

O-006-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 82283  
BY LIQUID PLASTICS LIMITED  
FOR A DECLARATION OF INVALIDITY IN RESPECT OF  
TRADE MARK REGISTRATION NO. 2358804 IN THE NAME OF  
IMPERIAL CHEMICAL INDUSTRIES PLC**

## TRADE MARKS ACT 1994

**IN THE MATTER OF application No. 82283  
By Liquid Plastics Limited  
for a declaration of invalidity in respect of  
Trade Mark registration No. 2358804 in the name of  
Imperial Chemical Industries PLC**

### DECISION

1. Trade Mark registration No.2358804, for the mark STERISHIELD, has a registration date of 29 October 2004, and is registered in Class 2 in respect of the following goods:

Paints, varnishes, lacquers; driers including curing driers, thinners, colouring matters, all being additives for paints, varnishes or lacquers; priming preparations (in the nature of paints); wood stains; mastic; putty; repositionable patches of paint, varnishes or lacquers.

2. By an application dated 28 September 2005, Liquid Plastics Limited applied for the registration to be declared invalid. The application is made on the following grounds:

- 1. Under Section 5(2)(b)** because the applicants are the proprietors of an earlier mark that is similar to the mark of the subject registration, and which is registered for goods that are identical or similar to those of the subject registration.
- 2. Under Section 5(3)** because the applicants are the proprietors of an earlier mark that is similar to the subject registration, such that in view of the opponents' reputation, use of the subject mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of their earlier mark.
- 3. Under Section 3(1)(b)** because the subject mark consists of two verbal elements combined to make one word, but in which the two elements remain clearly identifiable. The word "STERI" being a commonly used abbreviation for the words "sterile", "sterilise" or "sterilant", and the word "SHIELD".
- 4. Under Section 3(1)(c)** because the mark may serve, in trade, to designate a characteristic of the goods for which it has been registered.
- 5. Under Section 3(1)(d)** because the mark consists exclusively of signs or

indications which have become customary in the current language or in the bona fide and established practices of the trade.

3. The registered proprietors filed a counterstatement in which they put the applicants to proof that the earlier mark relied upon has been used in the five years preceding the filing of the application for invalidity, and that the earlier mark has a reputation in the UK. They deny the grounds on which the application is based.

4. The registered proprietors and the applicants for invalidity both ask for an award of costs in their favour.

5. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. The matter came to be heard on 8 August 2006, when the applicants were represented by Mr Doug McCall of W.P. Thompson, their trade mark attorneys. The registered proprietors were represented by Ms Laurel McBray of Withers & Rogers, their trade mark attorneys.

### **Applicants' evidence**

6. This consists of two Witness Statements. The first is dated 9 January 2006, and comes from John Gregson, Company Secretary of Liquid Plastics Limited, a position he has held since November 2000. Mr Gregson states that the facts contained in his statement come either from his own personal knowledge, or from his company's records.

7. Mr Gregson confirms his company's ownership of trade mark registration No. 1484605, details of which he shows as Exhibit JG1. Exhibit JG2 consists of a print taken from the applicants' website that states the company is involved in the manufacture of high performance hygiene control coatings, inter alia, under the name STERISHEEN ULTRA. The print refers to the company having been involved in this business since the mid-1960s, but not that they have been using STRERISHEEN since that date.

8. Mr Gregson provides details of his company's turnover for products sold under the STERISHEEN name in the years 2000 to 2004, which ranges from £178,765 in 2000, rising to £349,259 in 2003, the final year being after the relevant date.

9. Exhibit JG3 is described as being a list of "hygiene coating contractors using STERISHEEN products in the UK" and the dates of "first supply", which ranges from November 1999 to December 2004.

10. Exhibit JG4 consists of a list of distributors for STERISHEEN, with the dates of first supply ranging from 1999 to 2003. The exhibit includes prints taken from the named distributor's websites, one mentioning STERISHEEN, although as none can be dated it is not known whether they are representative of the position at, or prior to the relevant date.

11. Exhibit JG5 consists of a "Hygiene referral list" that gives details of the location and date that STERISHEEN has been used, the earliest listed being in 1989 at Roussel Laboratories in

Swindon, through to 2004 when the STERISHEEN product was used in Wickwar Brewery, Gloucestershire.

12. Exhibit JG6 consists of two product brochures dating from November 1998 and June 2004. The earlier brochure refers, *inter alia*, to STERISHEEN ULTRA, describing the product as a “waterborne modified acrylic for internal surfaces, with similar performance characteristics to STERIDEX”. Whilst the later brochure refers to STERISHEEN, it originates from after the relevant date, and contains no information that casts light back.

13. Exhibit JG7 consists of a further extract from the applicants’ website, giving details of where STERISHEEN has been used. Although not stating when, if read in conjunction with Exhibit JG5, it can be seen that the Portobello Swimming Pool contract appears to date from 1997/98.

14. Exhibit JG8 consists of a list of trade fairs at which Mr Gregson says the STERISHEEN product was promoted in the years 1999 to 2004. He goes on to refer to various publications and magazines in which STERISHEEN has been advertised. Exhibit JG9 consists of extracts from KOMPASS, Building Products Index, OGC Directories and the RIBA Product Selector Directory. Whilst these may mention the STERISHEEN product, they do not give any details that establishes either the date of first use of STERISHEEN, any date that the reference to the product first appeared in the publication, or the date of the extract exhibited. In some cases it is apparent from the copyright indication that this information originates from 2005 or later.

15. Exhibit JG10 consists of a list of countries (other than the UK) in which the STERISHEEN product is stated to have been sold. Exhibit JG11 consists of an undated news sheet from the registered proprietors’ website giving details, *inter alia*, of the STERISHIELD product.. Mr Gregson concludes his Statement by exhibiting an extract from the registered proprietors’ website, drawing attention to the similarity in the stated use of STERISHIELD to that of his company’s STERISHEEN product.

16. The next Witness Statement is dated 9 January 2006, and comes from Rigel Kate Moss McGrath, an associate trade mark attorney with W.P.Thompson & Co.

17. Ms McGrath refers to Exhibit RKM1 and RKM2, which consist of extracts from the registered proprietors’ website, and Chambers Science and Technology Dictionary. Ms McGrath draws attention to the intended use of their STERISHIELD product, and the relevance of the Dictionary entries for “sterile” and “sterilization”. In the latter case Ms McGrath repeats an assertion that “STERI” is a recognized abbreviation for these words, although provides no corroboration. Ms McGrath goes on to refer to Exhibit RKM3 which consists of an extract from The Penguin Concise Dictionary, and in particular, to the possible relevance of the word “SHIELD” in describing a characteristic of the registered proprietors’ STERISHIELD product. From this information, Ms McGrath asserts that the subject mark, as a whole, is devoid of distinctive character for the goods registered.

18. Exhibit RKM4 and RKM5 consist of an internet search into the use of “sterile paints systems” to establish commonality in the use of the term STERI for such goods, and details of registrations for trade marks containing the word SHIELD to demonstrate the widespread use of this term within the paints industry.

### **Registered proprietors’ evidence**

19. This consists of a Witness Statement dated 23 February 2006 from Steve Snaith, Director of Marketing, Trade Paints Brands within the Paints Division of Imperial Chemical Industries PLC (ICI), a position he has held since 1 November 2005. Mr Snaith confirms that he spent 10 years in Trade Marketing and a further 14 years in Research and Development, also within ICI. He confirms that the information within his statement is either from his own knowledge or the company records available to him.

20. Mr Snaith states that in February 2004 his company came up with the name STERISHIELD, the “SHIELD” suffix being chosen because the company already owns and uses several trade marks that include this word, and it is a word that customers associate with the company. Exhibit SS1 consists of a list of his company’s UK and EC trade marks. He states that a prior rights search was conducted in the UK, details of which he exhibits as SS2, which revealed no earlier trade marks which were similar to STERISHIELD. He refers to the official ex-parte examination of his company’s application, a copy of the acceptance letter being shown as Exhibit SS3. Mr Snaith says that he believes that STERI is a common abbreviation of “sterile”, “sterilise” or “sterilisation” such that no single party should be entitled to stop others from using it.

21. Mr Snaith states that his company launched the STERISHIELD product on 1 September 2005, pre-launch material being available from an earlier date. He mentions, in particular, the Dulux Product Launch Brief (Exhibit SS4) issued on 4 August 2005, which announces the launch of STERISHIELD on 1 September, confirming the details given. He goes on to refer to Exhibit SS5, referring to this as an example of how his company uses the trade mark. The exhibit appears to be a label for a paint can. It bears a logo incorporating the name STERISHIELD placed over an image of a shield placed to the left of the words “Sterishield Quick Drying Eggshell” and “Sterishield Diamond Matt”, the name also being used in the product description.

### **Applicants’ evidence in reply**

22. This consists of a Witness Statement dated 8 May 2006, from Rigel Kate Moss McGrath. Ms McGrath comments on the relevance or otherwise of the “SHIELD” marks referred to by Mr Snaith as being owned by the registered proprietors. Exhibits RKM2A, RKM2B and RKM2C consisting of register evidence to support her contentions.

23. That concludes my review of the evidence insofar as it is relevant to these proceedings.

## Decision

24. The application for a Declaration of Invalidity is made under the provisions of Section 47, which reads as follows:

“47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground -

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration

(2A)\* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has 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, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

25. There is no claim that the mark has become distinctive by virtue of the use made of it, so the proviso to Section 47(1) is not relevant in these proceedings.

26. Turning first to the grounds under Sections 3(1)(b), (c) and (d) of the Act, which read as follows:

“3. - (1) The following shall not be registered -

(a) ...

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

27. The mark that is the subject of this application is the word STERISHIELD. The applicants argue that it consists of two verbal elements, “STERI” and “SHIELD” combined to make one word, but with the elements remaining clearly identifiable. They submit that STERI is a commonly used abbreviation for the word “sterile”, “sterilise” or “sterilant”, that SHIELD is descriptive, and the word as a whole is devoid of distinctive character.

28. Turning first to the ground under Section 3(1)(d) of the Act, as that is most easily disposed of. The leading guidance from the European Court of Justice on Article 3(1)(d) (equivalent to Section 3(1)(d) of the UK Act) is contained in *Merz & Krell GmbH & Co*, [2002] ETMR 21:

“41. It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. It is immaterial, when that provision is applied, whether the signs or indication in question describe the properties or characteristics of those goods or services.”

29. As this case indicates, an objection based on this ground is not focused on whether the mark has some descriptive aptness for the goods or services; that is a matter to be considered under the provisions of Sections 3(1)(c) of the Act. An assertion that a trade mark has become customary in the language and practices of the trade connected to the relevant goods and services is to be supported by clear and cogent evidence of the fact, and in this case there is none. That being the case, I do not see on what basis I can conclude that the mark tendered for registration falls foul of Section 3(1)(d) of the Act, and the objection founded on that section is dismissed.

30. I turn next to consider the grounds under Section 3(1)(b) and (c) of the Act. In the *Cycling Is...* decision [2002] RPC 37, it was stated that a the distinctiveness of a trade mark is not to be considered in the abstract, but rather by reference to the goods or services in respect of which registration is sought, and the relevant public’s perception of that mark. In the judgment issued in respect of *Joined Cases C-53/01 to C-55/01 Linde AG, Windward Industries Inc and Rado Uhren AG* (8th April 2003), paragraphs 37, 39 to 41 and 47, the European Court of Justice (ECJ) summarized the considerations in respect of assessing distinctiveness under Section 3(1)(b) in the following terms:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods or services of one undertaking from those of other undertakings.

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services.



According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and *circumspect* (see *Case C- 210/96 Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

31. In a judgment issued in respect of *Wm. Wrigley Jr. Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case -191/01 P, the *Doublemint* case, the ECJ gave the following guidance on the scope and purpose of Article 7(1)(c) of the Community Trade Mark Regulation, equivalent to Section 3(1)(c) of the Trade Marks Act:

“28. Under Article 4 of Regulation No 40/94, a Community trade mark may consist of any signs capable of being represented graphically, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

29. Article 7(1)(c) of Regulation No 40/94 provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin, time of production of the goods or of rendering of the service, or other characteristics of the goods or service are not to be registered.

30. Accordingly, signs and indications which may serve in trade to designate the characteristics of the goods or service in respect of which registration is sought are, by virtue of Regulation No 40/94, deemed incapable, by their very nature, of fulfilling the indication-of-origin function of the trade mark, without prejudice to the possibility of their acquiring distinctive character through use under article 7(3) of Regulation No 40/94.

31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of article 3(1)(c) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (OJ 1989 L 40, p. 1), *Windsurfing Chiemsee*, paragraph 25, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I- (3161), paragraph 73).

32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the

mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

32. From this it is clear that the prohibition to registration under Section 3(1)(c) of the Act relates to signs that may not be being used as a designation of a characteristics of the relevant goods, but nonetheless could be apt for such use. It must therefore first be determined whether the mark designates a characteristic of the goods in question.

33. The opponents’ case is founded in part on the premise that the term STERI is an abbreviation that denotes “sterile” or similar, but despite these claims there is no evidence that this is the case, a fact confirmed by reference to Collins English Dictionary of which I have taken judicial notice. There is evidence relating to the word “sterile” that not surprisingly shows it to be apt for use in relation to “sterile paint systems”, but there is nothing that shows the term STERI is so used in relation to the goods covered by the application, or in the common parlance of the industry concerned.

34. Ms McGrath also seeks to establish that the word SHIELD is directly descriptive of a characteristic of the goods covered by the application. This is an ordinary English word that the reference from Chambers English Dictionary provided by Ms McGrath shows as meaning “to protect (something or somebody) with, or as if with a shield: to provide a protective cover or shelter.”. Ms McGrath has provided evidence obtained from the applicants’ website relating to STERISHIELD which shows the product to be a paint that forms a film that “actively inhibits bacteria...” from which Ms McGrath concludes that the product creates a barrier, or in other words, a “shield”. The word is undoubtedly capable of describing the properties of something that creates a barrier, but is this the case in respect of a paint film? Such goods are not “shields” and if that word says anything about paints it is more a reference to the desired effect obtained from the use of the goods rather than the goods or a characteristic of them.

35. The “state of the register evidence” shown as Exhibit RKM5 shows SHIELD to be a suffix to a number of trade marks that have been applied for or registered. In *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281 Jacob J (as he then was) said:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. [MADAME Trade Mark](#) and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

36. Although it has not been established that STERI is an “officially recognised” abbreviation for “sterile”, “sterilised” or similar, this does not necessarily mean it does not function as such in the market. In fact, in his evidence filed on behalf of the registered proprietors, Steve

Snaith argues that STERI is in common use. From the evidence it is apparent that the goods that the applicants and the opponents use their respective marks in connection with are in some way connected to the function or concept of “sterilising”. Being specialised products most likely to be bought and used by particularly well informed and knowledgeable consumers, to my mind means that to these people STERI will be viewed in the same way as the word from which it is taken. Similarly, the SHIELD suffix to the registered proprietors’ mark brings to mind the concept of something that protects, whereas the applicants use of SHEEN is also intended to indicate that the goods will achieve a shiny or glossy finish. The relevance of SHEEN can be seen in a brochure forming part of Exhibit JG6, which describes STRERISHEEN as a “single pack, tough, modified acrylic, mid-**sheen** surface coating which...contains a non-leaching anti-microbial system.”.

37. The fact that trade marks may bring to mind an idea because they are composed of a combination of linked concepts does not necessarily make them, as a whole, descriptive. Trade marks are often constructed to bring to mind an image that says something about the goods/services or a characteristic of them that the trader wishes to convey to the target consumer. This reference varies from the skilful and allusive, to those where the origins of the trade mark are plain to see, but are nonetheless not directly descriptive. Whilst I would place STERISHIELD in the latter group, this still means that the trade mark has a distinctive character, and in the absence of evidence to the contrary, is capable of functioning as a badge of origin when used in respect of the goods for which it is registered. The ground under Section 3(1)(c) is rejected, and I believe it follows that the ground under Section 3(1)(b) must also be dismissed.

38. Turning next to consider the ground under Section 5(2)(b). That section of the Act reads as follows:

“5.-(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.”

39. An earlier trade mark is defined in Section 6 of the Act as follows:

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

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

40. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723. It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & C. GmbH v. Klijsen Handel B.V.* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, 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 BV v. Puma AG*, 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 Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, 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 BV v. Puma AG*, 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 BV v. Puma AG*, 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 Mode CV v. Adidas AG & Adidas Benelux BV*, 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 Kabushiki*

*Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

41. Accordingly, I must consider the matter through the eyes of the average consumer of the goods in question, assuming them to be reasonably well informed, circumspect and observant, and on the basis that they will make comparisons of marks based upon an imperfect recollection kept in their mind, not by an analysis of its component parts, but as whole against whole. This must be balanced against the fact that in a comparison of trade marks it is inevitable that reference will be made to the elements of which the marks are composed. Whilst this approach is consistent with the case law which requires that consideration be given to the distinctiveness and dominance of the component parts, it must be the marks as a whole that are compared.

42. The opponents rely on one earlier trade mark which was registered on 8 January 1993, some twelve years prior to the date on which the application for a declaration of invalidity was made. This being the case, the provisions of Section 47(2)(A) introduced under The Trade Marks (Proof of Use, etc.) Regulations 2004 apply, and must be considered before going on to determine the substantive issues. The Proof of Use Regulations place an onus upon the applicants to show that there has been genuine use of their earlier mark, in the UK, within the five years preceding the date of the application. Therefore, the applicants for invalidity must show use in the period from 29 September 2000 to 28 September 2005. The use may be by the proprietors themselves, or by another party with their consent, and must be in relation to the goods for which the earlier mark is registered, or if it has not been so used, they must establish that there are proper reasons for this. The provisions of sub-section (2)(c) allow for use of a trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.

43. The Act refers to “genuine use” having been made of the trade mark but does not set out what constitutes use that is genuine. The European Court of Justice (ECJ) in Case C-40/01, *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 page 725 paragraph 36, answered the question of what “genuine use” means in the following terms:

“Genuine use must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others that have another origin.”

44. So according to *Ansul*, genuine use entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. Such use must be in relation to goods or services that are already on the market, or about to be marketed and for which preparations are underway to secure customers, for example, by means of advertising. The *Bud* Trade Mark case [2002] RPC 38 at paragraphs 41 and 42 gives some limited guidance on advertising. The assessment of whether there has been genuine use must take into account all of the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, and may include giving consideration, inter alia, to the nature of the goods or services at issue, the characteristics of the market concerned, and the scale and frequency of use; the use need not always be

“quantitatively significant” for it to be deemed genuine.

45. In the *Police* case [2004] RPC 35, the Appointed Person took the view that the *Ansul* decision did not limit the factors to be taken into account in establishing whether use was genuine only to the three areas specifically mentioned. It had stated that all facts and circumstances relevant to establishing whether there had been real commercial exploitation should be included, and that the size of a proprietor’s undertaking may be relevant.

46. Further guidance on the scale and frequency of use can be found in the *La Mer Technology Inc* case [2005] F.S.R. 29. This is the decision of a resumed appeal hearing following a reference to the ECJ on various questions relating to the meaning of “genuine use”. In his decision Blackburne J stated:

“31. Whether in any given case the proven use amounts to genuine use ("whether the commercial exploitation of the mark is real" as paragraph 38 of *Ansul* puts it) will depend on all of the facts and circumstances relevant to establishing such a state of affairs, including the characteristics of the market concerned and of the products or services in question, and the frequency or regularity of use of the mark. Even minimal use will be sufficient if, in the market concerned, the proven use is considered sufficient to preserve or create a market share for the goods or services protected by it. Thus, the sale or offering for sale (in, say, a trade magazine) of a single exceedingly costly and highly unusual item carrying the mark in a specialised market, for example a very large and complex piece of earth-moving equipment, may very well be considered by itself to be sufficient in the market for such equipment to preserve or create a market share for items of that kind which carry the mark whereas the sale of a low priced everyday product in a widespread market, for example a single jar of face cream bearing the mark or the exposure for sale of, say, half a dozen such jars for sale on a shop shelf, would almost certainly not be. It would be irrelevant to this conclusion that, in the latter example, the purpose of the proprietor of the mark (or of some third-party acting with the proprietor’s consent) when offering the jar of cream for sale was to create a share in the market for face cream sold in jars bearing the mark.”

47. Mr Justice Blackburne referred back to the decision of Jacob J in the earlier part of the appeal:

“15. Jacob J himself ventured an answer to those questions. At paragraph 29 of his judgment [2002] FSR 51 at 29) he said this:

"I take the view that provided there is nothing artificial about a transaction under a mark, then it will amount to "genuine" use. There is no lower limit of "negligible". However, the smaller the amount of use, the more carefully must it be proved, and the more important will it be for the trade mark owner to demonstrate that the use was not merely "colourable" or "token", that is to say done with the ulterior motive of validating the registration. Where the use is not actually on the goods or the packaging (for instance it is in advertisement) then one must further enquire whether that advertisement was really directed at customers here. ...

Nor do I think that the absence of a *de minimis* rule significantly affects the policy behind the legislation. Yes, marks must be used within the relevant period, but there seems no reason to make a trader who has actually made some small, but proper, use of his mark, lose it. Only if his use is in essence a pretence at trade should he do so. And of course, if he has only made limited use of his mark it is likely that the use will be only for a limited part of his specification of services. If he has a wider specification, that can and should be cut back to just those goods for which he has made use ..."

48. Mr Gregson states that his company has made continuous use of the STERISHEEN trade mark in the five years prior to the application, and that it has been actively promoted for some 12 years, which taking into account the date of his Statement would be from 1993/94. He provides turnover figures for STERISHEEN products sold in the years 2000 to 2004, which on their face do not appear to be significant in relation to the paint market as a whole. However, the use appears to be in respect of a specialised product within that market and it may well be that in that context they represent a significant trade; I do not know and there is no evidence to assist me. Whatever is the case, I take the view that they are of a sufficient scale to suggest a real commercial activity.

49. The evidence relating to the use of the applicants' trade mark includes product literature that appears to be available on the applicants' and also on trade-related websites such as the Building Products Index, OGC Buying Solutions and Kompas Company Directory. Apart from the OGC site, these mention the STERISHEEN and/or STERISHEEN ULTRA products. However, apart from copyright statements dated 2005, which may or may not be within the relevant five year period, there is no means by which to date this use.

50. As Exhibit JG3, Mr Gregson provides a list of "hygiene coating contractors" stated to have been supplied with the STERISHEEN product in the years 1999 and 2004. Exhibit JG5 provides details of the projects where the STERISHEEN product is said to have been used. These range from hospitals, manufacturing facilities, food preparation areas and sanitary areas such as washrooms and shower facilities. The earliest project is stated to have completed in 1993, with further projects being completed each year through to 2004. Whilst these exhibits recount circumstances where the STERISHEEN product has been used, without further supporting evidence such as tender and contract documentation, delivery notes or invoices for goods supplied, they are not evidence of actual use.

51. Exhibit JG4 consists of a list of UK distributors of STERISHEEN, including one in the ownership of the applicants, and extracts from their website. Only the pages from the GSN Coatings Ltd website mentions STERISHEEN, but as the only dates shown on the site are copyright claims from 2005 and 2006, this exhibit does not, of itself establish use of the mark within the relevant five years.

52. Exhibit JG7 consists of a list of case studies of contracts that Mr Gregson says appears on his company's website. Some, but not all are stated to have involved the use of STERISHEEN, and whilst they give no indication of the date on which the project was undertaken, in the case of the Portobello Swimming Pool project it is possible to work this

out by referring back to the project list at Exhibit JG5. This states that that the work was completed in 1997/98 which is outside of the relevant five year period. Even though the contracts may not have been undertaken within the relevant five-year window, had the case studies been available on the website during this period it could have constituted relevant use, but as Mr Gregson does not say when they were placed on the website, it is not possible to say this,

53. In my view, Exhibit JG6 provides the only real support to the registered proprietors. This consists of two product brochures. The first is entitled “HIGH PERFORMANCE COATINGS AND FLOORING SYSTEMS”, and under the name STERISHEEN ULTRA gives the product details as being a “Waterborne modified acrylic for internal surfaces”. The cover states “November 1998 - Revised July 2000”. The second brochure has the same title and bears the legend “COMMON ARRANGEMENT: M60” and “JUNE 2004”. There is a section detailing the STERISHEEN product, referring to this as a “single pack, tough, modified acrylic, mid-sheen surface coating which...contains a non-leaching anti-microbial system.” Mr Gregson does not say how many, or to whom these brochures were supplied, but at the very least, they show that the STERISHEEN product was available and being promoted for sale. I accept that in the first use the mark shown is STERISHEEN ULTRA, but to my mind this is not use of a mark in a form that changes the distinctive character from the registered form. Ultra is a laudatory term frequently used in trade, and one that the consumer will be conditioned to seeing being used to indicate that this is a superior or higher spec version of the product specified by the preceding name. To my mind STERISHEEN is the sole distinctive element of STERISHEEN ULTRA.

54. I consider that I am supported in this by the judgment of the Court of Appeal in *Bud and Budweiser Budbrau Trade Marks* [2003] RPC 25, and the findings in Case C-353/03, *Societe des Produits Nestle SA v Marks UK Ltd*. In this the ECJ had been asked to make a preliminary ruling on the meaning of Article 3(3) of the Directive, which is the basis for the proviso to section 3(1) of the Act. This allows for registration of a trade mark that lacks the necessary (inherent) distinctive character if it has acquired such a character through use. The referring court’s question was whether such a character could be gained as a result of the use of a trade mark in conjunction with, or as a part of another trade mark. The ECJ’s answer was that it could. Advocate General Kokott, in paragraph 24 of her opinion in the *Nestle* case stated:

“Structurally it would surely be wrong to recognise use for the acquisition of distinctive character but not to allow it to suffice in order to prevent loss of trade mark protection. Indeed, it is not precluded that use of a mark as part of another mark may also suffice in the context of Article 10. Under Article 10(2)(a) it also constitutes use if the trade mark is used in a form differing in elements which do not alter the distinctive character of the mark in the form in which it is registered. Use of a sign as part of a principal mark also comes within that definition...”

55. In summary, I find the applicants to have shown use of their earlier mark in respect of an “acrylic surface coating”. This is clearly nowhere near the full extent of the specification for which the opponents’ earlier mark is registered, and therefore the provisions of Section 47(2E) apply. This states that where an earlier trade mark satisfies the use conditions in respect of some of the goods or services for which it is registered, it shall be treated as if it



were registered only in respect of those goods or services. However, this does not mean that I simply proceed on the basis that the applicants' mark is registered in respect of the acrylic surface coatings.

56. The consequence of having failed to show genuine use of a mark in respect of all of the goods or services for which a mark is registered are the same as those found in the provisions relating to revocation on the grounds of non-use under Section 46. When considering partial revocation of a mark the starting point is for the court to find as a fact what use had been made of the trade mark. In *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 293 it was stated that because of the rights conferred by Section 10(2) of the Trade Marks Act 1994, fairness to the proprietor did not require a wide specification of goods or services. This was approved in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32. In the *Thomson* case Aldous L.J conducted a useful critique of recent case law relating to revocation and referring to the *Decon* case said:

“30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?”

57. This approach was cited with approval in *West (T/A Eastenders) v Fuller Smith & Turner plc* [2003] FSR 44, in which it was stated that the aim is to arrive at “a fair description which would be used by the average consumer for the products in which the mark has been used by the proprietor”. He went on to say:

“31 .... In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use ... Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

58. The opponents' specification is as follows:

Paints; coatings and enamels, all in the nature of paints; varnishes (other than insulating varnish); colouring matters (not for laundry or toilet use); distempers; japans; lacquers; paint and varnish drying preparations and substances; wood preservatives; wood stains; anti-corrosives; anti-fouling compositions; thinners for the foresaid goods; all included in Class 2.

59. To my mind the term “paints” is a general description that covers many of the following terms. In their evidence the registered proprietors describe their STERISHEEN product as a “coating” rather than a paint. That “coatings...in the nature of paints” is listed in the specification to me indicates that when constructing the specification, the registered proprietors considered “coatings” to be a definable subset of paints. It seems logical to infer that the consumer of such products will recognise the STERISHEEN product in the same way. I do not, however, consider it would be appropriate to restrict these coatings to being of acrylic or for coating surfaces. There is no evidence, nor any reason to believe that coatings form separate subsets by material, or that there are coatings other than for surfaces. It is,

however, necessary to qualify the coatings as being “in the nature of paints, as not doing so would have the consequence of widening the scope of the specification. I therefore consider it appropriate to proceed on the basis that the specification of the applicants’ earlier mark is as follows:

Coatings in the nature of paints.

60. The selection of a paints and coatings will primarily be a visual act, which means that similarity in the appearance of the marks will be of some significance. However, such goods may also be made orally, such as through an enquiry made of a sales assistant where it will be the aural similarity that will play its part. But however the goods at issue are obtained they are of such a nature that conceptual similarity will have some bearing. I am of course conscious that the consumer will not always be in a position to see the respective goods displayed side by side. They may well be able to do so in builders merchants, DIY stores and the like where goods are displayed together by type according to their purpose, particularly where this is specialised, but of course only in establishments that stock both brands and that is an unknown quantity.

61. In a visual comparison of long words such as STERISHIELD and STERISHEEN the number of letters in each is of less significance than the overall impact on the eye brought about by any similarities and/or differences in the sequencing and the relative strength of the letters and syllables, and whether there are elements that are discernable or more memorable to the consumer. It is also relevant to consider that it is generally the beginnings of words that are considered to have most significance in any comparison, as is the fact that in longer words, differences may have proportionately less significance than in shorter words.

62. Both of the respective marks begin with the element “STERI”. As I have already stated, whether or not this is a recognised abbreviation, shortening form (or whatever), given the nature of the goods covered by the respective marks it is not unreasonable to infer that the relevant consumer is likely to recognise the element as separately indicating that the goods have a function related to sterilising. The remaining parts of the respective marks consist of ordinary English words that have an indirect reference to the goods. It therefore seems to me that whether viewed from the perspective of the Registrar, or the consumer of the goods in question, it is apparent that the respective marks are composed of two discernable elements.

63. To the extent that both marks begin with STERI they will be identical in sound and appearance. Although followed by different words, these both begin with the consonants “SH” preceding two vowels that add to the similarity, albeit more so in sound than appearance. These elements have a significant impact upon the aural impression of the respective marks, as does the fact that the difference exists in their termination which is generally accepted as being the least important because of the tendency of slurring. Both marks have a flow composed of three syllables, and although words are not usually spoken with regard to every letter and syllable, the letter “I” in STERI creates a natural break emphasising that the marks are composed of two distinct parts. In my view, that the second element is a well known word means that the eye is more likely to pick it out. This, in turn will influence the sound when spoken because the consumer will see and enunciate the marks in three steps – STER-I-SHIELD or STER-I-SHEEN. Taking a balanced view, I consider the respective marks to be similar in sound, but not so in appearance.

64. Insofar as these are, as a whole, invented words, they will convey that idea to the consumer. That the first element is identical and likely to be viewed as an indicator of something sterile or for sterilising adds to this conceptual similarity. However, the marks must be viewed in their totality, which is where the differences in meanings of the suffix words will diminish this conceptual overlap to the extent that I would say that in this respect these marks are not similar. In my view, balancing all of the factors for and against these marks being similar, I find them not to be.

65. If only by virtue of its positioning, the STERI prefix is clearly something that will stick in the mind, but this is lessened by the fact that the consumer of the relevant goods is likely to see it as an indication of some capacity or result obtained from their use. Equally, SHIELD and SHEEN are also likely to be regarded as having a similar reference. Consequently I do not consider there to be a distinctive element in the respective marks that significantly dominates; their distinctiveness rests in their whole, which in any event is how the case law says the consumer sees a mark.

66. Turning to the question of the similarity (or otherwise) of the goods covered by the applicants' earlier marks, and those for which the subject trade mark is registered. The applicants provided evidence showing that they use STERISHEEN on a product described as a "waterborne modified acrylic for internal surfaces", which when considering the proof of use requirement I accepted as justifying a specification of "Coatings in the nature of paints". There is also evidence that shows the registered proprietors to use STERISHIELD in respect of a "paint" product in the form of a film that inhibits the formation of bacteria. To me this indicates that in the reality of the market there is a similarity in the goods for which the respective marks are actually used. I appreciate, however, that taking into account my findings in relation to the Proof of Use requirements, I am required to determine the matter on the basis of the "notional" range of goods covered by the respective specifications. That there is identity in these specifications is self-evident; one covers "coatings in the nature of paints", and the other "paints" at large which would include those in the nature of "coatings".

67. Whilst the respective goods for which the marks are actually used are fairly specialised, neither the opponents' nor the applicants' specifications contain any qualifications or restrictions that would serve to move them into separate markets. Both are expressed in fairly general terms, and notionally contain the same range, from the simple to the sophisticated, and go into the same area of trade. I must therefore proceed on the basis that the respective goods are capable of being of the type purchased by the public at large with minimal care and attention, to the technical used by the trained and knowledgeable professional who will make a deliberate and informed purchase. Notionally, the channels of trade, the means by which they reach the point of sale, retail circumstances and the "relevant" consumers of the respective goods are also the same.

68. The applicants lay claim to having made continuous use of STERISHEEN for some 12 years, which means that the use would have commenced around 1993–94. The turnover figures relating to sales in the years 2000 to 2004 appear very modest, even for a single and specialised product, and as they have not been put into the context of the relevant market, I am unable to gauge the likely impact on the consciousness of the consumer of such goods.

69. Much of the evidence provided by the applicants either consists of information prepared by them without any indication of when or where it may have reached the consumer, or is undated or dated after the relevant date. Evidence showing use prior to the relevant date is thin to say the least. Taking Exhibit JG7 which consists of a list of case studies of contracts that involved the use of STERISHEEN in conjunction with Exhibit JG5 it is possible to pinpoint use dating from 1997/98. Exhibit JG6 consists of two brochures. One shows use of STERISHEEN ULTRA that was first available in November 1998. This describes the product as a “Waterborne modified acrylic for internal surfaces”. The second dates from June 2004 and shows use of STERISHEEN in relation to a “single pack, tough, modified acrylic, mid-sheen surface coating which...contains a non-leaching anti-microbial system.”. There is, however, nothing that tells me how many, or to whom these brochures were supplied. Taken as a whole I reach the conclusion that the evidence does no more than suggest the applicants have built a reputation in the name STERISHEEN, but as to establishing this, let alone the extent, it falls woefully short.

70. It seems to me that the applicants’ case rests on the proposition that the consumer will focus on the “STERI” prefix to the marks, will overlook the fact that the second element is different, and through “imperfect recollection” confuse the two. Such a finding would be against the prevailing case law which states that the relevant consumer will be reasonably well informed, circumspect and observant, and will perceive a mark as a whole rather than analyse its various details. To my mind, whilst there are similarities these are more than counterbalanced by the fact that the respective marks have a relatively weak distinctive character, and are, as a whole different.

71. It is also important to take account of the fact that the respective parties both accept that the marks are composed of one or more elements that are in common use in their trade. In *Office Cleaning Services Ltd* [1946] RPC 39 it was held that where a trader adopts a trading name containing words in common use, some risk of confusion may be inevitable, but that risk must be run unless the first trader is allowed an unfair monopoly, and in such cases the Court will accept comparatively small differences as sufficient to avert confusion. This seems an eminently sensible approach. I do not consider that when appreciated “globally”, the facts and circumstances are such that use of the mark STERISHIELD by the registered proprietors will lead the public to believe, and wrongly so, that the goods are those of the applicants or some linked undertaking, and the ground under Section 5(2)(b) is dismissed.

72. This leaves the ground under Section 5(3). That section reads as follows:

“5.-(3) A trade mark which - (a) is identical with or similar to an earlier trade mark, 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.”

73. The European Court of Justice in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C-292/00) which was confirmed by its decision in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (C-408/01) determined that Article 5(2) of the Directive granted a right to the proprietor of an earlier trade mark with a reputation, to prevent others from using an identical or similar trade mark in relation to goods or services where such use would, without due cause, take unfair advantage or be detrimental to the distinctive character of the earlier trade mark.

74. The registered proprietors do not specifically deny that they will benefit, or that the distinctiveness or reputation of the applicant’s mark will suffer as a result of their use of STERISHIELD, instead relying on a general denial of the grounds. Whilst there is nothing inherently wrong with this, the consequence is that in the event of it being found that advantage will be gained, or detriment suffered, I do not see that I am in a position to conclude that the registered proprietors nonetheless had due cause to use the trade mark.

75. It was stated in *Premier Brands UK v Typhoon Europe* [2000] FSR 767, “Section 10(3) is not intended to have the sweeping effect of preventing the use of any sign which is the same or similar to, a registered trade mark with a “reputation” or have the intention of enabling the proprietor of a well known registered mark “... to be able to object as a matter of course to the use of a sign which may remind people of his mark.”.

76. As I have already stated in my determination of the earlier grounds, whilst it is clear that there is identity in respect of the goods, I do not consider the applicants’ mark STERISHEEN to be to be similar to the mark STERISHIELD.

77. The next requirement is that the applicants’ mark possesses a reputation in the UK to the extent set out by the ECJ in *General Motors Corporation v Yplon SA* [1999] E.T.M.R. 122 (*Chevy*). In this case the Court concluded that the requirement implies a certain degree of knowledge amongst the public, and that the required level would be considered to have been reached when the earlier mark is known by a significant part of the relevant sectors of the public. In deciding whether this requirement is fulfilled all relevant factors should be considered, including, the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking promoting it; the stronger the reputation and distinctive character, the easier it will be to accept that detriment has been caused to it.

78. Earlier in this decision I expressed my view that the evidence fell well short of establishing, with any degree of certainty, that the applicants possessed a reputation of any quantifiable value. It certainly does not go anywhere near to proving the existence of a

reputation amongst a “significant part” of the relevant sectors of the public, primarily because it is lacking in the very detail identified in *Chevy*.

79. I am also unclear as to the benefit to be gained, or detriment caused by the registered proprietors’ use of STERISHIELD in relation to the goods for which it is registered. In the *Chevy* case, the ECJ said the following:

“43. It is to be noted in particular that Article 5(2), in contrast to Article 5(1)(b), does not refer to a mere risk or likelihood of its conditions being fulfilled. The wording is more positive: “takes unfair advantage of, or is detrimental to”. Moreover, the taking of unfair advantage or the suffering of detriment must be properly substantiated, that is to say, properly established to the satisfaction of the national court: the national court must be satisfied by evidence of actual detriment, or of unfair advantage. The precise method of adducing such proof should in my view be a matter for national rules of evidence and procedure, as in the case of establishing likelihood of confusion: see the tenth recital of the preamble.”

80. There is no evidence that damage or detriment will occur. I presume that the applicants consider that this will come about through origin confusion, but I have already found that that will not happen. Consequently, the ground under Section 5(3) is also dismissed.

81. The application having failed on all grounds, I order the applicants to pay the registered proprietors the sum of £2,750 as a contribution towards their costs. This sum 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 January 2007**

**Mike Foley  
for the Registrar  
the Comptroller-General**