

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 1544798 BY
STARBRITE CHEMICALS LIMITED TO REGISTER A MARK
IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 43880 BY STAR BRITE INTERNATIONAL CORPORATION**

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No 43880 BY STAR BRITE INTERNATIONAL CORPORATION**

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DECISION

20 On 12 August 1993 Starbrite Chemicals Limited applied under section 17 of the Trade Marks
Act 1938 to register the mark STAR BRITE in the form shown below for a specification of
goods which reads "Cleaning, polishing, dressing, scouring and abrasive preparations and
substances; soaps; all not being for use on marine vehicles; all for sale in the South East of
England; all included in Class 3" (this reflects an amendment requested by the applicants by
25 means of a Form TM21):-

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The application is numbered 1544798.

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On 12 January 1996 Star Brite International Corporation of Fort Lauderdale, Florida, USA
filed a notice of opposition to this application. The grounds of opposition in summary are:-

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(i) that the applicant is not the proprietor of the mark in the United Kingdom.
That the opponents are the true proprietors of the mark and so Registration
would be contrary to sections 17 and 68 of the Act.

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(ii) that the opponents and its predecessors in business have used the mark STAR
BRITE in the United Kingdom since 1979 in relation to a similar range of
goods and by virtue of such use they say that this mark has acquired an
extensive reputation and valuable business goodwill. As such, use of the mark

applied for would be likely to deceive and cause confusion and registration would be contrary to section 11 of the Act.

- 5 (iii) At the time this application was filed the opponents had an application of their own, No 1412916 for the mark STAR BRITE in respect of Class 3 goods. Registration would therefore be contrary to section 12(3) of the Act. However, that application has now matured to registration with the following specification "cleaning and polishing preparations; protective coating preparations; all for use on marine vehicles; all included in Class 3" and registration of the mark applied for would thus now be contrary to section 10 12(1) of the Act. The opponents' mark is in the following form:



- 25 (iv) finally the opponents ask the registrar to refuse the application in the exercise of his discretion.

The applicants filed a counter-statement denying the above grounds.

30 Both parties ask for an award of costs in their favour. Both sides filed evidence and the matter came to be heard on the 15 September 1999 when the applicants were represented by Dr M Hutchins of Fry, Heath & Spence, Trade Mark Attorneys and the opponents by Ms A Roome of Laurence Shaw & Associates, Trade Mark Attorneys.

35 By the time the matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provision of the old law.

40 Background

This application for registration was advertised before acceptance by the Registry under the provision of Section 18(1) and Section 12(2) of the Act, on the basis of evidence of use of the mark since 1988, in the face of the opponents' registration (No 1412916 referred to above).
45 No 1412916 was previously the subject of opposition by the current applicants but proceeded to registration for the specification set out above.

Opponents' evidence

The opponents filed a statutory declaration dated 24 September 1996 by Ann Elizabeth Roome, the trade mark agent responsible for the conduct of this opposition on behalf of the opponents. Ms Roome refers to a Declaration of a Peter Gordon Dornau which was filed in support of the opponents' own application no 1412916. She states that the declaration sets out the evidence of use of the opponents mark and a copy of Mr Dornau's declaration is attached as an exhibit. The Hearing Officer in the opposition proceedings to application No 1412916 summarised Mr Dornau's declaration in his decision and I adopt that summary for the purpose of these proceedings as follows.

"Mr Dornau says that he is the President of Star Brite International Corporation a company incorporated in February 1989 and he has been President since that date. Mr Dornau goes on to say that Star Brite International is engaged in the manufacture and sale of a wide variety of maintenance and cleaning products for use in marine, land vehicle and aeroplane industries. He further says that Star Brite International sells all its products in the UK, the USA and elsewhere under the trade mark STAR BRITE which was first used in the United Kingdom by his corporation and its predecessors in business in 1979. At PGD1, he submits an illustrative sample of papers showing the mark as used in the United Kingdom in the period 1979-80. The first sample is described in the declaration as a letter, but which is a copy of an invoice addressed to Epping Motor and Marine Group Ltd at Ilford, Essex, but also marked "Shipped to Correctcraft", with an address in Orlando, Florida. This document appears to be dated 10 January 1979. The second sample is labelled "Invoice" and is marked to both 'Ship and Bill' to Smith Aviation Services Ltd, Wellesbourne, Mountford, Aerodrome, Wellesbourne, Warwick, England, it is dated 3 December 1980. The third sample is marked 'Ship and Bill' to T.T.L. Services of Edgware, Middlesex, it is dated 19 August 1980 and appears to be for the sum of either \$ or £ 2,257.

Mr Dornau goes on to say that the trade mark STARBRITE is used on a wide variety of goods in the United Kingdom, which he lists. The list includes degreasing agents, diesel and gasoline fuel additives, engine degreasers, lubricants, anti-rust preparations, oil absorbent pads, thread lubricants, sealants for electrical connections. Other items in the list appear to be more specifically for marine use. At PGD2, he submits brochures which he says illustrate goods sold under the mark in the United Kingdom and on which the mark is clearly visible. These are photocopies. The cover of the first brochure says STAR BRITE No 1 in RV/MH Care Products and gives a Florida address. There is no obvious date on the brochure and it is marked "Printed in the U.S.A.". Nor are there any prices given. A number of the products again appear to be for marine use but they also include a tyre cleaner, colour restorers, which appear to have a picture of a land vehicle on the packaging, a 'wax'n wash' product, a "bug and tar remover", a car polish, rug and upholstery cleaners etc., all of which appear to be for use in relation to motor vehicles. The cover of the second brochure is marked STAR BRITE No 1 in Marine Care products, again with a Florida address. Again this has no date and has no price information.

Mr Dornau says that his company sells goods in the United Kingdom, both directly from the US and via British distributors. At PGD3 he submits a bundle of papers showing both types of sale. The first of these dated 24 August 1989 is addressed to Cypher Components Co Ltd

in London and is for liquid electrical tape; the second appears to be a copy of an invoice dated 19 August 1980 already submitted to T.T.L Services of Edgware, Middlesex but there is no indication as to what the goods were, beyond the descriptor 'Poly System'. The next is the invoice to Smith Aviation dated 3 December 1980 and is for aircraft polish; the fourth is dated 5 30 March (year illegible) but Mr Dornau says in the statutory declaration that it is 1983, and is to P S Squires at Oakhampton, Devon and is for Instant Shine and Auto Pre-Pack. 20 units of Instant Shine appear to have been shipped at a net cost of £26.30 and one Auto Pre -Pack at a unit cost of £45.50. The next invoice is dated 10 April 1979 and is addressed to Chamois Export F.M. Meyer Ltd, at Horsham, West Sussex, and is said to be of samples of auto 10 cleaning solution of no commercial value. The next invoice is dated 21 May 1979 and is to Fletcher International Sportsboats Ltd and is for 2 cases of Marine Polish at a total value of £277.97. The next invoice is dated 1981 to IDM Beauty Fashion Limited of Brentford, England, and is for one Marine Mini Pre-Pack at a cost of £26. I note the cost is outweighed by the Air Parcel Post charge of £32. The final invoice is dated 30 April 1984, is to Mr Ralph 15 James of Leicester, is for 6 Diamond Shine Kits, 10 Instant Diamond Shine and one Rust Shield. The total value on the invoice is illegible. Mr Dornau goes on to list four companies which he says are his company's main distributors in the United Kingdom. They are: Sowester of Dorset, Plastimo Manufacturing of Hampshire, Mark Downlands Marine of Dorset, and H Burdens of Northamptonshire. He says these distributors sell the full range of 20 products sold under his mark in the United Kingdom. He adds that while his company has not kept full records of all sales to the United Kingdom, because these are handled by the United Kingdom distributors, he can give estimated sales of goods by Sowester of Dorset. These are listed below:

25	Year	£
	1986-87	2,500
	1987-88	10,000
	1988-89	37,300
30	1990-91	43,400
	1991-92	30,000
	1992-93	unavailable
	*1993-94	83,000
	1994-95	67,000
35	* the application was filed in August 1993	

At PGD4, Mr Dornau submits copies of invoices to his British distributors and a printout illustrating sales to the United Kingdom in the period 1992-5. These start from 24 June 1986 and insofar as they are legible (several are not) appear all to be addressed to South Western 40 Marine and to be for goods for marine application.

Mr Dornau goes on to say that the goods sold under his mark have been advertised in the relevant press by his Corporation's distributor and at PGD5, he says he offers an illustrative sample showing how the goods have been promoted in the United Kingdom. The 45 advertisements appear to have been in the Marine Press and Mr Dornau goes on to say that his goods have been promoted at the London Boat Show and The Sandown Park Marine Trade Show.

Mr Dornau sets out the various registrations which his company owns in other jurisdictions. I note, that with the exception of the United States of America, none of these registrations is earlier than 1990."

5 Applicants' evidence

The applicants filed a statutory declaration dated 21 March 1997 by Glen Warriner. Mr Warriner states that he a Director of StarBrite Chemicals Limited, a position that he has held since 1988.

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Mr Warriner says that StarBrite Chemicals was established as a Limited Company on 24 December 1987 for the purpose of marketing and selling a range of cleaning and polishing products primarily intended for the motor trade. He states that the company commenced trading in 1988 and was originally based at Beaumont House, 177 Arthur Road, Wimbledon Park, SW19 8 AE. He goes on to state that as a result of expansion the company moved in March 1990 to its current address, Fontigarry Business Park, Reigate Road, Sidlow, Reigate Surrey RH2 8QH.

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Mr Warriner goes on to say that the company currently markets over 80 products. At GW1 he exhibits a Product Guide in which he says the majority of the company's product range is shown. The cover of the guide says "Product Guide STAR BRITE - A comprehensive range of quality cleaning products for automotive, industrial and business usage." The guide contains a range of products including inter alia products for pressure washers, automotive vehicle wash range, polishes and waxes, dressings and cleaners. The majority of the products appear to be for use on the interior and exterior of motor vehicles but there are also products under the heading "Janitorial" for more general cleaning use, hand care products and various cleaning products including washing up liquid, bleach, tile cleaner and hand cleaner. Mr Warriner goes on to say that the company's products are primarily directed at the motor trade and food manufacturing trade but that their products are increasingly being used in other trades.

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At GW2 he submits a bundle of copies of labels for various products sold by StarBrite Chemicals Limited under the STAR BRITE trade mark. The labels are undated but Mr Warriner points out that these are examples of labels used before their move to their new premises in March 1990. The address shown on the labels is the company's Wimbledon Park address. The labels relate to a range of products for use in inter alia "car washing machines" and "high pressure water cleaning machines" but also "GLASS-BRITE SPRAY" for "cleaning glass", "FAB-BRITE SUPER CONCENTRATE" for use in "soil extracting cleaning machines", "DETERGENT SANITISER" suitable for "use on any washable surface...such as.. walls, floors, tiles...", "ANTISCALE" "an efficient water softening compound". Other labels relate to products for use in carpet cleaning machines, cleaning aluminium clad vehicles, rubber cleaner for cleaning vehicle tyres, lacquer remover for removing protective films from motor vehicles, spot cleaners, tar & glue remover, brake cleaner, and a range of waxes for use on motor vehicles, toilet cleaner etc. At GW3 he exhibits a range of more recent labels again covering a range of cleaning and polishing products.

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Mr Warriner says that they have been using the trade mark continuously since they commenced trading in April 1988. By way of example at GW4 he exhibits copies of letters dated 26 January 1989 and 16 May 1989. The letter dated 26 January 1989 is to C.C.S. with an address in Crawley. It sets out a range of their products together with the price for each product. The second letter dated 16 May 1989 is to Mr A New at an address in Thames Ditton. This again sets out a range of products together with their prices.

Mr Warriner then sets out the total annual turnover for products sold under the “STARBRITE” and star device trade mark as follows:

10	July 1988 to 31.10.1988	£99,684
	01.11.88 to 31.10.89	£231,020
	01.11.89 to 31.10.90	£328,426
	01.11.90 to 31.10.91	£348,437
15	01.11.91 to 31.10.92	£336,452
	01.11.92 to 31.10.93	£365,884
	(7 months to 30.06.1993)	£237,121
	*01.11.93 to 31.10.94	£461,403
	01.11.94 to 31.10.95	£500,481
20	01.11.95 to 31.10.96	£545,635

*thereafter use is after the date of the application.

Mr Warriner says the mark has mainly been used in the south-east of England, Hampshire, Sussex, Surrey, Kent, Middlesex, Essex, Wiltshire, Berkshire, Oxfordshire and Greater London but also includes Powys and Devon. In a second statutory declaration Mr Warriner attaches at GW5, an exhibit of a bundle of invoices for the years 1989 - 1997 which he states are merely representative of his company's sales over that period. In accordance with rule 127 of the Trade Marks and Service Marks Rules 1986 a direction was sought that GW5 should be kept confidential to the Registrar and to the agents for the opponent. Such a direction was given.

Mr Warriner states that he first became aware of the opponents' trade mark application no 1412916 shortly after its publication in the Trade Mark Journal on 30 June 1993. He says that his company filed an opposition to that application. Neither he nor any other member of his company, nor any customers with whom he has spoken on the matter have come across any instances of the opponents' company selling products for use in the motor and catering trades. He concludes by stating that to his knowledge, the opponents, Star Brite International Corporation have never approached his company or their customers, concerning the use of the “STARBRITE” name.

Opponents' evidence in reply

Mr Dornau filed a further declaration dated 22 June 1998. In this declaration Mr Dornau says that his companies' United Kingdom trade mark application no 1412916 has now proceeded to registration with the following specification of goods: “Cleaning and polishing preparations; protecting coating preparations; all for use on marine vehicles.” Mr Dornau states that in

addition to his company's use of the mark STAR BRITE on goods for use on marine vehicles his company has used the mark on other goods from a date prior to the date of this application. As an example he refers to the fact that his company has used the mark STAR BRITE on aircraft polish in the United Kingdom since at least 1980. He refers to his previous
5 declaration dated 31 July 1995 and exhibit PDG01 which is a copy of an invoice to Smith Aviation Services, Wellsbourne, Warwick. He says that the company continues to sell aircraft polish in the United Kingdom and at PDG02 he refers to brochures of Transair Pilot Shop dated 1992 and 1996, both contain an advert for STAR BRITE "super silicone aircraft
10 polish". He says that Transair Pilot Shop is the largest Pilot Supplies Company in Europe and has been selling Starbrite aircraft polish in the United Kingdom since at least 1981.

Mr Dornau says that his company sells goods under the mark STAR BRITE for use on recreational vehicles and motor homes in the United Kingdom and has done so since at least 1987. At PDG03 he exhibits a bundle of papers which he says show evidence of use of the
15 mark STAR BRITE on goods for use on recreational vehicles and motor homes. The first of these is a letter from Recreation Associates Ltd of Merseyside and is dated 9 April 1987. The penultimate paragraph of the letter refers to StarBrite RV lines which in the declaration Mr Dornau refers to as an abbreviation for recreational vehicle. Reference is made to contact and discussions with three major distributors. The second document is said to set out the
20 commission paid to Recreation Associates Ltd for the sale of Star Brite recreational vehicle and motor homes products in 1987. The document is dated 22 July 1987 and indicates 10% commission for an Ernie Schlesener. He is the signatory of the letter dated 9 April 1987 from Recreation Associates Ltd. However, this company is not mentioned in this second document and although a figure of either \$ or £ 1584.85 is given as the amount of cash received no
25 indication is given as to the nature of the goods to which this commission relates.

The third, fourth and fifth documents are brochures. The cover of these all say STAR BRITE No 1 in RV/MH Care Products and give a Florida address. One brochure is the same as that referred to at PGD02 in Mr Dornau's earlier declaration. The three brochures are undated but
30 a note has been taped to one showing 91 and to another showing 93. In his declaration Mr Dornau asserts that the three brochures are dated 1991, 1993 and 1994 and that all three were sent to United Kingdom distributors.

The sixth and seventh documents are also brochures, the covers of which say BURDENS
35 LEISURE and are dated 96 and 97. The address given for the company H. Burden Ltd is Northamptonshire. Both brochures contain references to various Star Brite products.

For the period 1995 to date, Mr Dornau gives a figure of approximately US\$ 405,547 in relation to sales of goods under the mark STAR BRITE in the United Kingdom for use in the
40 recreational vehicle, motor home and aircraft market. He also says that there are other sales to the United Kingdom by US distributors but he cannot be sure of the exact number of such sales. Mr Dornau states that earlier sales figures are not available as they were not kept when they changed their computer system.

45 Mr Dornau then refers to the applicants' two statutory declarations. He says that his trade mark agents have advised him that use of the mark STAR BRITE and device by the applicants after the 12 August 1993 is irrelevant to these proceedings. Referring to exhibit

GW1 of Mr Warriner's Declaration he notes that it is dated 1994 after the date of the application. In relation to the confidential exhibits GW5 he states that he is advised by his trade mark agents that of the 97 copy documents submitted 46 are dated later than 12 August 1993. Mr Dornau then notes the twelve areas where the applicants claim to have used the

5 mark. He refers to an earlier declaration of Mr Warriner used in opposition proceedings no 38953 and points out that in this declaration the areas were defined as, Hampshire, Sussex, Surrey, Kent, Greater London and Middlesex. He therefore says that he assumes that as at 8 August 1993, the area of use was less than that outlined in the declaration of 21 March 1997.

10 Finally Mr Dornau says that, in his view, none of the evidence filed by the applicants shows use of the mark on products for use on marine vehicles, aircraft or recreational/motor homes. He asserts that the evidence filed demonstrates use on goods for industrial use in the motor trade and food manufacturing trade and not for general retail use.

15 That concludes my review of the evidence.

An objection has been raised under Sections 17 and 68 in that the applicants cannot claim to be the proprietors of the mark. I see nothing in the evidence which supports such a claim. The parties' marks have, I think, been independently adopted. The issue before me is,

20 therefore, one of conflicting rights rather than proprietorship. I, therefore, dismiss these grounds.

Section 11 and 12(1) of the Act read as follows:

25 "11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

30 12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

35 a. the same goods

b. the same description of goods, or

40 c. services or a description of services which are associated with those goods or goods of that description."

The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

45 The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted, in the case of

Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

5 **(Under Section 11)** Having regard to the user of the opponents' mark ((a) below), is the tribunal satisfied that the mark applied for ((b) below), if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

10 **(Under Section 12)** Assuming user by the opponents of their mark in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception among a substantial number of persons if the applicants use their mark, normally and fairly in respect of any goods covered by their proposed registration?

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(a)

(b)

Opponents' mark

Applicants' mark

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40 Although there are minor stylistic and presentational differences it is, I think, accepted that the marks are similar and in practice are both likely to be known and referred to as STAR BRITE marks. With that point in mind I will deal firstly with the Section 12(1) ground. As indicated above the opponents' own application which was pending at the time these proceedings were launched has progressed to registration for a limited specification of goods following an opposition by the current applicants. Shortly before the hearing the current applicants filed a Form TM21 to amend the specification of the application before me. For
45 ease of reference I set below details of the resulting specifications.

Opponents' registered specification

Cleaning and polishing preparations; protective coating preparations; all for use on marine vehicles; all included in Class 3.

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Applicants' specification

Cleaning, polishing, dressing, scouring and abrasive preparations and substances; soaps; all not being for use on marine vehicles; all for sale in the South East of England, all included in Class 3.

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At the hearing Dr Hutchins for the applicants, sought to persuade me that in the light of the restrictions to the specifications (towards and away from use on marine vehicles as it were) there was no conflict. Moreover it was said that cleaning preparations for non-marine use were not goods of the same description as those limited to marine use. I will say at the outset that I am not persuaded that this is the case but I will comment briefly on my reasons for having this view.

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The standard test for deciding if goods are of the same description is that laid down in Jellinek's application (63 RPC 59). The Court's guidance is that consideration should be given under three headings viz -the nature of the goods, the purpose of the goods and their respective channels of trade. As noted in the Registry's Work Manual (Chapter 10) "In practice, if it is considered that the respective goods coincide in respect of two headings then this is sufficient to justify a finding that the goods are of the same description. (See the Floradix case 1974 RPC 583)".

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So far as is apparent from the evidence before me the cleaning preparations appear in the main to be in the normal liquid form (though other forms such as sprays are available). No doubt different manufacturers adopt slightly different formulations depending on the surfaces or goods to be cleaned but the underlying nature of the products is in my view substantially the same. In terms of the purpose of the products, the mere fact that one is sold primarily for marine use and the other for automotive use does not detract from the fundamental purpose which is to clean. I accept that there may be cleaning products so specialised in nature that some form of distinction can be drawn by reference to end users or uses but that is not the case here. The applicants in their product literature (GW1) say: "While we are particularly well-placed to meet the specialist needs of the automotive and transport markets, the sheer scale of our product range means that we can look after the everyday cleaning needs of almost any business or industry".

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One should not perhaps read too much into claims made in the context of advertising but it is indicative, I think, of the difficulty of trying to segment the market. The opponents' evidence too bears out this point. Their "marine care products" brochure (PGD02) although ostensibly targeted at a specialist market contains a variety of goods such as carpet cleaners, vinyl shampoos, engine cleaners, glass cleaners etc that one suspects could equally be used for non-marine purposes. The purposes are, therefore, substantially the same. There was some measure of agreement before me that in terms of usage to date the parties' respective goods are sold through different trade channels. The apparent absence of confusion lends some

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support to this view and I am prepared to accept that from a current trading perspective there is clear water between the parties. However I must consider what it would be notionally possible for the parties to do and I cannot be certain that whatever differentiation currently exists in trade channels will be perpetuated. Given the closely similar nature and overlapping purposes of the goods (the opponents' marine products brochure for instance illustrates a car polish) such differentiations may not persist. However I do not need to consider the trade channels point any further as my finding in relation to the first two elements of the test is in itself sufficient to conclude that goods of the same description are involved and thus that the opposition succeeds under Section 12(1).

As the consequence of the above finding is mandatory the applicants can only proceed to the extent that they are able to convince me of the merits of their counterclaim under Section 12(2). However before I go on to consider that claim I will comment briefly on the Section 11 position. The opponents' evidence goes particularly to their claim to have used their mark not just on products for marine applications but also cleaning preparations for aircraft and recreational vehicles and motor homes (abbreviated in product literature to RV/MH care products). The opponents' case is based largely on evidence filed in earlier proceedings between the parties. On the basis of that evidence the Hearing Officer concluded that the applicants' (the current opponents) use had only been substantiated in relation to goods for marine use (hence the restriction to their now registered specification). Mr Dornau's evidence in those proceedings has been adopted into the current proceedings and supplemented by a further declaration and exhibits. The evidence taken as a whole was criticised by the applicants principally on the grounds that some of it was beyond the relevant date; products were not clearly identified; older use had not been continued or different (not relevant) goods were involved; and the geographical coverage was uncertain. Some of these criticisms seem to me to be well founded and making the best I can of it the opponents' evidence is thin to say the least when it comes to proper substantiation of the underlying claim. However for present purposes I do not consider I need to undertake a full analysis of the evidence as even if I were to accept the opponents' position it would not in my view materially affect (or extend the scope of) the objection that the applicants already face and must respond to in the light of my finding under Section 12(1). I do not, therefore, propose to make a formal finding in relation to Section 11. I go on to consider the Section 12(2) position:

"12.-(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the court or the Registrar may permit the registration by more than one proprietor in respect of:-

- a. the same goods
- b. the same description of goods or
- c. goods and services or descriptions of goods and services which are associated with each other,

of marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or Registrar, as the case may be, may think it right to impose."

The main matters for consideration under Section 12(2) were laid down by Lord Tomlin in the PIRIE case 1933 RPC 147. They are:

- 5 (i) the extent of use in time and quantity and the area of trade;
- (ii) the degree of confusion likely to ensue from the resemblance of the marks, which is, to a large extent, indicative of the measure of public inconvenience;
- 10 (iii) the honesty of the concurrent use;
- (iv) whether any instances of confusion have been proved;
- 15 (v) the relative inconvenience which would be caused if the mark in suit was registered, subject if necessary to any conditions and limitations.

In relation to (i) of the above a brief summary of the applicants' trading activities has been given in the evidence summary. By the material date in these proceedings (12 August 1993) the applicants could claim over five years' use on a reasonably substantial scale in the geographical area referred to in their specification. However for the purposes of the PIRIE test I need to consider their use in some detail not least because the turnover figures themselves are not broken down between each user area or customer type.

The applicants have elected to limit their specification of goods to "..... all not being for use on marine vehicles". That is still a broad claim in the circumstances of the case and in effect embraces any of the goods in question for use outside the marine area. I quoted above an extract from the applicants' promotional literature which taken at face value might appear to support a broad claim. But as Ms Roome, for the opponents, was quick to point out, the subsequent text suggests that the applicants' products are in practice targeted at a narrower range of customers. I, therefore, rely on Exhibits GW2 to 5 (insofar as they predate the filing date of the application) in coming to a view on the applicants' position. Exhibits GW2 and 3 are specimen labels. I conclude from these that:

- 35 S the majority refer to automotive related uses such as car shampoos, cleaning preparations for use with car washing machines, windscreen cleaners, brake cleaners etc
- S in further cases where the specific purpose is not clearly indicated it is possible to infer from the Directions' that the products are aimed at the automotive market (eg "... Start at the base of the vehicle ...")
- 40 S a small number of the labels relate to hand cleaners (which could be of general application) but refer specifically to engineers and mechanics
- 45 S there are isolated examples of other non-automotive applications such as a tile cleaner and sanitary ware cleaner

S a few items such as deodorising preparations and disinfectants give rise to classification issues and may or may not be appropriate to Class 3.

5 Exhibit GW4 does not shed much further light on the matter and appears to relate largely to automotive goods. GW5 does, however, add a further perspective to the applicants' claim. As indicated above the details of the exhibit are subject to a confidentiality order but it was agreed at the hearing that there would be no objection to referring to the content in general terms. Almost half of the invoices in this exhibit bear dates after 12 August 1993. I discount them for the purposes of my analysis. The remainder are again mainly addressed to companies
10 in the automotive trade. I use that term in a reasonably broad sense because it is clear that sales have been made to car rental companies, car dealers, car valeting services, car washes/garages, car bodyshops and bus operators. In the case of a small number of invoices it is not possible to tell from the title of the addressee or the goods ordered what the purchasers' line of business is. The only other broad category of customers that can clearly be identified are food
15 companies (bakeries, frozen food companies and the like). I am therefore left with the clear impression that at the material date the applicants' business was directed towards the automotive, food and catering trades.

20 There was some suggestion before me that a further point of difference existed in that the applicants' sales were of commercial or industrial size containers whereas the opponents' were smaller sizes for domestic/private use. There may well be some support for that general proposition but I note that both sides sell goods in gallon/5 litre sizes so I do not think any meaningful differentiation can be drawn in this way.

25 In the context of the PIRIE criteria it seems to me that the applicants have made out their case under point (i) and there is no great danger of confusion (point (ii)) if their specification is suitably limited.

30 I have no reason to suppose the applicants' use has been other than honest (point (iii)) and no instances of confusion have been proved (point (iv)).

The final matter is the relative inconvenience if the applied for mark is registered. I have indicated that the applicants have substantiated their claim in respect of the uses set out above. But there is no or insufficient evidence to say that they have ever sold to the recreational
35 vehicle/motor home market where the opponents claim to have traded. Whilst I have questioned the extent to which the opponents have been able to substantiate their own activity it seems probable that some trade has taken place. In these circumstances the opponents would in my view be inconvenienced if I were to allow the application to proceed to registration for a specification which covered that particular part of the automotive market. I
40 take this into account in the proposal set out below bearing in mind also the power available to me under the Act to impose "... such conditions or limitations ..." as I see fit and the general discretion available to me.

45 In all the circumstances the application will be allowed to proceed under the provisions of Section 12(2) if the applicants amend their specification as follows:

"Cleaning, polishing, dressing, scouring and abrasive preparations and substances; soaps; all for automotive use or for use in the food and catering trade; and all for sale in the South East of England; all included in Class 3 but not including any of the aforesaid goods for use in relation to recreational vehicles or mobile homes".

5

I am aware that the above makes for a somewhat untidy specification but it seems to me to reflect most accurately the applicants' area of trade whilst making due allowance for the opponents' position and the trade channels that appear to exist in relation to their activities.

10 The application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision the applicants file a Form TM21 amending their specification as set out above. If the applicants do not file a TM21 restricting their specification in this way the application will be refused in its entirety.

15 As both sides can claim some measure of success and as this opposition was filed before the previous opposition case between the parties was resolved I do not intend to make any order as to costs. However if the applicants do not amend their specification the opposition will have succeeded in its entirety and the opponents will be free to apply for an award which would then be based on the published scale.

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Dated this 7 day of October 1999

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30 M REYNOLDS
For the Registrar
the Comptroller General