

O-209-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2264665
BY THE WATERLESS VALETING COMPANY LIMITED
TO REGISTER A SERIES OF TRADE MARKS IN CLASS 37**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No. 91197
BY WILLIAM STRUTH**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST THE DECISION OF MR. M. REYNOLDS
DATED 22 DECEMBER 2003**

DECISION

Application No. 2264665

1. Application No. 2264665 was filed on 20 March 2001 in the name of The Waterless Valeting Company Limited requesting registration of a series of trade marks in Class 37 in respect of “vehicle valeting services; vehicle cleaning services; vehicle maintenance services”. The Registry objected to the application under section 41(2) of the Trade Marks Act 1994 (“the TMA”) because the seventeen marks claimed did not form a series within the meaning of that section. Fifteen marks were deleted from the application leaving the following series of two:



2. The application was published on the 31 July 2002 with the following colour claim:

“The Applicant claims the colours pink and blue as an element of the first mark in the series. The Applicant claims the colours purple, blue and grey as an element of the second mark in the series.”

3. On 25 October 2002 William Struth (“the Opponent”) filed notice of opposition to the application relying on sections 5(4)(a) and 3(6) of the TMA. Since the appeal relates in part to the Hearing Officer’s finding on the form of earlier right(s) on which the Opponent based his opposition, it is necessary to set out the statement of grounds of opposition in full:

- “1. The opponents are the unregistered proprietors in the United Kingdom of the following mark(s) since 1995.
2. The trade mark applied for consists of the word “Waterless” in the colours pink and blue which so closely resembles the opponent’s trade mark as to be likely to deceive or cause confusion. The following goods/services in respect of which registration is sought “Class 37 – Vehicle Valeting Services” are similar goods/services to the following goods/services in respect of which the opponent’s said trade mark is used “Class 37 – Vehicle Valeting Services, Vehicle cleaning services”.

The registration of the trade mark applied for would offend the provision of section 5 – 4(a) and also 3 – (6) of the Trade Marks Act 1994.

3. The opponent’s mark has been continuously used in the United Kingdom upon and in relation to the following goods/services since the year 1995. In 1998 we set up an agreement allowing the applicant to use this mark with certain conditions. The

applicant has breached this agreement and has applied for the mark in bad faith.

4. Attached documents as a formal exhibit as proof of usage of mark.
In relation to Section 5 – (4)(a)
Specimen A – Photograph showing mark on livery with printed date on reverse.
Specimen B – Newspaper cutting showing goods/services upon which mark is used.
In relation to Section 3 - (6)
Specimen C – Agreement stating mark belonged to opponent’s and permission was granted for applicant subject to conditions.
5. The applicants have been requested to withdraw usage of mark and application but have declined to do so.
6. The opponents ask that this application be dismissed with an award of costs to the opponents.”

4. I note the following from the attached documents listed in paragraph 4 of the Opponent’s statement of grounds:

- (a) Specimen A is a colour photograph of a parked four wheel drive vehicle. The vehicle is white and has the sign “WATERLESS” painted on the front of the bonnet. The word is presented in a wave form with the letters at the beginning and the end higher than those in the middle. The letters are a cerise shade of pink. “WATERLESS” also appears (in the same shade of pink) on the driver’s door of the vehicle but this time the front of the wave is higher so that the end letters flatten out. The photograph does not show the passenger side of the vehicle. There is other writing on the vehicle in turquoise blue and white on pink but it is impossible to discern from the photograph what this states. The photograph seems to have been taken in May 1996.
- (b) Specimen B is a copy of a newspaper article. A later witness statement of Mr. Struth makes clear that the article appeared in the Edinburgh Evening News sometime in 1995. The article describes a new business started by Wilma Rogers [sic?] and William Struth as a direct result of a trip to the United States of America:

“Wilma Rogers and William Struth were so fascinated by a waterless car cleaner produced in America that they brought a suitcase full of it back to Scotland.

Now the company they have set up, Global Concepts, is selling Dry Wash and Guard and using it in their car detailing business – a form of upmarket, intensive valeting. ...”

The article contains a picture under the caption “Wilma and William demonstrate their dry-wash system”. Two oblong signs are included next to the vehicle being valeted. Down the left hand side of each sign is a strip bearing the designation DRIWASH ‘N GUARD. Otherwise the top sign states: “Revolutionary Waterless Technology”, “Cleans Polishes Seals Protects”, “No More Car Washes” and the sign immediately underneath says: “This Car Valeted With Waterless Car Wash” (with the order of “Wash” and “Car” inverted), “Cleans Polishes Seals Protects”, “Dealers Wanted”. The word “Waterless” in each of the first phrases is presented in waveform with the letters at the beginning and end of the word raised above the middle letters. In the top sign, the word “Revolutionary” appears above the wave and the word “Technology” below it. In the lower sign, the word “Wash” appears above the wave and word “Car” below it. The vehicle also bears an oblong sign but this merely includes the DRIWASH ‘N GUARD designation, the phrase “No More Car Washes” and a telephone number to contact. As the Hearing Officer noted, the copy newspaper cutting is in black and white.

- (c) Specimen C is stated to be an Agreement between William Struth/Wilma Rodgers and Brian Anderson/Lynne Anderson:

“WILLIAM STRUTH/WILMA RODGERS agree to allow BRIAN ANDERSON/LYNNE ANDERSON to use their logo “WATERLESS” (as below) in their business as long as they do not use the logo to franchise, pass to anyone else without prior consent and do not bring any disrepute to the name.”

The logo referred to is shown as the word “WATERLESS” in waveform and in cerise pink. The Agreement is signed by Wilma A. Rodgers and L. Anderson “for and on behalf of above names” in each case. It is dated 22 June 1998.

5. The Hearing Officer also took into account the following statement signed by the Opponent and attached to the statement of grounds:

“The “Waterless” mark was first used in 1995.

William Struth was introduced to a product “Dri Wash n Guard” in 1995 from America. It was being used to clean cars without water. He brought product back to Britain and decided to start a valeting business in Scotland and hopefully the UK with the product.

At this point in 1995 the word Waterless was not associated with valeting. He put it on all livery and stationery and started to promote valeting from a mobile unit. After much hard work, determination and money spent on advertising, promotion and free samples Waterless has now become a recognised terminology used in car valeting.

Anyone who is associated or using the word waterless in respect of car valeting has either been trained by him or given permission to use the

logo. There are a number of car valeting company's using the word Waterless in their own business and logo all of which have asked to use this mark and none are in conflict with our own mark.

We feel the mark is very distinctive in colour and wave like form and the mark 2264665 is too close in resemblance to our mark especially that of series 17 [now the first mark in the series] which he claims colours pink and blue.

We do not have any objection to the applicant using the word Waterless but feel his mark using the word Waterless in pink is too similar.

With regards section 5- 4(a) We feel strongly that the applicant is using the mark similar to ours and is virtue of rule of law (passing off) We would also like to note that the applicant has applied for marks in his distinctive design but does not display this mark on his livery instead he displays a mark nearly identical to the opponent. Please refer to website www.waterless-mobile-valeting.co.uk which shows pictures of his vehicles with mark which is more like ours than mark applied for.

We have also applied for trademark of our mark which we are awaiting approval for. We did contact a trademark agent back in 1997 regards trademarking our mark but was told it was impossible to do at this time therefore we did not go ahead."

The paper on which the statement is typed has blue and pink headers and footers. The header contains the word WATERLESS in waveform and cerise pink (accompanied by the © symbol. Copyright was not relied on by the Opponent) with the words "Car Care" above and "Specialists" below the wave in turquoise blue. Also in turquoise blue are the words "No. 1 in Vehicle Preparation". The footer bears a device "Guild of Waterless Valeters and Master Detailers" and the legend "Founder Member of the Guild of Waterless Valeters and Master Detailers". The device and legend are in turquoise blue and black.

6. In the counterstatement the Applicant repeatedly queried the mark or marks on which the alleged grounds of opposition were based. As to Specimen C, the Applicant stated:

"Moreover, it is denied that the Applicant had any knowledge of having entered into the Agreement that Specimen C attached to the Statement of Grounds purports to be a copy of or, in any case, that the Agreement is binding upon the Applicant, or indeed that the purported Agreement has any relevance to proceedings."

The Hearing Officer found this response on behalf of the Applicant "less than forthcoming". Nevertheless, he concluded that the Opponent had not proved on the evidence any connection between the Andersons and the Applicant. In

those circumstances, and quite apart from other issues arising out of the Agreement, the Hearing Officer concluded that the Opponent's case under section 3(6) of the TMA had not been made out. There is no appeal against this aspect of the Hearing Officer's decision.

The Opponent's evidence

7. The Opponent's evidence consisted of a witness statement by William Struth dated 4 June 2003. Mr. Struth states that he is the proprietor of a business, which trades as Waterless Car Care and that he has been trading under that name and its abbreviation WATERLESS since 1995. He continues:

"I began trading under the name WATERLESS (hereinafter referred to as "my Mark") in 1995. In my trade, my Mark has frequently and consistently been presented in a stylised form, with the first letters of the word being placed at a higher elevation than the last few letters of the word (i.e. – conveying a sloping or wavy presentation). A representation of this form of my Mark is attached herewith at Exhibit WS1."

Exhibit WS1 shows the word WATERLESS presented in waveform and in black and white.

8. Mr. Struth says that since 1995 he has traded actively and continuously under his mark. Exhibit WS2 is a copy of Infogram Magazine, October 1997. The back page features an article entitled "There's Nothing Like Advertising" and reads:

"Scottish Distributors Steven Hedley, William Struth and Wilma Rodgers sent in these photos which show how they've customised their vehicles to advertise their businesses."

The first photograph appears to be of the same four wheel drive vehicle shown in Specimen A described at paragraph 4 above, but this time taken of the driver's side of the vehicle. Thus WATERLESS is presented in waveform with elevated front letters. The words "Revolutionary" and "Technology" appear either side of the wave and below that the phrase "No More Car Washes". Alongside the taillights there is a strip containing the designation DRIWASH 'N GUARD and next to that "Cleans Seals". "Polishes Protects" is written on the front wing. A second photograph shows the driver's side of a van with the same information written on it in slightly different positioning and with the end (instead of the front) letters of WATERLESS in waveform elevated. However the van also has on it what appears to be a flag device and the name "Steven Hedley" "Mobile Car Valeter". There is no indication in the Opponent's evidence as to whom Mr. Hedley is and/or what relationship he has with the Opponent, if any. The photographs are not in colour.

9. Exhibit WS3 is a copy of an invoice to Eastern Western Motor Group in Edinburgh, dated 11 April 1997. It is in the sum of £35 for valeting an Audi car using Dri Wash & Guard. The Invoice is headed WATERLESS in

waveform “Total Car Care. No 1 in Vehicle Preparation” and requests payment in the name of W. Struth. The footer states “Founder Member of the Guild of Waterless and Master Detailers”. Exhibit WS4 is a similar invoice dated 4 April 1996 to Volvo Truck & Bus (Scotland) Ltd, Glasgow in respect of a “Man Skip” and in the sum of £45. The invoices in WS3 and WS4 are in respect of purchase orders made out to “Waterless Car Care”. The copy invoices are not in colour. Exhibit WS5 comprises two invoices dated 17 April 2000 from Phase 8 in respect of registration for two years of the domain names waterlessvaleting.com, waterlessdetailers.com, waterless.uk.com and waterlessvaleting.co.uk. The invoices are addressed to “Waterless Detailers” which Mr. Struth describes as “a variation of my Mark”. Exhibits WS6 and WS7 comprise a promotional leaflet and stickers respectively. The leaflet and the stickers contain WATERLESS in waveform and the words “Car Care Specialist(s)”. The leaflet has the wave in cerise pink; the stickers are in black and white. Neither the leaflet nor the stickers are dated.

10. Mr. Struth provides sales figures for the years 1996 – 2001. He says that the figures relate to services (which he defines as vehicle valeting and cleaning) “provided under my Mark (as in Exhibit WS1)”. Exhibit WS1 is a copy of WATERLESS waveform in black and white. The figures are as follows:

<u>Year Ending</u>	<u>Amount</u>
2001	£92,000
2000	£78,500
1999	£67,500
1998	£59,000
1997	£31,000
1996	£29,500

Mr. Struth also gives expenditure in promoting these services as follows:

<u>Year Ending</u>	<u>Amount</u>
2001	£6,000
2000	£6,500
1999	£7,000
1998	£12,000
1997	£12,000
1996	£9,500

Mr. Struth explains that advertising costs decreased in later years due to “reputation in my Mark in connection with my services through means such as referrals/word of mouth”.

11. There are three witness statements exhibited to Mr. Struth’s witness statement. The first (WS8) is from Timothy C. Airey, Edinburgh formerly General Manager of Computercenter, Scotland and Director of Panther-amg Ltd, dated 24 October 2002. Mr. Airey states:

“I have been using William Struth – who has always traded under the “Waterless” identity – since 1996 when I was General Manager of Computercenter. To my knowledge there were, at that time in Edinburgh, no other individuals operating with the same products that William was using and certainly none were operating under the “Waterless” logo. Further I was introduced to the proprietor of the now named “Waterless Valeting Company” by William when said individual was learning his trade from William. Subsequent to this the “Waterless Valeting Company” and associated logo was used.”

The Hearing Officer noted from this witness statement that Mr. Airey does not explain what he means by the “Waterless” logo not does he exhibit a copy of it.

12. The second witness statement (WS9) dated 18 October 2002 is made by Keith Manson Miller, Chief Executive of the Miller Group Ltd, who says:

“I ... hereby confirm I have been using William Struth, who is, and is known as, “Waterless” for the purpose of valeting my own and my family’s vehicles since 1996.”

J. R. Collins’ witness statement (WS10) dated 28 October 2002 is in similar terms:

“I have been using William Struth who is and is known as “Waterless” since 1995. I saw an article on their services in the Edinburgh Evening News in 1995 ... I have since introduced them to friends/colleagues as “Waterless”.”

13. The Hearing Officer gave no weight to the two remaining exhibits WS11 and WS12 because they comprised “To whom it may concern” letters, which failed to comply with Rule 55 of the Trade Marks Rules 2000. I agree with the Hearing Officer that in any event they do not assist the Opponent’s case.

The Hearing Officer’s decision

14. Neither party requested a hearing and the Hearing Officer decided the opposition from the papers. Only the Opponent delivered written submissions through his trade mark attorneys, Kennedys. Since there is no appeal against the Hearing Officer’s decision to reject the opposition under section 3(6) of the TMA, I say no more about it.
15. Section 5(4)(a) of the TMA provides:

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

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

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

The Hearing Officer instructed himself as to the three requisite elements of passing off namely, goodwill or reputation, misrepresentation and damage by reference to the decision of Mr. Geoffrey Hobbs QC sitting as the Appointed Person in *WILD CHILD Trade Mark* [1998] RPC 455. The Hearing Officer also reminded himself of the observations of Pumfrey J. in *REEF Trade Mark* [2002] RPC 19 at paragraphs 27 – 28:

“There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s. 11 of the 1938 Act (see *Smith Hayden & Co. Ltd’s Application (OVAX)* (1946) 63 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case.”

There is no suggestion that the Hearing Officer misdirected himself as to the applicable law under section 5(4)(a) of the TMA.

16. The Hearing Officer first identified the earlier right(s) on which the Opponent sought to rely. It can be mentioned that until recently there was no requirement in the Trade Mark Rules 2000 for Form TM7 to include a representation of the unregistered trade mark or other sign asserted by an opponent. (As from 5 May 2004, the omission is remedied by rule 7 of the Trade Marks (Amendment) Rules 2004, which substitutes a new rule 13.) The Hearing Officer construed the statement of grounds in the light of Specimens A, B and C and the further statement appended thereto (described in paragraphs 3 – 5 above) and arrived at the following conclusions:

“12. The opening paragraph of the statement of grounds claims that the opponent is the unregistered proprietor in the United Kingdom “of the following mark(s)” since 1995. That appears to anticipate the

possibility of a claim in relation to more than one mark. There is nothing wrong inherently wrong with such a claim. A business may be known under more than one mark or sign. The statement of grounds does not itself specifically identify the mark(s) relied on at this point. Attachment A shows a vehicle which is said to display the livery. It is not possible to read all the words but I note the word WATERLESS depicted in a wave form and in pink lettering. Attachment B is a copy of a newspaper article showing, inter alia, a sign with the word WATERLESS in wave form. As the newspaper cutting is not in colour it is not possible to say whether colour forms part of the sign. Attachment C is an agreement between the opponent and (it is said) the applicants. I will return to the Agreement itself below. Suffice to say at this point that it shows the word WATERLESS in wave form and in pink lettering.

13. The supporting explanatory note sheds further light on the nature of the underlying claim. The key passage is, it seems to me, the following:

“We feel the mark is very distinctive in colour and wave like form and the mark 2264665 is too close in resemblance to our mark especially [the first mark in the series for] which he claims colours pink and blue.

We do not have any objection to the applicant using the word Waterless but feel his mark using the word Waterless in pink is too similar.”

14. ... However, the important point to be drawn from the above is that it clarifies the claim. I understand the opponent to be saying that he makes no claim to the word WATERLESS per se as a distinguishing feature but rather that word in colour and wave like form. I draw the further inference that the claim relates to those two elements of colour and form in combination. There is a further possible reading of the claim that the opponent claims these elements separately but I regard that as being contrary to the main thrust of the case. The opponent’s claim, therefore, falls to be tested on the basis that the distinguishing feature of the underlying business is the word WATERLESS presented in the wave like form and in pink lettering ...

15. I should also say at this point that the underlying concept is a car cleaning system that involves spraying the product (which I take to be a chemical formulation) onto a car without the addition or aid of water. I note that the opponent’s advertising refers to this feature of the system (“No Water! No Mess!”) and that the opponent is a Founder Member of the Guild of Waterless Valeters and Master Detailers. I infer that “waterless” is a term of art in the trade and hence that the opponent, quite properly, makes no claim to be able to prevent the applicants or others from using that word.”

17. The Hearing Officer then moved on to consider the opposition under section 5(4)(a) of the TMA in the light of the Opponent's evidence. His findings were as follows:

“35. I find the collective force of this evidence to be at best inconclusive in supporting the opponent's claim. The exhibited material provides some support for the claim that the word WATERLESS is frequently presented in wave – like form. But it is not in my view a complex or particularly remarkable way of presenting the word. It may have some slight visual appeal but, once it is established that the word is directly descriptive of the services, it requires convincing evidence that such a modest degree of styling has itself come to be recognised as distinctive of the opponent. The evidence from customers might have been expected to address that point but only Mr. Airey refers to a logo (and he does not exhibit an example of the logo he is referring to). The other witness statements make no mention of any feature other than the word WATERLESS which may in itself be attributable to the fact that they have been customers from the time the word was first used by Mr. Struth (and he may have been the only trader using waterless methods at the time).

36. So far as any claim to colour is concerned only the counterstatement [sic] and one of the exhibited items (WS6) shows the mark in pink lettering form.

37. During the course of the evidence the opponent's business is referred to in various ways by customers and suppliers, notably Waterless Car Care (Exhibits WS3 and 4), Waterless Detailers (Exhibit WS5). There is also the company name, Global Concepts, (see the newspaper cutting at attachment B to the counterstatement [sic] and Exhibit WS10).

38. Making the best I can of this material I am not persuaded that the opponent has shown that the word WATERLESS in wave-form lettering (and in pink) has come to be recognised as a distinguishing feature of his business. The passing-off case does not, therefore, get off the ground.

39. In the circumstances I am not in a position to assess whether the opponent has a goodwill under or in relation to the claimed sign. The opposition fails under section 5(4)(a).”

The appeal

18. On 19 January 2004, the Opponent through his professional representatives Kennedys filed notice of appeal against the Hearing Officer's decision under section 5(4)(a) of the TMA. The oral hearing of the appeal was appointed for 9 June 2004. Neither party wished to attend or to be represented at the oral hearing. Both parties were content for me to hear and determine the appeal on paper. Pursuant to my powers under rule 65(3) of the Trade Marks Rules

2000, as amended, I accordingly requested the Treasury Solicitor to vacate the time and place appointed for the oral hearing. I also invited the parties to send to me through the Treasury Solicitor any further written submissions they wished to make within a set time limit. None were received by the due date. I have reminded myself that the appeal is by way of review. I should show a real reluctance, but not the very highest degree of reluctance, to interfere with the decision of the Hearing Officer in the absence of a distinct and material error of principle (*REEF Trade Mark* [2003] RPC 101, per Robert Walker LJ at paragraph 28).

19. As I understand it, the main complaint on appeal is that the Hearing Officer misidentified the earlier right on which the Opponent seeks to rely under section 5(4)(a). The Opponent asserts at paragraph 2 of the grounds of appeal goodwill and reputation in the mark WATERLESS presented in stylised form. A representation is attached showing the word WATERLESS in waveform and in black and white. (The representation is the same as that exhibited to Mr. Struth's witness statement at WS1.) As an aside, I note that paragraph 2 impliedly confirms the Hearing Officer's assumption that the Opponent makes no claim to the word WATERLESS alone. Paragraph 3 of the grounds of appeal continues:

“The registrar erred in drawing the inference that the appellant claims goodwill and reputation only in the mark presented in ‘wave form’ in combination with presentation only in the colour pink. At no stage in the proceedings did the appellant specify that their goodwill and reputation lies solely in a mark which is limited to the colour pink. In particular he erred in dismissing or discounting several items of evidence attesting to the appellant's goodwill and reputation in the mark on the basis that these exhibits are not presented in colour, specifically pink, and accordingly holding that he was unable to assess the appellant's goodwill and/or reputation in the mark.”

20. In painting the background to this appeal, I have endeavoured to give full details of the case and evidence before the Hearing Officer. I believe that from the statement of grounds and supporting attachments the Hearing Officer was justified in deducing that the earlier right claimed by the Opponent was the word WATERLESS in wave form and in pink. The Hearing Officer mentions, in particular, paragraphs 5 and 6 of the “explanatory note”. I believe Specimen C is also telling. Nevertheless, the Hearing Officer concedes that a possible reading of the statement of grounds is that the elements of colour and stylisation were claimed separately. I have therefore alternatively considered the appeal on the basis that the earlier right comprises the word WATERLESS stylised i.e. in waveform but not in any particular colour.
21. The Opponent says that the Hearing Officer dismissed or discounted several items of evidence. The Opponent does not, however, specify which items he believes are compelling but the Hearing Officer ignored. Going through the evidence, WS1 is the representation of WATERLESS in waveform and in black and white. WS2 is the Infogram Magazine, October 1977, showing

photographs of two motor vehicles. The use of WATERLESS in waveform on both vehicles is likely to be viewed by the observer as describing the system of cleaning – the “technology” – rather than identifying the supplier especially since the van in the second photograph bears the name and device mark of Steven Hedley. Exhibits WS3 and WS4 comprise two invoices in the total amount of £80.00. Each concerns a purchase order addressed to “Waterless Car Care”. Again the use of WATERLESS in waveform on the invoices is in conjunction with descriptive matter. Exhibit WS5 is an invoice from Phase 8 addressed to “Waterless Detailers” in respect of the registration of three domain names. Exhibit WS5 reveals nothing about the use of WATERLESS in waveform. Exhibit WS6 is in colour. It is the promotional leaflet but it is undated. Exhibit WS7 shows promotional stickers again undated. Both promotional items use WATERLESS in waveform with other descriptive matter – “WATERLESS Car Care Specialists”. Exhibits WS8 – 10 are the three extra witness statements. Only Mr. Airey refers to the “Waterless” identity and the “Waterless” logo but does not explain what he means by those terms. Mr. Miller and J. R. Collins merely say that William Struth is known as “Waterless”. The Hearing Officer rightly discounted Exhibits WS11 and WS12 for failing to comply with evidentiary requirements. Mr. Struth’s witness statement seeks to include Specimens A, B and C attached to the statement of grounds. Specimens A and C are in any event in colour. Specimen B is the newspaper cutting from the Edinburgh evening News sometime in 1995. This refers to Dry Wash and Guard being sold by and used in the car detailing business of a company, Global Concepts.

22. It is not clear to me that the Hearing Officer in fact dismissed or discounted any of the Opponent’s evidence simply on the ground that it did not show the WATERLESS wave in pink lettering. His conclusion (at paragraph 38) was: “Making the best I can of this material I am not persuaded that the opponent has shown that the word WATERLESS in wave-form lettering (and in pink) has come to be recognised as a distinguishing feature of his business”. However, whether the case put forward by the Opponent under section 5(4)(a) is based on the stylised word WATERLESS in pink lettering or alternatively the stylised word WATERLESS simpliciter, the result is the same. On the evidence presented, passing off does not in the words of the Hearing Officer “get off the ground”.
23. In the light of my decision on the Opponent’s first ground of appeal, strictly speaking the remaining grounds fall away. I will however say something with regard to each. The Opponent submits that the Hearing Officer erred in holding that presentation of the appellant’s mark in ‘wave-like form’ lends only a small degree of stylisation to the Opponent’s mark. This is a matter of impression for which the Hearing Officer cannot be criticised. In any event it did not affect the outcome. The Opponent also claims that the Hearing Officer erred in holding that use of a single colour (e.g. including, but not limited to the colour pink) within a mark results in increased difficulty in establishing distinctiveness. The relevant passage in the Hearing Officer’s decision reads as follows:

“26. I am not aware of any reason why, in principle, the form in which a word is presented coupled with the colour used should not be capable of being the distinguishing feature by which a business is known. The ease with which the form and colour will come to be recognised as distinctive is likely to depend on the complexity of the form, the intensity and consistency with which it is used and the effort expended in drawing this element to consumers’ attention. In so far as the colour aspect of the claim is concerned, it has been said that combinations of colours are more likely to be distinctive than single colours (see the Law of Passing-Off by Christopher Wadlow – Second Edition at 6.66). The decision of the European Court of Justice in *Libertel Groep BV and Benelux Merkenbureau*, [2003] ETMR 63 provides a further indication of the difficulty of establishing distinctiveness for single colours (albeit in the context of trade mark registration).”

The Opponent is correct in pointing out that the Court of Justice’s decision in *Libertel* concerned colour per se, not spatially limited. However, it seems to me that in the above passage the Hearing Officer was making general observations, which, as it transpired, were irrelevant to his actual decision under section 5(4)(a). Finally, the Opponent says that equivalent evidence sufficed to overcome objections by the Registry on grounds of distinctiveness to the Opponent’s own trade mark application number 2273516 WATERLESS logo. Those are different proceedings that cannot affect the present opposition and on which I refrain from comment.

Conclusion

24. In the event the appeal fails. No oral hearing took place and I received no written submissions from the Applicant. The appeal is dismissed with no order as to costs.

Professor Ruth Annand, 2 July 2004.