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THE PATENT OFFICE

Harmsworth House,
13-15 Bouverie Street,
London EC48DP.

Tuesday, 1st April 2003

Before:

MR. G. HOBBS QC
(The Appointed Person)

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In the matter of THE TRADE MARKS ACT, 1994.

and

In the matter of Application No. 2204593 by Linseal
International Limited to register the
mark OKO in Class 1

and

In the matter of Opposition No. 50491 thereto by the
Hokochemie GmbH

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Appeal of the Applicant from the
Decision of Mr. J. MacGILLIVRAY

- - - - -

(Transcript of the Stenograph Notes of Marten Walsh Cherer
Ltd., Midway House, 27/29 Cursitor Street, London EC4A 1LT.

Telephone No: 020-74055010 Fax No: 020-74055026)

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MR. TOM COSTELLO (of Linseal International Limited) appeared
for the Applicant.

DR. WOLFGANG MUNK (of Hokochemie GmbH) appeared for the Opponent.

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D E C I S I O N
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(As approved by the Appointed Person)

1 THE APPOINTED PERSON: Linseal International Limited is the
2 proprietor of United Kingdom registered trade mark
3 No. 1585175, consisting of the following device:



4 registered, as of 15th September 1994, as a trade mark for
5 use in relation to: "Chemical preparations for use in the
6 manufacture, treatment and repair of tyres; sealants;
7 preparations for repair of tyres and for preventing
8 punctures in tyres; all included in Class 1."

9 The registration is entitled to the benefit of the
10 presumption of validity contained in Section 72 of the
11 Trade Marks Act 1994.

12 Hokochemie GmbH is the proprietor of International
13 Trade Mark (UK) No. 701295, consisting of the following
14 device:



1 protected in the United Kingdom, with a date of designation
2 of 31st July 1998, as a trade mark for use in relation to
3 various goods and services in Classes 1, 2, 5, 31, 39 and
4 42.

5 The specification of goods in Class 1 reads as follows:

6 "Chemicals used in science, agriculture, horticulture and
7 silviculture; unprocessed plastics; chemicals for
8 industrial, scientific, photographic, as well as
9 agricultural, horticultural and silvicultural processing
10 purposes; products for folia, soil and hydroponic
11 fertilisation; vine disease preventing chemicals;
12 carbolineum for the protection of plants; plant growth
13 regulating preparations; seed preserving substances;
14 chemical additives for biocides, fuel oils and abrasives;
15 biological preparations other than for medical or
16 veterinary purposes; microorganism cultures for (non-
17 medical use); **but not including any such goods being**
18 **preparations for use in the manufacture, treatment or repair**
19 **of tyres, or for preventing punctures in tyres, and not**

1 *including sealants."*

2 I understand that the exclusion at the end of the
3 Class 1 specification was inserted during the course of
4 examination in the UK Trade Marks Registry with a view to
5 overcoming the obstacle to registration represented by
6 Linseal's earlier trade mark registration No. 1585175.

7 Hokochemie's international registration is also
8 entitled to the benefit of the presumption of validity
9 contained in Section 72 of the 1994 Act.

10 On 31st July 1999, Linseal applied, under No. 2204593,
11 to register the designation **OKO** as a trade mark for use in
12 relation to the goods in Class 1 for which registration
13 1585175 had already been granted with effect from 15th
14 September 1994.

15 The application was accepted and published for the
16 purposes of opposition in accordance with the provisions of
17 Section 38 of the 1994 Act.

18 On 3rd December 1999, Hokochemie gave notice of
19 opposition contending, inter alia, that registration should
20 be refused under Section 5(2)(b) of the 1994 Act on the
21 ground that use of the designation **OKO** in relation to the
22 goods of interest to the applicant, Linseal, would conflict
23 with the rights to which the opponent was entitled as
24 proprietor of the earlier International Trade Mark (UK)
25 701295.

26 The objection to registration under Section 5(2)(b) was
27 upheld by Mr. MacGillivray, on behalf of the Registrar of
28 Trade Marks, in a provisional decision issued on 28th June
29 2001. He affirmed his provisional decision on 29th August

1 2002, following completion of the procedure for
2 registration of the opponent's International Trade Mark
3 (UK) and ordered the applicant, Linseal, to pay £550 as a
4 contribution to the opponent's costs of the opposition
5 proceedings.

6 In essence, the Hearing Officer concluded that the
7 designation **OKO** and the mark protected by the opponent's
8 international registration were distinctively similar and
9 that the goods in Class 1 for which they were respectively
10 proposed to be registered and registered were similar on
11 the following basis: "The Class 1 specification of the
12 opponent's mark is wide and includes chemicals for
13 industrial processing purposes. This would include
14 chemicals for use in the manufacture, treatment and repair
15 of rubber products; not tyres, by virtue of the exclusion.
16 The applicant's specification includes chemical
17 preparations for use in the manufacture, treatment and
18 repair of tyres. It seems to me, given that 'tyres' are
19 manufactured from rubber, both sets of goods i.e. the
20 chemicals or chemical preparations (the raw product), are
21 likely to be produced and sold by the same manufacturer or
22 processor and would be suitable for use both in relation to
23 tyres and other rubber products without any separate
24 adaptation. Therefore, the physical nature of the goods
25 would be the same and the uses, users and trade channels
26 would overlap. Accordingly, I find that the respective
27 specifications include similar goods."

28 He considered that the similarities were such as to
29 give rise to a likelihood of confusion within the meaning
30 of that expression as interpreted in the case law of the

1 European Court of Justice.

2 In September 2002, Linseal gave notice of appeal to
3 an Appointed Person under Section 76 of the Act, contending
4 that the Hearing Officer had erred in upholding the
5 objection under Section 5(2)(b). At the same time, it
6 applied for a declaration of invalidity in respect of the
7 opponent's International Trade Mark No. 701295 on the basis
8 that the registration of it must, if the Hearing Officer's
9 decision in the present case is correct, have conflicted
10 with the rights to which it was entitled as proprietor of
11 the earlier trade mark registration No. 1585175.

12 In the context of Linseal's appeal, Hokochemie
13 supports the Hearing Officer's decision and reasoning in
14 the present opposition proceedings. However, in the
15 context of Linseal's application for a declaration of
16 invalidity, it seeks to emphasise the differences between
17 the mark protected by its International Trade Mark (UK)
18 and the mark protected by Linseal's earlier registration
19 and also the differences between the relevant
20 specifications of goods.

21 It appears to me that in the circumstances I have
22 outlined, there is a real need to reduce the risk of the
23 Hearing Officer's decision in the present opposition
24 proceedings being upheld inconsistently with the decision
25 that may, in due course, be issued in the Trade Marks
26 Registry in relation to the application for a declaration
27 of invalidity that has been filed by Linseal on the basis
28 of its earlier trade mark registration No. 1585175.

29 For that reason, and taking account of the matters

1 I have discussed with the parties during the course of
2 this hearing, I think the right course is for the present
3 appeal to be suspended pending the outcome of the
4 application for a declaration of invalidity now proceeding
5 in the Trade Marks Registry. I will give each of the
6 parties liberty to apply for the appeal to be restored for
7 further hearing in the event that circumstances should
8 change in a way that makes it appropriate or desirable for
9 the suspension to be lifted.

10 The costs of today's proceedings will be reserved,
11 to be dealt with when the appeal is dealt with
12 substantively in due course.

13 Thank you very much for attending. That is my
14 decision for today.

15 MR. COSTELLO: Thank you.

16 DR. MUNK: Thank you.