

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

**IN THE MATTER OF AN APPLICATION NO B1530280  
BY BONDAGLASS-VOSS LIMITED TO REGISTER  
A MARK IN CLASS 1**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 41998 BY W DAVID & SONS LIMITED**

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**DECISION**

20 On 19 March 1993 Bondaglass-Voss Limited of Beckenham, Kent applied under  
Section 17(1) of the Trade Marks Act 1938 (the old Act) to register the mark EASY SAND in  
Class 1 in respect of: "polyesters in the form of pastes for the repair and filling of holes and  
flaws in surfaces; all included in Class 1". The application is numbered B1530280.

25 On 10 February 1995 W David & Sons Limited filed notice of opposition to this application.  
The grounds of opposition are, in summary:

- i under Section 68, in that the term EASY SAND is not a trade mark;
- 30 ii under Sections 9 and 10, in that the mark is neither distinctive of nor capable  
of distinguishing the goods of the applicants from those of other  
manufacturers.

35 The opponents also cite Section 11. They ask the Registrar to refuse the application and to  
award costs in their favour.

The applicants filed a counterstatement denying these various grounds. They ask the  
Registrar to dismiss the opposition and to award costs in their favour.

40 Both sides filed evidence in these proceedings and the matter came to be heard on  
18 December 1997. At the hearing the applicants were represented by Mr John Fitzgerald, of  
Counsel, instructed by their trade mark agents Chancery Trade Marks. The opponents were  
represented by Mr Colin Birss, of Counsel, instructed by their trade mark agents Wildbore &  
Gibbons.

45 By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in  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. These

proceedings having begun under the provisions of the Trade Marks Act 1938 however, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, all references in this decision are references to the provisions of the old law.

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Opponents' evidence

In support of their opposition the opponents filed Statutory Declarations by: Colin David of Whetstone, London N20; Alec Brookshank of Bicester, Oxfordshire; Brian Michael Cotterell of Baldock, Hertfordshire, and Gary Johnson of Ealing, London W5. I turn first to consider Mr David's evidence.

Mr David, who is Joint Managing Director of the opponent company W David & Sons (his company), states that his company has manufactured and marketed a range of products named P38 EASY SAND since 1992. The letter and numeral P38 are his company's registered trade mark in the United Kingdom and many other countries says Mr David. The words EASY SAND are used purely to describe the easy-sanding properties of the filling compound in question he says, and states his belief that this term is and should be common to the trade.

Mr David gives approximate figures of his company's annual United Kingdom turnover in its P38 EASY SAND product since its introduction, as follows:

	<u>Year</u>	<u>£</u>	<u>No of Tins sold</u>
25	1993	1,157,500	805,673
	1994	1,060,511	733,171
	1995	895,964	617,776

Mr David exhibits a brochure and specimen price list mentioning his company's P38 EASY SAND product.

Mr David also exhibits a price list for competing products sold by Plastic Padding where the words EASY SAND are used in a similarly descriptive way. Turning to consider a photograph of a tin of the applicants' product (also exhibited) as sold alongside his company's product P38 EASY SAND, Mr David gives his opinion that it is clear from the appearance of the latter that the applicants' trade mark is in fact the letters ES and that the words EASY SAND are used as a description. Mr David states that he is not aware of any aspect of the get-up of the applicants' products which suggests to customers or to the trade that the applicants use the words EASY SAND in any way other than descriptively.

Finally, Mr David states that ease of sanding is one of the prime factors in describing the quality and benefits of his company's filling compound and is thus critical to the customer's decision to buy. He therefore believes that registration of the descriptive words EASY SAND by the applicants would unfairly restrict the present freedom of its competitors to use these words as an accurate description of their products.

I turn next to consider the evidence of Mr Alec Brookshank, who states that he is the Southern Area Sales Manager of Loctite UK Limited (LUK) and was previously National Sales Manager of Plastic Padding Limited, which was acquired by LUK in the course of 1994. He has been associated with Plastic Padding Limited and its successor, LUK for a total of more than 21 years and the information he gives comes from his personal knowledge, he says.

Mr Brookshank goes on to state that Plastic Padding Limited adopted the term EASY SAND in connection with its PP100 body filler in 1991. The product was sold through the Halfords chain of retail stores and through other distributors throughout the United Kingdom says Mr Brookshank. LUK continues to market this product using the words EASY SAND as part of the brand to describe the most important characteristic of the product from the customer's point of view, he says.

I next turn to consider Mr Cotterell's evidence. Mr Cotterell states he is employed by A.R. Davies Motor Factors of Baldock, Herts, and in the course of his work over several years he has become familiar with the body filler pastes sold by W. David & Sons Limited and Bondaglass-Voss Limited under the names P38 EASY SAND and BONDAGLASS VOSS ES (Easy Sand) respectively. Mr Cotterell goes on to state that he regards the term EASY SAND as descriptive of one of the main attributes of these products or indeed of any filler paste which can be sanded easily after application.

Finally, I come to the evidence of Mr Gary Johnson, who states that he is employed by Sayers Motor Factors of Ealing, London. He states that in the course of his work over 16 years he has become familiar with the body fillers pastes sold by W. David & Sons Limited and Bondaglass-Voss Limited under the names P38 EASY SAND and BONDAGLASS VOSS ES (Easy Sand) respectively. Mr Johnson confirms that he too regards the term EASY SAND "as descriptive of one of the main attributes of these products or indeed of any filler paste which can be sanded easily after application".

#### Applicants' evidence

In response to this the applicants filed Statutory Declarations by: Peter John Aird Owen of Beckenham, Kent; Keith Elmes of Canvey Island, Essex; L S Taylor of Tyne and Wear; Barry Redstone of Romford, Essex; Alan Davey of West Kingsdown, Kent, and Jeffrey Mendoza of Isleworth, Middlesex. I take first the evidence of Mr Owen.

Mr Owen states that he is the Managing Director of the applicant company, Bondaglass-Voss Limited (BVL). Mr Owen goes on to state that BVL first made use of the trade mark EASY SAND in the year 1979 in relation to a general purpose vehicle and body filler. Annual figures relating to sales of BVL's EASY SAND filler for each of the years from 1983 to 1993 are given by Mr Owen, as follows:

	<u>Year</u>	<u>Kilos</u>
	1983	57,630
	1984	76,477
5	1985	95,287
	1986	94,520*
	1987	93,409
	1988	120,938
	1989	146,846
10	1990	217,174*
	1991	228,642
	1992	233,087*
	1993	165,476

15 \* shown the same as on the Statutory Declaration.

The average trade price of a kilo of BVL's EASY SAND product is approximately £1.23 (excluding VAT), says Mr Owen.

20 Mr Owen goes on to state that the distribution of BVL's EASY SAND filler is on a national scale and has been supplied to major trade factors such as:

25 Dana Limited (formerly Brown Brothers Limited)  
Partco  
Spray Shop Supplies  
Spray Stores  
Maccess

30 When BVL introduced its EASY SAND filler says Mr Owen, the product was featured in a number of trade press editorials. Mr Owen exhibits copies of the said trade press editorials. While a number of them are undated, some are identified as:

	Bodyshop	July 1978
	Garage and Transport	March 1979
35	Auto Trade	January 1981
	Automotive and Commercial	
	Commercial Refinisher	April 1982
	Body	October 1984
	Auto Trade	February 1986
40	Builders Merchants Journal	January 1979

45 BVL does not have a complete set of price lists says Mr Owen, but he exhibits copies of BVL's price lists for the years 1981, 1985, 1986, 1991 and 1995 each of which clearly refers to EASY SAND filler, he says. Mr Owen also exhibits invoices and promotional material showing use of its trade mark EASY SAND.

Mr Owen makes various submissions relating to the opponents' allegations and in particular he clarifies the matter of Plastic Padding Limited's use of the term EASY SAND. It is true he says that that company did use the name EASY SAND on a filler product that they marketed to Halfords Limited. At or around the time this was done, says Mr Owen, he met  
5 with Mr Philip Scott then Marketing Director with Plastic Padding Limited. Mr Scott informed Mr Owen they were introducing as "own brand or private label" filler into Halfords Limited. Mr Owen states that he ascertained later that Plastic Padding Limited had lost the Halfords' business and assumed that no further use of the mark would be made. No formal exchange of letters was made with regard to this matter says Mr Owen, as it was a matter of  
10 trust and BVL had friendly relations with Plastic Padding Limited, he says.

Mr Owen also comments on paragraph 6 of Mr David's Declaration in which he asserts that BVL's trade mark is the letters ES and that the words EASY SAND are used as a description. This is not the case says Mr Owen, as firstly BVL's price lists referred to in paragraph  
15 (exhibited) make reference to the trade mark EASY SAND and make no reference to ES, he says.

Mr Owen points out that the opponents' use of the term EASY SAND dates from just one year prior to the application in suit and came some 13 years after BVL's first use of that  
20 term as a trade mark. Mr Owen points out that the opponents are themselves registered proprietors of the mark QUICK SAND (Registration No 1577839). Finally Mr Owen states his reasons for believing that his mark is registrable, and the opponents' "trade" evidence should be disregarded.

I now turn to consider the evidence of Mr Elmes, who states that he is a Director of Canvey Auto Refinishing Supplies Limited of Canvey Island, Essex. He has been employed in the car refinishing and repair business for over eight years, he says, and is familiar with the various names and terms used in this trade. Mr Elmes states that he associates the words  
25 EASY SAND with a polyester body filler produced by Bondaglass-Voss Limited. He is aware he says, that the words EASY SAND have been used by Bondaglass-Voss Limited since the early 1980s in relation to light weight filler, and he recognises the words EASY  
30 SAND as being a trade mark the exclusive property of Bondaglass-Voss Limited.

I take next the evidence of Mr Taylor. Mr Taylor states that he is the Managing Director of Spraymead Limited of Tyne & Wear. He has been employed in the car body repair and respraying business over 20 years he says, and hence he is "very familiar with the various names and terms used in this specialised trade". Mr Taylor goes on to state that he associates the words "EASY SAND" with a polyester body filler produced by Bondaglass-Voss  
35 Limited. He has known the words "EASY SAND" being used for over 15 years and associates them with a trade mark of Bondaglass-Voss Limited for their polyester body filler, he says. Finally, Mr Taylor states that he knows of no other use being made of the words  
40 EASY SAND in the trade and to him those words are the exclusive property of Bondaglass-Voss Limited.

Next, I turn to consider the evidence of Mr Redstone, who states that he is a Director of Car Colour Services Limited of Romford, Essex. He has been employed in the car body repair

and respraying business for 30 years he says, and is familiar with the terms and names used in that trade.

5 Mr Redstone goes on to state that to him the words “EASY SAND” mean easy to remove body filler when flatted with abrasive paper, and he associates those words with the body filler sold under that name by Bondaglass-Voss Limited. He has known the words “EASY SAND” being used as a trade mark by Bondaglass-Voss Limited for 3-5 years, he says.

10 I take next the evidence of Mr Alan Davey, who states that he is a Director of Blakestripe Limited, trading as Spraystore of West Kingsdown, Kent. Mr Davey goes on to state that he has been employed in the car spraying business for over 20 years and is familiar with the terms, names and trade marks used in that trade. He associates the words “EASY SAND” with a body filler he says and he recognises those words as being a trade mark belonging to Bondaglass-Voss Limited, he says. He has known the words “EASY SAND” being used as a trade mark by Bondaglass-Voss Limited for over 9 years in relation to a car body filler and to 15 him those words indicate a trade mark exclusive to Bondaglass-Voss Limited, says Mr Davey.

20 Finally, Mr Davey states that he is aware that others in the trade have attempted to use similar sounding brand names, but he again confirms that he associates EASY SAND only with Bondaglass-Voss Limited.

25 Lastly, I take the evidence of Mr Mendoza, who is Director of Lasmen Supplies Limited of Isleworth, Middlesex. Mr Mendoza states that he has been employed in the car body repair and respraying business over 28 years, and hence he is very familiar with the various names and terms used in that specialised trade. Mr Mendoza goes on to state that he associates the words “EASY SAND” with a body filler produced by Bondaglass-Voss Limited. He has known the words “EASY SAND” being used for over 10 years and associates them with a trade mark of Bondaglass-Voss Limited for their body filler, he says.

30 Finally, Mr Mendoza states that he knows of no other use being made of the words EASY SAND in the trade and to him those words are the exclusive property of Bondaglass-Voss Limited.

35 Opponents’ evidence-in-reply

In response to the foregoing, the opponents filed further evidence, a Statutory Declaration by Graham Keith Barlow of Erdington, Birmingham, and a second Declaration by Mr Brian Cotterell. I will take first the evidence of Mr Barlow.

40 Mr Barlow states that he is Joint Managing Director of Motor City Wholesale Ltd and has been employed with that company for approximately 17 years. He has 28 years experience in the trade he says and he confirms that the information he gives comes from his knowledge of the products used in the repair and maintenance of car bodies.

45

Mr Barlow goes on to state that for several years he has bought/used/sold the well-known range of car body fillers sold under the trade mark P38. The P38 range includes a grade of filler sold as EASY SAND, the meaning of which appears to Mr Barlow to be entirely self-explanatory, he says. He has bought/used/sold this product on many occasions and he does not believe that he or his customers have ever regarded the words EASY SAND as anything other than a description of the grade of product involved. It seems to Mr Barlow that the words can have no other meaning, he says.

Finally, I turn to consider Mr Cotterell's second Declaration. This however appears to do no more than reiterate his view that the term EASY SAND is descriptive of a filler paste which can be sanded easily after application.

With all this evidence in mind I now turn to consider the grounds of opposition.

At the outset I can dismiss the ground of opposition under Section 11 of the Act since the opponents confirmed at the hearing before me that they did not wish to pursue this ground.

The first ground of opposition to consider is that under Section 68 of the Act. The relevant part of this section reads as follows:

“68. - (1) ... "trade mark" means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person ....”

In support of his submissions that the mark applied for satisfies the criteria set down in Section 68, Mr Fitzgerald pointed to the fact that the mark has been used extensively for a long period of time by the applicants. There has been use in price lists and on invoices and a number of people from the relevant trade say that goods bearing this mark are identified with the applicants, Bondaglass-Voss Ltd.

On behalf of the opponents Mr Birss submitted that it is far from clear that the mark applied for is in fact a mark at all. His trade declarants say the mark is merely the descriptive words EASY SAND and if this is the case then it is difficult to see how these words could have any trade mark significance whatsoever.

I have carefully considered the respective submissions and taken account of how the applicants have used their mark. While the matter is far from being clear-cut I am prepared to accept that as the normal descriptive terms for this type of product are likely to be easy to sand or easily sanded I believe that the mark applied for may have some capacity to function as a trade mark and it therefore satisfies the requirements of Section 68.

The second ground of opposition is the claim by the opponents that the mark applied for is not capable of distinguishing the goods of the applicants from those of other traders. This ground goes to Section 10 of the Act which reads as follows:



5 “10 (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to the limitations, in relation to use within the extent of the registration.

10 (2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

15 (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

20 It is not in dispute between the parties that the mark at issue is not prima facie capable of distinguishing the applicants' goods. At examination stage I assume that prima facie objections were raised by the examiner under Sections 9 and 10 of the Act and that the applicants then supported their application by filing details of their user of the mark. The application was then allowed to proceed to advertisement under the provisions of Section 18 of the Act on the basis of Advertisement before Acceptance.

25 Acceptance of the mark is disputed by the opponents so I must consider the evidence filed in support of the mark in these proceedings in considering its capacity to distinguish.

30 The applicants say they commenced to use the mark EASY SAND in 1979 so user has extended over a considerable period. During this period user has been modest, increasing from about £75,000 in 1983 to some £350,000 (assuming an average price of about £1.50 per kilo). During this period the mark has always been used as a secondary mark in that at the outset it was used in conjunction with BONDAGLASS and BONDAPASTE and more recently with the stylised letters ES and the words BONDAGLASS PRODUCT.

35 There would appear to have been no advertisement of products under the mark EASY SAND. Mr Owen files a number of trade press editorials under Exhibit BV1 and it is included in product lists under the Bondaglass name. In this context in the 1981 price list it was used in the form BONDAPASTE EASY SAND for car body fillers and on its own in respect of “Dispenser refills” which appear to be larger sized cans of filler. Included also in this list are products named as SUPERCREAM, VII and HARDNER TUBES so the product list is not necessarily a list of distinctive marks. In the 1986 product list the EASY SAND product was described as “a general purpose polyester filler” but by 1991 the description had changed to “smooth and easy sanding” which in my view highlights the descriptive nature of the mark.

45 Mr Owen files a number of specimen invoices under BV3 which show references to EASY SAND under the heading “description”. Also included under this heading are other products such as “deep fill” and “wheel covers” so again such inclusions weaken the claim to

distinctiveness. Also included under BV3 is product literature issued by the applicants giving information about their products. The EASY SAND product is described as “easy to sand” and “easy sanding with low paper clogging”.

5 A number of declarations from trade sources are provided by the applicants. There appear to be from customers who use the applicants’ products and say they recognise EASY SAND as a mark of the applicants. This evidence appears to me to be of little assistance to the applicants since it merely states the obvious. I note for example that the trade declarations filed by the opponents say that they regard the mark EASY SAND merely as a descriptor and  
10 that other marks indicate origin.

To summarise, the applicants’ evidence shows that they have used the mark EASY SAND on a modest scale for a number of years prior to the date of application. All use has been in close association with the applicants other marks such as BONDAGLASS, BONDAPASTE  
15 and ESand the applicants’ goods have never been advertised or promoted under the mark EASY SAND.

At the hearing, Mr Fitzgerald on behalf of the applicants, argued that the mark at issue had through use come to identify the applicants’ products and he said it had quite rightly been  
20 allowed to proceed to advertisement by the examiner. He recognised of course that the mark has descriptive connotations but referred to earlier decided cases such as the Burberrys v J. C. Cording & Co Ltd case involving the trade mark “SLIP-ON” (Vol 1909) 26 RPC 693 and the PERFECTON case 26 RPC 837 where it is clear from comments made in the judgements that descriptive marks are not necessarily barred from registration.

25 In his submissions Mr Fitzgerald also made it clear that the applicants did not object to use by the opponents of other descriptive terms such as easy to sand”; “easy sandable”, etc. They did, however, object to the opponents’ use of what they think is their mark EASY SAND. On behalf of the opponents Mr Birss said that one must consider the mark at issue in a practical  
30 fashion. The fact that it might not be grammatical did not assist in hiding its descriptiveness. He referred to the level of acquired distinctiveness set down by Jacob J in British Sugar Plc v James Robertson & Sons Ltd as necessary to justify, in that case, the registration of the laudatory word TREAT and compared it with the evidence of distinctiveness filed by the applicants in these proceedings. In this case no evidence whatsoever has been filed to show  
35 how the public react on encountering the applicants’ mark or indeed if they considered it a trade mark at all.

In the EUROLAMB case 1997 RPC 279, The Appointed Person, Geoffrey Hobbs QC held that the mark EUROLAMB would be understood as an abbreviation of “European Lamb” and  
40 in this case Mr Birss said he was of the opinion that the applicants’ EASY SAND mark would indicate to the general public a product which is easy to sand. Mr Birss also referred to the PROFITMAKER case 1994 RPC 613, where Mr Hugh Laddie QC, the Secretary of State’s Hearing Officer, said that where a mark is descriptive and laudatory, as here, the fact that honest traders have a number of alternative ways of describing a product is no answer to  
45 criticism of such a mark. If it were, then all those ways could, on the same argument, also be

the subject of registered marks. The honest trader should not need to consult the register to ensure that common descriptive or laudatory words had not been monopolised by others.

5 Both Counsel in their submissions referred to the TORQ-SET case 1959 RPC 344 where Lloyd Jacob J said at page 346 lines 37 to 39:

10 “Part B of the Register is intended to comprise marks which in use can be demonstrated as affording an indication of trade origin without trespassing upon the legitimate freedom of other traders.”

15 In this case the applicants have not demonstrated to my satisfaction that their mark EASY SAND does in fact distinguish their goods from other traders. It is my view that origin is indicated by other brand names such as BONDAPASTE or BONDAGLASS and that the mark EASY SAND is more likely to be seen by the vast majority of the public as merely a  
20 descriptive and laudatory term. It is also clear from the evidence before me that other parties in this field wish to use the term EASY SAND in a descriptive fashion, for fillers which are easily sanded, and they should be free to do so. I, therefore, believe that registration would trespass on the legitimate freedom of other traders and that being the case I have reached the conclusion that registration should be refused. The opponents thus succeed in this ground of their opposition.

In conclusion, therefore, I have found the opponents to be successful in these proceedings in their ground of opposition under Section 10 of the Act.

25 There remains the matter of the Registrar’s discretion but I see no need for any exercise of that discretion.

30 As the opponents have been successful in these proceedings they are entitled to a contribution to their costs. I hereby order the applicants to pay to the opponents the sum of **£885**.

**Dated this 3<sup>rd</sup> day of February 1998**

35

**N A HARKNESS**  
**Assistant Registrar of Trade Marks**  
**For the Registrar**  
40 **the Comptroller General**