

O-017-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2615542**

**BY**

**FINISHLINE PRODUCTS**

**TO REGISTER THE TRADE MARK**

**SPRAYMAX EQUIPMENT**

**IN CLASS 7**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO 104011**

**BY**

**PETER KWASNY GMBH**


## BACKGROUND

1. On 27 March 2012, Finishline Products (the applicant) applied to register the above trade mark in class 7 of the Nice Classification system<sup>1</sup>, as follows:

Class 7  
Spray Equipment

2. Following publication of the application, on 27 July 2012, Peter Kwasny GmbH (the opponent) filed notice of opposition against the application.

3. The grounds of opposition were brought under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (the Act). The opponent relies upon the following community trade marks ("CTM") and goods shown below.

Mark details and relevant dates	Goods
<p>CTM 384859</p> <p>Mark:</p>  <p>Filed: 16 September 1996</p> <p>Registered: 4 November 1998</p>	<p><b>Class 2</b> Paints, varnishes, lacquers and painting preparation materials (included in class 2);</p> <p><b>Class 8</b> Atomizing devices, in particular for paints, varnishes, lacquers and painting preparation materials.</p>
<p>CTM 365809</p> <p>Mark:</p> <p>SPRAYMAX</p> <p>Filed: 13 September 1996</p> <p>Registered: 20 July 1998</p>	<p><b>Class 2</b> Paints, varnishes, lacquers and painting preparation materials (included in class 2);</p> <p><b>Class 8</b> Atomizing devices, in particular for paints, varnishes, lacquers and painting preparation materials.</p>

4. On 17 December 2012, the applicant filed a counter statement. It denies the grounds upon which the opposition is based. It states:

*"7. We registered Spraymax Equipment to cover a range of Airless Spraying*

<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

*Equipment which we sell to Shot Blasters. Spraymax from Germany is a range of Aerosols for the domestic market. There is no similarity...”*

5. Only the opponent filed evidence and submissions in lieu of a hearing; neither party asked to be heard.

## **EVIDENCE**

6. The opponent’s evidence consists of a witness statement by Hans-Peter Kwasny dated 22 March 2013. It is accompanied by 5 exhibits. Mr Kwasny is the CEO of the opponent company. The main facts emerging from his statement are, in my view, as follows:

7. Mr Kwasny states:

*“4. The trade mark is used by applying it to labels of spray paint cans which are sold by car manufacturers such a Volkswagen and Nissan as well as by market chains and by other automotive paint suppliers in the car refinishing industry, e.g. Spies Hecker, and international manufacturers of automotive paints, e.g. Standox.”*

8. Exhibit HPK-001 is described by Mr Kwasny as:

*“3...sample flyers and product brochures in the English language, which have been used and are currently in use in the United Kingdom.”*

Pages 1-6 of the exhibit relate to *FillClean* a product described as ‘*The filling system for spray paint cans*’. Page 2 of the exhibit describes the *FillClean* product as a modular component of the *SprayMax PaintRepair System*. The final page of the exhibit shows the products in the *FillClean* range. At the bottom of the page it states, “*There are more SprayMax products in the brochure “PRODUCTS”*”. CTM 384859 which I shall refer to as “The logo mark” is shown on spray cans throughout the exhibit, and CTM 365809 which I shall refer to as “the word mark” is used throughout the text of the document. The brochure is not dated.

9. Pages 7-42 consist of a brochure titled ‘Products Paint Repair’. At page 8, under the heading ‘Philosophy’, is the following:

*“At the end of the 90s, a milestone was set in paint spray technology, which again significantly changed the paint spray world: the launch of the patented spray lacquer system “SprayMax” - a revolutionary invention. This innovative aerosol technology combines the mobility and flexibility of a spray paint can with the application properties of a professional spray gun.*

*The SprayMax program initially kicked off with individual products but now comprises a complete painting system, the SprayMax PaintRepair System. All the products, colours and applications required for professional paint repair work are available in the SprayMax range.”*

10. The table of contents on the second page of the brochure features aerosol technology, surface preparation products, primers, fillers, basecoat, top coat, clear coat and spot blenders. The opponent’s word mark is used throughout the brochure when describing the

SprayMax system, the logo mark is shown on the product spray cans. The product brochure appears to be dated 10.12, which is after the relevant date.

11. Pages 44-45 consist of a leaflet titled 'Primer Shade System'. It shows the logo mark on various spray cans and the word mark when describing the SprayMax system. It appears to be dated 07.12 which is after the relevant date.

12. Pages 47-48 consist of a leaflet titled 'Headlight Sealer' which is described as a 'colourless one-component primer for restoring damages of polycarbonate covers, e.g. car headlight.' The logo mark is shown on the can, the remaining text on the can is in German. The word mark is used in the text of the document, which appears to be dated 08.12 (after the relevant date).

13. Pages 50-51 consist of a leaflet titled 'Gun cleaner', a product for cleaning paint spray guns. The logo mark is shown on the product can. The leaflet appears to be dated 07.12, after the relevant date.

14. Mr Kwasny describes exhibit HPK-002 as, "copies of the respective labels of my Company's customers..." The exhibit is made up of four pages of printer's proofs of labels for the opponent's products.

Page 1 of the exhibit is a label for Epoxy-Primer Filler. It shows Volkswagen Group badges at the top and includes both of the opponent's marks. It appears to be dated 2004.

Page 2, a label for 'Forklift Spray Paint', shows the logo mark and a Nissan trade mark on the front. On what would be the back of the product are the words, "*SprayMax® is a product and registered trade mark of Peter Kwasny GmbH*".

Page 3 is a label for 'Primer Filler' distributed by STANDOX. It shows a copyright date of 2012 and has the opponent's logo mark displayed beneath the word STANDOX.

Page 4 is a label for 'Wash Primer' distributed by Spies Hecker. The opponent's logo mark is shown on the front of the label. It has a copyright date of 2012.

16. Exhibit HPK-003 is described by Mr Kwasny as, "*a complete overview of the turnover figures for the years 2007-2011*". He provides the following explanation:

*"In the left column the abbreviation PKD refers to turnover generated in Germany; the abbreviation PKF refers to turnover generated in France and the Southern European countries (effected via France); and Co-branding in PKD includes SPRAY MAX products which are delivered from Germany to the respective customers Volkswagen, Nissan Forklift, DuPont, Standox and Spies Hecker."*

17. A list of countries is provided below the table of figures. These are countries to which the opponent's Spray Max products are supplied either directly or indirectly. The list is in German and includes the UK. However, no dates of supply or turnover figures are supplied in respect of these listed countries.

18. Exhibit HPK-004 is sample copies of invoices dated from 26 October 2006 to 27 April 2012. Mr Kwasny states that product codes LLS MAX and SM refer to the opponent's

Spray Max products. Twelve of the invoices are addressed to Volkswagen AG in Germany. The invoices are in German, without translations, and do not show any trade marks on them. They appear to show a range of products including fillers and wash primer along with others which I am unable to translate. Another of the invoices is to Nissan BV in Amsterdam. It has no trade marks on the invoice but indicates sales of several paints, none of which are clearly Spray Max products. However, they do show sales of products with codes LLS MAX and SM, which Mr Kwasny states are SprayMax products. The remaining eight invoices have the following mark displayed at the top of the page:



19. Four of the invoices are to Nissan BV in Amsterdam and show sales of goods which I cannot translate. The remaining four are to Kingsley Auto Supplies in Feltham, Middlesex and include sales of a range of products which are listed in German. None of the invoices bears the marks relied upon by the opponent.

20. At paragraph 8 of his witness statement Mr Kwasny says:

*“Details of my Company’s “Fill In System” are found on pages 1 to 5 of Exhibit HPK-001 and in the same exhibit on pages 24 et seq are details of the SprayMax FillClean Aerosol Filling Machine, which is also an “Airless Spraying Equipment” cf. the Applicant’s Counterstatement. Further details of my Company’s SprayMax Technology and the “Fill In System” can be found on my Company’s websites...”*

21. Exhibit HOK-005 is copies of pages from those websites accessed on 21 March 2013. The first of four pages is headed ‘Auto-K Fill In: Colour variety made easy’ and states:

*“The Auto-K Fill In cans that are pre-filled with a specific blowing agent and solvent are filled quickly and simply with the required tone using a spray paint can filling appliance. This creates a ready-to-use spray paint can in the original colour tone of the respective paint can manufacturer. The Auto-K Fill In cans can be filled with the cleaning-free FillClean filling device...”*

*The cleaning-free FillClean filling device is a modular component of the SpraxMax Paint Repair concept, the system for professional spot repairs. For more information, please visit [www.spraymax.com](http://www.spraymax.com).”*

22. The second page of the exhibit describes the ‘SprayMax paint can technology’ in the following terms:

*“Specific spray head, valve and propellant technology*

*2-component technology: Paint and hardener in one can. Wide spray dispersion like a spray gun, but with little overspray*

*Fine, even dispersion and high dispersion pressure.*

*No painting booth, gun or compressed air required*

*Diverse applications; cars, commercial vehicles, industrial applications, construction sector, agricultural sector, rail, aircraft...*

*Fast, inexpensive and proven processing*

*SprayMax Paint Repair: Complete product and module system*

*Ideal supplement for painting booths and spray guns”*

23. The remaining two pages show directions for use and the shape and coverage of the spray from the cans. Both of the marks relied on by the opponent are visible on the web pages.

24. This completes my summary of the evidence. I will refer to the submissions as necessary below.

## **DECISION**

25. First I will deal with the opposition based upon section 5(2)(b) of the Act which reads as follows:

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

(a)....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

26. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

27. The section 6A of the Act read as follows:

(1) This section applies where –

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
- (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

28. The relevant period during which the opponent is required to prove use of its mark is the five year period ending on the date of publication of the application, namely 28 July

2007 to 27 July 2012. The onus is on the opponent, under section 100 of the Act<sup>2</sup>, to show genuine use of its mark during this period in respect of those goods relied on or, alternatively, to show that there are proper reasons for non-use of the mark during this period.

### Use of the earlier mark

29. The opponent relies on two earlier marks, both Community marks, with identical specifications and both subject to proof of use. I intend to carry out the comparison based on CTM 365809, the word mark.

30. In reaching a conclusion in respect of use of the earlier mark, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use.

31. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

‘In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

(2) The use must be more than merely ‘token’, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

---

<sup>2</sup> “If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”



(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

32. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29. I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30. Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31. Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

33. The comments of Mr Justice Jacob in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

"20. The reason for bringing in the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pedantic way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

34. The comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (Espana), SL v OHIM, Case T- 126/03* are also relevant:

"45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub- divisions within the

category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

35. First, I have to identify, as a matter of fact, whether the trade mark relied on by the opponent has actually been used and if so, in respect of which goods. Having reached a conclusion on that point, I must then go on to decide what, from the perspective of the average consumer of the goods, constitutes a fair specification.

36. The opponent's evidence provided by Mr Kwasny, which has not been contested or challenged by the other side, shows a range of spray cans bearing combinations of both of the opponent's marks and the marks of third parties. Supporting literature and product brochures also show use of both marks. The word only mark is used in the forms, 'SprayMax' and 'SprayMax®'. The opponent's word mark is used in a standard typeface with the first and sixth letters presented in upper case. In accordance with section 6A(4)(a) of the Act<sup>3</sup> this slight variation does not alter the distinctive character of the mark.

37. The evidence shows turnover figures for 2007 to 2011, (mostly within the relevant period) and is said to include sales to a number of countries in Europe, including the UK. A breakdown of figures is only provided in respect of sales to France and Germany. Most of the invoices are in German, without translations and do not show either of the opponent's marks. They do show sales of products with codes LLS MAX and SM, which Mr Kwasny states are SprayMax products. Invoices are provided which show a number of sales to one UK address, amounting to a fairly low volume of sales of products which are listed in German. Some of the goods clearly include a colour such as 'avacado' or 'bubble pink' and are therefore likely to be paints. No advertising or promotional figures have been supplied. Whilst sample product leaflets and product brochures have been provided, these are either undated or dated outside the relevant period.

38. The evidence filed by the opponent is not perfect, however, considering the evidence as a whole, I am prepared to accept that the use shown is sufficient to demonstrate use of the mark within the relevant period for a range of goods for which it is registered. Having established that there has been genuine use, I must now go on to consider what constitutes a fair specification.

---

<sup>3</sup> *Reproduced at paragraph 31 above.*

39. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

40. Use of the mark for the opponent’s goods in class 2 is shown in respect products for use on forklifts, cars and automotives. All of these are vehicles, a term which is well known and easily defined by the average consumer. A fair specification for the opponent’s goods in class 2 is as follows:

Paints, varnishes, lacquers and painting preparation materials (included in class 2) all for use on vehicles.

41. I conclude that this is how the average consumer would describe the goods in respect of which the mark has been used and represents a fair specification (which is neither too broad nor too pernickety) and is the basis on which I intend to proceed to carry out the required comparisons.

42. In respect of its goods as registered in class 8 the opponent has shown evidence relating to its Fill Clean spray system. It is described as being able to be filled with a range of products which can be mixed to create any colour, for a wide range of applications. In its supporting literature the product uses are described as, inter alia, “*diverse applications; cars, commercial vehicles, industrial applications, construction sector, agricultural sector, rail, aircraft...*” I am content that the totality of evidence shows use of the opponent’s class 8 goods for the specification applied for and it is on this basis that I intend to proceed to carry out the required comparisons. The specification reads as follows:

Atomising devices, in particular for paints, varnishes, lacquers and painting preparation materials.

43. The opponent’s earlier mark is a community mark and the evidence provided, which includes sales breakdown figures for France and Germany, is sufficient to satisfy section 6A of the Act. The evidence is not sufficient, however, to conclude that the mark has enhanced distinctiveness due to the degree of use made of it in the UK.

### **Section 5(2)(b) case law**

44. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

### **The CJEU cases**

*Sabel BV v Puma AG* [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000]

F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) C-334/05 P.

### The principles

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

## The average consumer and the nature of the purchasing act

45. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

46. The average consumer of the goods at issue will be a member of the general public, carrying out their own painting and/or finishing; or they may be a professional. The goods may be sold through specialist retailers or through DIY stores and supermarkets. They may be bought from a catalogue, a shelf or online the purchase will be, for the most part, a visual one, especially considering that the purchase may require careful colour consideration. The goods will vary in price but will always require a fairly high level of attention to be paid, whether to select or match a colour or to purchase the correct apparatus for the job.

## Comparison of goods

47. The goods to be compared are as follows:

The opponent's goods	The applicant's goods
<p><b>Class 2</b> Paints, varnishes, lacquers and painting preparation materials (included in class 2);</p> <p><b>Class 8</b> Atomizing devices, in particular for paints, varnishes, lacquers and painting preparation materials.</p>	<p><b>Class 7</b> Spray Equipment</p>

48. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

*“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”*

49. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

- (a) the respective *uses* of the respective goods or services;
- (b) the respective *users* of the respective goods or services;
- (c) the *physical nature* of the goods or acts of service;

(d) the respective *trade channels* through which the goods or services reach the market;

(e) in the case of self-serve consumer items, where in practice they are found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

50. I also bear in mind the decision in *El Corte Inglés v OHIM* Case T-420/03, in which the court commented:

“96...goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi [2005] ECR II-685)”

51. In its submissions, dated 21 October 2013, the opponent states:

*“7. Taking the Applicant’s specification of goods - Spray Equipment - at face value, it does cover spray equipment for use with paints, varnishes, lacquers and painting preparation materials and could include such equipment fitted with atomising devices. As any visit to a DIY store will confirm, it is common practice for some manufacturers of paints, varnishes, etc. to promote and sell their products in association with appliances and equipment, including spray equipment, for use in their application. Thus we submit that the respective goods are highly similar.”*

52. The opponent’s goods in class 8 are atomising devices, particularly for paints, varnishes, lacquers and paint preparation materials. An atomiser is defined in Collins English Dictionary as:

*“A device for reducing a liquid to a fine spray.”<sup>4</sup>*

53. The applicant’s goods in class 7 are spray equipment. The users of both parties’ goods may be the same, either a professional or a member of the general public, wishing to spray something. Both parties’ goods may be used to spray any number of substances. The applicant’s specification is not limited to a particular use, the opponent’s suggests use with paints, varnishes, lacquers and painting preparation materials but is not limited to these goods. The opponent’s atomising devices may be small scale or larger industrial devices. The applicant’s spray equipment may include small handheld equipment of the type used by a hobbyist or large industrial machinery for large scale spraying. Both parties’ goods may be sold online, in stores or by mail order and are likely to be displayed in the same areas. The parties’ goods may be in competition and may also be complementary, used alongside one another, or one in place of the other. Taking all of these factors into

---

<sup>4</sup> Collins English Dictionary, © HarperCollins Publishers 2000

account I find the opponent's goods in class 8 and the applicant's goods in class 7 to be similar goods.

54. In my view the opponent's goods in class 2 are not as close to the specification of the mark applied for. However, there is a degree of complementarity between the goods, to the extent that spray equipment may be used to spray the opponent's goods in class 2. The users and uses may be the same and it is likely they will reach the end user via the same or very similar trade channels. They are also likely to be displayed near each other. Consequently, I find there to be a moderate degree of similarity between the opponent's class 2 goods and the applicant's goods in class 7.

### **Comparison of marks**

55. The marks to be compared are as follows:

<b>The opponent's mark</b>	<b>The applicant's mark</b>
SPRAYMAX	Spraymax Equipment

56. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components<sup>5</sup>, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

57. The opponent's mark consists of the single word 'SPRAYMAX' in plain block capitals. No part of the word is stylised or emphasised in any way. Consequently, the mark does not possess any distinctive or dominant elements, the distinctiveness lying in the mark as a whole.

58. The applicant's mark consists of the two words 'Spraymax' and 'Equipment' in title case. I have no hesitation in concluding that 'Equipment' is not distinctive in the context of the goods which are spray equipment. It simply describes the nature of the goods being provided. It is likely to receive little or no attention from the average consumer who. 'Spraymax' is the distinctive and dominant element of the applicant's mark.

### **Visual similarities and aural similarities**

59. The distinctive and dominant element of the applicant's mark is SPRAYMAX, which is the entirety of the opponent's mark. The additional word 'equipment' may or may not be articulated but in any case is not distinctive for the goods at issue. I find the parties' marks to be visually and aurally similar to a high degree.

---

<sup>5</sup> *Sabel v Puma AG, para.23*



## Conceptual similarities

60. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>6</sup> The assessment must be made from the point of view of the average consumer.

61. The word SPRAYMAX, the first word of the application and the entirety of the earlier registration, has a natural break between SPRAY and MAX, two well known words. Whilst the combination is not directly descriptive of the respective parties' goods, the marks allude to a quality of the goods. 'Max' may give the impression of, inter alia, maximum coverage, quality, longevity, of the goods concerned. In any event, however the average consumer considers the marks, the position will be the same for both parties' marks. The marks are conceptually highly similar.

## Distinctive character of the earlier mark

62. I must now assess the distinctive character of the opponent's earlier trade mark. The distinctive character of the opponent's earlier trade mark must be appraised first, by reference to the goods upon which I have found it has been used and, secondly by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

63. As I have discussed above, SPRAYMAX alludes to the nature of the goods at issue and consequently can only be of fairly low distinctiveness for spraying devices and the goods to be sprayed by those devices. I have already concluded that the evidence provided by the opponent is not sufficient to establish enhanced distinctive character through the use made of the mark.

## Likelihood of confusion

64. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>7</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

65. I have found the marks to be visually, aurally and conceptually similar to a high degree. I have found a fairly low level of inherent distinctive character in the earlier mark and have found the applicant's goods in class 7 to be similar to the opponent's class 8 goods and fairly similar to the opponent's goods in class 2. I have identified the average

---

<sup>6</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

<sup>7</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27.

consumer, namely a member of the general public or a professional and have concluded that the purchase will be primarily visual. The level of attention paid to the purchase will always be fairly high given that the goods require careful selection of, inter alia, colour and finish.

66. Taking all of these factors into account the similarity of the marks is such that even bearing in mind the low degree of distinctive character of the earlier mark and the level of attention being paid to the purchase, in the context of goods which are similar there will, in my view, be direct confusion (where one mark is mistaken for the other).

67. The opposition having succeeded under section 5(2)(b), I need not go on to consider the 5(3) grounds.

## **CONCLUSION**

**68. The opposition succeeds.**

## **COSTS**

### **Costs**

69. The opposition having succeeded, the opponent, is entitled to a contribution towards its costs. In making an award I have taken into account that the opponent filed evidence and that no hearing took place. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£200
Preparing and filing evidence:	£500
Official fee:	£200
Total	£900

70. I order Finishline Products to pay Peter Kwasny GmbH the sum of £900. 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 this 14<sup>th</sup> January 2014**

**Ms Al Skilton  
For the Registrar,  
The Comptroller General**