

O/410/18

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION No. 3172249

IN THE NAME OF AKZO NOBEL COATINGS INTERNATIONAL B.V.

AND

APPLICATION No. 501666

BY CROWN BRANDS LIMITED

FOR THE TRADE MARK TO DECLARED INVALID

Background and pleadings

1. This is an application by Crown Brands Limited (“the applicant”) for trade mark 3172249 - **LOVE IT, MATCH IT, MIX IT** – to be declared invalid and cancelled.

2. The trade mark was applied for by Akzo Nobel Coatings International B.V. (“the proprietor”) on 30th June 2016 (“the relevant date”). It is registered in relation to:

“Class 2: Paints; coatings; varnishes; lacquers; thinners; coloring matters all being additives for paints, varnishes or lacquers; preservatives against rust and against deterioration of wood; priming preparations (in the nature of paints); wood stains.”

3. The grounds for invalidation are that:

- (i) The mark is devoid of any distinctive character in relation to the goods for which it is registered because it sends only the promotional message that the paints consumers love can be matched and mixed for them.
- (ii) The mark is a normal way of describing paints, coatings and emulsions which are matched to a chosen/loved colour and then bespoke mixed.
- (iii) Use of the mark would be contrary to the law of passing off. This is because of the applicant’s claimed earlier right in **YOU LOVE IT, WE’LL MATCH IT**, which it has used throughout the UK since 2011 in relation to paints, coatings for walls, retailing of paint and coatings and paint mixing services.

4. According to the applicant, registration of the contested mark was therefore contrary to sections 3(1)(b),(c) and/or 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

5. The proprietor filed a counterstatement denying the grounds for invalidation. I note that the proprietor denied that the combination of words that make up the contested mark is a common or usual way to refer to the registered goods. The proprietor

claims that, at most, the mark is merely allusive. It claims that such trade marks are neither wholly descriptive nor lacking in distinctive character. The proprietor points out that the IPO agreed with this analysis.

6. I understand that the last point is a reference to an *ex parte* hearing that took place on 25th October 2016. The hearing was held following the trade mark examiner's refusal to accept the application on the grounds of lack of distinctiveness. The proprietor's (then applicant's) representative persuaded the Hearing Officer that the mark possessed a distinctive character. This led to the acceptance, publication and subsequent registration of the mark on 6th January 2017.

7. Both sides seek an award of costs.

Representation

8. The applicant is represented by Harrison IP Limited. The proprietor is represented by D Young & Co LLP. A hearing took place on 19th June 2018. Mr Ben Longstaff appeared as counsel for the applicant. Mr Matthew Dick of D Young & Co. appeared on behalf of the proprietor.

The evidence

9. The applicant's evidence consists of two witness statements by Mr Colin Brigden (with 7 and 1 exhibits, respectively). Mr Brigden is the applicant's Group Legal Counsel. His second statement was filed in reply to the proprietor's evidence, which consists of a witness statement by Mr Robert Spruitenburg, the proprietor's IP Counsel.

10. Mr Brigden says that the applicant viewed its own **YOU LOVE IT, WE'LL MATCH IT** mark as inherently non-distinctive before that non-distinctiveness was cured through substantial commercial use of the trade mark. According to Mr Brigden, the mark was first used in 2011, and then used more widely in 2012 and 2013. The mark is used in the applicant's CROWN TRADE and CROWN DECORATOR CENTRE businesses. CROWN TRADE is the Crown Group's

professional paint brand. CROWN DECORATOR CENTRES are sales outlets used by contractors, decorators, builders and other members of the decorating and building trades. In May 2017, there were 130 such outlets across the UK and Ireland.

11. The mark has been used in promotional material aimed at the trade since 2012. An example is shown below.



12. The mark has also been used since 2014 on counter artwork and banners in CROWN DECORATOR CENTRES. An example is shown below.



13. The mark is also used on the CROWN TRADE and CROWN DECORATOR CENTRES websites.¹ In 2012 the applicant ordered 15k T-shirts bearing the mark (as well as CROWN TRADE and other marks) as a promotional tie-in with a TV advertisement. I pause here to note that it is not clear what happened to these T-shirts, nor is there any further information as to the content or purpose of the TV advertisement.

14. The applicant encourages its trade partners to display the mark on their websites.²

15. Finally, Mr Brigden says that the parties have a somewhat adversarial relationship and monitor each other's trade mark filings and marketing campaigns. Therefore, the proprietor would have known about the applicant's earlier right to **YOU LOVE IT, WE'LL MATCH IT** when filing the contested trade mark. He asks that this "guilty knowledge" be considered in the context of the applicant's claim to a passing off right.

16. Mr Spruitenburg points out that the screen shots from the applicant's website filed as exhibit CB5 to Mr Brigden's statement are incomplete. He provides copies of the full pages from which the strapline **YOU LOVE IT, WE'LL MATCH IT** is always used in conjunction with the trade marks CROWN TRADE or CROWN DECORATING CENTRES.³

17. Mr Spruitenburg also provides printouts of various webpages from third party websites, which he says show how retailers or sellers of paint products and/or who offer paint mixing facilities, communicate this to the public.⁴ For example, Lakeland Paints says that if a member of the public cannot find the colour he or she likes in its colour charts "*just tell us what you'd like and we'll match it.*" Reeds, another company offering a paint mixing service, suggested that if you've "*found a colour you love, maybe your favourite album cover or even just existing paint, once you've*

¹ See exhibit CB5

² See exhibit CB6

³ See exhibits RN1 -RN3

⁴ See exhibit RN5

found that perfect colour come to the team at Reeds and we will make it into a reality.”

18. Mr Brigden’s evidence in reply consists of arguments rather than evidence of fact. I deal with the parties’ arguments below.

The correct approach to the matter

19. At the hearing, Mr Dick submitted that I should approach the matter in a way analogous to an appeal against the decision of the Hearing Officer who accepted the application to register the contested mark following the *ex parte* hearing. According to Mr Dick, this requires me to approach the s.3(1) grounds for invalidation by way of a review (as opposed to a rehearing) of the Registrar’s earlier decision to register the contested mark.

20. Mr Longstaff said that this was obviously wrong. I agree. Such an approach would require the applicant to show that the *ex parte* Hearing Officer made an error of law, or was clearly wrong on the facts, or left something relevant out of his consideration. That approach is justified on appeal because the parties have already had an opportunity to present their cases without such constraints at first instance. It cannot be justified where only one of the parties was involved in the original decision and therefore there has been no previous proceedings between the parties. Approaching the matter in the manner proposed by the proprietor would not provide a level playing field in these first instance proceedings. That would be contrary to the applicant’s right to a fair and impartial trial for ECHR purposes. I am aware that the Cancellation Division at the EUIPO at one time approached applications for cancellation on the basis advocated by Mr Dick. It is possible that this is where the idea has come from. However, that approach was widely criticised and has now been abandoned.⁵

21. Section 72 of the Act states that registration of a trade mark shall be *prima facie* evidence of its validity. The burden is therefore on the applicant to persuade me that

⁵ See Kerly’s Law of Trade Marks and Trade Names, 16th Edition, at paragraph 8-295

the registration is invalid. However, a decision maker should not resort to the burden of proof unless, having strived to do so, he or she finds it impossible to decide on the weight of the evidence.⁶ I will therefore approach the matter afresh and unfettered by the decision of the *ex parte* Hearing Officer, but mindful that the persuasive burden is on the applicant. This means that if, having looked at the evidence and considered the arguments, I find that I cannot make a clear decision as to whether the contested trade mark is invalid, then I must reject the application for invalidation.

The section 3(1)(b) and (c) based grounds for invalidation

22. The relevant parts of s.47 of the Act are 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.

⁶ See *Verlander v Devon Waste Management Ltd* [2007] EWCA Civ 825

(2A) – (4) -

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

23. Section 3(1) of the Act is as follows.

“3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (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.”

24. As the answer to the questions posed under sections 3(1)(b) and 3(1)(c) depend to a large extent on the likely reaction of the relevant consumers to the contested trade mark, I will start by examining the meaning and significance of the mark (if any) to such consumers. For the applicant, Mr Longstaff submitted that the average

consumer is someone who buys paints and the other goods covered by the contested mark. There can be no dispute about that. I find that the average consumer is a person who buys paints or coatings for use in his or her work, e.g. a decorator, or it may be a member of the public buying paints or coatings for DIY purposes. Such consumers are likely to pay an average or 'normal' degree of attention when selecting the goods at issue.

25. According to Mr Longstaff, average consumers would have no difficulty ascertaining that the contested mark refers to paints and other coatings that result from taking the consumer's chosen colour, matching it in the sense of working out what pigments are required to reproduce the colour, and then mixing the relevant coating accordingly. Mr Longstaff accepted that the mark may consist of a "*compressed expression*". However, he reminded me of the words of Mr Geoffrey Hobbs QC, as the Appointed Person, in *We Create Space*⁷ where Mr Hobbs pointed out that "*A terse explanation is nevertheless an explanation.*"

26. Mr Dick denied that the contested mark consists of plain English words conveying the advertising message that the paints consumers love can be matched and mixed for them. According to Mr Dick, relevant consumers would perceive the mark as an "*unusual statement.*" He invited me to attach importance to the following:

- The mark requires a cognitive process and/or an interpretative effort to understand;
- It has an unusual syntax because one would normally expect to mix a paint or coating before it can be matched to something else;
- The recurring word IT creates a rhythm that helps to identify the mark as more than just a description or informative statement.

Additionally, Mr Dick submitted that even if the mark alluded to characteristics of a paint matching service, it can designate a trade source of the goods provided through it.

⁷ BL O/342/10

27. As to the last point, I accept Mr Longstaff's submission that if the mark describes a colour matching process, the average consumer would readily understand that, when used in the context of goods, the process produces the coatings that the consumer desires. In fact, the matching service/mixing process is likely to be part and parcel of the trade in the goods. Consequently, when assessing what message the mark conveys, there is no meaningful distinction to be drawn between the message it may convey about a colour matching service/mixing process and the coatings produced through such a service/process.

28. I accept that the recurring word 'IT' creates a rhythm that may help to distinguish the mark from a traditional descriptive or informative statement. However, advertising slogans often show a certain degree of repetition whilst remaining purely descriptive. I do not therefore regard this point as decisive.

29. I do not accept that the order in which the words MATCH and MIX appear in the mark creates any unusual syntax. The word MATCH clearly refers to matching the colour of the required coating to some existing colour or coloured article. This requires an analysis of the blend of pigments required to replicate the desired colour. Matching the existing colour or coloured article therefore naturally precedes mixing the components required to replicate the required colour.

30. The general message of loving a colour, or an article of that colour, matching the colour, and having a bespoke paint or coloured coating mixed, is plainly one that consumers of bespoke paints and coloured coatings are likely to attribute to the nature of the goods, rather than to their trade source. The question is whether the contested mark will immediately convey this message to average consumers (as the applicant contends), or whether the mark would require a significant interpretative effort to extract this meaning (as the proprietor contends). The answer appears to me to turn on what (if anything) the average consumer would readily understand was being referred to by the recurring word 'IT'.

31. I have no doubt that when the contested mark is used in relation to paints and coatings, the average consumer would immediately see that **MIX IT** describes the process of mixing a paint or coating. In the same relevant context, the words

MATCH IT appear likely to be readily understood as referring to matching a colour. When followed by the words **MATCH IT, MIX IT**, the words **LOVE IT**, are liable to be understood as referring to the love of a colour, or an article in that colour. In the context of bespoke paints and coatings, these two possible meanings of 'IT' effectively amount to the same thing, i.e. the colour you love. The contested mark is therefore likely to immediately convey the message "Love the colour, match the colour, mix the paint/coating."

32. One of the reasons advanced by Mr Dick for resisting this analysis of the mark was that it depended on the consumer attributing a different meaning to 'IT' in the third iteration of the word as compared to the first and/or second iterations. I do not think that this would be beyond the capacity of the average consumer where the other words in the mark require that 'IT' be given a different meaning in the third iteration. In any event, mixing paints (or coloured coatings) and mixing colours (in the context of bespoke paints etc.) is pretty much the same thing from the perspective of relevant consumers.

The section 3(1)(c) based ground for invalidation

33. In *SAT.1 SatellitenFernsehen GmbH v OHIM*⁸ the Court of Justice of the European Union ("CJEU") stated that:

"25. it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46)."

⁸ Case C-329/02 P

34. The case law under section 3(1)(c)⁹ was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*¹⁰ as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-

⁹ Corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation

¹⁰ [2012] EWHC 3074 (Ch)

2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).”

And

“49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a ‘characteristic’ of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms ‘the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’, the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

35. To fall within the exclusion in s.3(1)(c) of the Act the mark must consist exclusively of a sign or indication which may serve, in trade, to designate a characteristic of the goods. The applicant says that the contested mark designates the kind and quality of the goods covered by the registration.

36. I can well see how MATCH IT, MIX IT could be regarded as designating the kind of goods (i.e. bespoke paints and coatings) as well as their quality (i.e. that the goods will provide an effective match to the desired colour). However, the words LOVE IT appear to me to relate to the consumer’s emotional attachment to the desired colour rather than to the goods. I do not accept that this can properly be classified as a characteristic of the goods (as opposed to a characteristic of the consumer). For this reason, I reject the ground for invalidation based on s.3(1)(c) of the Act.

The section 3(1)(b) based ground for invalidation

37. The principles to be applied under article 7(1)(b) of the CTM Regulation¹¹ were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*¹² as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

¹¹ Now article 7(1)(b) of the EUTM Regulation, which is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act

¹² Case C-265/09 P

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes 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 those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

38. Both parties invited me to take account of decisions on slogan-like marks in other cases. These included (i) a recent decision of the Registrar to invalidate a figurative

trade mark dominated by the words ANY COLOUR ANY FINISH, which the applicant in these proceedings had registered for paints and coatings¹³, and (ii) a decision of the EU's Court of First Instance to invalidate the EU trade mark LIGHT & SPACE (also for paints and coatings).¹⁴ Both marks were held to be devoid of any distinctive character. However, each case turns on its own facts. There is therefore little to be gained from trying to compare the facts in this case against factual findings relating to different marks in other cases.

39. Earlier I found that the contested mark is likely to immediately convey the message “Love the colour, match the colour, mix the paint (or coating).” This does not necessarily mean that it lacks distinctive character. As the CJEU stated in *Audi AG v OHIM*:¹⁵

“.....the laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. Thus, such a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood – perhaps even primarily understood – as a promotional formula has no bearing on its distinctive character.”

40. However, I find that “Love the colour, match the colour, mix the paint (or coating)” would be understood by relevant consumers as conveying a purely promotional message in relation to the goods at issue. The highpoints of the case for finding that the mark has distinctive character are, in my view, that (a) although the contested mark may be readily be understood as having the same meaning as the full expression above, it does not actually use those words, i.e. it is a compressed statement, and (b) the recurring word IT gives the mark a certain rhythm which makes it easier to remember.

¹³ BL O/168/18

¹⁴ Case T-224/07

¹⁵ Case C-398/08, at paragraph 45 of the judgment

41. However, I find that the contested mark will be too easily equated to the full and purely promotional expression “Love the colour, match the colour, mix the paint (or coating)” for **LOVE IT, MATCH IT, MIX IT** to strike the consumer as also identifying the commercial origin of the goods marketed under it. In these circumstances, I find that the ‘rhythm’ of the mark is insufficient to imbue it with a trade mark character in relation to paints and coloured coatings. This finding plainly covers:

“Paints; coatings; varnishes; lacquers; coloring matters all being additives for paints, varnishes or lacquers.”

42. This leaves:

“Thinners, preservatives against rust and against deterioration of wood; priming preparations (in the nature of paints); wood stains”

43. I note that the in *LIGHT & SPACE* the Court of First Instance stated that:

“37 It is necessary to examine whether that ground of refusal can be applied to each of the goods in Class 2 covered by the application for trade mark registration. As regards, first, ‘paints, varnishes, lacquers’, the reasons stated by the Board of Appeal are particularly relevant to those goods, which are in fact likely to possess the properties lauded by the sign *LIGHT & SPACE*. In that regard, besides the fact that varnishes and lacquers can readily be regarded as goods similar to paints, they are also likely to perform the functions of paint, particularly because they also can contain colour and reflect light. The expression *LIGHT & SPACE* will accordingly be perceived in the same way vis-à-vis varnishes and lacquers.

38 As regards, next, ‘driers including curing driers, thinners, colouring matters, all being additives for paints, varnishes or lacquers’ those goods can be placed in the same category as paints, varnishes or lacquers, in so far as they are designed to be added to them. Consequently, it must be held that the reasons stated by the Board of Appeal are equally relevant to those goods. Similarly, there is no need to distinguish between ‘priming preparations (in the

nature of paints)' and ordinary paints, in so far as priming preparations contribute to the effect created by the paint finally applied to the surface and are goods similar to paint.

39 As regards, lastly, preservatives against rust and against deterioration of wood, and wood stains, it must be pointed out that, although intended for specific purposes, it cannot be excluded that such goods and paints perform similar functions, in so far as they are also likely to contain colour. Such goods can therefore also contribute to reflecting light around interior spaces and to make them, as a result, more spacious. Since the description of those goods in the trade mark registration application does not exclude such a function and, in addition, those goods can be regarded as similar to paints, the reason stated, that the sign LIGHT & SPACE will be perceived by the public concerned as a promotional laudatory formula rather than as an indication of the commercial origin of those goods, must be considered to be equally applicable to them.”

44. In my view, the same reasoning should be applied to the goods listed in paragraphs 41 and 42 above. I therefore find that the mark is devoid of any distinctive character for all the goods for which it is registered.

45. There is no evidence that the mark was used and had acquired a distinctive character prior to the date of the application for invalidation. Consequently, my finding of *prima facie* non-distinctiveness means that the registration of the mark must be declared invalid.

The applicant's passing off right claim

46. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

47. In the *Jif Lemon* case,¹⁶ Lord Oliver set out the requirements for establishing a successful passing off right as follows:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services.

Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to the belief that the goods or services offered by him are the goods or services of the plaintiff.

Thirdly, he must demonstrate that he suffers or, in a *quia timet* action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”

48. The applicant claims to have acquired goodwill under the sign YOU LOVE IT, WE’LL MATCH IT because of the use of that sign, in trade, since 2011. There is no

¹⁶ *Reckitt & Coleman Products Ltd v Borden* [1990] RPC 341 HL

doubt that the applicant owns a valuable goodwill in a business selling paints and similar coatings. The real question is whether the slogan concerned has become distinctive of the applicant's business through use.

49. The reason this question arises is that, as the applicant itself recognises, when considered in relation to paints and/or retailing of paints, the sign YOU LOVE IT, WE'LL MATCH IT is an inherently non-distinctive advertising slogan. In other words, it serves as an encouragement to do business with the current user, but it says nothing which indicates that the user will always be the same. Accordingly, buyers of bespoke paints would have no reason to believe that the term is specific to a particular trader, still less that they can rely on that term to identify the goods or services of a particular undertaking.

50. The applicant's case is that this defect has been cured through the extensive use of the slogan, which has caused the relevant public to associate the slogan specifically with the applicant's goods or services.

51. The proprietor disputes this.

52. What use has the applicant made of the sign? The applicant claims to have used the sign since 2011, and made more substantial use of it since 2012/13. However, the applicant has not provided any sales figures showing the volume of goods sold under the sign. Indeed, there is no evidence that the mark is used on the goods themselves. The applicant claims to have used the sign since 2014 on counters and banners at its Crown Decorating Centres. According to the applicant there were 130 of these centres across the UK and Ireland in May 2017. That was almost a year after the relevant date. However, I am prepared to infer that a substantial proportion of the stores were in place at and before the relevant date. The applicant also claims that it uses the sign on promotional material and on its websites. Again, the scale and length of such use is not clear. The applicant further claims that the contested mark is used (alongside CROWN) on the websites of some of its trade partners. However, the only example in evidence postdates the relevant date by more than a year. Accordingly, there is also some doubt as to the extent to which the sign has been used on third party websites prior to the relevant date.

53. However, my main difficulty with the applicant's case is with the nature of the use. The applicant's case assumes that 'use equals distinctiveness'. However, it is well established that mere use does not automatically result in distinctiveness. For example, no matter how many times a trader uses the word COLOUR in relation to paint, it will never become distinctive of the paint of a particular trader. For an inherently non-distinctive sign to acquire a secondary meaning denoting the trade source of the goods/services, the use must be such as educate the public to that perception of the mark.

54. Looking at the applicant's use of the mark, as exemplified in paragraph 12 above, the words YOU LOVE IT, WE'LL MATCH IT are plainly used in conjunction with the distinctive trade marks CROWN DECORATOR CENTRES/CROWN PAINTS. In those circumstances, the public are likely to rely primarily on those distinctive marks to identify the trade source of the applicant's goods and services. Indeed, in the case of Crown Decorator Centres, the public will already know which trader he or she is dealing with by having chosen to go to a store of that name. Further, there is no evidence that anyone in the trade regarded the sign as distinctive of the applicant's business at the relevant date. In these circumstances, I find that the sign at issue is, at best, a 'limping' trade mark; meaning that it only identifies the applicant's business to an uncertain proportion of its trade customers when used in conjunction with CROWN. Therefore, it is not, by itself, distinctive of the applicant's business.

55. This means that the passing off right claim must be rejected. This is because if YOU LOVE IT, WE'LL MIX IT is not, by itself, distinctive of the applicant's business, the proprietor's use of LOVE IT, MATCH IT, MIX IT at the relevant date could not have amounted to a misrepresentation to the applicant's customers or potential customers.

56. The s.5(4)(a) ground for invalidation therefore fails.

Outcome

57. The s.3(1)(b) based ground for invalidation succeeds in full. The registration of trade mark 3172249 will therefore be declared invalid for that reason.

Costs

58. The applicant has been successful and is therefore entitled to a contribution towards its costs. I assess these as follows:

£450 for filing an application for invalidation (including the £200 filing fee) and considering the counterstatement;

£550 for filing evidence and considering the proprietor's evidence;

£1000 for attending a hearing and filing a skeleton argument.

59. I therefore order Akzo Nobel Coatings International B.V. to pay Crown Brands Limited the sum of £2000. This sum to be paid within 50 days of the date shown below.

Dated this 04th day of July 2018

**Allan James
For the Registrar**