement are as profound as Mr. Shaw would have me believe. In this context, I think that we must be clear about the claim Mr. Warriner makes. He states (see the sworn Statutory Declaration in Exhibit MRH5, paragraph 9):

“The Mark ‘STARBRITE’ and star device has been used in advertisements in the Yellow Pages publication and in local newspapers.”

The claim applies to two advertising mediums: Yellow Pages and local newspapers. The former consists of a misspelling of the SBC name as STAR BRIGHT CHEMICALS LTD (used with the ir accurate address), but that (arguably) does not exclude the interpretation that Mr. Warriner was referring to that organ *and* the local papers together as vehicles for the STARBRITE mark and device. Though, alternatively, one might argue (as I am sure Mr. Shaw would) that the mark (misspelt or not) is not used: the company name is. Whatever, I do not believe that any of this amounts to commercial fraud; perhaps the most one can say about it is that Mr. Warriner has been careless. Or uninformed. In my experience it is not unusual for declarants to assert claims they may believe, but are not wholly supported by the material facts. This may come from a misunderstanding of what those facts are capable of verifying. There is not enough here to conclude that it is distinctly proved that Mr. Warriner’s claim amounts to dishonesty. And even if it did, I cannot see that this one reference taints the whole application such that it amounts to one made in bad faith.

27. Finally, Mr. Shaw appeared to want me to accept that this debate about the Yellow Pages was crucial to the claim of honest concurrent use, which allowed the application to progress (see s. 7) and, if questionable, undermined the basis of the whole application. I can’t accept this. There is other material enclosed with the Warriner Declaration that meets the requirement of s. 7 of the Act, which seems enough, *prima facie*, to justify the application proceeding, as the examiner did, in fact, allow. The ground under s. 3(6) fails.

Section 5(1) – Identical marks, identical goods

28. Mr. Shaw said that, for the purposes of s. 5(1), the marks were identical. This is especially having regard to phonetic use. He cited the cases of *Lifsystems* [2000] RPC 851 and *Bravado Merchandising v Mainstream* [1996] RPC 851. As regards the goods he said there is overlap, noting the Registry’s cross search manual.
29. S. 5(1) confers on the earlier registered trade mark holder an unqualified ground of objection and no confusion is required. This tends towards an interpretation which is restrictive and certain; the sort of interpretation given by Simon Thorley, sitting as Appointed Person, in the *BAYWATCH* (BL (SRIS) O/486/00) case, where he stated (page 7):

“The next question that arises is whether, under section 5(2), that mark is identical to the earlier mark BAYWATCH. Mr James held that it was, but went on to hold, if he were wrong on that, that it was virtually identical and therefore as similar as it is possible to be without being identical.

I am not satisfied that the marks are identical. I think it is important in the context of section 5(2) that the word ‘identical’ is given its normal English meaning, since under section 5(2)(a) [sic], if the trade mark used is identical and is used in relation to identical goods or services, an absolute monopoly is granted. Just as there is an important distinction between anticipation and obviousness in patent law, so also there is an important distinction between identity and similarity for trade mark law. Here there is a plain difference. The earlier registered mark consists solely of capital letters in the same size. The mark opposed consists of capitals in different sizes. They are therefore not identical. However, I agree that they are virtually identical, certainly orally they are identical, and I cannot dissent from Mr James’ conclusion that they are as similar as it is possible to be without being identical.”

30. Applying Mr Thorley’s reasoning I do not hesitate to say that the marks, whilst phonetically identical, are not identical for the purposes of s. 5(1). The opposition under this section fails. By the same reasoning, the ground under s. 5(2)(a) must fail also.

Section 5(2)(b) – Similar marks, identical or similar goods

Comparison of goods

31. The specifications are as follows:

1412916	Cleaning and polishing preparations; protective coating preparations; all for use on marine vehicles; all included in Class 3.
CTM 371500	Class 3: "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; cleaning, polishing and protective coating preparations for application to marine vehicles, land vehicles and aeroplanes; cleansers for use in marine lavatories and chemical lavatories."
Application	<p>Class 2: "Car body, wheel and tyre paints and dyes; thinners, thickeners and solvents for all the aforesaid goods."</p> <p>Class 3: "Cleaning, polishing, dressing, scouring and abrasive substances; abrasive polishes; cutting compounds; cutting polishes; conditioners; degreasers; disinfectants; dry cleaning preparations; fresheners; glazes; glass cleaning preparations; glue and tar removers; leather cleaning preparations and waxes; polishing preparations; shampoos; soaps; toilet cleaners; washing-up liquids; waxes; thinners, concentrates, additives and solvents for the preparation of the aforesaid preparations; all for use on land vehicles or in the catering trade".</p> <p>Class 21: "Polishing and cleaning utensils; buckets; brushes; chamois leathers for cleaning and wiping; dispensers for cleaning and polishing preparations; mops; mop heads; polishing and cleaning cloths; polishing and cleaning gloves; scouring pads; sponges; all for use in connection with land vehicles or in the catering trade."</p>

32. Mr. Norris, in particular, made reference to the decisions previously determined, referring to the comparisons made therein between the goods at issue, and it must be appreciated that these proceedings have considerable history, with two registry decisions already taken under the 1938 Act. We are not starting here with a blank sheet. In relation to those earlier decisions, whilst they were taken under the 1938 Act, I do not propose to revisit what I would regard as any key findings of fact. If I were to summarise those decisions in broad terms, it would be that in both cases the Registry recognised the claims of both parties and sought to put 'clear water' between the respective specifications. It is this 'clear water' or, strictly speaking, limitation on the applicants' rights that, as I have said, has led to issues to be decided here.

So, what precisely has changed since Mr Reynolds decided the opposition No. 43880 against the applicants' earlier mark 1544798 ?

33. First, it appears to me that the evidence of use relied on by the parties has not changed materially. The applicants have provided some updated turnover figures to bridge the gap between opposition No. 43880 and these proceedings, but I do not regard these as of probative significance.

34. Beyond this observation, I hesitate to be restricted by these two previous decisions, as they resulted from old Act, and considerations as to the similarity of goods (in particular) are not identical. It would be better, in my view, to approach this matter afresh, employing the principles set out in the Cases below. For example, *Open Country* [2000] RPC 477 (cited by Mr. Norris) is an old Act case, and may or may not, be germane to this process. Anyhow, it does not appear to say what Mr. Norris suggested it did: that ‘..actual use by both sides in this case ..[is].. the paradigm of how the parties would use their goods.’ That judgment refers to marks, not goods – see page 482:

“The test laid down in *Smith Hayden*, adapted in accordance with the speech of Lord Upjohn in *Bali*, is the test applicable whether the applicant has or has not used his trade mark. However, no court would be astute to believe that the way that an applicant has used his trade mark was not a normal and fair way to use it, unless the applicant submitted that it was not. It does not follow that the way that the applicant has used his trade mark is the only normal and fair manner. However in many cases actual use by an applicant can be used to make the comparison. I believe that this is such a case.”

35. Mr. Norris also referred to *Premier Brands UK Ltd v. Typhoon Europe Ltd.*, [2000] F.S.R. 767, which is under the new Act, but makes much the same point about marks, not goods (see page 779), as *Open Country*.

36. Turning to more pertinent law, I must first consider only the goods as they are set out in the specifications as listed. Whatever use is claimed may, or may not, reflect the goods as specified, but is, nevertheless, irrelevant to the scope of the right granted by registration (see *Origins Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280, page 284). Under s. 5(2)(b) notional and fair use of the respective marks for the goods/services contained within the specifications is assumed. The protection granted to the opponents is that bounded by the limits of their specification of goods, not by what they may actually be trading in at a given time: the Registrar will compare mark against mark and specification against specification, and that is what I must consider here.

37. Of course, the use the parties have made may be relevant to their intention in specifying certain goods in a class, and it is certainly helpful in applying the factors as set out in *Treat and Canon*. By the former, I mean *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, at page 296. Adapted to the current case the test proposed by Mr. Justice Jacob involved consideration of the following:

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

(b) the users of the respective goods or services;

- (c) the physical nature of the goods or services;
- (d) the trade channels through which the goods or services reach the market;
- (f) the extent to which the respective goods or services are competitive.

These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45 - 48. In its judgment, the ECJ stated at paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

38. A number of other authorities have dealt with the proper approach to the meaning of particular terms. Terms are to be given their ordinary and natural meaning. For example, *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 puts a more recent gloss on the point.

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations” or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

Also from *TREAT* case:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

39. Finally, the Registrar is entitled to treat the Class number as relevant to the interpretation of the scope of the specification of goods (*Reliance Water Controls Ltd v Altecnic Ltd* [2002] RPC 34).
40. Against this background, I cannot but find that the goods specified in Class 2 of the application share no similarity with the goods specified with the earlier marks. Those in Class 3 of the UK mark no. 1412916 are excluded by the limitation to marine vehicles – which I regard as a completely different market to what I will call the ‘car care’ trade: the users are different, the trade outlets are different and they are non-competitive markets. Anyhow, I consider the items in Class 3 to be different to those in Class 2. Though the CTM lists ‘..protective coating preparations for application to... land vehicles...’, I understand these to be polishes and the like, not paints such as the ‘Car body, wheel and tyre paints and dyes...’ of the application (which might, imaginatively, also be defined as ‘protective coatings’). This belief is fortified by the choice of Class 3 to specify the opponents’ goods: I note the 8th Edition of the Nice Classification of goods and services (from the WIPO website at <http://www.wipo.org/classifications/en/index.html>) lists Class 3 as:

“Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.”

Further, the examples of the opponents’ products set out in Exhibit PGD03, to Exhibit AER02 of Ms. Roome’s Declaration, does not contain examples of paints and the like.

41. However, it seems to me that the goods in Class 3 are identical (or similar) to those specified in the opponents’ CTM. Again, I am ignoring the earlier UK registration: the limitation to marine vehicles arguably excludes this registration on the same basis I set out in the last paragraph.
42. I note the general restriction in the application confining the goods to those ‘..for use on land vehicles or in the catering trade’. I do not believe this helps them, as the CTM has no such general restriction on it’s goods, but for the specific ‘..cleaning, polishing and protective coating preparations for application to marine vehicles, land vehicles and aeroplanes..’ and ‘..cleansers for use in marine lavatories and chemical lavatories.’ In fact, it seems to me that the opponents’ unbounded ‘..cleaning, polishing, scouring and abrasive preparations...’ include the applicants’ cleaning, polishing, dressing, scouring and abrasive substances; abrasive polishes’ despite the limitation ‘ for use on land vehicles or in the catering trade’. Further, the opponents’ goods also appear to include – or at least are similar to – the following of the applicants’ goods:

‘..cutting compounds; cutting polishes; conditioners; degreasers; disinfectants; dry cleaning preparations; fresheners; glazes; glass cleaning preparations; glue and tar removers; leather cleaning preparations and waxes; polishing preparations; shampoos; soaps; toilet cleaners; washing-up liquids; waxes; thinners, concentrates, additives and solvents for the preparation of the aforesaid preparations..’

restriction or no restriction. In particular, ‘dry cleaning preparations, fresheners and glue; tar removers and leather cleaning preparations and waxes..’ are all items that might be sold as care-care products: they are more (or less) obvious examples of the genus. I also deem, in any case, that dry cleaning preparations, leather cleaning preparations might be considered similar to ‘bleaching preparations and *other substances* for laundry use’ (emphasis mine). As for ‘shampoos and soaps’, these are captured by the ‘soaps and cosmetics’ of the CTM.

43. Mr. Norris submitted, in relation to the Class 3 goods that, as the trade channels were acknowledged to be different in opposition No. 43880, so they are now; nothing has changed. Indeed, he spent some time at the hearing in taking me to, and highlighting, evidence apparently showing the opponents’ use limited to marine products only. This, in my view avails nothing (but see below, under ‘likelihood of confusion’). - What has changed is that the opponents’ CTM confers significantly more protection than their UK registration. The question therefore is no longer whether the specifications can be separated by the respective uses of the cleaning preparations, since the opponents’ rights in respect of their cleaning preparations under their CTM are not limited to a particular use, as I have said (compare this with my citation of *Beautimatic*, above).

44. On that basis, and in summary, applying the tests in *Treat*, I do not feel able to conclude anything other than that all the applicants goods in class 3 are apt to fall within the (unlimited) description: ‘cleaning, polishing, scouring and abrasive preparations’.

45. Turning to the goods in Class 21, these are :

“Polishing and cleaning utensils; buckets; brushes; chamois leathers for cleaning and wiping; dispensers for cleaning and polishing preparations; mops; mop heads; polishing and cleaning cloths; polishing and cleaning gloves; scouring pads; sponges; all for use in connection with land vehicles or in the catering trade.”

46. These I compare with the opponents’ Class 3 ‘..cleaning, polishing, scouring and abrasive preparations...’, specified with their CTM. Mr. Norris stated:

“ I say you can approach Class 21 in two different goods type restrictions, one of which is casting your eye over that from the view of the catering trade or casting your eye over that from the perspective of land vehicles. Starting from the position of the catering trade, there is a significant difference. Someone who buys a kitchen cleaner for use in the catering trade is not going to use a cloth or a bucket or cleaning gloves. People who buy for the catering trade have very different concerns than those in the marine industry. In the marine industry you just apply common sense rather than anything else. One looks to anti-fouling capabilities and things like that, which is in fact one of the products sold by the opponents in any event. In contrast to the catering trade effectively anything you use in respect of your cleaning are going to be things used on things people are going to prepare food on for eating, therefore, you are not bothered by anti-fouling. You are concerned with the anti-bacterial qualities in preventing bacteria and other germs from growing on catering surfaces.”

47. Had the restrictions been present in the opponents’ CTM this argument might have aided process of the application. But they are not and, again, I must point out, that the former has no restriction, and thus captures the latter. The question of similarity, here, comes down to an application of the *Treat* criteria.

48. First, the users of both types of goods are the same and, though the uses are different, the products will be used together. The physical nature is different, but the trade channels are the same – they are likely to be sold side by side. I have come to the conclusion that the goods are similar. I must now go on to consider the marks themselves.

Comparison of marks

49. I do not consider that there has been any material change between the marks in suit, such that the applicants’ mark is now visually distinguishable from the opponents’. Both marks are dominated by the words STAR BRITE and, despite the fact that the applicants are now claiming a series of two marks, the second having a colour limitation, Mr. Reynold’s finding of ‘similarity’ under section 12 (1) of the 1938 Act (page 10 line 39 of his decision) holds good in the present proceedings. That said, of course, a simple finding of similarity of marks is not decisive of likelihood of confusion under section 5(2)(b). All factors in the global assessment have to be considered.

Honest concurrent use

50. It was accepted by both parties that the question of honest concurrent use, under the 1994 Act, was but a factor in this overall global assessment of likelihood of confusion (see s. 7 of the Act). It may be taken into account when a determination of a likelihood of confusion between marks is made. It may, of course, aid an applicant where there is evidence of use of both marks and no evidence of confusion. In that occurrence, it becomes one of the relevant inputs to the ‘global appreciation’ instructed by the case law (see, for example, *Codas Trade Mark* [2001] RPC 14). This is not necessarily decisive, however. *Kerly’s* 13th Edition of the *LAW OF TRADE MARKS AND TRADE NAMES*, paragraph 16-101 states:

“Even where the proper inference to be drawn is that there has been no confusion this cannot be conclusive by itself: the decision is for the court, which cannot abdicate it in favour of the witnesses. Nevertheless, where the marks have been circulating side by side in the market where deception is said to be probable, the fact that no one appears to have been misled is very material, unless satisfactorily explained.”

51. Plainly, in relation to the earlier decisions between the parties, honest concurrent use was the decisive issue. Applying the criteria in *PIRIE* (1933) RPC 147, on the evidence before them, the hearing officers both found they could separate the respective specifications on the basis of an analysis of the uses made of the marks before the respective applications were made. The statutory framework is different under the 1994 Act, as I have said, honest concurrent use is only a factor in the overall consideration of likelihood of confusion. As such, I have to say in the present case I am not inclined to let it counterbalance the other significant factors (similarity of marks and goods) discussed in this decision. This is particularly because I feel unable to conclude with any degree of certainty from the evidence that the marks have actually been ‘circulating side by side’. In fact, Mr. Norris, for the applicants, rather forcefully argued that they were not, operating in very different markets.

Distinctive Character

52. The mark in application is dominated by the words STAR BRITE. It has some added matter, but this (as I have found) does not overwhelm the words and their meaning, which is not arbitrary for the goods at issue (various cleaning and polishing products). The spelling BRITE in the suffix will be interpreted as ‘bright’ and will not be viewed, by the average consumer, as unusual in a mark of trade, where such misspellings are common. Thus the mark is allusive. It possess inherent capacity to distinguish, but not overwhelmingly so. I note point (f) on page 11. I have not found the applicants’ use of their sign sufficient to increase the level of distinctiveness of their mark on the marketplace.

Average Consumer

53. Any consumer of cleaning, polishing, scouring and abrasive preparations, cosmetics and the like, which are not particularly expensive products, and not drawing uncommon attention during purchase.

Likelihood of confusion

54. Taking together the similarities between the goods I have identified, and the closeness of the marks, I have no hesitation in coming to the conclusion that the marks are confusable for the goods in Classes 3 and 21. To this extent, the opposition succeeds.

CONCLUSION

55. For the application to proceed, the applicants must amend their specification of goods and services to the following:

Class 2: “Car body, wheel and tyre paints and dyes; thinners, thickeners and solvents for all the aforesaid goods.”

If the applicants do not file a TM21 within one month of the end of the appeal period for this decision restricting the specification as set out above the application will be refused in its entirety.

COSTS

56. The opponents have not been wholly successful, but, I suspect, have ‘come away’ with much of what they sought. I do not consider this a ‘score-draw’ and award them £1000 in costs. This is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5TH Day of February 2003.

**Dr W J Trott
Principal Hearing Officer
For the Registrar.**