

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF APPLICATION NO. 2196597**  
**BY PHILIP JOHNSTONE GROUP LIMITED**  
**TO REGISTER A TRADE MARK IN CLASS 2**

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**DECISION AND GROUNDS OF DECISION**

1. On 8 May 1999, Philip Johnstone Group Limited of Tingewicke Road, Buckingham MK18 1AN, applied to register the mark BEAVER in Class 2 in respect of "Paints, varnishes, lacquers; preservatives against rust and other corrosion, and against deterioration of wood; colourants; mordants; raw natural resins; enamels, coatings in the nature of paints; light reflecting coatings; size; thinning agents."

2. Specification queries were raised in the original application which were largely overcome by amending the specification to that above. Therefore, no more mention need be made of the matter other than to say that "size" is proper to Class 1 and the matter has not been addressed by the applicants either by deleting it or adding Class 1 to the application.

3. Objection was taken to the application under Section 5(2) of the Act as the mark was considered to conflict with the following registered mark:

Number	Mark	Class	Specification
2015121	BEAVER STONEFACE	2	Emulsion based paints; emulsion based paints having a smooth or textured finish; emulsion based paints having a smooth or textured finish and being for exterior use.

4. At a hearing, at which the applicants were represented by Ms J M Maddox of W P Thompson & Co their trade mark agents, the prima facie objections were maintained. A period of time was allowed for the applicants to overcome the objection. No further correspondence was received and therefore the application was refused. Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Mark Rules 1994 to state in writing the grounds of the decision and the materials used to arrive at it.

5. Section 5(2) of the Act reads as follows:

5(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

or

- (b) it is similar to an earlier 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

6. The mark applied for and the earlier mark raised as an objection are not identical and consequently Section 5(2)(a) does not apply.

7. Dealing first with the question of whether the goods of the application are the same or similar to those covered by the earlier mark, there cannot be any doubt that the goods of the cited mark (paints) are contained within the applicants' specification of goods. Furthermore, the applicants' other goods not covered by the cited mark are similar to those goods. This is not a matter which has been disputed by the agent.

8. The question, therefore, is whether the mark of this application is so similar to the earlier mark that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

9. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

10. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29."

11. The cited mark consists of two elements - "BEAVER" and "STONEFACE" which do not hold together as a phrase or combine to create a different idea. Therefore, in my view, the public will see this mark as consisting of no more than a strong housemark, "BEAVER" , and a semi-descriptive secondary mark, "STONEFACE" . The applicants' mark consists simply of the word "BEAVER". Therefore, I consider the public cannot come to any other conclusion than that the goods at issue come from the same source, one range of products using the housemark alone and the other using the housemark with a secondary mark. Having concluded that there is a likelihood of confusion, I find that the application is debarred from registration by Section 5(2) of the Act.

12. This is, however, not the end of the matter. Prior to the hearing the applicants' agents provided information to the Registrar that they were seeking to assign the cited mark. The application had been examined on 4 June 1999 and on 3 December 1999 the applicants' agents requested an extension of time. The reasons given for the request were - "The cited registration has been assigned to the applicants. We are attending to the recordal of the assignment."

13. Subsequently, in correspondence, the agents explained that "the assignment has yet to be recorded" and that "It was part of a substantial transaction and we are trying to trace the original assignment document." In later requests for further extensions of time the agents

confirmed that they had managed to track down the original assignment but "are unable to record the transaction as there is a question about what stamp duty has already been paid." A copy of the assignment document was later sent to the Registrar but the agents said they were unable to file a TM16 as "We are having difficulty in obtaining Solicitor's confirmation that stamp duty has been paid."

14. Further extensions of time were granted up to 4 December 2000, i.e. a total of one year since the original request. This extension was regarded by the Registrar as final, subject to their right to a Hearing and this duly took place before me on 13 February 2001.

15. As the Section 5 objection had been maintained I granted one final period of 3 months, to 13 May 2001, to either complete the assignment or to withdraw the application. In the absence of any response the application was subsequently refused.

16. I consider the period of 18 months from the date of the first request for an extension of time to be more than sufficient to resolve the matter. No explanation has been provided for the delay and no further time has been requested.

17. I bear in mind that whether or not the applicants are now the beneficial owners of the cited mark they are not the registered owners of the earlier mark which clearly qualifies as an "earlier trade mark" for the purposes of Section 5 of the Act. The "proprietor" has not consented to the registration of the later trade mark under Section 5(5) of the Act. I also bear in mind that the term "proprietor" is not defined in the Act and may have different meanings for different purposes. However, in Section 5(5) "proprietor" must mean "registered proprietor" as the beneficial owner cannot act as the proprietor until he is recorded as such - see Section 25(4) of the Act which reads:

"25.- (4) Where a person becomes the proprietor or a licensee of a registered trade mark by virtue of a registrable transaction, then unless -

- (a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months beginning with its date, or
- (b) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter,

he is not entitled to damages or an account of profits in respect of any infringement of the registered trade mark occurring after the date of the transaction and before the prescribed particulars of the transaction are registered."

This implicitly recognises that a proprietor cannot launch an infringement action until his name has been recorded.

18. Therefore, as the citation is registered in a different name from that of the applicants it remains debarred from registration by Section 5(2) of the Act.

19. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act as it is debarred from registration under Section 5(2) of the Act.

Dated this 8<sup>TH</sup> day of November 2001.

R A JONES  
For the Registrar  
The Comptroller General