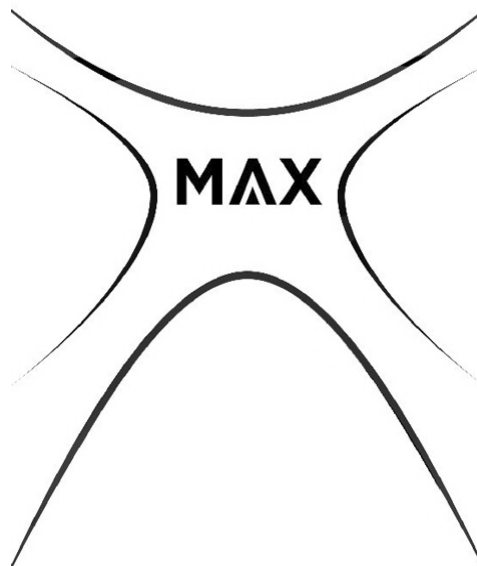


O-475-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2615411 FOR REGISTRATION OF



BY THE VALSPAR CORPORATION

AND

OPPOSITION THERETO UNDER NO 103854
BY PETER KWASNY GMBH


Background

1. On 23 March 2012, The Valspar Corporation (“The applicant”) sought registration of the mark shown on the front cover of this decision for the following goods:

Class 2:

Aerosol spray paints; paints, stains, varnishes, lacquers; coatings; protective coatings; 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.

2. Following publication of the application in the *Trade Marks Journal*, No 6945 on 22 June 2012, notice of opposition was filed by Peter Kwasny GmbH (“the opponent”). The opposition is founded upon grounds under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and relies upon the following Community trade mark (“CTM”):

| Mark | Dates | Specification relied upon |
|--|--|--|
|  <p>CTM 384859</p> | Filing date: 16 September 1996 Registration date: 4 November 1998 | Class 2: Paints, varnishes, lacquers and painting preparation materials (included in class 2). |

3. The opponent states that it has used its mark throughout the EU since 1997 in relation to all of the goods relied upon. It claims that as a result of this use, its mark has acquired a reputation and use by the applicant of its mark will take unfair advantage of that repute resulting in its dilution and tarnishment.

4. The applicant filed a counterstatement essentially denying the grounds of opposition. Both parties filed evidence and the matter came before me for a hearing on 12 November 2013. Mr Terry Rundle of Wilson Gunn represented the opponent. The applicant did not attend but written submissions in lieu of attendance were filed by Mr David Powell of Stevens, Hewlett & Perkins.

The evidence

The opponent’s evidence

5. The opponent’s evidence takes the form of a witness statement dated 18 February 2013 by Hans-Peter Kwasny, who is the Chief Executive Officer of the opponent.

6. Mr Kwasny states that the opponent’s trade mark was first used within the European Community at least as early as 1997 with that use being continuous since that time. He states that the trade mark “is used by applying it to the labels of spray

paint cans which are sold by vehicle manufacturers such as Volkswagen and Nissan as well as by market chains and by other automotive paints suppliers in the car refinishing industry, eg Spies Hecker and international manufacturers of automotive paints, eg Standox”.

7. Mr Kwasny exhibits the following:

HPK-001: Stated to be “sample flyers and product brochures in the English language, which have been used and are currently in use in the United Kingdom”.

Pages 1-6 comprise a leaflet entitled “FillClean® The filling system for spray paint cans” which is described as “a professional filling system for cleaning-free filling of spray paint cans with the original colour tone” and “a modular component of the SprayMax PaintRepair System comprising ~SprayMax Spraypaint Can System, incl. PaintRepair Case ~SprayMax PaintRepair FillClean System ~SprayMax PaintRepair Mini Mixing System”. The opponent’s mark is shown on various cans depicted on the document which appears to be dated 08/12 and which is after the relevant date.

Pages 7-42 is a brochure with the cover showing the words “Products Paint Repair”. At page 8 is included the following: “The SprayMax program initially kicked off with individual products but now comprises a complete painting system, the SprayMax PaintRepair System. All the products, colours and applications required for professional paint repair work are available in the SprayMax range.” The table of contents refers to primers/fillers, basecoats, topcoats and clear coats. The opponent’s mark is shown on various cans depicted on the document which is undated.

Pages 44-45 is a leaflet entitled “Primer Shade System” which shows the opponent’s mark on various cans. The document appears to be dated 07/12 which again is after the relevant date.

Pages 47-48 is a leaflet entitled “Headlight Sealer” which describes a “primer for restoring damages of polycarbonate covers e.g. car head light” and shows the opponent’s mark on various cans. The document appears to be dated 08/12 which is after the relevant date.

HPK-002: This exhibit is stated to be “copies of the respective labels” of products sold through customers. There are four pages, each of which appears to show a printer’s proof of a label.

Page 1 is for an epoxy primer-filler distributed through Volkswagen. It bears the opponent’s mark and ownership. The label bears no date.

Page 2 is for a forklift spray paint distributed by Nissan. It bears the opponent’s mark and ownership. The label bears no date.

Page 3 is for a primer filler distributed by Stadox GmbH. Bearing the opponent's mark, it shows a copyright date of 2012.

Page 4 is for a wash primer distributed by Spies Hecker. Bearing the opponent's mark, it shows a copyright date of 2012.

HPK-003: What is said to be:

“a complete overview of the turnover figures for the years 2007 to 2011. In the left column the abbreviation PKD refers to turnover generated in Germany, the abbreviation PKF refers to turnover generated in France and the southern European countries (effected via France); and Co-Branding in PKD includes SPRAY MAX products which are delivered from Germany to the respective customers Volkswagen, Nissan Forklift, DuPont, Stadox and Spies Hecker”.

A copy of the exhibit is attached at Annex A to this decision. It shows a table setting out the figures to which Mr Kwasny refers. He states that the list of countries set out below the table is a list of the countries to which the opponent's SPRAY MAX products are supplied, either directly or indirectly. Whilst various countries are listed (in what I presume is German) and includes the UK, no details of any sales which might have been made in or to those countries, at any particular time, are provided.

HPK-004: Said to be sample copies of invoices and which date from 26 October 2006 to 27 April 2012 (this latter date is after the relevant date). Each includes items identified as LLS MAX and SM which Mr Kwasny states refers to the opponent's Spray Max products. There are 21 invoices: 12 are addressed to Volkswagenwerk AG in Germany and, though they are in German and no translations have been provided, they appear to show sales of various goods such as primers and fillers; 5 are addressed to Nissan International SA in Switzerland and show what I take to be sales of paints for forklifts; 4 are addressed to an auto supplies shop in Feltham, Middlesex and show a total within the relevant period of 6 Epoxy Grd Fuller Beige, which I take to be a filler and 168 Klarlak, which I take to be clear lacquer. None of the invoices bear the mark relied on by the opponent.

The applicant's evidence

8. The applicant's evidence takes the form of a witness statement of Mr David Powell. As Mr Rundle pointed out at the hearing, much of Mr Powell's witness statement consists of submissions which, as it is not evidence, I do not summarise here though I will take them into account and refer to them as necessary in this decision.

9. At DEP2 he exhibits a copy of the entry for the word MAX taken from the Collins English Dictionary showing the word to be an abbreviation of the word maximum.

Mr Powell submits that the word MAX is commonly used in relation to paint and ancillary products, particularly in the automotive sector and in support exhibits extracts taken from the internet following searches he carried out (details of when, how or what he searched are not provided). Each of the exhibits (DEP4-DEP10) show various paints offered for sale. The extracts were downloaded on either 13 November 2012 or 17 April 2013 both dates being after the relevant date. I will return to these exhibits later in my decision.

10. Mr Powell states he carried out a search of the UK trade marks database and exhibits the results at DEP11. Details of thirteen CTM and UK marks are exhibited, each of which incorporates the word MAX within it and which includes the earlier mark relied on by the opponent in these proceedings. There are three other marks which either expired before the relevant date or have a filing date later than the relevant date.

11. Mr Powell states he carried out a search of the USPTO database and, at DEP12, exhibits copies of the case details for two registrations which co-exist on that register which are the same as are at issue in the current proceedings and owned by the same parties.

12. That concludes my summary of the evidence filed in these proceedings.

The objection under section 5(2)(b) of the Act

13. I turn first to the ground of opposition based on section 5(2)(b) of the Act which reads:

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.”

14. An “earlier trade mark” is defined in section 6, the relevant part of which states:

“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.”

15. The opponent relies on its CTM 384859. This is an earlier trade mark within the meaning of section 6(1) of the Act. The applicant has requested the opponent prove

use of its mark and, given the interplay between the date of registration of this earlier mark and the date the application was published, the provisions of section 6A of the Act are relevant.

16. Section 6A of the Act reads:

“(1) This section applies where –

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the period of five years ending with the date of publication of the application 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) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) 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.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) 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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

17. Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

18. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation of a trade mark registration based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of publication of the application for registration i.e. 23 June 2007 to 22 June 2012.

19. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The 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 goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at

maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

20. I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, in relation to determining what constitutes a fair specification, namely:

“Pumfrey J in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the 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”.

21. In *Animal Trade Mark* [2004] FSR 19, Jacob J held:

“The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White’s brilliant and

memorable example of a narrow specification) “three-holed razor blades imported from Venezuela” is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say “razor blades” or just “razors”. Thus the “fair description” is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (“the umbra”) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (“the penumbra”). A lot depends on the nature of the goods—are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

22. Also of relevance are the comments of the General Court in *Reckitt Benckiser (España) SL v OHIM*, Case T-126/03 where it said:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

23. Finally, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs Q.C., sitting as the appointed person, stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be

achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

Findings on the use of the earlier mark

24. Mr Kwasny’s evidence is that the earlier mark has been used “by applying it to labels of spray paint cans” which are sold by third parties who are car manufacturers or automotive paints suppliers in the refinishing industry. Exhibits have been provided which shows various cans bearing both the third parties’ and opponent’s names. Mr Kwasny has provided turnover figures for the period 2007 to 2011. Those figures are said to relate to sales made in Germany and France. Whilst sales are said to have been made in or to a number of other countries within Europe, no separate turnover figures have been supplied in relation to these other countries, including any relating to sales to the UK. Invoices exhibited at HPK-004, most of which date from within the relevant period, appear to be in German and no translations have been supplied and do not show the earlier mark but bear the abbreviations LLS MAX and SM referred to in my summary of the exhibit at paragraph 7 above. The invoices relevant to the UK show sales within the relevant period to the same auto supplies shop of Grd Fuller (I have assumed this is a filler) and Klarlak (I have assumed this is clear lacquer) totalling just 6 and 168 cans respectively. No advertising or promotional costs have been supplied though sample product leaflets have been exhibited at HPK-001. Whilst these leaflets are either undated or appear to bear dates from after the relevant period, they show a number of spray cans for various paints and coatings which bear the earlier mark. Labels from cans of such goods are exhibited at HPK-002 (again, mostly undated).

25. The evidence filed by the opponent has a number of flaws but it has not been challenged by the applicant. Mr Kwasny claims the mark has been used continuously since at least 1997 in the EU and has provided what he says are current examples of use intended to show how it was used in the relevant period. Considering the evidence as a whole, I am prepared to accept that use of the mark has been shown within the relevant period in relation to a variety of products such as primers, paints and lacquers. I am also prepared to accept that the use shown is sufficient to enable the opponent to rely on its mark for each of the goods for which it is registered. That use, however, is shown in the evidence to refer to goods for use in relation to automobiles, cars and forklifts. All of these are types of vehicles. This is a sector of the market that is easily identified by the relevant consumer and so I consider that a fair specification of the use shown, and the one I shall take into account in my consideration under this ground, is:

Paints, varnishes, lacquers and painting preparation materials (included in class 2) all for use on vehicles.

26. Whilst the turnover figures supplied are not insignificant, no figures are given which allows me to put them into context in terms of the relevant trade. Nor are any figures provided which allows me to determine the level of sales made to customers in the UK. Mr Kwasny states that the material exhibited at HPK-001 has been and is

used in the UK but gives no specific details of where, when and to whom it may have been distributed and, as indicated above, the material is either undated or dates from after the relevant period. The invoices exhibited at HPK-004 include invoices issued to a UK address. As Mr Powell states in his written submissions, these invoices are “raised in the name of a single UK undertaking... [and] it would seem that the volumes of products shipped are low”. The invoices do not show the earlier mark. Again, considering the evidence as a whole, whilst I have found that it is sufficient to show use of the earlier mark, I do not consider it shows that the earlier mark benefits from any enhanced distinctiveness and neither is it shown to have a reputation in the UK. The earlier mark relied upon is a CTM and, whilst use has been shown in both France and Germany is sufficient to satisfy the requirements of section 6A of the Act, for the purposes of confusion and in respect of the consideration of the objection under section 5(3) of the Act, it has to be shown that the mark is known and has a reputation in the UK. The evidence does not support such a finding.

27. In considering the objection under section 5(2)(b) and the likelihood of confusion between the respective marks, I take into account the guidance from the settled case law provided by the CJEU in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *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, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs Q.C., acting as the Appointed Person, set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

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

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; 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, and whose attention varies according to the category of goods or services in question;

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the respective goods

28. Taking into account my findings regarding the use shown to have been made of the earlier mark, the goods to be compared are:

| Earlier mark's specification | Applicant's specification |
|---|--|
| Paints, varnishes, lacquers and painting preparation materials (included in class 2) all for use on vehicles. | Aerosol spray paints; paints, stains, varnishes, lacquers; coatings; protective coatings; 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 |

29. In his written submissions, Mr Powell states that there is “a level of identity/similarity between the respective sets of Class 2 goods”. For his part, Mr Rundle submits that “with the possible exception of “raw natural resins” [...] all other goods....are identical...”.

30. As the terms “paints”, “varnishes” and “lacquers” appear in both specifications, those for use on vehicles being a subset of the more general term, these goods must be considered to be identical (as per the findings of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) case T-133/05). “Aerosol spray paints” are a subset of paints and are identical to them. Similarly, “coatings” and “protective coatings” will include each of the opponent’s “paints, varnishes and lacquers” and these latter goods will include “preservatives against rust and against deterioration of wood” and “raw natural resins” given that these are goods as could be used on e.g. interior trim or classic

cars which use wood on their exteriors and so each of these are also identical goods. “Stains”, “colorants” and “mordants” are each coatings which apply a colour to a surface and are highly similar, if not identical to the opponent’s goods.



31. That leaves the applicant’s “metals in foil and powder form for painters, decorators, printers and artists”. Whilst each of these goods may be used as a decorative coating, they are likely to have different users to those of the opponent’s goods, be of a different nature to them and come through different trade channels. Any similarity between these respective goods is low.

The average consumer and the nature of the purchasing process

32. The respective goods are such as will be used by professionals as well as those members of the general public who carry out repair or enhancement works themselves whether in relation to general decorators’ products or those for use on vehicles. They are goods that will be bought through specialist suppliers but may also be bought in supermarkets or other stores (whether on the high street or via the Internet). They are goods that are likely to be bought by self-selection and so the visual aspects of the marks are likely to be of prime relevance whether bought in a store or online, though I do not rule out the possibility that the aural aspects may also play a part as buyers seek help and advice to ensure the product meets their technical needs or to place an order by telephone. Such goods may vary in price but, regardless of cost, I consider the average consumer will take a high degree of care in their purchase to ensure that what they are buying is e.g. suitable for the use intended and is of the appropriate colour or finish especially when needing to colour match.

Comparison of the respective marks

33. For ease of reference, the marks to be compared are:

| Earlier mark | Applicant's mark |
|---|--|
|  <p>The earlier mark consists of the word 'SPRAY' in a bold, sans-serif font, positioned above the word 'MAX' in a larger, bold, sans-serif font. To the right of 'MAX' is a stylized spray nozzle icon with a fan-shaped spray pattern.</p> |  <p>The applicant's mark features the word 'MAX' in a bold, sans-serif font, centered within a stylized frame. The frame is composed of four curved lines that meet at the corners, creating a shape reminiscent of a stylized 'X' or a decorative border.</p> |

34. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance

to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must compare the respective trade marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be their distinctive and dominant elements.

35. The earlier mark consists of a number of elements. There is the word SPRAY presented on a, largely rectangular, shaded background, the shading darkening towards the chamfered right hand side of that background. Underneath this, and in a larger font, is the word MAX where the letter X has one cross member longer than the other. Despite this lengthening, the letter will not be seen as anything other than the final letter of the word MAX. To the right of the letter X is a wedge-shaped area of shading which darkens to the (curved) right hand edge. The right hand side of the shading around the word SPRAY and the left hand side of the other area of shading are parallel to the relevant limbs of the letter X.

36. The word SPRAY is not distinctive for goods, such as paints and coatings which are provided in aerosol form. The word MAX, as Mr Powell's dictionary evidence shows, is an abbreviation of the word maximum. He submits that:

"The relevant public's perception of the element MAX (in light of the only possible ascribable meaning) will be that it constitutes an origin neutral indication which makes reference to the coating capabilities of the products and/or that the products are of the upmost quality or an enhanced version of a standard version predecessor."

37. In his submissions, Mr Rundle accepted that the word MAX has this meaning but indicated that it also had other meanings. He submitted:

"Whilst that may be the sole meaning given to MAX in that particular dictionary there are other meanings in other dictionaries and sources which are freely available on the Internet and in the public domain. For instance, the word MAX may be a noun, e.g. "the sound is distorted to the max", an adverb, e.g. "the trip costs about 35p max" and a verb e.g. "job growth in high technology will max out". Moreover, it is impossible to ignore the fact that the word MAX is used as a well-known first name, being the diminutive form of 'Maximilian'.

38. Whilst I accept that the word is used in a variety of grammatical contexts as submitted by Mr Rundle, it seems to me that in each of the examples he uses, the word is still used as a reference to the word maximum. And whilst I accept that Max is the diminutive form of the name Maximilian, as I indicated to Mr Rundle at the hearing and he accepted, this meaning is highly unlikely to be accorded to the word in the context of the earlier mark given the use of the word Spray within it.

39. As I indicated earlier, Mr Powell submits that the word MAX is in widespread use in relation to many goods and further submits that it is a word in use by others involved in the sale of paints. In support, he exhibits material at DEP4-10 as follows:

- DEP4: Pages showing details of the Dulux Weathershield Max paint products.
- DEP5: Pages taken from the Amazon UK website. Various products are advertised including Autotek Max Matt Paint, Autotek Max Plastic Primer, Autotek Max Primer Red and Autotek Max Gloss Paint. Details of the latter of these are given and it is promoted as providing “extra coverage”.
- DEP6: Pages taken from the website of a Telford company showing Max-line instant line marking paint described as having “superb brightness, excellent longevity”
- DEP7: Pages showing a range of tools and equipment for use when painting. The pages indicate a search was carried out for the word ‘maxfinish’
- DEP8: Pages showing liquid paint markers offered under the names Pro-Max and Pro Max
- DEP9: Pages showing the use of Aquamax in relation to tinters and basecoats
- DEP10: Pages showing the use of DuPont Cromax.

40. As Mr Rundle submits, the material at DEP4 is taken from a Malaysian website. Acknowledging that the materials at DEP6 to DEP10 all include the word MAX, he submits that this word forms only one element within the respective marks and the relevant marks are not on all fours with the current case. As to DEP5, Mr Rundle accepts that it appears to show use of the word MAX in relation to various vehicle paint products but points out that the information was downloaded on 13 November 2013, well after the relevant date and there is no indication for how long such goods might have been on sale.

41. Mr Powell refers me to a decision issued by the First Board of Appeal (case R 909/2011-1) in which the word MAX was found to lack “any inherent distinctive character” in respect of the goods and services in question which were, broadly speaking, building materials and construction services. Mr Rundle submitted that whilst the decision might be regarded as instructive, it is not binding on the registrar. He referred me to the decision of Ms Carboni sitting as an appointed person in BL O/075/12, where she referred to the Hearing Officer Mr James’s finding at first instance that:

“60. I find that, when used alone, the word MAX would not convey any clear descriptive message about the characteristics of cola flavoured beverages. The mark is certainly suggestive or allusive of some unspecified quality of the product, but the quality itself is not discernable from the mark. In that situation, there is no reason for s.3(1)(c) to be applied so as to leave the term MAX free for unfettered use by other traders”.

42. I note that Mr James's comments related to the word MAX *when used alone*. That is not the case here. In any event, I have to come to my own view of the matter taking into account the relevant marks and goods before me.

43. At the hearing, Mr Rundle submitted that the word MAX on its own "means nothing" though he went on to submit that "the words Spray Max might [mean something in that] it might refer to some allusive quality of the product".

44. I do not consider there can be any doubt that the word MAX is a well known and commonly used abbreviation for the word maximum. Whilst the material exhibited by Mr Powell dates from after the relevant date, it seems to me that it is indicative of a long established practice of 'puffery' intended to emphasise certain qualities of whatever goods are being offered for sale. I find support for my view in DEP5 above where the vehicle paint being offered is described as affording "extra coverage" and DEP6 where the paint being offered is said to afford "excellent longevity". Whilst I accept that the word MAX on its own has no specific meaning in relation to the goods at issue, the earlier mark is not for the word MAX alone; instead it contains the words SPRAY MAX which read into each other and is, in my view, non distinctive for aerosol paints etc. which maximise spray. I am not persuaded by Mr Rundle's submission at the hearing to the effect that people would not notice the word SPRAY within the earlier mark. Indeed, the evidence provided at HPK-001 shows the opponent not only refers to both words consistently throughout but also refers to the mark in written form by conjoining the word SPRAY and MAX.

45. Whilst none of the individual elements of the opponent's earlier mark is distinctive per se, the elements hang together and give the mark a degree of distinctiveness albeit a very low one see *Case C-363/99 Koninklijke KPN Nederland NV v Benelux Merkenbureau* [2004] E.T.M.R. 57, CJEU, *Case C-329/02P SAT.1 Satelliten Fernsehen GmbH v OHIM* [2005] E.T.M.R.. 20, CJEU, *Case C-37/03P BioID AG v OHIM* [2005] E.T.M.R. CN5 CJEU and *Case T-439/04 Eurohypo AG v OHIM*).

46. I must also assess the distinctive character of the earlier mark. The distinctive character of a mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public –*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings –*Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

47. As I indicated above, the opponent's evidence shows the mark to have been used over a number of years. Figures have been provided to show sales in Germany and France (and, it seems, for onward sale to other countries) which are said to range from €1.883.412 in 2007 to €7.432.358 in 2011. These sales are said to relate to goods for use on vehicles including industrial vehicles such as forklift trucks. Whilst the sales figures are not insignificant, no information is given as to the size of the relevant market(s) which allows me to put those figures into context, however,

given the number of vehicles in use, I would estimate the market(s) to be very large. Mr Rundle accepted at the hearing that the figures were unlikely to be high in the context of the relevant market and evidence of sales made in the UK is minimal. As I indicated earlier, I do not consider the earlier mark has been shown to benefit from any enhanced distinctive character through its use. In my view the earlier mark has a very low inherent distinctive character. As I also indicated above, the mark has not been shown to have a reputation in the UK.

48. The applicant's mark consists of the letter M and X in plain block capitals. Between these is a device reminiscent of two upside-down letters V (one within the other) with a triangle device at its centre. Whilst this stylisation is unlikely to be overlooked, it is not a separate or dominant element of the mark as its position and shape is likely to lead to it being viewed as a letter A with the resultant word being seen as MAX. The word MAX is the dominant element of the mark as the word appears 'framed' within a device element which consists of four parabolic lines with the lower and side positioned lines having a greater degree of curve than the upper one leading to it being somewhat reminiscent of a letter x: whilst not the dominant element, the device is a distinctive element of the mark.

49. I shall approach the visual, aural and conceptual comparison with those conclusions in mind.

50. Whilst both marks contain the word MAX, the presentation of the letters within them and the presence of the other elements within each mark results, in my view, in only a low to moderate degree of visual similarity between them. It is well established that where a mark consists of words and device elements, the average consumer is most likely to refer to the mark by the words. As both marks contain the word MAX, there is a degree of aural similarity between them, however, this is lessened by the presence of the word SPRAY in the earlier mark as the first word. There is a moderate degree of aural similarity between the respective marks. When considered from the conceptual perspective, the applicant's mark will bring to mind something which provides the most of something whilst the earlier mark will bring to mind something which provides the most of something in spray form. There is a reasonable degree of conceptual similarity between the respective marks. The similarity between the marks does not, however, amount to a distinctive similarity.

Likelihood of confusion

51. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the earlier trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparison between trade marks and must instead rely on the imperfect picture of them he has retained in his mind.

52. Earlier in this decision I concluded:

- that the average consumer will be a professional as well as those members of the general public who carry out repair or enhancement works themselves;
- that the goods are such as will be bought by self-selection whereby the visual aspects of the respective marks are likely to be of prime relevance though the aural aspects may also play a part;
- the respective marks share a low to moderate degree of visual similarity, a reasonable degree of aural similarity and a reasonable degree of conceptual similarity;
- the goods are such that a high degree of care will be taken over their purchase;
- the word MAX in the earlier mark has little or no distinctive character for the goods at issue;
- the earlier mark is of very low distinctive character which has not been shown to have been enhanced through its use.

53. Taking all matters into account, I find that the relevant public are more likely to believe that the appearance of the word MAX in both marks is because it is a descriptor and/or a coincidence rather than that it signifying the goods to be from the same or related undertakings. I find that there is no likelihood of either direct or indirect confusion between the respective marks and the opposition under section 5(2)(b) of the Act fails.

The objection under section 5(3) of the Act

54. Section 5(3) of the Act states:

“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 or international trade mark (EC), 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.”

55. In my consideration of the objection under section 5(2)(b) above, I commented that the evidence filed by the opponent was insufficient to find that the earlier mark is possessed of a reputation. Even if I am wrong and it is found that the earlier mark does have a reputation, as Mr Rundle accepted at the hearing, that reputation is outside the UK as there is a distinct lack of evidence of advertising and promotion here and the evidence relating to sales in the UK shows sales of minimal quantities

to a single buyer. The evidence does not support the claim that the earlier mark has a reputation in the UK. Consequently, no link will be made (and none of the heads of damage shown) from the perspective of the average consumer in the UK. That being the case, the objection founded on section 5(3) of the Act fails.

Summary

56. The opposition fails on each of the grounds on which it was brought.

Costs

57. As the opposition has failed, the applicant is entitled to an award of costs in its favour. In making the award, I note that the evidence filed by either party was not particularly extensive and that the applicant did not attend the hearing but did file written submissions in lieu of attendance. I make the award on the following basis:

| | |
|--|-------------|
| For filing a statement and reviewing the other side's statement: | £300 |
| For filing and considering evidence: | £300 |
| For the preparation of written submissions: | £300 |
| Total: | £900 |

58. I order Peter Kwasny GmbH to pay The Valspar Corporation the sum of £900 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of November 2013

**Ann Corbett
For the Registrar
The Comptroller-General**

Annex A

