

O/1145/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. UK00003796851
BY KINGFISHER INTERNATIONAL PRODUCTS LIMITED
TO REGISTER THE FOLLOWING SERIES OF TWO MARKS:



IN CLASSES 1, 3, 4, 5, 6, 16, 17, 19, 20, 21 AND 22

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 436772
BY RENNER SAYERLACK S.A.

Background and pleadings

1. On 08 June 2022, Kingfisher International Products Limited (“the applicant”) applied for the series of two trade marks shown on the cover page of this decision, in the UK. The series of trade marks was published for opposition purposes on 08 July 2022 in respect of the goods in classes 1, 3, 4, 5, 6, 16, 17, 19, 20, 21 and 22, as listed in Annex I to this decision.

2. On 10 October 2022, the application was opposed by RENNER SAYERLACK S.A. (“the opponent”) based upon Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opposition is directed at the goods underlined in the Annex I to this decision, which correspond to the following:

Class 1: *Chemicals used in industry; chemicals used in agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastics; adhesives used in industry; adhesives for wallpaper; adhesive cements; industrial adhesives for use in building; adhesives for plasters; adhesives for applying floor tiles; adhesives for floor coverings; additives (chemicals); adhesives for wall tiles; agglutinants for concrete; alginates for industrial purposes; ammonia; antifreeze; anti-static preparations, other than for household purposes; anti-tarnishing chemicals for windows; auxiliary fluids for use with abrasives; glue for industrial purposes; carpet glue; wood glues; bases (chemical preparations); bleaching preparations for industrial purposes; brazing fluxes; brazing preparations; brickwork preservatives, except paints and oils; cement for mending broken articles; cement preservatives, except paints and oils; cement-waterproofing chemicals, except paints; ceramic glazes; chemical additives for oils; chemical condensation preparations; chemical intensifiers for rubber; chemical preparations for facilitating the alloying of metals; chemical preparations to prevent mildew; chemicals, except pigments, for the manufacture of enamel; chemicals for the manufacture of paints; chemicals for the manufacture of pigments; colour-brightening chemicals for industrial purposes; concrete-aeration chemicals; concrete preservatives, except paints and oils; chemicals used to prevent condensation; corrosive preparations; damp-proofing chemicals, except paints, for masonry; degreasing preparations*

for use in manufacturing processes; degumming preparations; dehydrating preparations for industrial purposes; detergents for use in manufacturing processes; emulsifiers; enamel-staining chemicals; filtering materials (chemical preparations); leather glues; leather-renovating chemicals; leather-waterproofing chemicals; limestone hardening substances; masonry preservatives, except paints and oils; mastic for leather; oil-bleaching chemicals; oil cement (putty); oil dispersants; oil purifying chemicals; oil-separating chemicals; polish-removing substances; preparations for preventing the tarnishing of glass; preparations for the separation of greases; preservatives for tiles, except paints and oils; rubber preservatives; salts for colouring metal; scale-removing preparations, other than for household purposes; silicones; soldering fluxes; solvents for varnishes; synthetic materials for absorbing oil; synthetic resins, unprocessed; wallpaper-removing preparations; fillers; expanding foam; de-icers; wallpaper paste; polymers and retarders for use in plasters; sealants [chemicals] for tiles; urethane floor sealants; sealant mastics for use in industry; sealants [chemicals] for the sealing of surfaces.

3. The opponent relies under both grounds on the trade marks and goods set out below:¹

UK00903993995 (“the earlier figurative mark”)



Filing date: 25 August 2004; Registration date: 17 April 2009

Class 1: *Unprocessed synthetic and acrylic resin.*

¹ On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having two EUTMs being protected as at the end of the Implementation Period, corresponding comparable UK trade marks were automatically created. The comparable trade marks shown here are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing date.

UK00903759917 (“the earlier word mark”)

RENNER

Filing date: 21 April 2004; Registration date: 24 November 2005

Class 2: *Paints, varnishes, enamels, lacquers, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins, agglutinants for painting, anti-fouling paints, gum resins, latex paints, wood preserving paint, fungicidal paint, powder paint, aluminium paint, paint tinctures, synthetic resins, acrylic resin, ink for leather, oil paints, enamel paint, concrete-effect paint, masonry paint, anti-rust paint, anti-oxidation preservation paint and varnishes.*

4. Under Section 5(2)(b), the opponent claims that because of the similarity between the marks, and the identity/similarity between the competing goods, there exists a likelihood of confusion.

5. Under Section 5(3), the opponent claims that its marks have a reputation for the goods set out in the table above. The opponent claims that use of the applicant’s mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character and/or repute of its trade marks. It states:

“The Opponent has a substantial reputation in relation to the goods covered in the Registration and has been using the Registration since 2004. The Opponent provides the goods throughout the UK and the EU. The Application is for a Trade Mark which is similar to the Opponent’s Mark and is used on similar/complementary goods. In light of this, the average consumer is likely to think that the goods emanate from the Opponent or are provided with its consent. This will confer an unfair advantage on the Applicant. The Applicant’s use of the Application will lessen the attractiveness and strength of the Opponent’s Mark as an indicator of origin. The use of the Application will clearly reduce the capacity of the Opponent’s Mark to distinguish its goods. As a result, any use of the Application by the Applicant in relation to the goods covered by the Application would blur the distinctiveness of the Opponent’s Mark that has

been acquired by the Opponent and the Opponent has vigilantly protected its exclusivity in the Opponent's Mark".

6. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use.

7. The applicant is represented by Bird & Bird LLP and the opponent is represented by Withers & Rogers LLP.

8. Only the opponent filed evidence. A hearing took place before me on 22 November 2023, by video conference. The applicant was represented by Mr Robert Milligan of Bird & Bird LLP. Ms Stephanie Davies of Withers & Rogers LLP filed submissions in lieu dated 14 July 2023 and attended the hearing in an observational capacity only, without making any oral submissions.

THE EVIDENCE

9. The opponent filed evidence in the form of the witness statement of Lindo Aldrovandi dated 7 March 2023 which is accompanied by four exhibits (LA1-LA4). Mr Aldrovandi is the Managing Director of Renner Italia S.p.A., which is a subsidiary of the opponent's company.

DECISION

10. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Section 5(2)(b)

11. Section 5(2)(b) of the Act is as follows:

“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”.

12. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Proof of use

13. By virtue of their earlier filing date, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to Section 6 of the Act. As the earlier marks had completed their registration process more than five years before the filing date of the application in question, they are both subject to proof of use pursuant to Section 6A of the Act.

14. The relevant statutory provisions are as follows:

“Section 6A:

(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), (aa) 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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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)-(5A) [Repealed]

(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.”

15. Section 100 of the Act is also relevant, which reads:

“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.”

16. As the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

17. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period ending with the filing date of the application in issue i.e. **9 June 2017** to **08 June 2022**. As the earlier marks are comparable marks, pursuant to paragraph 7 of Part 1, Schedule 2A of the Act, use in the EU (including the UK) will be relevant for the period up to and including IP Completion Day i.e. 31 December 2020. After that date, only use in the UK will be relevant.

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being 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, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned;

(d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19. Proven use of a mark which fails to establish that “*the commercial exploitation of the mark is real*” because the use would not be “*viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark*” is not, therefore, genuine use.

Assessment of proof of use

20. The main facts emerging from the opponent’s evidence are as follows:

- The opponent was founded in 1968 and is a leading manufacturer of wood coatings, paints and varnishes. The registered goods are sold worldwide, including in the EU and UK. Mr Aldrovandi’s company, Renner Italia S.p.A., is authorised to use the earlier marks as a subsidiary of the opponent company. It is responsible for the sale and distribution of Renner branded products in Europe, Middle East and Africa;

- The opponent's earlier marks form part of the company name and logo of Renner Italia S.p.A. and have been used in connection with the registered goods since Renner Italia S.p.A. was incorporated in 2004;
- Mr Aldrovandi provides the following EU and UK sale figures:

EU Sales

€36,612,744 (2017)

€74,614,751 (2018)

€79,196,767(2019)

€5,926,644 (from 1 January 2020 to 31 January 2020)

Total: €199,350,906

UK Sales

€4,267,245 (from 31 January 2020 to 31 December 2020):

€5,386,141 (2021)

€6,475,889 (2022)

€602,347 (from 1 January 2023 to 31 January 2023)

Total: € 16,734,622

- The UK company Danro Coatings Limited was acquired by the opponent in May 2018. The name was subsequently changed to Renner Coatings Limited which became responsible for the distribution of the registered goods in the UK market. Sample invoices issued by Renner Italia S.p.A. to Renner Coatings Ltd are provided. Mr Aldrovandi states that the registered goods were subsequently distributed to UK-based retailers and distributors;
- Mr Aldrovandi provides the following sales figures that are said to have been generated by Renner Coatings Ltd in connection with the registered goods:

Renner Coatings Ltd's sales

€2,099,299 (2018)

€3,333,565 (2019)

€3,606,548 (2020)

€7,027,607 (from 1 January 2021 to 31 January 2021)

Total: €16,067,019

- Renner Italia S.p.A. invested the following sums in promoting the earlier marks in the EU:

EU Advertising expenditures

€634,557 (from August 2017 to December 2017)

€743,839 (2018)

€608,904 (2019)

€39,019 (from 1 January 2020 to 31 January 2020)

Total: €2,026,319

Form of the mark

21. There are plenty of examples of use of the earlier marks on a product brochure² and on sample invoices³ exhibited in evidence before me. Additionally, the evidence includes copies of webpages from third party retailers (www.koolcreations.co.uk, www.allfinishes.co.uk, www.finework.co.uk, www.symphonycoatings.co.uk, www.eicoatings.com) and from the opponent's own website (www.renneritalia.com) showing the figurative mark on branded products, whereas the word mark is referenced as the brand's name on the product brochure, on the opponent's website and email address (info@renneritalia.com), and on third party websites.⁴

22. In his oral submissions, Mr Milligan reiterated his criticisms that the product brochure and the website evidence are outside the relevant period. Whilst that is correct, the evidence includes plenty of invoices falling within the relevant period of 9 June 2017- 08 June 2022 which clearly display the figurative mark on the top-left corner in the form shown below:

² LA1

³ LA4

⁴ LA2 and LA3



23. Bearing in mind that the form used differs from the registered mark only in the addition of the descriptive words 'WOOD COATING', which appear in a very small size underneath the dominant and distinctive element 'RENNER', I consider that the mark used is acceptable use of the mark as registered.⁵

24. Further, the decision in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, establishes that if a registered trade mark that is used as part of a composite mark or in conjunction with another mark continues to be perceived as indicative of the origin of the product at issue, such use will count towards genuine use.

25. Accordingly, applying the guidance from *Colloseum*, I am satisfied that use of the figurative mark on the invoices dated within the relevant period counts towards genuine use of the word mark. If I am wrong about that, I consider that the incorporation of the word 'RENNER' on the email address and on the domain name (as shown on invoices dated within the relevant period), counts towards genuine use of the word mark.

Genuine use

26. A further criticism put forward by Mr Milligan is that there is no evidence of the earlier marks being used on the goods themselves. According to Mr Milligan, the use shown is, at best, use in relation to retail services. At the hearing I asked Mr Milligan to comment expressly on the image shown below (which appears in the product brochure that Mr Milligan alleges is from 2012, i.e. outside the relevant period) and to explain why he did not think that it was use of the mark on the goods:

⁵ *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

Color System, limitless colors

The tintometric Color System produced by Renner Italia, was developed to faithfully reproduce every shade of the color spectrum. With an infinite range of possible solutions, the Color System meets the needs of both service centres and end users who demand top quality finishes. The Renner Italia (RTS) tintometric tinting systems for water-based and solvent-based coatings meet all the requirements for precision, speed and ease of use; setting and maintaining the highest quality standards while significantly reducing manual intervention.

Thanks to the Color System color reproducibility is now limitless.

The Renner Italia coloristic laboratory at your finger tips

The Color System brings the expertise and efficiency of the Renner Italia Coloristic Laboratory directly to the customer. Thanks to the extensive network of service centres located throughout the territory, every decorator can easily reproduce endless colors for all types of wood finishes:

- › matt polyurethane coatings
- › high-gloss polyurethane coatings
- › water-based products for outdoor joinery
- › water-based one-component products for indoor furniture
- › water-based two-component products for indoor furniture

For pigmented products used in high-tech coating systems, such as water-based and solvent-based UV-drying systems, as well as dual cure systems, acrylic-polyurethane coatings, etc., the chromatic solution provided by the Color System is always extremely faithful.

The system does not only bring you excellent color consistency. Our service centres provide the same performance and chemical specifications as those coatings produced at Renner Italia central factories, and are subjected to the same most stringent quality levels.

Through the service centres located throughout the territory, the Color System brings Renner Italia total quality and efficiency to every corner of the planet.

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27. Mr Milligan said that it is not possible to determine what the product is and pointed out that the vertical lines coming out of the tin looked like wires. Having considered the image in more details, along with the text, it seems to me that it depicts a Tinto-metric colour system dropping colours in a liquid form into a tin. In any event, Mr Milligan's criticism is beside the point, as the product is clearly described as 'WOOD COATING' and 'water based', so it is clearly a tin of water-based wood coating. This conclusion is corroborated by other images featuring similar products displaying the figurative mark, including on the opponent's website and on websites of third-party retailers, as shown below:



28. All products are priced in GBP and are identified as 'RENNER' branded products; they include topcoats, primers, crosslinkers, hardeners, clear-self-sealers, and paints. In addition, the evidence from third-party websites contains multiple references to 'RENNER' being a leading producer of wood coating, as shown below:

“Renner Italia produces the most trustful, modern and innovative wood coatings. There is a whole worldview inside each can of their coatings. Above all, their coatings are formulated according to ethical principles. They are the experts in Water-based, Polyurethane and Polyester Technology if you're looking for high end wood coatings”

“RENNER WOOD COATINGS – One of Italy's fastest growing coating manufacturer and supplier, Renner Wood Coatings are known for their high quality and incredible innovation. We are one of the biggest Renner paint stockings in Ireland [...] Renner paints are some of the most technologically advanced and innovative. Renner Wood Coatings have become one of the biggest wood coatings suppliers in all of Europe. Their polyurethane products give superior finishes to competitors, offering the best level of clarity, strength and overall they bring out the very best looks in your wood or timber. If you are shopping for Renner paints, we here at European Industrial Coatings are one of the biggest Renner paint stockists Ireland.”

“Symphony has forged relationships with the best manufacturers in the world to bring an unrivalled range to the UK, our partners include: [...] Renner Italia”.

29. Admittedly, this evidence is undated (save for the printing date that is after the relevant period); nevertheless, it is evidence that deserves to be given some weight insofar as it corroborates the conclusion that the opponent is a leading supplier of wood coatings and paints. This conclusion is also supported by the significant EU and UK sale figures which amount to nearly €200million worth of goods sold in the EU (prior to the UK’s exit from the EU) and, at least, over €18million worth of goods sold in the UK during the relevant period.⁶ The EU marketing figures are also relatively substantial, amounting to over €2million spent between 2017 and 2020.

30. Finally, I am not persuaded by Mr Milligan’s argument that the sales to Dandro Coatings Ltd and Renner Coatings UK Ltd (formerly Dandro Coatings Ltd) must be discounted because they are internal sales, rather than sales to end consumers.

31. It is clear that prior to being acquired by the opponent in 2018, Dandro Coatings Ltd had purchased the opponent’s goods in order to re-sell them in the UK and so it had initially acted as a distributor of the opponent’s goods as demonstrated by the invoices dated 2017 which show that the opponent had sold hundreds of products to Dandro Coatings Ltd. Having been acquired by the opponent in 2018, the company – which changed its name to Renner Coatings UK Ltd - carried on selling the opponent’s goods in the UK as an operative company of the Italian business. Mr Aldrovandi’s evidence points unequivocally to the goods sold by the opponent to Renner Coatings UK Ltd being re-sold by Renner Coatings UK Ltd to UK-based retailers and distributors. In addition, as the evidence shows repeat sales to Renner Coatings UK

⁶ I calculated this as follows: **€9,039,412** sold by Renner Coatings Ltd between January 2018 and December 2020. I added to this the difference between the UK sale figures (which are only given from 2020 onwards) and Renner Coatings Ltd’s sale figures for 2020 as there appear to be a difference of **€606,697** in the sense that the UK sale figures are €606,697 higher than Renner Coatings Ltd’s sale figures for the same period. For 2021 there is an inconsistency as the witness statement says that Renner Coatings Ltd’s sold about 7million worth of goods in January 2021 only, whilst the UK sale figures for 2021 are about 5,3 million for the whole year, so given the inconsistency, I have used the UK figure, which brings it to a total of **€15,032,250** between 2018 and 2021. The UK figures for 2022 are about 6.4million and assuming that sales were evenly spread throughout the year, adding half of the 2022 sale to the total of €15,032,250, it would amount to **€18,270,194**.

Limited, it supports the conclusion that they would have no need to place repeat orders if they were not successfully selling the stock on to the end consumer. Hence, the alternative conclusion suggested by Mr Milligan would be that millions worth of goods was held as stock or left unsold by Renner Coatings UK Ltd without being offered for sale to consumers; that it is not only unrealistic, but also contrary to Mr Aldrovandi's unchallenged evidence; hence I reject it.

32. Taking into account the EU and UK sale figures, which are significant, the EU marketing figures, which are also significant, the length and continuity of the use shown, and the independent evidence from third party retailers about the opponent's leading position on the EU market, I am satisfied that the opponent has genuinely used the earlier marks in relation to wood coatings during the relevant period.

Fair specification

33. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“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.”

34. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

35. During the course of his oral submissions, Mr Milligan argued that if I were to find that the opponent has genuinely used the marks, the best the opponent should be able to rely on would be the goods which are underlined below (as covered by the specification of the word mark):

Paints, varnishes, enamels, lacquers, preservatives against rust and against deterioration of wood, colorants, mordants, raw natural resins, agglutinants for painting, anti-fouling paints, gum resins, latex paints, wood preserving paint, fungicidal paint, powder paint, aluminium paint, paint tinctures, synthetic resins, acrylic resin, ink for leather, oil paints, enamel paint, concrete-effect paint, masonry paint, anti-rust paint, anti-oxidation preservation paint and varnishes.

36. The evidence, taken as a whole, shows that the goods sold by the opponent are all wood coatings applied to wood in order to prepare, preserve, colour, give durability and finish to a desired professional result. In this connection, the invoices, the webpages and the brochure include references to 'paint' as well as other goods which are likely to be used before, after or together with paint, for example: primer, top-coat, base-coat, paint remover, solvent-base paste, hardener, filler, acrylic self-sealer and barrier for resinous woods.

37. Collins English dictionary defines resin as *"a thick, sticky substance that is produced by some trees and that becomes yellow and hard after it is collected, or any of various similar substances produced by a chemical process for use in industry"*. Further, one of the webpages exhibited in evidence refers to exterior wood finishes (which I consider to be the same as wood coatings) containing resin. It states:

These products contain wax, resin or drying oil. These reduce the absorption of moisture and therefore minimises the expansion and contraction of the wood, which helps create a more long-lasting product. They can also inhibit the growth of mildew on the wood. Water repellent preservatives can be used in their own right as a natural exterior finish. Some can even be used as a base coat under primer and paint layers for longer lasting protection. An exterior varnish provides an attractive finish to wood, as it enhances the natural colour and grain."

38. However, the evidence does not say whether the opponent's wood coatings are made from unprocessed rather than processed resin. Further, even accepting that the opponent might sell paint/varnish which contains resin, is not the same as showing use for the resin itself. Therefore, find that the evidence is not sufficient to conclude

that the earlier figurative mark has been used for *Unprocessed synthetic and acrylic resin*.

39. As regard the word mark, I am satisfied that the opponent has shown use in relation to *paints*. In addition, since the opponent's wood coatings preserve the wood against deterioration (preservatives being any chemicals that prevent things from decaying), I find that the opponent can rely on *preservatives against [...] deterioration of wood*.

40. *Varnish* is defined as an oily liquid which is painted onto wood or other material to give it a hard, clear, shiny surface. *Enamel* is defined as a type of paint that forms a shiny surface when dry. Although the terms *varnish* and *enamel* are not used in relation to the opponent's wood coatings, the invoices contain references to products that produce a gloss effect, for example gloss top coats. Hence, I find that the opponent can rely on *varnishes* and *enamels*.

41. *Lacquer* is defined as “a hard glossy coating made by dissolving cellulose derivatives or natural resins in a volatile solvent” and “a black resinous substance, obtained from certain trees, used to give a hard glossy finish to wooden furniture”. In addition, I note that the evidence refers to Renner products as Wood Lacquers.⁷ Hence, I find that the opponent can rely on *lacquers*.

42. *Mordant* is defined as a substance used before the application of a dye, possessing the ability to fix colours in textiles, leather, etc. There is no evidence of use of the earlier marks in relation to mordants and the opponent cannot rely on this term. Equally, there are no references in the evidence to *preservatives against rust [...]*, *colorants*, *raw natural resins*, *agglutinants for painting*, *synthetic resins*, *gum resins*, *acrylic resin*, *ink for leather*.

43. Finally, to reflect the evidence that all of the products are described as wood coatings, I think it is appropriate to add the limitation “*all of the aforesaid being coatings for use on wood*”. This will ensure that the opponent can retain the terms *anti-fouling paints*; *fungicidal paint*; *powder paint*; *paint tinctures*; *oil paints*; *enamel paint*; *latex*

⁷ LA2

paints, concrete-effect paint; anti-oxidation preservation paints and varnishes whilst reflecting that it is only a specific sub-category of these goods in relation to which use has been shown i.e. paints for use on wood. Equally, since there is only evidence of use of the marks in relation to wood paints, I consider that the opponent should not be able to rely on paints for other materials, namely, *aluminium paint, masonry paint, anti-rust paint* (as wood are non-metallic and are therefore not subject to rust). Consequently, I consider a fair specification to be:

Paints, varnishes, enamels, lacquers, preservatives against deterioration of wood, anti-fouling paints, latex paints, wood preserving paint, fungicidal paint, powder paint, paint tinctures, oil paints, enamel paint, concrete-effect paint, anti-oxidation preservation paint and varnishes; all of the aforesaid being coatings for use on wood.

44. Because the opponent has not been able to demonstrate use in relation to any of the goods covered by the specification of the figurative mark, it cannot be relied upon for the purposes of the opposition.

Section 5(2)(b) – case law

45. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 or 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;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also 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 of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

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

(j) 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;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

46. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”

47. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (“CJEU”) stated that:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary.”

48. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

49. The General Court (“GC”) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

50. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

51. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between the goods/services is to assess whether the relevant public are liable to believe that the responsibility for

the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

52. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”

53. The goods to be compared are as follows:

| The applicant's goods | The opponent's goods |
|---|--|
| <p>Class 1: <i>Chemicals used in industry; chemicals used in agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastics; adhesives used in industry; adhesives for wallpaper; adhesive cements; industrial adhesives for use in building; adhesives for plasters; adhesives for applying floor tiles; adhesives for floor coverings; additives (chemicals); adhesives for wall tiles; agglutinants for concrete; alginates for industrial purposes; ammonia; antifreeze; anti-static preparations, other than for household purposes; anti-tarnishing chemicals for windows; auxiliary fluids for use with abrasives; glue for industrial</i></p> | <p>Class 5: <i>Paints, varnishes, enamels, lacquers, preservatives against deterioration of wood, anti-fouling paints, latex paints, wood preserving paint, fungicidal paint, powder paint, paint tinctures, oil paints, enamel paint, concrete-effect paint, anti-oxidation preservation paint and varnishes; all of the aforesaid being coatings for use on wood.</i></p> |

purposes; carpet glue; wood glues; bases (chemical preparations); bleaching preparations for industrial purposes; brazing fluxes; brazing preparations; brickwork preservatives, except paints and oils; cement for mending broken articles; cement preservatives, except paints and oils; cement-waterproofing chemicals, except paints; ceramic glazes; chemical additives for oils; chemical condensation preparations; chemical intensifiers for rubber; chemical preparations for facilitating the alloying of metals; chemical preparations to prevent mildew; chemicals, except pigments, for the manufacture of enamel; chemicals for the manufacture of paints; chemicals for the manufacture of pigments; colour-brightening chemicals for industrial purposes; concrete-aeration chemicals; concrete preservatives, except paints and oils; chemicals used to prevent condensation; corrosive preparations; damp-proofing chemicals, except paints, for masonry; degreasing preparations for use in manufacturing processes; degumming preparations; dehydrating preparations for industrial purposes; detergents for use in manufacturing processes; emulsifiers; enamel-staining chemicals; filtering materials (chemical preparations); leather glues; leather-

renovating chemicals; leather-waterproofing chemicals; limestone hardening substances; masonry preservatives, except paints and oils; mastic for leather; oil-bleaching chemicals; oil cement (putty); oil dispersants; oil purifying chemicals; oil-separating chemicals; polish-removing substances; preparations for preventing the tarnishing of glass; preparations for the separation of greases; preservatives for tiles, except paints and oils; rubber preservatives; salts for colouring metal; scale-removing preparations, other than for household purposes; silicones; soldering fluxes; solvents for varnishes; synthetic materials for absorbing oil; synthetic resins, unprocessed; wallpaper-removing preparations; fillers; expanding foam; de-icers; wallpaper paste; polymers and retarders for use in plasters; sealants [chemicals] for tiles; urethane floor sealants; sealant mastics for use in industry; sealants [chemicals] for the sealing of surfaces.

54. The opponent states that the following goods in class 1 are identical to the opponent's resins in the same class:

unprocessed artificial resins; synthetic resins, unprocessed; chemicals used in industry; chemicals used in agriculture, horticulture and forestry; unprocessed plastics; additives (chemicals); bases (chemical preparations); adhesives used in industry; industrial adhesives for use in building; adhesives for applying floor tiles; adhesives for floor coverings; adhesives for wall tiles; glue for industrial

purposes; carpet glue; wood glues; leather glues; brickwork preservatives, except paints and oils; preservatives for tiles, except paints and oils; chemical preparations to prevent mildew; Dampproofing chemicals, except paints, for masonry; leather-waterproofing chemicals; leather renovating chemicals; fillers; sealants [chemicals] for tiles; urethane floor sealants; sealant mastics for use in industry; sealants [chemicals] for the sealing of surfaces.

55. The opponent provided additional reasoning for its claim that the goods are identical, for example it states that adhesives and glues are identical to resins because resins are multifunctional and can be used as adhesives and glues among other things such as coatings, fillers and sealants by consumers. This confirms my impression that the opponent's wood coatings can be made from, or contain, resin. The opponent also states that *brickwork preservatives, except paints and oils; preservatives for tiles, except paints and oils*, are identical to the opponent's resins because the latter can be used as preservatives.

56. The first thing to note is that the opponent cannot longer rely on resin in class 1 because I found that the evidence does not establish genuine use in relation to *Unprocessed synthetic and acrylic resin*. Equally, I found that the opponent's evidence is insufficient to establish that use in relation to the opponent's wood coatings amounts to use in relation to the registered resins in class 2 (i.e. *raw natural resins, gum resins, synthetic resins, acrylic resin*), because whilst the goods are likely to contain resin, it is not clear that they are 100% resin.

57. **Unprocessed artificial resins; synthetic resins, unprocessed.** During the course of his oral submissions, Mr Milligan pointed out that Class 1 includes mainly chemical products for use in industry, science and agriculture, whereas the opponent's goods are finished products.

58. As it will be recalled, the evidence indicates that wood coatings contain resin, and the dictionary definition of lacquers indicates that wood lacquers are made from resin. However, the fact that wood coatings contain resin is not enough for these goods to be considered similar. The goods target different consumers, because the applicant's goods will be purchased by manufacturers which use unprocessed or synthetic resins

in their manufacturing process, whereas the opponent's goods target DIY consumers or professionals who wish to purchase a finished product for protecting, restoring and/or colouring furniture or wooden goods, such as for example, fences, gates and decking. The uses, users, purpose, nature and methods of use of the goods are different, the goods are not complementary and do not travel through the same trade channels. Finally, I have no evidence on the bases of which I can conclude that the applicant's unprocessed resins may be used on wood without further industrial processing, so there is no competition in this sense. These goods are dissimilar.

59. Similar conclusions apply to the following goods which are all chemicals used in manufacturing processes: **Chemicals used in industry; chemicals used in agriculture, horticulture and forestry; unprocessed plastics; adhesives used in industry; industrial adhesives for use in building; alginates for industrial purposes; glue for industrial purposes; bleaching preparations for industrial purposes; chemicals, except pigments, for the manufacture of enamel; chemicals for the manufacture of paints; chemicals for the manufacture of pigments; colour-brightening chemicals for industrial purposes; degreasing preparations for use in manufacturing processes; dehydrating preparations for industrial purposes; detergents for use in manufacturing processes; sealant mastics for use in industry.** These goods are dissimilar. The same goes for **filtering materials (chemical preparations), corrosive preparations** (such as for example acids) **additives (chemicals), chemical intensifiers for rubber** and **auxiliary fluids for use with abrasives**, which are chemical products having either specific properties (filtering and corroding) that do not coincide with the purpose of the opponent's wood coatings, and/or refer to chemical products meant for a specialised public only (additives, chemical intensifiers for rubber and auxiliary fluids for use with abrasives), and are available from different suppliers than the opponent's goods.

60. **Adhesives for wallpaper; adhesive cements; adhesives for plasters; adhesives for applying floor tiles; adhesives for floor coverings; adhesives for wall tiles; preservatives for tiles, except paints and oils; sealants [chemicals] for tiles; wallpaper-removing preparations; wallpaper paste; leather glues; leather-renovating chemicals; leather-waterproofing chemicals; mastic for leather; carpet glue; agglutinants for concrete; cement for mending broken articles;**

cement preservatives, except paints and oils; cement-waterproofing chemicals, except paints; concrete-aeration chemicals; concrete preservatives, except paints and oils; polymers and retarders for use in plasters; oil cement (putty); anti-tarnishing chemicals for windows; preparations for preventing the tarnishing of glass; brickwork preservatives, except paints and oils; rubber preservatives; silicones; expanding foam; masonry preservatives, except paints and oils; Damp-proofing chemicals, except paints, for masonry.

The reason why I have grouped these goods together is because they are, or are used with, building material other than wood, or goods used for covering previously constructed floors and walls, including cement, concrete, brickwork and masonry (masonry being the craft of building a structure with brick, stone, or similar material), tiles, plasters, wallpapers, leather, carpet, rubber and glass.

61. Since the opponent cannot longer rely on resin, its argument that the applicant's adhesives are identical to resin, because resins can be used as adhesives and glues no longer stand. Equally, the argument that the applicant's preservatives are similar to the registered resin because resins can be used as preservatives is no longer viable.

62. Alternatively, the opponent argues that the goods covered by the application are highly similar to the opponent's goods, since they would be sold in the same shops, and they would share the same nature, be used for similar purposes, and be complementary.

63. The opponent's goods are wood coatings and the applicant's goods are products for use with material other than wood, including cement, concrete, brickwork, tiles, plasters, wallpapers, leather, carpet, rubber and glass. The goods have different uses and methods of use, are neither complementary nor in competition. However, I accept that the applicant's goods and the opponent's goods share trade channels as they will be sold by the same retailers offering goods for DIY and home improvement and will target the same users, i.e. tradespeople and DIY consumers. Further, although the goods have a different nature, at a very general level, they have a similar purpose insofar as they are used for DIY or home improvement. These goods are similar to a low degree.

64. **Ceramic glazes; salts for colouring metal.** Similar considerations apply to these goods, which are likely to share the users and trade channels with the opponent's goods. Furthermore, there some overlap in terms of nature and specific purpose between these goods and the goods of the opponent (albeit at a general level), because both are likely to be types of paint, and/or both will be used for preserving/colouring the material to which they are applied to. These goods are similar to a low to medium degree.

65. **Limestone hardening substances.** Limestone is a rock which is used for building and for making cement. I understand these goods to be used in construction. The use, nature, and method of use of the goods clearly differ but the users and trade channels overlap; furthermore, the goods have a similar purpose insofar as they are used for DIY or home improvement. These goods are similar to a low degree.

66. **Brazing fluxes; brazing preparations; soldering fluxes; chemical preparations for facilitating the alloying of metals.** Brazing is a metal-joining process. Soldering flux is mainly used to prepare the metal surfaces before soldering by cleaning and removing any oxides and impurities. A metal alloy is a mixture of a metal with another element so the applied for chemical preparations for facilitating the alloying of metals would facilitate the process of mixing/melting. These are mostly specialist goods and the opponent has not filed any evidence to assist me in identifying where the similarity might lie, but based on my own understanding of the terms, I am not convinced that these goods would be used in DIY or home improvement and that they would share trade channels with the opponent's goods or target the same users. These goods are dissimilar.

67. **Antifreeze; anti-static preparations, other than for household purposes; scale-removing preparations, other than for household purposes; chemicals used to prevent condensation; chemical condensation preparations; de-icers.** These goods are chemical substances used to extract moisture from the air (i.e. *chemicals used to prevent condensation; chemical condensation preparations*), reduce static electricity (i.e. *anti-static preparations, other than for household purposes*), remove scale - which is a hard, white substance that forms where water collects or dispenses (i.e. *scale-removing preparations, other than for household*

purposes), reduces the temperature at which water freezes in car engines to keep them from freezing (i.e. *antifreeze*) and remove ice (i.e. *de-icers*). The nature, method of use and purpose of the goods clearly differ because, as the applicant argues, these goods have very specific purposes for use in agriculture and against the cold. These goods are dissimilar.

68. **Ammonia** is “a gas or liquid with a strong smell, having various industrial uses such as in cleaning”. There is no evidence that ammonia is used to prepare wood before wood coatings are applied to it. Hence, the users, nature, method of use, purpose of the goods clearly differ, the goods are neither complementary nor in competition and do not share trade channels. These goods are dissimilar.

69. **Degumming preparations**. I understand *degumming* to be a process used in oil refining plants to remove gum impurities from oil. The nature, method of use and purpose of the goods clearly differ. Further, neither the users nor the trade channels overlap, as the goods are highly specialised and unlikely to be found in DIY and home improvement shops where the opponent’s goods are offered. These goods are dissimilar.

70. **Oil dispersants; oil-bleaching chemicals; oil purifying chemicals; oil-separating chemicals; preparations for the separation of greases; chemical additives for oils; synthetic materials for absorbing oil.** A dispersant is used to disperse small particles or drops; hence, oil dispersants are likely to be used to treat spills of oils and prevent oil dispersion in the water. Likewise, it seems to me that *oil-bleaching chemicals; oil purifying chemicals; oil-separating chemicals; preparations for the separation of greases; chemical additives for oils; synthetic materials for absorbing oil;* are all chemicals for use with oil or in industrial processes. The nature, method of use and purpose of the goods clearly differ. Further, neither the users nor the trade channels overlap. These goods are dissimilar.

71. **Emulsifiers**. Emulsifier is a substance that forms or keeps an emulsion and is often added to processed foods to prevent particular parts from separating. It is therefore a substance that is used in the manufacture of food products. The use,

nature, method of use and purpose of the goods clearly differ. Further, neither the users nor the trade channels overlap. These goods are dissimilar.

72. **Polish-removing substances; solvents for varnishes**. Polish remover is a substance used for removing polish. Collins English dictionary defines polish as “a substance that you put on the surface of an object in order to clean it, protect it, and make it shine” and provides the following examples: “The still air smelt faintly of furniture polish” listing the following synonyms: “varnish, wax, glaze, lacquer”. Likewise, solvents for varnishes includes solvents for wood varnishes. Since the opponent’s goods are varnishes and paints for use on wood, and the applicant’s goods can be used to remove furniture polish and wood varnishes, there is a degree of overlap between the goods to the extent that they can both be used to treat wood. For example, the applicant’s polish-removing substances and solvents for varnishes could be used to remove old layers of polish and varnish from furniture, before using the opponent’s products. Although the nature and purpose of the goods is different, the goods target the same consumers, share trade channels, are likely to be found in close proximity and are complementary in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking. These goods are similar to a medium degree.

73. **Chemical preparations to prevent mildew; bases (chemical preparations)**. These goods are sufficiently broad to include chemical preparations to prevent mildew in wood. Further, the goods are not limited to goods for industrial purposes. The closest clash I can see here is with preservatives against deterioration of wood, which include preservative to prevent mould. Adopting a similar approach to that I have adopted in relation to *polish-removing substances; solvents for varnishes*, I find that these goods are similar to a medium degree. Further, insofar as *bases (chemical preparations)*, is sufficiently broad to include chemical preparations to prevent mildew, they are also similar to a medium degree.

74. **Wood glues**. Adopting a similar approach to that I have adopted in relation to *polish-removing substances; solvents for varnishes*, I find that these goods are similar to a medium degree.

75. Sealants [chemicals] for the sealing of surfaces; urethane floor sealants.

Being unlimited, the applicant's *sealants* include sealants for the sealing of wood surfaces. Adopting a similar approach to that I have adopted in relation to *polish-removing substances; solvents for varnishes*, I find that these goods are similar to a medium degree.

76. Fillers. Being unlimited, the applicant's fillers include fillers for use with wood. Adopting a similar approach to that I have adopted in relation to *polish-removing substances; solvents for varnishes*, I find that these goods are similar to a medium degree.

77. Enamel-staining chemicals. I understand these goods to be chemicals which are used to stain enamels. Although there is no evidence on the point, I am inclined to think that these goods would be something that would be used in the production of the opponent's enamels. However, as I found in relation to resin, that would not be sufficient for a finding of similarity. These goods are dissimilar.

78. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

79. As I found that some of the goods at issue are dissimilar, the opponent's claim under Section 5(2)(b) fails in respect of those goods.

Average consumer

80. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”


81. The average consumer of the parties' goods is the general public or a professional user. The goods are likely to be self-selected from the shelves of a retail outlet or their online equivalent. Consequently, visual considerations are likely to dominate the purchasing process. Although consumers who select the goods might consider factors such as colour, composition and price, the degree of attention is likely to be no more than medium.

Comparison of marks

82. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

83. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective marks are shown below:

| The applicant's marks | The opponent's mark |
|---|---|
|  | <p data-bbox="810 1182 948 1218">RENNER</p> |

Overall impression

84. In its submissions in lieu, the opponent states that the dominant and distinctive element of the applicant's mark is the word 'BRENNER' and that the non-verbal elements of the mark are non-distinctive and negligible from the viewpoint of the consumer.

85. The opponent's mark is a word-only mark comprises word 'RENNER' presented in capital letters, and therefore, the overall impression lies in that word.

86. The applicant's mark comprises the stylised word 'BRENNER', and a horizontal red line above the letters 'NNER' and a vertical grey line; the first mark in the series also comprises a grey rectangular. It is a general rule of thumb that words speak louder than devices. I consider that rule to be applicable here. Although the figurative elements are distinctive and have a visual impact, it is the word elements 'RENNER' and 'BRENNER', by which the marks are likely to be referred to and which carry the greater weight in the overall impression of the marks.

Visual similarity

87. In a visual comparison of the marks, the main point of similarity is the presence of the seven letters 'RENNER' in the same order; this is the only verbal element of the opponent's mark. The applicant's mark has an additional letter 'B' which is positioned before the letters 'RENNER', however, seven out of eight letters are identical. In the first mark in the series and in the opponent's mark the words 'BRENNER' is presented within a rectangular background, which also creates a point of dissimilarity, however, this element and the other figurative elements of the applicant's marks are banal even considering the impact of the colour. I acknowledge that differences at the beginning of a mark tend to make more of an impact, nonetheless, taking into account the similarities and the differences, I consider the marks to be visually similar to a medium to high degree.

Aural similarity

88. In an aural comparison of the marks, it is unlikely that a consumer would vocalise the figurative elements of the marks. The only difference between the marks is the additional letter 'B' at the beginning of the applicant's marks, however, the letters 'RENNER' are identical. I consider the marks to be aurally similar to a high degree.

Conceptual similarity

89. In a conceptual comparison of the marks, to the extent that neither mark has a meaning, a conceptual comparison of the verbal elements of the marks is not possible. The lines in the applicant's mark are unlikely to form part of a conceptual hook.

Distinctive character of earlier mark

90. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

91. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

92. The word 'RENNER' has no meaning and will be perceived as an invented word which is inherently distinctive to a high degree.

93. Evidence of use can contribute to increasing the distinctiveness of a mark; however, in this case I am not persuaded that the evidence filed by the opponent is sufficient to establish that. Whilst the UK sale figures are healthy, there is no context or information about market share which would assist me in assessing the opponent's position in the UK market for the relevant goods. Further, the marketing figures refer to the EU as a whole, rather than the UK, and whilst there are some references to the opponent's being one of the biggest suppliers in the EU, it is not clear how strong the opponent's position is in the UK. Hence, I find that the evidence is insufficient to establish that the distinctiveness of the opponent's mark has been enhanced as a result of the use made of it.

Likelihood of confusion

94. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

95. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. (as he then was) as the Appointed Person explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it

is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

96. Earlier in this decision I found that:

- Some of the applicant's goods are similar to a low and medium degree to the goods of the earlier mark;

- The average consumer would be a member of the general public or a professional who would pay a medium degree of attention during the purchasing process. The purchasing process would be predominantly visual, although aural considerations cannot be excluded entirely;
- The marks are visually similar to a medium to high degree, and aurally similar to a high degree. Conceptually, the position is neutral insofar as the verbal elements of the marks have no meaning;
- The earlier mark is inherently distinctive to a high degree.

97. Bearing in mind the principle of imperfect recollection, I consider that the marks are likely to be directly confused one for the other. The similarity between the verbal element of the marks (which are the most important parts of the marks) is such that they can easily be mistaken or misremembered, especially given that there is no conceptual hook to aid that recollection. Further, the impact of the figurative elements is not sufficient to differentiate the marks. Consequently, I find that there is a likelihood of direct confusion in relation to the goods which I found to be similar, namely:

Adhesives for wallpaper; adhesive cements; adhesives for plasters; adhesives for applying floor tiles; adhesives for floor coverings; adhesives for wall tiles; preservatives for tiles, except paints and oils; sealants [chemicals] for tiles; wallpaper-removing preparations; wallpaper paste; leather glues; leather-renovating chemicals; leather-waterproofing chemicals; mastic for leather; carpet glue; agglutinants for concrete; cement for mending broken articles; cement preservatives, except paints and oils; cement-waterproofing chemicals, except paints; concrete-aeration chemicals; concrete preservatives, except paints and oils; polymers and retarders for use in plasters; oil cement (putty); anti-tarnishing chemicals for windows; preparations for preventing the tarnishing of glass; brickwork preservatives, except paints and oils; rubber preservatives; silicones; expanding foam; masonry preservatives, except paints and oils; Damp-proofing chemicals, except paints, for masonry; Ceramic glazes; salts for colouring metal; Limestone hardening substances; Polish-

removing substances; solvents for varnishes; Chemical preparations to prevent mildew; bases (chemical preparations); Wood glues; Sealants [chemicals] for the sealing of surfaces; urethane floor sealants; Fillers.

Section 5(3)

98. 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 and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

99. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

100. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a

characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L’Oreal v Bellure*).

101. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, being 08 July 2022.

Reputation

102. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

103. I have already found that the distinctiveness of the earlier mark has not been enhanced through use. For similar reasons to those I have set out above, I also find that the opponent's mark did not have a qualifying reputation in the UK at the relevant date. However, I will consider the Section 5(3) ground in the event that I am wrong and there is a small reputation in the UK at the relevant date (which is the opponent's best case given the evidence filed).

LINK

104. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

The marks are visually similar to a medium to high degree and aurally similar to a high degree. Conceptually, the marks are neutral insofar as they are both invented words with no meaning.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

The applied-for goods in class 1 are either similar to medium or low degree or dissimilar to the goods in relation to which the opponent's mark has a reputation.

The strength of the earlier mark's reputation.

The opponent's mark has a small reputation (at best) for wood paints.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

The earlier mark is inherently distinctive to a high degree, but its distinctiveness has not been enhanced through use.

Whether there is a likelihood of confusion.

I have found there to be a likelihood of confusion in relation to similar goods and no likelihood of confusion in relation to dissimilar goods.

Assessment

106. Although, I accept that there would be a link and damage in the context of goods which I found to be similar and for which the opposition under Section 5(2)(b) has been successful, in my view it is unlikely that customers for the applicant's goods would see any link with the opponent's goods, when the goods at issue are dissimilar, owing to the differences between the goods and the modest size of the opponent's reputation. Hence, even if successful, the opposition under Section 5(3) cannot put the opponent in a better position than that under Section 5(2)(b).

Conclusions

107. The partial opposition against the applied-for goods in class 1 succeeds in relation to the following goods only:

Class 1: *Adhesives for wallpaper; adhesive cements; adhesives for plasters; adhesives for applying floor tiles; adhesives for floor coverings; adhesives for wall tiles; preservatives for tiles, except paints and oils; sealants [chemicals] for*

tiles; wallpaper-removing preparations; wallpaper paste; leather glues; leather-renovating chemicals; leather-waterproofing chemicals; mastic for leather; carpet glue; agglutinants for concrete; cement for mending broken articles; cement preservatives, except paints and oils; cement-waterproofing chemicals, except paints; concrete-aeration chemicals; concrete preservatives, except paints and oils; polymers and retarders for use in plasters; oil cement (putty); anti-tarnishing chemicals for windows; preparations for preventing the tarnishing of glass; brickwork preservatives, except paints and oils; rubber preservatives; silicones; expanding foam; masonry preservatives, except paints and oils; Damp-proofing chemicals, except paints, for masonry; Ceramic glazes; salts for colouring metal; Limestone hardening substances; Polish-removing substances; solvents for varnishes; Chemical preparations to prevent mildew; bases (chemical preparations); Wood glues; Sealants [chemicals] for the sealing of surfaces; urethane floor sealants; Fillers.

108. Subject to any successful appeal, the application may proceed to registration in respect of the remaining goods.

COSTS

109. As both parties have achieved a measure of success, I order that each party bear their own costs.

Dated this 1st day of December 2023

**Teresa Perks
For the Registrar**

ANNEX I

Class 1: Chemicals used in industry; chemicals used in agriculture, horticulture and forestry; unprocessed artificial resins; unprocessed plastics; adhesives used in industry; adhesives for wallpaper; adhesive cements; industrial adhesives for use in building; adhesives for plasters; adhesives for applying floor tiles; adhesives for floor coverings; additives (chemicals); adhesives for wall tiles; agglutinants for concrete; alginates for industrial purposes; ammonia; antifreeze; anti-static preparations, other than for household purposes; anti-tarnishing chemicals for windows; auxiliary fluids for use with abrasives; glue for industrial purposes; carpet glue; wood glues; bases (chemical preparations); bleaching preparations for industrial purposes; brazing fluxes; brazing preparations; brickwork preservatives, except paints and oils; cement for mending broken articles; cement preservatives, except paints and oils; cement-waterproofing chemicals, except paints; ceramic glazes; chemical additives for oils; chemical condensation preparations; chemical intensifiers for rubber; chemical preparations for facilitating the alloying of metals; chemical preparations to prevent mildew; chemicals, except pigments, for the manufacture of enamel; chemicals for the manufacture of paints; chemicals for the manufacture of pigments; colour-brightening chemicals for industrial purposes; concrete-aeration chemicals; concrete preservatives, except paints and oils; chemicals used to prevent condensation; corrosive preparations; damp-proofing chemicals, except paints, for masonry; degreasing preparations for use in manufacturing processes; degumming preparations; dehydrating preparations for industrial purposes; detergents for use in manufacturing processes; emulsifiers; enamel-staining chemicals; filtering materials (chemical preparations); leather glues; leather-renovating chemicals; leather-waterproofing chemicals; limestone hardening substances; masonry preservatives, except paints and oils; mastic for leather; oil-bleaching chemicals; oil cement (putty); oil dispersants; oil purifying chemicals; oil-separating chemicals; polish-removing substances; preparations for preventing the tarnishing of glass; preparations for the

separation of greases; preservatives for tiles, except paints and oils; rubber preservatives; salts for colouring metal; scale-removing preparations, other than for household purposes; silicones; soldering fluxes; solvents for varnishes; synthetic materials for absorbing oil; synthetic resins, unprocessed; wallpaper-removing preparations; fillers; expanding foam; de-icers; wallpaper paste; polymers and retarders for use in plasters; sealants [chemicals] for tiles; urethane floor sealants; sealant mastics for use in industry; sealants [chemicals] for the sealing of surfaces.

Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; polish for furniture and flooring; floor waxes; polishing waxes; abrasives except dental abrasives; rust-removing preparations; scouring solutions; preparations for cleaning waste pipes; shampoos for floor coverings; stain removers; scale-removing preparations for household use; detergents other than for use in manufacturing operations and for medical use; emery cloths; oil of turpentine; paint-stripping preparations; laundry preparations; polishing paper; sandpaper; degreasers other than for use in manufacturing processes; paint strippers; wax polish for wooden floors; wood treatment preparations for cleaning, colouring and polishing; cream cleaners; upholstery cleaner; toilet cleaners; window cleaners; non-medicated preparations in cream form for forming a barrier against dirt on the body; soaps; hand cleaner; sugar soap; essential oils; essential oils for household use; essential oils as fragrances for laundry use; degreasing preparations; preparations for grinding and sharpening; preservatives for leather; sand paper; glass and emery paper; wet and dry abrasive paper; stain-removing preparations including stain-removing preparations for carpets, hard surfaces and laundry; degreasing detergents; disposable wipes impregnated with chemicals and compounds for household use; shower, tub and tile cleaners.

Class 4: Industrial oils and greases; lubricants; dust-absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting; lamp wicks; waxes for industrial use; waxes for lighting; waxes for belts; wicks; firelighters; firewood; preservatives for leather (oils and greases).

Class 5: Deodorants (other than for personal use); air fresheners; air freshener refills; car air freshener.

Class 6: *Common metals and their alloys; metal building materials; transportable buildings of metal; non-electric cables and wires of common metal; ironmongery; pipes and tubes of metal; safes; aluminium; aluminium wire; arbours (structures of metal); balls of steel; baskets of metal; bathtub grab bars of metal; binding screws of metal for cables; bindings of metal; bolts, flat; bolts of metal; boxes of common metal; box fasteners of metal; braces of metal for handling loads; brackets of metal for building; branching pipes of metal; brazing alloys; broom handles of metal; buckles of common metal (hardware); building or furniture fittings of nickel-silver; building panels of metal; bungs of metal; cable joints of metal, non-electric; casement windows of metal; cashboxes of metal; cast iron, unwrought or semi-wrought; ceilings of metal; chains of metal; chests of metal; chimney shafts of metal; chimneys of metal; clips of metal for cables and pipes; clothes hooks of metal; collars of metal for fastening pipes; common metals, unwrought or semi-wrought; containers of metal (storage, transport); copper rings; copper, unwrought or semi-wrought; copper wire, not insulated; cornices of metal; couplings of metal for chains; door bells of metal, non-electric; door bolts of metal; door closers, non-electric; door fittings of metal; door frames of metal; door handles of metal; door knockers of metal; door openers, non-electric; door stops of metal; drain pipes of metal; drain traps (valves) of metal; ducts of metal, for central heating installations; ducts of metal for ventilating and air conditioning installations; elbows of metal for pipes; eye bolts; fences of metal; ferrules of metal; ferrules of metal for handles; figurines (statuettes) of common metal; filings of metal; firedogs (and irons); fittings of metal for beds; fittings of metal for building; fittings of metal for furniture; fittings of metal for windows; flanges of metal (collars); flashing of metal, for building; floors of metal; floor tiles of metal; foils of metal for wrapping and packaging; frames of metal for building; frameworks of metal for building; furnace fireguards of metal; furniture casters of metal; grease nipples; grilles of metal; gutter pipes of metal; hardware of metal, small; hinges of metal; hooks for slate (metal hardware); hooks (metal hardware); hooks of metal for clothes rails; hoppers of metal, non-mechanical; house numbers of metal, non-luminous; ironwork for doors; ironwork for windows; junctions of metal for pipes; keys; knife handles of metal; knobs of metal; latch bars of metal; latches of metal; laths of metal; lead seals; lead, unwrought or semi-wrought; letter boxes of metal; letters and numerals of common metal, except type; linings of metal (building); lintels of metal; lock bolts; locks of metal for bags; locks of metal for*

vehicles; locks of metal, other than electric; metal clips; metals in powder form; mouldings of metal for cornices; monuments of metal; nails; nozzles of metal; nuts of metal; outdoor blinds of metal; packaging containers of metal; padlocks; partitions of metal; paving blocks of metal; paving slabs of metal; pegs of metal; pins (hardware); pipes of metal; pipework of metal; platforms, prefabricated, of metal; poles of metal; posts of metal; pot hooks of metal; props of metal; pulleys of metal, other than for machines; reels of metal, non-mechanical, for flexible hoses; refractory construction materials of metal; registration plates of metal; reinforcing materials of metal for building; reinforcing materials, of metal, for concrete; reinforcing materials of metal for machine belts; reinforcing materials of metal for pipes; rings of common metal for keys; rings of metal; rivets of metal; rods of metal for brazing; rods of metal for brazing and welding; rods of metal for welding; roof coverings of metal; roof flashing of metal; roof gutters of metal; roofing of metal; roofing of metal, incorporating solar cells; roofing tiles of metal; ropes of metal; rope thimbles of metal; runners of metal for sliding doors; safes (strong boxes); safety cashboxes; safety chains of metal; screws of metal; screw tops of metal for bottles; sealing caps of metal; sheet piles of metal; sheets and plates of metal; shims; shuttering of metal for concrete; shutters of metal; sills of metal; silos of metal; silver-plated tin alloys; slabs of metal for building; sleeves (metal hardware); slings of metal for handling loads; soldering wire of metal; spring locks; springs (metal hardware); spurs; steel alloys; steel buildings; steel pipes; steel sheets; steel strips; steel, unwrought or semi-wrought; steel wire; stops of metal; strap-hinges of metal; straps of metal for handling loads; street gutters of metal; tacks (nails); tanks of metal; taps for casks of metal; tiles of metal for building; tin; tin cans; tinfoil; tinplate; tinplate packings; tool handles of metal; towel dispensers, fixed, of metal; trays of metal; tree protectors of metal; trellises of metal; troughs of metal for mixing mortar; tubing of metal; tungsten; tungsten iron; valves of metal, other than parts of machines; vanadium; vats of metal; wall claddings of metal (building); wall linings of metal (building); wall plugs of metal; wall tiles of metal; washers of metal; water pipes of metal; water-pipe valves of metal; window casement bolts; window closers, non-electric; window fasteners of metal; window frames of metal; window openers, non-electric; window pulleys; window stops of metal; wire of common metal; wire of common metal alloys, except fuse wire; wire rope; small items of metal hardware namely nails, screws, bolts, nuts and rivets; laminated and cast building materials; construction elements of metal; boxes and containers; tool handles; silos; traps for

wild animals made of metal; hooks; trellises and latticework; metal pipe connectors; valves (other than parts of machines); reels; vats; weathervanes; floors; fences; gratings; barriers; gutters; bed mouldings; pickets; door handles; doors; padlocks; locks; letter boxes; gutters; drains; frameworks; cornices; bed mouldings; corner pieces; keys; wainscoting; roof tiles; drain grills; reinforcements; piping; dividers; hinge-pins; metal joinery fittings; hinges; assembly brackets; corner brackets; straps; chains; pulleys; knobs (handles); iron frameworks; rolled and cast construction materials; elements for building; building panels; posts; pegs; iron fittings; angle irons; fittings for windows; latches; vehicle number plates; building structures for agricultural or horticultural use; keyring strips; sheets of metal; shaped sections; welding and soldering metals; metal rings for keys; key blanks; door gratings; bells; work-holding devices; articles of hardware; door gratings; bells; tanks; roller blinds of steel; blinds of metal; work-holding devices; water pipe valves; conservatory frames of metal; transportable conservatories of metal; steel wire; security boxes; key tags; screw cups; screw caps; tool clips; hose clips; shackles; casters of metal; door stops; roofing; clamps; compression fittings; floor edging; grab rails; weather bars; weather-strippings; ducting installations; paper towel dispensers; display signs of metal; gas supply ducts and pipes of metal for central heating installations; metal fasteners; namely screw eyes; cup hooks; nuts; bolts; rivets; threaded rods; staples and anchors; washers; metal cable clips and ties; metal pipe clips' locks; metal assembly blocks for the assembly of furniture; metal joints; metal safety hasps for commercial and industrial use; metal d-rings; screw rings; tacks; picture wire; metal hardware namely threaded fasteners, unthreaded fasteners; reinforcement and support hardware namely metal shelf brackets; metal corner braces; metal mending plates; metal tee plates; metal plates, brackets and angle braces for building construction; metal fixtures and fittings; non-electric cable connectors of metal; boxes for storage; metal storage units; roofing (metallic-); strips of common metals; sheets of metal; sheets of aluminium; sheets of steel; copper tubes (other than parts of machines); articles of metal hardware; threaded rods of metal; staples of metal; anchors of metal; welding rods; small items of metal hardware for use in plumbing; risers of metal; couplings of metal; pipe couplings of metal; waste to trap connectors of metal; brackets and seals of metal; drains of metal; traps of metal; drain pans of metal; building bricks of metal; jointing articles of metal (non-electric); metal reinforcement materials for building; corner elbows of metal; junction boxes (metal, non-electric) for trunking; gate latches

of metal; gate eye bolts of metal; gate hooks of metal; metal balusters; fence posts of metal; assembly fittings for interconnecting fence sections; fence panels of metal; hose fittings of metal; hose clamps of metal; interlocking metal cross-braces; clamps of metal for attaching awnings; stackable containers for the storage of materials; storage apparatus; key cabinets (not furniture) of metal; frames of metal, namely for conservatories and prefabricated greenhouses; metal pipe fittings; metal pipe clips; handles and locks for doors; handles and locks for windows; handles and locks for furniture; metal locks (non-electric); welding wire; solder wire; metal fencing; fencing materials of metal; metal fittings for doors; metal fittings for hangings; articles for use as plumbing fittings; materials for use in plumbing; non-electric metal door bells; fireplace grates; blinds of metal; jointing articles of metal (non-electric); hasps of metal; metal knobs; tacks of metal; corner elbows of metal; towel dispensers of metal; kitchen worktops of metal (fitted); cloches (metal framed) for gardening use; hanging flower baskets of metal; metal plant pot stands; metal brackets for hanging baskets; garden wire; barbed wire; compost bins of metal; water butts of metal; lawn edging (metallic); connectors of metal for hoses; wire mesh; letter boxes of metal; speed bumps of metal; all the aforesaid goods being of metal or predominantly of metal; parts and fittings for all the aforesaid goods.

Class 16: *Stationery; adhesives for stationery or household purposes; tapes (adhesive)[stationery]; paint brushes; office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printing blocks; paint rollers; sealing wax; stencils; wall stickers; paper or plastic garbage bags; cardboard boxes for moving; materials for modelling; hand rollers and pads incorporating holding devices, all for applying paint; decalcomanias; publications (printed); promotional material; brochures; printed forms; cards (other than encoded or magnetic) for use in connection with loyalty, bonus and incentive schemes; instruments for use in painting; paint applicators; hand held instruments for painting; pads for applying paint; hand rollers and pads incorporating holding devices, all for applying paint; paint roller covers; paint roller trays; paint stirrers; paint trays; requisites for painting (other than paint); correcting aids for painting purposes; correcting implements for painting purposes; bags of paper for lining refuse bins; bags of plastics for lining refuse bins; dustbin bags; carrier bags; parts and fittings for all the aforesaid goods.*

Class 17: *Plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal; sheets, plates and rods of plastic materials (semi-manufactured); stopping, packing and insulating materials; flexible non-metallic pipes; watering hoses; insulating felt; adhesive tape (other than for medical, stationery or household use); insulators; seals; articles made of rubber or synthetic rubber for jointing purposes, sealing and insulation purposes; casings of synthetic rubber for tubes and pipes; covers made of rubber for protecting electrical components; draught excluders made of rubber; insulating materials made of plastics; articles and materials, all for packing, jointing, stopping, sealing or insulating (insulating materials and insulating floorings); pipes, tubes and hoses, all made wholly or principally of non-metallic materials; articles made of rubber for sealing, jointing, protection and insulation purposes; insulating tape; weather strips (non-metallic-); silicone sealants; adhesive sealant and caulking compounds; insulation materials; insulation materials for roofs and walls; masking tape other than for household or stationery purposes; flexible conduits not of metal, flexible tubes, not of metal; connectors; pipe connectors; couplings, pipe clips; brackets and seals, all being parts and fittings for pipes and all being goods of plastic or rubber; insulating plaster; rubber stoppers for use with sinks and baths; expansion joints of non-metallic materials for buildings and construction works; expansion joints of non-metallic materials for floors and walls; couplings and joints not of metal for pipes; adhesive sealing strips for roofing joints; foam for use as heat insulation; foam rubber; silicone foam heat shielding; insulating fillers; joint fillers (expansion); parts and fittings for all the aforesaid goods.*

Class 19: *Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; natural and artificial stones; cement; building felt; wooden bridges; wooden screen walls; building timber; lumber; semi-worked wood; manufactured timber; wood panelling; posts; sand (except foundry sand); silos; coatings (building materials); parquet floors; panelling; roof tiles; slate; chimneys; insulating glass; draining grills; drain troughs; frameworks; hinges; gutters; cornices; bed mouldings, not of metal; corner pieces; dividers; mouldings, not of metal, for building; mouldings, not of metal, for cornices; repair coatings for interior walls in powder or paste form; fillers; smoothing plaster; mortars; cabins; wattle fences; floors; fences; building panels; gullies; angle irons; lime, mortar, sand, plaster and*

gravel; pipes of earthenware or cement; bitumen-based compositions for building purposes; portable buildings; stone monuments; floor boards; skirtings; concrete building elements; coverings; door panels and frames; plasterboards; plywood; roof coverings and flashings; roofing slates; water pipe valves not of plastic or metal; wood pulp board for buildings; portable structures (non-metallic); gazebos; gazebos not primarily of metal; paving; materials (non-metallic-) for use as underlays; slabs, not of metal; cement blocks; roofing materials; roofs (non-metallic-); building materials (non-metallic) for use in plumbing; drainpipes (not of metal); drainage installations (non-metallic); pipes of terracotta or cement; sheeting for roofs, barriers and scaffolding; garden sheds of non-metallic materials; concrete joints for levelling concrete floors; concrete joints forming parts of concrete floors; non-metallic speed bumps; expansion joints of non-metallic materials for use in buildings and construction work; expansion joints of non-metallic materials for floors and walls; wood joints; roofing joints; non-metal fencing stays; coving; barrier apparatus (non-metallic structures); non-metallic cold frames; cloches (non-metallic frame); lawn edging (non-metallic); wine racks not of metal; flooring blocks; flooring boards; rubber stoppers for use with sinks, baths; expansion joints of non-metallic materials for buildings and construction works; expansion joints of non-metallic materials for floors and walls; couplings and joints not of metal for pipes; trap doors (non-metallic).

Class 20: *Furniture; hinges; hinge-pins; valves (other than machine parts); bands of wood; wood baskets; screws, not of metal; castors; tile spacers; screw rings; ring closures, other than of metal; hooks; curtain hooks; cases of wood or plastic; trim for windows; doors; frame strips; furniture doors; frame mouldings; latches; knobs (handles) of plastic; wallpapering tables; workbenches; furniture coasters and stands; honeycomb foundations; curtain rods; door handles of wood; garden stands; letter boxes (not of metal or masonry); display units; racks; packaging of wood; bins; clothes hangers; wickerwork; mobiles (decorative items); packaging containers of wood or plastic; metal display units; door handles of porcelain; knobs of porcelain; cable clips; mirrors; bed fittings (not of metal); water-pipe valves of plastic; tables; chairs; deck chairs; stools; cushions; frames for chairs; dressing tables; cupboards; wardrobes; chests of drawers; materials for shelves; shelf brackets; coat hangers; hanging holders; handles for furniture and doors; frames for prints; shelf supports; shelf units; furniture fittings not of metal; door fittings, not of metal; window fittings, not of metal;*

edgings of plastic for furniture; clothes hooks, not of metal; door handles, not of metal; packaging containers of plastic; wall plugs, not of metal; parts and fittings for all the aforesaid goods.

Class 21: *Household or kitchen utensils and containers; combs and sponges; brushes (except paintbrushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); cleaning instruments and equipment; brooms; garbage cans; refuse bins; wheeled refuse bins, not of metal; decorative wall fixtures (furnishings) not of textile; parts and fittings for all the aforesaid goods.*

Class 22: *Tarpaulins; textile storage bags.*