

O-325-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 2492827  
IN THE NAME OF HARMAN TECHNOLOGY LIMITED  
IN RESPECT OF THE TRADE MARK**

**OPALJET**

**AND**

**OPPOSITION THERETO (NO 98642) BY  
PRIPLAK**

## **THE BACKGROUND AND THE PLEADINGS**

1) Harman Technology Limited (“Harman”) applied for the trade mark OPALJET on 16 July 2008. The mark was published in the Trade Marks Journal on 21 November 2008 in respect of the following goods in class 16:

Paper, plastic, fabric or film based media used as a printing substrate in ink jet printers.

2) The registration of the above mark is opposed by Priplak, the proprietor of UK registration 1440661 for the trade mark OPALINE which is registered in class 17 in respect of:

Plastics and other synthetic materials in sheet form; sheets of printable synthetic material; sheets of printable polypropylene; sheets of printable coated polyethylene; all included in Class 17

3) Priplak’s mark forms the basis of claims under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Its mark was filed on 20 September 1990 and it completed its registration procedure on 1 November 1991. The relevance of these dates are that: i) the mark constitutes an earlier mark as defined by section 6 of the Act, and ii) that the proof of use provisions set out in section 6(A)<sup>1</sup> apply meaning that the use conditions set out in those provisions are relevant in these proceedings. Priplak also relies on the use of the sign OPALINE since 1996, such use being the basis of a claim under section 5(4)(a) of the Act, the relevant rule of law pleaded being the law of passing-off.

4) Harman filed a counterstatement denying the grounds of opposition. Harman put Priplak to proof of use. Both sides filed evidence. Neither party requested a hearing or filed written submissions.

## **THE MATERIAL DATES**

5) In relation to the section 5(2)(b) and 5(3) grounds, the material date at which the questions must be assessed is the date of filing of the trade mark the subject of the dispute, namely 16 July 2008. In relation to the use conditions, they must be met in the five year period ending on the date of publication of the opposed mark. The relevant period is, therefore, 22 November 2003 to 21 November 2008.

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<sup>1</sup> See section 6A of the Act, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

6) Under section 5(4)(a), the material date is also the date of filing of the mark in dispute<sup>2</sup>. However, the position at an earlier date may also be relevant if Harman were able to establish a senior user status, or that there has been common law acquiescence or that the status quo should not be disturbed due to there being a concurrent goodwill<sup>3</sup>. I will come back to this if it is relevant to do so.

## **THE EVIDENCE**

### **Priplak's evidence**

7) A witness statement is provided by Mr Simon Lewis. Mr Lewis is Priplak's marketing director. He has worked for Priplak since 2003 and has held his current position since 2006. Mr Lewis states that OPALINE was first used in the UK in 1989 and continues to be used. Such use is said to be in relation to "plastics and other synthetic materials in sheet form, sheets of printable synthetic material, sheets of printable polypropylene". The products are said to be point of sale materials, packaging and stationery, all of polypropylene. The total market of such products is said to be around 7000 tonnes per year, and that 45% of this is comprised of products of the quality and price of those of the OPALINE mark. OPALINE is said to comprise around 35% of the total UK market for products in this category.

8) Priplak sells its goods to a distributor, Robert Horner Group Ltd ("RHGL"), to satisfy customer orders. Figures for such sales between 2003 and 2008 are provided. The wholesale values range between 2,289,000 EURO and 1,635,000 EURO (showing a downwards trend) and the amount in tonnes ranges between 1305 and 845. A large number of invoices and corresponding order confirmations, from 2004, 2005, 2006 & 2008 are provided in support. Most of them feature the words PRIPLAK OPALINE. Some have just the word OPALINE together with a description such as "tints"/"clear natural". The invoices also refer to the number of sheets in the pack and, also, what I take to be indications of thickness. A good number of the invoices carry the words "sheets of polypropylene" to identify the products. The other invoices carry codes. Mr Lewis provides a sample pack of polypropylene sheets to show that the codes on the invoices match the codes on the OPALINE samples, which account for a good many of the samples provided. A small device appears above the word OPALINE.

9) It is stated that Priplak and RHGL have advertised OPALINE for many years. In the period 2003-2008 the expenditure was over £50,000. Literature is also

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<sup>2</sup> See the comments of the General Court ("GC") in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07

<sup>3</sup> See, for instance: *Croom's Trade Mark Application* [2005] R.P.C. 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] R.P.C. 42.

produced to promote and support sales, an example is provided dated October 2004. It is called PRIPLAK NEWS. Various brands are contained including OPALINE. It is to be noted that OPALINE is listed under what appears to be a category heading of OPALESCENT. The document explains that “the shades of the material produce particularly attractive opalescent effects”.

10) Also provided by Mr Lewis are i) a technical data sheet on which “Opaline” is listed as a translucent product, and ii) a brochure dated 3 June 2004 containing a similar data sheet within a page containing swatches of products including Opaline.

### Harman’s evidence

11) A witness statement is provided by Mr Garry Hume, Harman’s Large Format Business Principal. He has held this position since October 2007 prior to which he was sales and marketing director of Kentmere Photographic Limited (“Kentmere”). Mr Hume states that OPALJET was first used in the UK in 2000 by Kentmere and that it was acquired by Harman in 2007<sup>4</sup>. He says that since launch it has been used continuously. Sales figures are provided for the years 2000-2008. They range from £65,000 to £2,490,000 (an upwards trend). Advertising and promotional expenditure has ranged between £0 and £29,000 (again, an upwards trend).

12) Mr Hume provides in Exhibit GDH1 what he describes as a local area (South East England) salesman’s report for 2002. It contains a large number of entries, including sales of OPALJET products. Exhibit GDH2 contains price lists dated between 2001 and 2004 for some of the dealers who sell OPALJET. One is RHGL which sells OPELJET under the category “SPECIALIST DISPLAY FILM”; the other lists provided show the product listed under the same category. A product catalogue produced by Kentmere is provided in Exhibit GDH3 from October 2003. OPALJET is one of the products featured; it is, again, under the heading of DISPLAY FILM.

13) Mr Hume states that the OPALJET product has been advertised and promoted in various trade magazines and trade shows such as Sign UK. Various promotional material is provided in Exhibit GDH4 consisting mainly of what seem to be printed advertisements – when and where they were published is not clear. One has a handwritten date of 2003. Exhibit GDH5 contains slides from a training presentation given by Kentmere to RGHL (a stockist of both OPALINE and OPALJET). The OPALJET product is referred to in the presentation; it is referred to as being “totally opaque”. Mr Hume considers that OPALJET has a reputation for inkjet coated media.

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<sup>4</sup> As this is not challenged, the acquisition is accepted as fact.

## **THE PROOF OF USE PROVISIONS**

14) As stated earlier, the proof of use provisions apply to Priplak's earlier mark. The relevant legislation reads:

### **“6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) 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, ...

(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...”

15) Section 100 is also relevant which reads:

“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.”

16) The use conditions must be met in the relevant period of 22 November 2003 to 21 November 2008. The earlier mark is a UK registration so the genuine use must be in the UK. I bear in mind the leading authorities on the principles to be applied in determining whether there has been genuine use of a trade mark, namely, the judgments of the Court of Justice of the European Union (“CJEU”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). It is also worth noting the Court of Appeal’s (“COA”) judgment ([2006] F.S.R. 5) in the latter of these cases when it had to apply the guidance given by the CJEU. From these judgments the following points are of particular importance:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);

- there is no requirement that the mark must have come to the attention of the end user or consumer (*La Mer* (COA), paragraphs 32 and 48);

- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*La Mer* (COA), paragraph 34);

-the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*La Mer* (COA), paragraph 44).

17) I also note i) *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-39/01 [2003] ETMR 98 where the General Court (“GC”) stated:

“47 In that regard it must be held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned.”

and ii) *Laboratoire De La Mer Trade Mark* [2002] FSR 51 where Jacob J stated:

“9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye -- to ensure that use is actually proved -- and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

18) Priplak’s factual evidence has not been challenged. It has provided sales figures for the five years of the relevant period and a large number of invoices covering at least four of those five years. This is certainly not token use and represents a real business interest. Although the sales are made to RHGL, a distributor, this cannot be characterised as merely internal use. The companies are quite separate. In any event, the function of a distributor is to distribute the goods on the market. There is no suggestion that the goods are re-branded. The invoices carry the words PRIPLAK OPALINE. This is suggestive of a primary/sub brand designation. Such use constitutes use of OPALINE. The samples carry the word OPALINE with a small device above it. I take the view that this also represents use of OPALINE, the device not really forming an overall combined mark. OPALINE is also used alone on brochures etc. Based on all of the above, the OPALINE mark has been genuinely used during the relevant period.

19) It is necessary to decide upon a fair description for the goods for which genuine use has been shown and which falls within the parameters of the specification and the statement of use. The description must not be over picky<sup>5</sup>. It is necessary to consider how the relevant public would describe

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<sup>5</sup> See *Animal Trade Mark* [2004] FSR 19.

the goods<sup>6</sup>. The GC in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* held:

“43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

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 sub-categories relating to which the goods or services for which the trade mark has actually been used actually 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

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<sup>6</sup> See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32.

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.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

20) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. 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."

21) Priplak's specification reads:

"Plastics and other synthetic materials in sheet form; sheets of printable synthetic material; sheets of printable polypropylene; sheets of printable coated polyethylene; all included in Class 17"

22) In its statement of case Priplak made a statement of use reading:

"At least "plastics and other synthetic materials in sheet form; sheets of printable synthetic material; sheets of printable polypropylene", and possibly all goods."

23) It is readily apparent from the evidence that only one product is sold under the OPALINE mark, namely sheets of polypropylene. This can clearly be seen from the descriptions on some of the invoices and, furthermore, where codes are used the corresponding samples relate to polypropylene sheets. The evidence also demonstrates that the purpose of the sheets is for printing. It is not as though the sheets are sold for any other purpose or application. The specification

and statement of use includes the term “sheets of printable polypropylene”. This is what the goods are. In respect of the other terms, I am not satisfied that they represent a fair description of the goods. No evidence is provided as to whether the goods used would fairly be described as plastics or other synthetic material. The absence in the first term of “printable” also introduces a far broader term as it would cover all forms of sheeting used across a whole range of purposes and applications, many of which may require different manufacturing processes. It seems from the evidence that “polypropylene sheets” (albeit printable) is used to describe the product. Whilst the goods are specific to point of sale material etc, it would be pernickety to include this in any specification. It is considered that a fair description of the goods used, when the specification and statement of use is borne in mind, is “sheets of printable polypropylene”. In relation to the grounds of opposition under sections 5(2)(b) and 5(3), the earlier mark will be considered on this basis.

### **SECTION 5(2)(b) OF THE ACT**

24) Section 5(2)(b) of the Act reads:

“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,

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

25) In reaching my decision I have taken into account the guidance provided by the CJEU in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

26) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc.*).

### **Comparison of the goods**

27) In making an assessment of goods similarity, all relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

28) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(a) The respective uses of the respective goods or services;

(a) 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 respectively 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. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

29) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“It is true that goods are complementary if 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 those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

30) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>7</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>8</sup>.

31) Finally, when comparing the respective goods, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play<sup>9</sup> even if there may be other goods within the broader term that are not identical.

32) Harman seeks registration of its mark for:

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<sup>7</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>8</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

<sup>9</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)*(OHIM) Case T-133/05 (“Gérard Meric”).

“Paper, plastic, fabric or film based media used as a printing substrate in ink jet printers”

33) This must be compared to:

“sheets of printable polypropylene”

34) Self-evidently, both sets of goods are for printing upon. The closer of the goods are plastic and film based media (compared to sheets of printable polypropylene) as they are plasticity in nature as is polypropylene. It is unclear whether sheets of printable polypropylene differs from the various media in class 16 in terms of nature and method of use. It may be that the class 16 goods consist of media for insertion into a printer (an inkjet printer) whereas the class 17 goods are “rawer” in terms of material, which can then be cut to size, printed upon and used for various applications. Whilst this may be so, the nature is still similar (plasticity), and there is still a degree of overlap in terms of method of use. It is clear that both sets of goods may be sold through the same trade channels. For example, RHGL are Priplak’s distributor and they have also stocked Harman’s goods. All things considered, there is a high degree of similarity in terms of plastic and film based media. There is less similarity with paper and fabric media on account of the difference in nature. The purposes overlap as they are all still for printing, but the final applications may differ. I consider there still to be at least a reasonable degree of similarity.

### **The average consumer**

35) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

36) Priplak’s goods are printable polypropylene sheets. From its evidence, it does not appear that these are the type of things sold to the general public. They seem to be items sold either to specialist printers or specialist manufacturers to produce point of sale materials, packaging and stationery. They could be purchased by a company with the in-house facilities to produce such items rather than them using a specialist printer or specialist manufacturer. The characteristics that such an average consumer will possess include having a reasonable degree of technical knowledge together with a more cautious approach to buying the goods. The precise characteristics of the product will be considered so as to ensure that it is fit for purpose and of the appropriate quality. The goods are likely to be purchased in reasonably large amounts to fulfil a print/package run. All of this indicates a purchasing process that is more

considered than the norm, although, there is no evidence to lend support to the proposition that it will be the most highly considered of all potential purchases.

37) Some of Harman's goods fall in the same category (plastic and film media) as it is clear from the evidence that these are sold through the same trade channels. Such goods, given the overlap of average consumer, is where there is a greater potential for a likelihood of confusion. In relation to paper and fabric media, there is no reason why such goods could not relate to the same average consumer also. Such goods, particularly paper, may also be sold to the general public. When this is the case the purchasing process will be less well considered.

38) In terms of the ordering process, both sides have provided brochures etc. Visual considerations are, therefore, clearly important. I do not, though, ignore the importance of aural similarity as orders can, of course, particularly business to business orders, be placed over the phone or in person.

### **Comparison of the marks**

39) The marks under comparison are: OPALJET and OPALINE

40) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

41) It is noted that Priplak, in its statement of case in relation to section 5(2)(b), stated:

"The first and prominent element in the opposed mark is the word "opal". This is identical with the portion "opal" in the earlier right. This element is believed distinctive in context, though suggests that the product may have some opal-like characteristic, such as, for example, opalescence.

The latter element of the opposed mark is the word "jet". Whilst this does differ from the –"line" suffix of the earlier right, it is relatively non-distinctive in the context of a material for use in ink-jet printers. The earlier right could also be considered as an elided form of the words "opal" and "line", "line" in this context also being relatively lacking in distinctiveness. The similarity that the public will recall will therefore lie with the "opal" portion, and it is submitted that this will lead to a likelihood of confusion."

I also note that in relation to its 5(4)(a) case it added:

“The distinctive element of the mark OPALINE is clearly the opening word “opal”, this being identical with the opening word “opal” in the Applicant’s mark. Materials for printing cannot literally be said to share the characteristics of opal and hence use of the mark OPALJET by the applicant on identical goods can only be intended to suggest an association with the opponent and to cause a misrepresentation as a result of which damage to the opponent will result.”

42) Harman responded in its counterstatement thus:

“The only similarity in the Applicant’s and Opponent’s marks is the prefix OPAL. As mentioned by the Opponent in its Notice of Opposition OPAL may be seen as describing a characteristic of the product i.e. that it is opalescent, and is widely used in the industry. Therefore the only element shared by both marks has a low degree of distinctive character.

43) Harman stated that OPAL is widely used in the industry. Regrettably, it did support this by way of evidence. Priplak stated that materials for printing cannot literally be said to share the characteristics of opal, yet in their own evidence they categorised their OPALINE product as an opalescent material and used that word descriptively. In view of this, it seems that OPALESCENT is certainly a word which would send a simple descriptive message and, by extension, OPAL will simply be seen as a contraction of that word. It is a suggestive word at best, descriptive at worst. Strictly speaking, the marks in question are not composite multi-element marks, they consist of one word OPALJET/OPALINE, although it is still necessary to consider if, in the event that the consumer is likely to consider them as conjoined or elided words, whether one of the words will take on more importance than the other, so performing the more distinctive role. For the reasons assessed I do not consider that OPAL will stand as the dominant and distinctive element of either mark. I consider the net effect to be that the dominant and distinctive element is the relative combination OPALJET/OPALINE. This is so even though JET may also be a suggestive word (of goods to be used in ink jet printers); the mark will be viewed as a combination of two suggestive words neither dominating the other which stand together rather than being seen as two separate independent elements. The same can be said of the word LINE which Priplak claims may be seen as a non-distinctive word indicating the OPAL “line” of products; for the reasons set out below, I do not consider this to be the likely reaction to the mark.

44) In terms of the resulting similarities, the presence of the word OPAL in both marks creates an inevitable degree of visual and aural similarity. The point of similarity is at the beginning. This, though, is tempered by the differing endings. Whilst I note Priplak’s statement that OPALINE may be seen as an elision of the words OPAL and LINE, the construction has a whole word feel, whereas OPALJET will more clearly be seen as the words OPAL and JET conjoined.

OPALINE is in fact a word in its own right (which I refer to below) which supports this proposition. This impinges on both the visual and aural degree of similarity. I consider there to be a moderate, neither high nor low, degree of visual and aural similarity.

45) In terms of concept, and considering the marks in totality, the concepts are not identical. Nevertheless, there is a degree of conceptual similarity on account of both marks making at least a suggestive reference to goods with an opalescent characteristic.

### **The distinctiveness of the earlier mark**

46) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent perspective the word OPALINE actually means opalescent<sup>10</sup>. For the reasons already given this means that, inherently, the earlier mark is low in distinctive character. This is so even if the mark were perceived as OPAL and LINE elided.

47) Priplak has provided evidence of the use it has made of the OPALINE mark. The use made of a mark may enhance its distinctive character. The mark is claimed to have been used since 1989, however, I have only the statistics for the five year period 2003-2008 to go on. Whilst, on the face of it, there seems to be a not insignificant amount of sales, what this really equates to is difficult to establish without market context. An attempt was made to explain what is OPALINE's market share. However, Mr Lewis first seems to subdivide the market with reference to particular goods (polypropylene printable sheets for point of sale, packaging etc) and then subdivides this with reference to products of the same quality and price of OPALINE (45% of the former) and then provides an estimate of a market share of 35% of this. This sub-division approach waters down the claimed market share and also leaves the tribunal in a mathematical conundrum. Either way the market share is not exactly clear. The best I can say is that the distinctive character of the earlier mark will have been enhanced to some degree, although it is not safe to infer that such enhancement has resulted in it being a highly distinctive mark.

### **Conclusions under section 5(2)(b)**

48) It is clear that all the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors

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<sup>10</sup> See Collins English Dictionary – 5<sup>th</sup> Edition.

from the viewpoint of the average consumer and determining whether they are likely to be confused.

49) I will firstly consider the position in relation to Harman's plastic and film media in the first instance. Given the high degree of similarity and the overlapping average consumer, if Priplak cannot succeed here then it is unlikely to succeed with the other goods. The goods are highly similar but the marks only moderately so. The earlier mark may have an enhanced degree of distinctiveness (from its low starting point) but I have not found that it is enhanced to a high degree of distinctiveness. Harman highlights the concurrent trading of the parties. The case-law advocates a cautionary approach when considering confusion-free parallel trade claims<sup>11</sup>. However it is clear that both parties have traded at the same time (at least five years, perhaps longer) and that they sell to the same people. This latter point is highlighted by RHGL stocking, at some point in time, both products. Whilst the actual goods sold, printable film against printable polypropylene, are not identical, they are still highly similar. No instances of confusion have been highlighted by Priplak. This could, of course, mean that confusion has simply not been reported and come to Priplak's attention. However, trade in such a similar field for such a length of time, through the same types of stockists will have provided fertile ground for confusion.

50) That there has not, apparently, been confusion, is symptomatic of my view on whether there exists a likelihood of confusion. Despite the close field involved, and despite there being a moderate degree of similarity, it is my view that the common presence of the word OPAL in the respective marks will be put down to a co-incidental use of a suggestive word rather than use of the same element to indicate a shared economic connection. The construction of the marks and the nature of the words within them means that the average consumer is more likely to recall the totality of the marks. The differences are enough, in my view, to mean that there is no likelihood of the consumer mistaking one mark for the other. Indirect confusion must also be borne in mind, where, despite a noticed difference, the similarity between the marks is still put down to there being an economic connection between the suppliers of the goods. However, for similar reasons, the common presence of OPAL within the marks, when the totalities are considered, will not lead the average consumer to assume that the goods come from the same stable. The use and distinctiveness of the earlier mark, when all the circumstances are considered, does not improve Priplak's argument. **There is no likelihood of confusion.**

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<sup>11</sup> Whilst Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the marketplace, a number of decision express caution about the circumstances in which it is appropriate to give these factors weight (see the Court of Appeal in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, Laddie J in *Compass Publishing BV v. Compass Logistics Ltd* [2004] RPC 41 at 809 and the Court of Appeal in *Phones 4U Ltd v. Phone 4u. co. Uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45.)

51) As stated earlier, the opposition in relation to the other goods stands no better prospect of success. To the extent that the other goods are targeted at the same average consumer then, for similar reasons, there is no likelihood of confusion. To the extent that the average consumer is a member of the general public then there is even less potential because the average consumer of Priplak's goods are different. **The opposition under section 5(2)(b) fails.**

### **Other grounds of opposition**

52) I do not consider Priplak to be in any better position under section 5(4)(a) than it is under section 5(2)(b). Even though Priplak may have possessed a protectable goodwill at the material date, the issues discussed above in relation to confusion equally apply in relation to the potential for a misrepresentation to occur. Furthermore, Harman's evidence of use goes back to the year 2000 whereas Priplak's evidence goes back to only 2003. Although I note Priplak's statement that its use commenced in 1989, there is no evidence that the tribunal can use to assess whether it had a protectable goodwill in 2000, when Harman began its use. Harman has, at the very least, a concurrent goodwill of at least 8 years standing. In these circumstances, and as indicated in paragraph 6, **the claim under section 5(4)(a) cannot succeed.**

53) In relation to section 5(3), whilst Priplak may have succeeded in establishing a reputation, the strength of that reputation, coupled with the suggestive meaning behind the word OPAL, is unlikely to have resulted in a link being made. Even if it was, I am far from satisfied that any advantage, let alone unfair advantage, would have accrued to Harman as the average consumer will merely put the common presence of the word OPAL down to the co-incidental sharing of a suggestive word and, therefore, I do not see why the reputed image, if there is one, of the earlier mark will transfer to Harman's mark. Furthermore, Harman's mark has been used since the year 2000. There is no evidence that Priplak had a reputation at this point so the registration by Harman of a mark it had been using for so long (and before the reputation of Priplak) would count as due cause. **The section 5(3) ground would fail.**

### **Costs**

54) Harman has been successful and is entitled to a contribution towards its costs. I hereby order Priplak to pay Harman Technology Limited the sum of £1100.

Preparing a statement and considering the other side's statement - £500

Filing evidence and considering Priplak's evidence - £600

55) The above sum should 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 23 day of September 2011**

**Oliver Morris  
For the Registrar  
The Comptroller-General**