

O-048-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2388778
BY PAINTMASTER (2000) LTD TO REGISTER
A TRADE MARK IN CLASS 2**

AND

**IN THE MATTER OF OPPOSITION NO 93737
BY WICKES LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2388778 by
PAINTMASTER (2000) Ltd to register a Trade Mark
in Class 2**

and

**IN THE MATTER OF OPPOSITION NO 93737 by
WICKES LIMITED**

BACKGROUND

1. On 6 April 2005 Paintmaster (2000) Ltd applied to register the following mark.



for a specification of goods that reads:

“Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.”

The application is numbered 2388778.

2. On 12 September 2005 Wickes Limited filed notice of opposition to this application citing a single ground of objection under Section 5(2)(b) of the Act based on earlier trade mark No 1530915. The latter is registered in respect of “paints, paint products, varnishes; enamels; lacquers; coatings; paint thinners; preservatives against rust and against deterioration of wood; all included in Class 2”.

3. The opponent was also required to make a statement of use pursuant to the requirements of the Trade Marks (Proof of Use, etc) Regulations 2004. In relation to No 1530915 the opponent claimed use on paints.

4. The opponent has further indicated that it regards “paints” in the applied for specification to be identical to its own goods and “varnishes, lacquers, preservatives against rust and against deterioration of wood, metals in foil and powder form for painters, decorators, printers and artists” to be similar. Hence, the opposition is a partial attack.

5. The applicant filed a counterstatement denying the above ground and putting the opponent to proof of its claims. The counterstatement also contains a number of submissions in relation to the marks. I bear these points in mind.

6. Only the opponent has filed evidence in these proceedings. Neither side has asked to be heard and neither side filed written submissions in response to the Registry’s letter of 7 December 2006 inviting them to do so. However, as I have noted above, the applicant’s counterstatement included what amounts to submissions as does Carpmaels & Ransford’s (the opponent’s professional representatives) letter of 26 June 2006 covering the opponent’s evidence.

7. Acting on behalf of the Registrar and with the above material in mind I give this decision.

Opponent’s evidence

8. This comes in the form of a witness statement by Jeremy Bird, a director of Travis Perkins Trading Company Ltd and of a number of Wickes companies. The Wickes Group, including Wickes Limited, became part of the Travis Perkins Group following its acquisition in 2005.

9. The MASTER trade mark was first used by Wickes in the UK in relation to paints in 1991 and such use has been continuous since then. Retail sales value is estimated at approximately £130 million. The following breakdown is given for the years 1993 onwards:

YEAR	Retail Sales Value Of Master Branded Paint, Including Vat (£ Million)
1993	5.5
1994	6.5
1995	7.4
1996	7.4
1997	9.2
1998	7.7
1999	10.3
2000	10.0
2004	14.2
2005	16.2

10. The values for the years 1993 to 1995 are said to be estimated. The values for subsequent years are actuals. I note that no figures have been given for the years 2001 to 2003. I think this might be an inadvertent omission as the market share figures

which are subsequently set out by Mr Bird include the years 2001 to 2003. Market share has been fairly consistent at or about 1.5% from 1993 to 2005.

11. The MASTER trade mark has been used on all packaging, point of sale material, colour cards and in photographs included in the Wickes catalogue. Exhibits 1-17 consist of a selection of materials that have been used by Wickes to market the MASTER trade mark, including colour cards and catalogues. The Wickes catalogues are said to have a distribution of approximately 10 million households per issue. In a normal year there are 7-8 issues of this type of catalogue.

12. Examples of product labelling are shown in Exhibit 18.

13. Mr Bird goes on to give information on marketing and advertising. He estimates that Wickes spends in the region of £250,000 per year on MASTER colour cards alone.

14. The MASTER products also appear in various trade publications and price lists. A sample price list from DIY Week is shown in Exhibit 19, along with a page taken from the magazine illustrating the circulation of the publication (Exhibit 20). Current official circulation figures for DIY Week are given in Exhibit 21.

15. Exhibit 22 is a report provided by the company's advertising agents showing details of national and local press advertising containing references to the MASTER range. Advertisements have appeared in The Daily Record, The Daily Star, The Evening Chronicle, The Evening Standard, The Daily Express, the Liverpool Echo, The Mirror and The Sun. The costs of placing individual advertisements range from £2,660 to £46,600. Examples of actual advertisements are shown in Exhibit 23.

16. Finally a store by store breakdown of MASTER sales in 2005 is given at Exhibit 24 for the purpose of illustrating the geographical spread of the business.

17. That completes my review of the evidence.

DECISION

18. The single ground of opposition is under Section 5(2)(b) of the Act. This 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.”

19. As noted above, the Proof of Use Regulations apply to the opponent's earlier trade mark. The applicant's counterstatement denies that the opponent's mark has been

used in respect of all the goods covered by the registration. However, the opponent makes no such claim. It merely claims use in relation to paints. The applicant's supplementary claim is that, to the extent that there has been use, it is of 'Wickes Master Paint' and not the mark as registered.

20. I accept that the word MASTER often appears in close association with the housemark WICKES but I do not accept the generality of the applicant's claim. One need look no further than Exhibit 1 to find examples of MASTER being used as a standalone mark. I am in no doubt that the opponent is fully entitled to claim use of MASTER in relation to paints.

21. In turning to the substance of the opposition I take account of the guidance from the following well known cases from the European Court of Justice - *Sabel BV v Puma AG* [1998] R.P.C. 199 *Canon Kabushiki Kaisha v Metro-Goldwyn- Mayer Inc.* [1999] R.P.C. 117 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*[2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 72:

Comparison of goods

22. Firstly, I reiterate that the opposition is directed at the goods set out in paragraph 4 above. No objection has been taken against "colorants; mordants; raw natural resins" (confirmed in Carpmaels & Ransford's letter of 26 June 2006).

23. It is clear from the opponent's evidence that the terms "paints" must be taken to include products for a variety of purposes inside and out including paints for specialist areas such as kitchens and bathrooms and masonry paint. Apart from a general statement that the opponent is put to strict proof of all elements of Section 5(2)(b), the applicant has not commented on the issue of similarity of goods. Clearly, however, identical goods are involved to the extent that paints is a self-contained term in the applied for specification. Varnishes, lacquers and preservatives against rust and against deterioration of wood are closely similar to paints being alternative forms of surface coatings intended to protect or provide decoration. The remaining item that is objected to is metals in foil and powder form for painters, decorators, printers and artists. Neither side has offered further explanation of the term. I am not clear, therefore, whether such products are in competition with paints or complementary or ancillary to paints. Their nature, being metals in foil and powder form, suggests that they are somewhat different to paints and probably intended for specialist purposes though I note that they are, inter alia, directed at painters and decorators. I have no information on their channels of trade. If, or to the extent that such products are similar to paints I regard that similarity as being at a low level.

Comparison of marks

24. The opponent's mark is the plain word MASTER. The applied for mark is a composite one. The applicant's counterstatement has this to say:

"..... the mark applied for is a word and device mark in colour, the word element is one word of a total eleven letters and three syllables PAINTMASTER. The logo element, the rectangle containing the word

PAINTMASTER and the rhombus shape containing the rectangle also assist in distinguishing the mark applied for from the word of six letters and two syllables, MASTER, as does the combination of colours in the mark applied for, black and yellow.”

25. The applicant is clearly right to identify the elements that make up its mark. Nevertheless the logo element is in itself unremarkable. The rectangle serves as little more than a backdrop for the word PAINTMASTER. The rhombus is visually prominent but is also more likely to be seen as contributing to the framing of the word rather than constituting a distinctive feature in its own right. The mark is presented for registration in the colours yellow and black but is not so limited.

26. Whilst it is well established that marks must not be overanalysed or dissected, the irresistible conclusion seems to me to be that it is the word PAINTMASTER that will, for the average consumer, constitute the distinctive and memorable element of the mark.

27. As the applicant has pointed out PAINTMASTER is an eleven letter word in contrast to the six letters of MASTER. On the other hand PAINTMASTER readily breaks down into its component elements with the result that the conjoining of the words does little to obscure the derivation of the resulting word. The applied for mark self evidently contains the whole of the earlier trade mark.

28. The European case law makes it clear that the mere fact that a composite mark contains an element that is identical or similar to another mark does not necessarily result in a finding of similarity. Thus in *The Royal County of Berkshire Polo Club Ltd v OHIM*, Case T-214/04 it was held that:-

“39. Next, it must be recalled that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany* (MATRATZEN) [2002] ECR II-4335, paragraph 33).”

29. But descriptive elements will not generally form the focus of consumer attention with the consequence that such elements will not usually be considered to be distinctive and dominant within the context of the overall impression conveyed by the mark (see *Jose Alejandro SL v OHIM*, Case T-129/01, [2004] ETMR 15).

30. In Case T-22/04 the Court of First Instance (CFI) annulled the decision of OHIM’s Second Board of Appeal in a case involving the marks WESTLIFE and WEST. In its judgment the Court said:

“37 It must also be borne in mind that the Court of First Instance has already held that, on an initial analysis, where one of the two words which alone constitute a word mark is identical, both visually and aurally, to the

single word which constitutes an earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned, the marks at issue, each considered as a whole, are normally to be regarded as similar (Case T-286/02 *Oriental Kitchen v OHIM – Mou Dybfrost (KIAP MOU)* [2003] ECR II-0000, paragraph 39).

38 In this instance one of the two words which alone constitute the word mark applied for is actually identical in appearance to the sole word forming the earlier word mark. Aurally, there is a degree of similarity, although the pronunciation of the word ‘west’ is not identical, at least as regards the whole of the relevant public. In this instance, the two words forming the Westlife mark mean something to the relevant public but they do not describe either the goods or services in question or their qualities and therefore do not have any particular connotation in relation to them.

39 Although the approach described at paragraph 37 above is not therefore directly applicable in this case, it must none the less be stated that the only visual difference between the two word marks at issue is that one of them contains a further element added to the first. Moreover, as stated above, there is a degree of similarity between the two marks in aural terms and, in particular, in conceptual terms.

40 It must therefore be held, in this case, that the fact that the Westlife trade mark consists exclusively of the earlier West trade mark, to which another word, ‘life’, has been added, is an indication that the two trade marks are similar.”

31. The CFI went on to find that the relevant public might consider the mark applied for to be a variant of the earlier mark or at least that there was an economic link between the companies or undertakings marketing goods or services under the marks.

32. It may well be said that the first element of the word PAINTMASTER being merely the name of a category of goods, should be assumed to carry little weight with consumers. But that would be to ignore the context in which it appears and the significance (if any) of the whole word. Indeed, it seems to me that this case turns in large measure on whether PAINTMASTER (and device) conjures up a sufficiently distinct and different idea to MASTER solus.

33. It has been held that different conceptual considerations can play an important part in serving to distinguish between marks (see paragraph 54 of the CFI’s judgment in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH*, Case T-292/01). The ECJ has also held that where conceptual dissimilarities are being relied on to counteract visual and/or aural similarities, it is necessary for one of the signs to have a clear and specific meaning so that the public is capable of grasping it immediately, Case C-361/04P *Ruiz Picasso and Others v OHIM* [2006] ECR I-0000, paragraph 20.

34. The word MASTER may be used either as a noun or a verb. It is often also used as a modifier in expressions such as a master craftsman. In certain contexts, in

combination with other words, it may suggest a controlling function eg a master switch. In my view the word PAINTMASTER is resistant to conventional analysis in this way. If it does yield a meaning at all it might be as a compressed form of master of paint. But in my view the meaning, if there is one, is indeterminate and somewhat impenetrable. In the context of the guidance from the *Picasso* case referred to above there is no clear and specific meaning that the public is capable of grasping immediately. I am not persuaded, therefore, that there is a clear point of conceptual difference between the word elements of the respective marks.

35. Reverting to a whole mark comparison I find that the marks are similar but to a moderate rather than a high degree. In reaching this view I take account of both the slightly unusual combination of the words PAINT and MASTER and the logo and colour elements of the applied for mark although it is fair to say that I regard these latter features as being ancillary to the word itself.

Distinctive character of the opponent's earlier trade mark

36. It is convenient at this point to comment briefly on the following claim made in the applicant's counterstatement.

“The registration of the word MASTER under No 1530915 by the Opponent is invalid on the basis that this mark is not capable of distinguishing goods of the Opponent from those of other undertakings and is devoid of distinctive character. The mark is therefore liable to be declared invalid under Section 47(1) Trade Mark Act 1994.”

37. Registration of a mark is prima facie evidence of its validity (Section 72). That presumption is, of course, capable of being displaced by, for instance, a successful invalidation action. So far as I am aware the applicant has not launched any such action against the opponent's registration or, if it has, there has been no request to stay the current proceedings to await the outcome. To that extent the applicant's claim leads nowhere.

38. Underlying the claim appears to be the suggestion that MASTER is devoid of distinctive character in relation to the goods for which it is registered. There is no explanation as to why this should be the case. I have indicated above that MASTER may have descriptive significance in the context of combinations such as master craftsman or master switch. I am unaware of any such descriptive significance in relation to paints.

39. That said MASTER is an ordinary dictionary word and (based on its inherent qualities) cannot claim the sort of distinctive character that is normally associated with invented word. In this case, however, the opponent has filed evidence of use including sales and market share figures that allow me to conclude that the modest inherent qualities of the word have been enhanced. The evidence shows that MASTER is a Wickes sub-brand and that the word is sometimes used with or in close association with the housemark but I am in no doubt that it is also clearly presented as a stand-alone mark. I note too that the Wickes catalogues, in which the mark appears, have a very wide distribution (said to be 10 million households per issue) and that there has been extensive advertising in the national press.

The average consumer

40. In addition to wholesalers, retailers and others in the distribution chain, there are likely to be two distinct categories of retail customers for paints and associated goods – the general public who purchase for home decoration purposes and the trade (painters, decorators etc) who purchase in the course of their business. Whilst paint is not an especially expensive item some care is likely to be exercised in the purchasing process not least because colour and colour matching is important and purchasers will want to satisfy themselves that the products are suited to their particular needs (indoor, outdoor and specialist uses within those broad categories). On the other hand (and particularly for the general public) paint may not be purchased on a regular basis so imperfect recollection will come into play.

Likelihood of confusion

41. It has been held (per *Sabel v Puma* paragraph 23) that the average consumer does not analyse marks into their component parts. The word PAINTMASTER has no obvious meaning of its own but readily suggests the elements from which it is formed. Even so the differences between the respective marks are such that I consider direct confusion to be unlikely. Allowing for the inherent and acquired distinctiveness of the opponent's mark I take the view that the average consumer will make an association between them particularly given the non-distinctive nature of the first element of the applied for mark. Mere association, in the sense of a bringing to mind, is not sufficient for the purposes of Section 5(2) (*Sabel v Puma*, paragraph 26). 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 v MGM*, paragraph 29).

42. I note also in this case that the opponent's advertising plays on the MASTER theme. Thus, for instance, Exhibit 9 shows use of MASTER PLANS, MASTER STROKE, MASTER CHEF (in relation to the kitchen paint range), MASTER PEACE (of relaxation) etc. Similar word plays appear in Exhibit 10 and 12. I do not regard the opponent's case as turning on such references but it does reinforce me in my view that the association between the respective marks is sufficiently strong to lead consumers to consider that paint and closely associated products offered under the applied for composite mark would be from the same stable as the MASTER paints with which they were already familiar. As the opponent's written submissions suggest it is likely that a consumer with imperfect recollection of MASTER paint will mistakenly think that a PAINTMASTER product comes from the same trade source.

43. The opposition succeeds under Section 5(2)(b) in relation to paints, varnishes, lacquers and preservatives against rust and against deterioration of wood. I am not persuaded that the same position can be sustained in relation to metals in foil and powder form for painters, decorators, printers and artists where I have found a lower level of similarity to exist with the opponent's goods (based on its inherent qualities). Accordingly, the application will be allowed to proceed for colorants, mordants and metals in foil and powder form for painters, decorators, printers and artists and refused for the other items.

COSTS

44. The opponent has been largely successful in its partial attack and is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of **£1000** (adjusted to reflect the balance of success for the parties). This sum 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 14th day of February 2007

M REYNOLDS
For the Registrar
The Comptroller General