

TRADE MARKS ACT 1994

IN THE MATTER OF Trade Mark Application No. 2224590
in the name of Nova Darkroom Equipment Ltd

AND

IN THE MATTER OF Opposition No. 51392
by Clariant AG and Clariant UK Ltd.

BACKGROUND

1. The details of Trade Mark Application No. 2224590 are as follows:

PERMAJET

Class 16

Stationery, paper, ink.

Date of filing: 6th March 2000

2. The applicants are Nova Darkroom Equipment Limited, and their mark was accepted and published for opposition purposes on 7th June 2000. On 7th September 2000 the mark was opposed by Clariant AG and Clariant UK Limited. The grounds of opposition were based on ss. 5(2)(a), 5(3) and 5(4)(a). The opponents cited their UK registration No. 1576594, formerly in the name of Ilford AG, but which had subsequently been assigned to the first opponents. The details of the opponents' mark is as follows:

PERMAJET

Class 2

Varnishes, paints, printing ink; all included in Class 2

Date of filing: 27th June 1994

3. The mark was defended and the statutory evidence rounds followed. At their conclusion, the Head of Inter Partes Proceedings at the Registry, wrote on 22nd February 2002 to the parties saying that he had reviewed the evidence and pleadings and, in his view, the opposition could be determined on the s. 5(2)(a) ground only. He felt that the opponents' claim to a reputation, necessary to support a s. 5(3) or s. 5(4)(a) claim, was not made out in the evidence. He also considered that the matter could be determined on the papers thus submitted alone, without a hearing, but invited further submissions on the question of similarity of goods, that is, 'ink' as specified in the application, and 'printing ink' as specified in the opponents' registration. In respect of the other goods in the applicants' specification: stationery and paper, he felt that these goods were plainly not similar.

4. Finally, it was pointed out by Mr. Knight in his letter that either party had a right to be heard: neither party made such a request, and they did not subsequently do so. Consequently, this decision is made from the material I have before me thus far.
5. Both parties made further submissions on the question of similarity of goods, as invited by Mr. Knight. In their submissions dated 4th April 2002, the opponents did not dispute Mr. Knight's view that the section 5(3) and 5(4)(a) claims could not be sustained on the evidence. Accordingly, I am proceeding on the basis that the sole ground necessary for me to determine in this decision is section 5(2)(a). As is usual, I will review the evidence first.

The opponents' evidence

6. Stephen John Parkinson, Company Secretary of Clariant UK Limited, has provided a Statutory Declaration dated 30th April 2001. He says that his company has been engaged in the continuous provision of goods under their PERMAJET mark since June 1998. The goods supplied are pigment preparations in powder form. They are used in the manufacture of solvent based ink jet ink and special inks, such as ketone or ester/ketone systems. As such, the opponents' goods are offered for sale directly to manufacturers of ink jet and special inks throughout the UK.
7. Approximate annual turnover figures in respect of the goods sold under the trade mark in the years 1998 to 2000 (calculated using retail values) are as follows:

Year	Turnover (£)	Turnover (Units)
1998	228,336.00	5,850 kg
1999	351,258.00	10,484 kg
2000	502,308.00	15,070kg

Mr Parkinson says that the trade mark is applied to the packaging of the goods, labelling and invoices. The goods are sold directly to the client and advertised in brochures. Goods bearing the mark were exhibited at the Surfex Exhibition 2000, which is the main exhibition in the UK surface coating industry, and held biannually.

8. Exhibited to his Declaration are several brochures. The first is a specific PERMAJET brochure illustrating the properties of the solid pigment preparation. Other general brochures show the mark used against the background of the complete range of Clariant products. Also exhibited is a batch of invoices, dating from 1998, showing the mark in use. There are two companies to whom the invoices have been sent: Lyson Limited and Small Products Limited.

The applicants' evidence

9. Roger Anthony Whetton is the applicants' managing director and has provided a Statutory Declaration dated 18th July 2001. He says that the applicants sell, by mail order and through a network of agents, a wide range of products for the home photographer. Recognising a movement away from traditional photography towards digital imagery, in 1999, the applicants introduced a range of new products specifically aimed at the digital fine art photography market. Searches at the trade mark registry at the time turned up trade mark registration No. 1576595

PERMAJET in Class 16 which had lapsed. This mark had, like the mark relied on by the opponents, been in the name of Ilford AG.

10. Mr. Whetton does not believe there is any risk of confusion since the opponents do not sell stationery, paper or even ink. They sell pigments in powder form directly to manufacturers. He says that there is no evidence that people who purchase inks would have any knowledge of the products used in their manufacture, especially inks in the nature of stationery which fall into Class 16.
11. Exhibited to his declaration is a brochure showing use of the mark in relation to both fine art papers and ink cartridges. The inks are available in 2 types: photo and premium. They come in cartridges said to fit most Epson printers.

The opponents' evidence in reply

12. Jonathan McDonough is an employee of Urquhart Dykes & Lord, agents acting for the opponents. He has provided an undated Witness Statement. He states that the opposition is not based on the lapsed mark No.1576695, but the live mark No.1576594. He says that the opponents sell pigments in powdered form to the non-impact printing industry, that is, inkjet ink and laser toner manufacturers, whereas 'the applicant .. sells ink cartridges for laser printers to the market'. Inks containing Clariant PERMAJET pigment are therefore sold to companies like the applicants and their competitors. He says, but does not substantiate, that the non-impact printing industry is a small and specialised profession. It is likely that the competitors to the applicants are likely to be confused into believing there is a link between Clariant AG, Clariant UK Limited and the applicants, since the companies use the same mark in this industry. This may dissuade the applicants' competitors from buying inks containing Clariant's pigment, particularly if the applicants' ink is unsatisfactory in some way.

Decision

13. S. 5(2)(a), which, as I have already said, is the only sustainable ground of opposition, states:

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

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

(b) .. ,

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

14. Clearly the marks are identical; the only questions therefore are whether the goods are similar and that a likelihood of confusion arises. It seems clear to me that a finding of similarity between the goods will result in success for the opponents in this matter: this follows from the complete identity of the marks and the lack of any factor that will mitigate against a likelihood of confusion (as, for example, in the *Lancia* case ([1987] RPC 303), where the goods at issue were chosen with the care attending the purchase of highly-priced items).

15. Similarity between goods is usually assessed by the factors identified in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (the *Treat* case) at page 296 (which have been confirmed in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* (Case C-39/97) [1999] E.T.M.R. 1, paragraph 23). In *Treat*, Mr. Justice Jacob cited the following as relevant in any consideration of similarity, which I have adapted to the present case:

- the respective uses of the respective goods;
- the respective users;
- the physical nature of the goods;
- the respective trade channels through which the goods reach the market; and
- the extent to which the respective goods are competitive. This inquiry may take into account how those in the trade classify goods.

I will come to these in a moment: first I wish to make some observations on the evidence provided, and comment on the written submissions, which both parties have submitted.

16. First, it is very important to note that the question of similarity under section 5(2)(a) proceeds on the basis of a comparison between the goods or services for which the earlier trade mark is protected, against the goods or services for which the applicants have sought protection. Thus I must consider ‘ink’ against ‘printing ink’. This largely makes irrelevant much of the evidence supplied by both sides, as this describes in detail what they actually sell, not that for which they have, or have sought, protection. The applicants’ may argue that PERMAJET has not been used on printing inks at all, but only for constituent pigment preparations, however - outside a successful revocation action based on non-use - this avails them nothing: I cannot pose the question of the similarity of goods in those terms. It remains that the opponents are protected for printing ink as such.
17. Having said that, I believe I am entitled to draw from this evidence what I can (pitifully little) which may shed light on the trading factors identified in *Treat*, as cited above.
18. Much the same criticism made of the evidence can be directed to some of the parties’ submissions, received in letters dated 4th April 2002 (the opponents), and 5th April 2002 (the applicants). Not only so, submissions were requested, not new evidence and, unfortunately, this makes significant parts of the parties’ letters inadmissible. For example, where the opponents argue that inks and printing inks are similar goods, they cannot base this on the contention of a supply chain between their clients and high street stationers, which converts large volumes of inkjet ink into cartridges containing ink: it has not been substantiated in evidence. Again, the comments reported from a Mr. Alan Hudd of Xennia - which is also secondhand hearsay - are also objectionable as new evidence.
19. As for the applicants, they state that the goods are already distinguished by virtue of the respective classes in which they appear - class 2 only covers inks for commercial use: ‘printing ink’ is used, for example, in ‘offset lithographic printing’. Class 16 ‘ink’ on the other hand is ink in the nature of stationery, eg for inkjet and bubblejet printers. I discuss the issue of the two classes in which these products appear below; as for the rest of these comments, it is new evidence, not submission, and again, inadmissible. There is nothing in the evidence that shows that, for example, the trade outlets for printing ink and ink are ‘to a large extent’ (rather an equivocal statement) mutually exclusive, nor that ‘stationery inks’ (undefined in evidence) are

sold through retail outlets to the general public who are never exposed to commercial inks. I have ignored these ‘submissions’.

20. On the issue of the two classes in which the parties specify their goods, classification of goods and services is based on the Nice Classification (see the 8th Edition) published by WIPO. The latter was established for administrative purposes only, and cannot be decisive on questions of similarity of goods; rather this must be discovered from evidence, particularly as to the intention of those seeking registration. Having said that, in terms of the latter, it is not unreasonable to assume that the class in which goods are placed reflect, in the absence of anything else, the intentions of the parties who placed them there. On this basis, goods in Class 2 include, in particular, paints varnishes and lacquers for industry, dyestuffs for clothing, colorants for foodstuffs and beverages. Class 16 includes mainly paper, goods made from that material and office requisites. It seems to me that, against this background, ‘Class 2 ink’ may have mainly commercial applications, where the final products might be, for example, banknotes, newspapers or wallpapers. Class 16 goods, on the other hand, are in the nature of office or home requisites, primarily paper, whether sold through retail or trade outlets.
21. I have, however, precious little information to ‘go on’ here, but it seems to me, from a common sense approach, that printing ink, and ink are similar goods. I have come to this conclusion as follows, guided by the principles established in *Treat*.

The uses of the respective goods or services

22. I think it is quite possible that ‘printing ink’, protected under Class 2, may, in fact, have the same use as ink covered in Class 16. For example, ‘inkjet’ ink may be both a commercial printing ink and sold in much smaller quantity in printer cartridges, or refills, for the stationery trade.

The respective users

23. Though one might assume that, in the case of printing ink, the user is a manufacturer or other business, and this might exclude exposure of the mark down the chain, while the applicants’ product (‘stationery ink’) - and thus their mark - will be exposed to the public in general, I do not think this can be assumed. The best submission the applicants can muster is, as I have pointed out, equivocal: ‘..the trade outlets ... are, *to a large extent*, mutually exclusive’. I note the following in evidence from Mr. McDonough, that the opponents sell pigments in powdered form to the non-impact printing industry, that is, inkjet ink and laser toner manufacturers, whereas ‘the applicant .. sells ink cartridges for laser printers to the market’, and that inks containing Clariant PERMAJET pigment are therefore sold to companies like the applicants and their competitors. There is thus some cross over between the markets at issue.

The physical nature of the goods or services

24. I must assume that the physical nature of the goods is the same or similar.

The respective trade channels through which the goods reach the market

25. The same comments apply here as under the ‘users’ head, above: there is some overlap of trade channels.

Are the respective goods/services in competition with each other ?

26. In general, the goods will not be in competition with each other.

Conclusions on the question of similarity in relation to section 5(2)(a).

27. On the basis of the evidence filed and applying the guidance in the '*Treat*' case, I find that printing ink in Class 2 and ink in Class 16 are similar goods. It follows from this, in view of the identity of the trade marks at issue, that confusion is inevitable. The application thus fails to the extent it applies to ink.
28. The other goods at issue (stationary and paper) were stated (paragraph 3) to be dissimilar, and thus the application can proceed if amended to remove ink. If the applicants do not file a TM21 within one month of the end of the appeal period for this decision, restricting the specification as thus set out, the application will be refused in its entirety.

Costs

29. The opponents have been partially successful, and are entitled to a contribution towards their costs. I order the applicants to pay them £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated the 11 day of September 2002

**Edward S Smith
Hearing Officer
for the Registrar.**