

TRADE MARKS ACT 1994

**IN THE MATTER OF Application N^o: 2204287
in the name of W David & Sons Limited**

and

**Opposition thereto under N^o: 51068 by
Akzo Nobel Coating International BV.**

1. W. David & Sons Limited trading as U-POL, Ridgemount House, 1 Totteridge Lane, Whetstone, London, N20 0EY applied for the mark PLAST 'X' on 28th July 1999, for:
 - Class 1: 'Adhesives and adhesive substances; plastic filler paste'.
 - Class 2: 'Paints; plastic priming preparations in the nature of paint.'
 - Class 3: 'Cleaning preparations'.
2. The opponents, Akzo Nobel Coating International BV, have one ground of opposition to registration of the above mark, based on s. 5(2)(b) of the Act, and their earlier registration of the mark PLASTOFLEX for 'Paints; varnishes (other than insulating varnish); lacquers' in Class 2 (registration N^o: 1234737).
3. A Counterstatement was provided by the applicants, in which the grounds are denied. Both parties ask for costs to be awarded in their favour.
4. No hearing was desired by the parties, and my decision here is based on the evidence submitted. I summarise this as follows.
5. Helen Whelbourn, a trade mark attorney of the firm acting for the opponents, is their sole declarant. She submits that, in her opinion, the marks PLAST'X (sic) and PLASTOFLEX are visually and phonetically the same. Customers of PLASTOFLEX might reasonably conclude that the apostrophe at the end of PLAST would be seen as an abbreviation, and therefore PLAST'X could be seen as a diminution of PLASTOFLEX.. Further, if spoken at speed the marks could be confused. She also points out that the applicants' goods in Class 2 are identical to those of the opponents.
6. The applicants enclose a Witness Statement and a Statutory Declaration. The former, by Gloria Parmesan a trade mark assistant acting for the applicants, consists of evidence about the state of the UK register. As a result of her searches she submits that the prefix PLAST is relatively common in Class 2, and therefore constitutes a prefix in which no one trader can claim a monopoly. She also submits that, according to her understanding of recent judgements of the European Court of Justice (ECJ), elements in a mark common to the trade should be given less weight when considering whether marks are confusingly similar.

7. The applicants' Statutory Declaration is by Jean-Charles Julien, a director of U-POL. He says that the mark in suit has been misrepresented in Helen Whelbourn's evidence; it is not PLAST 'X but PLAST 'X'. Thus the letter 'X' is not preceded by an apostrophe at all, and therefore would not be seen as a diminution of PLASTOFLEX.
8. He says that the company has used the mark since February 1997 and the products sold under the mark are sold to wholesale distributors who, in turn, supply professional end users. Exhibits to his statutory declaration show the mark in promotional use, distributor details, sales figures and articles about the product in a third party magazine and website.
9. He concludes by saying that, as far as he is aware, there has never been any confusion between his company's product and Akzo Nobel's PLASTOFLEX product. If his mark was likely to be seen as an abbreviation then he would have expected some confusion to have already arisen.

Decision

10. The sole ground of opposition is section 5(2)(b); this reads:

'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,

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

11. The opponents' registration is an earlier mark, by virtue of s. 6(1) of the Act. I will consider the goods in Class 2 only as these, as the opponents point out, are identical in both sets of specification. If the opponents cannot succeed here, they will not do so with the rest of the applicants' goods in Classes 1 and 3.
12. The opponents have not supplied any evidence of use of their mark, and so I am left with a strict comparison of marks and goods, unclouded with an enhanced 'penumbra of protection' which, in so many words, the relevant case law imbues marks which have a highly distinctive character resulting from use on the marketplace (*Sabel BV v Puma AG* [1998] RPC 199 page 8, paragraph 24).
13. Even keeping in mind that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] ETMR 1, at page 7, paragraph 17), I do not find that there is a likelihood of confusion as required under section 5(2)(b). The opponents' evidence – and the onus is with them in this matter - represents flimsy 'opinion' evidence of little, if no, probative worth. It also materially misrepresents the applicants mark: PLAST'X is not the same as PLAST 'X'. In my opinion, PLAST 'X' is unlikely to be seen as a diminution of PLASTOFLEX, as the 'X'

in PLAST 'X' is given an existence, and significant emphasis, *apart* from the prefix PLAST. That is, the structure of the mark tends, in my view, to stress the X, giving prominence and some degree of separation from the PLAST element of the mark. Further, the opponents' mark consists of three syllables, and I do not accept that the 'O' and 'FL' sounds would be easily lost, even in rushed speech.

14. As I have found the marks unlikely to confuse in any event I need not go any further. But there a couple of additional factors which, whilst not determinative of themselves, tend to reinforce my conclusion. To the best of his knowledge, the applicant has said that no instances of confusion have as yet occurred, despite the applicant's mark being in use since February 1997. I note also that the goods for which the mark is applied for are not apparently sold direct to the public at large, but to wholesale distributors and then professional end users. Such users are likely (I would put it no higher than that) to have more circumspection than a member of the public, browsing the shelves of his or her DIY store.
15. Finally, I have taken no account of the 'state of the register' evidence supplied by the applicants. It is now trite law that such material cannot be determinative of market place use of a mark, or part thereof, as here, where the PLAST prefix is proposed as a common abbreviation of PLASTIC.
16. However, in all the circumstances the opposition is dismissed and the application may proceed to registration.
17. The applicant having successfully defended the application is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £900. This sum to be paid within seven days of the expiry of the appeal or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19TH Day of December 2001.

**Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller General**