

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2003752
BY IMPERIAL CHEMICAL INDUSTRIES PLC TO
REGISTER A MARK IN CLASS 02**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 43454 BY WICKES PLC**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2003752**
by Imperial Chemical Industries PLC to
register a mark in Class 02

and

10 **IN THE MATTER OF Opposition thereto**
under No 43454 by Wickes

15 **DECISION**

On 30 November 1994 Imperial Chemical Industries PLC, of London SW1 applied to register
the mark SPEEDMASTER in Class 02, in respect of:- paints, varnishes, lacquers,
20 preservatives against rust and against deterioration of wood, colourants and raw material
resins. The application is numbered 2003752.

On 9 November 1995 Wickes PLC, of London W1 filed notice of opposition to the
application. The grounds of opposition are:-

- 25
- (i) under Section 3(1)(b), in that the mark is devoid of any distinctive character;
 - (ii) under Section 3(1)(c), in that the mark is descriptive of the goods;
 - 30 (iii) under Section 5(2)(b), by reason of the opponents' registrations of the marks
WICKES MASTER, and MASTER, and
 - (iv) under Section 5(4)(a), by reason of the opponents' extensive user of and
35 reputation in their mark MASTER.

The opponents ask that the application be refused and costs awarded in their favour.

An objection based on Section 3(6) was originally included in the Statement of Grounds,
but the opponents later confirmed that they were withdrawing this ground of their
40 opposition.

The applicants filed a counterstatement denying these various grounds. Both sides
subsequently filed evidence in these proceedings and the matter came to be heard on
21 January 1998. At the hearing the applicants were represented by Dr Peter Colley, of
45 Counsel instructed by Withers & Rogers. The opponents were represented by
Miss Denise McFarland of Counsel, instructed by Carpmaels & Ransford.

The opponents filed in evidence Statutory Declarations by Keith Stokes-Smith, the Company Secretary of Wickes plc, and by David Paul Rose, Clare Philippa Kay, Jonathan Mark Adelman and Simon Alexander Levy, all of S J Berwin & Co, Solicitors. The applicants' evidence comprises Statutory Declarations by Colin Thomas Barrett, a Trade
5 Mark Consultant, and David Iain Innes, the General Manager, Trade Contract, of ICI Paints. I shall refer to this evidence, as necessary, later in this decision.

Grounds of opposition: Section 3

10 As stated earlier, the opponents claim that the mark is barred from registration by the terms of Section 3(1)(b) and Section 3(1)(c). Those provisions read as follows:-

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

15 (a)

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

20 (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,

25 (d)

30 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.”

Mr Colley, in his defence of the applications under the first of these two provisions used as his basis Jacob J's analysis of Section 3 found in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281. Mr Colley focused particularly on lines 1-10 of page 306, which
35 read as follows:-

40 “Next, is “Treat” within section 3(1)(b)? What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act but the idea is much the same) devoid of any distinctive *inherent* character.”

In Mr Colley's submission SPEEDMASTER is precisely the kind of mark which can "do the job", it being a devised word.

5 Moving on to 3(1)(c) Mr Colley maintained that SPEEDMASTER could not be convicted of any of the offences listed there; it is a word that does not and cannot designate any of the attributes named in that subsection.

10 Finally, Mr Colley pointed out that the Registry's acceptance of SPEEDMASTER, in the prima facie case, had been entirely consistent with its published practice. He cited in particular the following extract from the Addendum to Chapter 6 of the Trade Marks Registry Work Manual (page 54):-

15 (d) MASTER combined with words to form a less meaningful description of the goods:

20 Accept if no sensible objection can be raised, for example, SWINGMASTER for golf clubs, SHIFTMASTER for excavating machines, SLEEPMASTER for beds, MASTERGUARD for cleaning preparations, MASTERPLAN for cosmetics, MASTERFLOW for concrete mixes, MASTERFOLD for paper napkins and MASTERFLAME for heating and cooking apparatus."

25 Miss McFarland argued skilfully against these submissions. In her view proper application of the Work Manual's precepts would have resulted in the rejection of the application at the examination stage. In support of this contention she cited the following extracts from the same chapter:-

30 "(b) MASTER combined with words descriptive of the goods, when applied to goods with a control function:

Object under Section 3(1)(b) and (c) prima facie, for example, MASTERSWITCH for electric switches."

35 and

"(e) MASTER combined with words descriptive of a nature of a service provided by artisans:

40 Object under Section 3(1)(b) and (c) prima facie, for example, MASTER REPAIRERS or REPAIRMASTER for shoe repairs, MASTER CLEANERS or CLEANMASTER for cleaning and MASTER PRINTERS or PRINTMASTER for printing."

45 Firstly, said Miss McFarland, the Manual focuses on things pertaining to artisans as being in a special category; paint also falls within that category, she said. Secondly, the word "speed", when used in connection with paint, indicates speed of application or speed of drying.

After careful consideration of the various arguments and submissions on this point I have come to the view that there is no valid objection to this mark under Sections 3(1)(b) or 3(1)(c). In my view the acceptance of SPEEDMASTER was in accordance with Registry practice as set out in the Work Manual, just as Mr Colley said it was. Registry practice, of course, is not decisive in opposition cases, nor is the Registry's Work Manual the law (although, of course, as time goes on it increasingly comes to be based on and to reflect decided cases). However, the Registrar's practice has been developed as an aid to consistency and fairness, and whilst I do not rely on it in this case, I am unwilling to depart from it when the result of its application seems right to me, as in this case, and in the absence of some clear indication that it would be wrong to apply it. No such indication has been forthcoming. The mark appears acceptable to me, and I therefore see no reason to disturb the finding of the examiner who accepted this mark. The opposition under Section 3(1)(b) and 3(1)(c) fails accordingly.

I now turn to consider the matter under Section 5(2)(b), which provision reads as follows:

(2) A trade mark shall not be registered if because -

(a), or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

The earlier trade marks cited by the opponents are: 1441529 WICKES MASTER and 1530915 MASTER. Both these registrations are in respect of paints, and other goods related to or similar to paints. The application is proposed in respect of paints, inter alia. These goods are undoubtedly identical or similar and the matter therefore comes down to a decision (a) as to the similarity of the marks, and (b) as to the likelihood of confusion on the part of the public judged in the light of my findings on the marks and the goods.

The similarity, or otherwise, of the marks is of course a jury question and it is for the judicial ear and the judicial eye alone to decide. In the matter of the likelihood of confusion, however, the opponents filed evidence with which they hoped to demonstrate that such confusion was reasonably likely. This evidence was gathered and attested to by the four members of S J Berwin & Co already listed on page 3 of this decision. The evidence describes a survey carried out by the witnesses into the public's reaction to the marks involved in these proceedings. Mr Colley attacked this evidence on two grounds:- (a) because the survey had not been carried out in accordance with well established guidance on the conduct of surveys to be used in trade marks proceedings, and (b) because the evidence gathered was hearsay. In respect of the first objection Mr Colley took me through a line of authorities including Imperial Group plc v Philip Morris Ltd [1984] RPC 293, KENT Trade Mark [1985] RPC 117 and PHOENIX Trade Mark [1985] RPC 122. In Mr Colley's

submission the survey was conducted by persons whose qualifications and experience in survey work are not made clear; the manner of selection of interviewees is not stated; the ground rules for the conduct of the interviews are not stated; the sample was too small and covered too small a geographical area and the complete results are not disclosed. In respect
5 of the second objection Mr Colley first took me to a decision in the Court of Appeal in
Bairstow and Others v Queens Moat Houses plc, reported in The Times on 23 October 1997,
in which it was decided that the Civil Evidence Act 1995 did not apply to actions begun
before the entry into force of that Act. These present proceedings having begun before that
date, he said, they were governed by the St Trudo Practice Direction [1995] RPC 381. In
10 Mr Colley's submission the evidence concerned ought not to be admitted to the proceedings.

After hearing counsel on this particular point of the admissibility of the evidence, and noting
in particular Miss McFarland's remarks on the lateness of this attack I decided to admit the
evidence in exercise of the discretion stated in paragraph 6 of the St Trudo Practice Direction.
15 However, I must make it clear at this point that whilst I have admitted the evidence
concerned, I give no weight to it because in my opinion it does indeed suffer from the other
defects enumerated by Mr Colley. It has therefore been of no assistance to me and it has
played no part in my deliberations under Section 5. That said, I now return to the
consideration of this matter under Section 5(2)(b).
20

As already stated the marks concerned are WICKES MASTER and MASTER and I compare
these, in turn, with the mark applied for SPEEDMASTER. For the purposes of these
comparisons I employ the authoritative test propounded by Parker J in Pianotist Co's
Application (1906) 23 RPC 774 at line 26 et seq. That test reads as follows:-
25

"You must take the two words. You must judge of them both by their look and by
their sound. You must consider the goods to which they are to be applied. You
must consider the nature and kind of customer who would be likely to buy those
goods. In fact, you must consider all the surrounding circumstances; and you must
30 further consider what is likely to happen if each of these trade marks is used in a
normal way as a trade mark for the goods of the respective owners of the marks.
If, considering all those circumstances, you come to the conclusion that there will
be a confusion - that is to say - not necessarily that one will be injured and the other
will gain illicit benefit, but that there will be a confusion in the mind of the public,
35 which will lead to confusion in the goods - then you may refuse the registration, or
rather you must refuse the registration in that case."

With this test in mind I first compare SPEEDMASTER with WICKES MASTER. Aside
from the common element MASTER, however, I see no phonetic or visual similarity in these
40 marks; and in this case the presence of a common element does not bring about a confusing
similarity, I believe. It is in fact the presence of the opponents' name WICKES which makes
these marks so easily distinguishable, in my view. It is a strongly distinctive element and one
which confers an identity on the mark quite different from that which attaches to the rather
vaguely defined SPEEDMASTER. My finding is that these marks WICKES MASTER and
45 SPEEDMASTER are not confusingly similar and I go on to compare the marks MASTER
and SPEEDMASTER.

These two marks are self-evidently close. The applicants' mark SPEEDMASTER comprises the whole of the opponents' mark plus the addition of the word SPEED. In such a case the addition of the word SPEED may be seen as no more than a simple variant on the main mark MASTER, and thus a connection or association may well be assumed by the viewer. This
5 was essentially the view taken in WAGAMAMA ([1995] FSR 713) and in RUS and SAN RUS (Ravenhead Brick Co v Ruabon Brick Co [1937] 54 RPC 341, said Miss McFarland.

For my part I find that these marks are confusingly similar and hence I find that registration of SPEEDMASTER is barred by the terms of Section 5(2)(b) by reason of the presence on the
10 register of the opponents' registration 1530915, MASTER.

During the course of counsel's submissions on this mark, there was a suggestion that the mark MASTER, solus, had no right to be on the register in the first place. That, however, was not a matter I could or should address in the context of an opposition. The validity or
15 otherwise of a mark on the register can only be tested in proceedings brought under Section 47, I believe, and no such matter was before me.

My finding under Section 5(2)(b) effectively decides the matter but for the sake of completeness I go on to consider the matter under Section 5(4)(a). Under this section the
20 question to be addressed is whether use of the mark SPEEDMASTER, by the applicants, is liable to be prevented by the opponents in their enforcement of their rights in the marks MASTER and WICKES MASTER under the law of passing off.

I have already found, under Section 5(2)(b) that there is no confusing similarity between the
25 marks SPEEDMASTER and WICKES MASTER and accordingly prima facie, therefore I see no basis for an action under Section 5(4)(a) and I was not persuaded otherwise. I therefore turn to consider the matter by reference to the opponents' mark MASTER.

In a recent decision (as yet unreported) in an appeal against the Registrar's decision in the
30 opposition (No 43414) to Pinwise Ltd's application for registration of the mark WILD CHILD, Mr Geoffrey Hobbs, QC, sitting as the Appointed Person under Section 76 of the Act, set out both the question to be addressed, and the relevant elements of the law to be applied, in the following way (which I have adapted to fit the facts of this case):-

35 “The sustainability of the Opposition

The question raised by the Grounds of Opposition is whether normal and fair use of the designation SPEEDMASTER for the purpose of distinguishing the goods of
40 interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art. 4(4)(b) of the Directive and Section 40 of the Act by enforcement of rights which the Opponent could then have asserted against the Applicant in accordance with the law of passing off, (having regard to his use of the mark MASTER).

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Erven Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

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In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

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(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

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(c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

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(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

25

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

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It would seem from the foregoing that an indispensable element of an opponent’s case under Section 5(4)(a) is use of the mark cited. Without such use the reputation upon which so much else in the opponent’s case depends, cannot be supposed to exist. In my view the opponents’ in these proceedings have provided no evidence of use, or no substantial evidence of use of the mark MASTER, solus. Neither have they provided any convincing evidence of a reputation in that mark. As Mr Hobbs said in the WILD CHILD case:

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“I appreciate that the Registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. However, I am not willing to regard assertions without any real substantiation as sufficient to sustain an objection to registration under Section 5(4). On my assessment of the evidence the asserted “*earlier right*” remains unsubstantiated and the question of conflict does not arise.”

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I take a similar view of the strength of the evidence in this case and accordingly I, too, find that the opponents have not established their case under Section 5(4).

In the result, therefore, the opponents succeed in their opposition under Section 5(2)(b), by reason of registration No 1530915, MASTER, in Class 02.

5 The opposition having succeeded I order the applicants to pay to the opponents the sum of **£1050**, as a contribution towards their costs.

Dated this 9th day of March 1998

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M J TUCK
For the Registrar
the Comptroller-General