

O-248-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2400543
BY ANDURA TEXTURED MASONRY COATINGS LIMITED
TO REGISTER THE TRADE MARK ANDURAGUARD IN CLASS 2**

AND

**IN THE MATTER OF OPPOSITION No. 94097
BY RPM/BELGIUM N.V.**

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BACKGROUND

1. On 1 September 2005 Andura Textured Masonry Coatings Limited applied to register the mark **Anduraguard** in respect of “paints, varnishes, lacquers, protective coatings” (Class 2 of the International Classification system).

2. By Form TM7 filed on 1 November 2006 this application is opposed by RPM/Belgium, N.V. (RPM). RPM is the proprietor of CTM No. 1897032, DURAGARD HY-BUILD registered for

“Paints, varnishes, lacquers, elastic coatings (paints) reinforced with fibres, for the waterproofing and protection of walls and facades against atmospheric, chemical and corrosive influences.”

3. The opponent submits that DURAGARD forms the most distinctive part of the mark DURAGARD HY-BUILD due to its nature and prominent position and that the visual and phonetic similarities are such that taken with identical and/or similar goods there will be a likelihood of confusion contrary to Section 5(2)(b) of the Act. A separate claim based on Section 56 that is to say a claim to well known trade mark status was abandoned during the course of proceedings.

4. The applicant filed a counterstatement denying the above ground and offering a number of detailed submissions in relation to the marks and the nature of its trade. I will come to these in due course.

5. Only the applicant filed evidence. Neither side has asked to be heard. Both sides have filed written submissions. Acting on behalf of the Registrar I give this decision.

Applicant's evidence

6. Danny Bayer, the Operations Director of Andura Textured Masonry Coatings Limited has provided a statement. He firstly describes the circumstances that led to the adoption of the trade mark Anduraguard. In relation to the product itself he makes the following main points:

- the masonry coating supplied is a specialist waterproof treatment that is thicker than ordinary masonry paint and needs to be sprayed on with specialist equipment.

- the product is only sold to “authorised dealers” who have the specialist skills and equipment to correctly apply the product.
- in addition to these authorised dealers the single largest recipients of the product are companies directly associated with Andura.
- it is only this supply to Andura associated companies where the product is branded Anduraguard. The branded product is not otherwise available for purchase.
- the branded product has never been sold through retail, wholesale or trade outlets.

7. Mr Bayer conducted an internet search and exhibits at DB1 and 2 a copy of the Home Page and Company Profile for Duragard Hybuild. This shows one address only in Belgium.

The law

8. Section 5(2)(b) reads:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

9. An objection under Section 5(2)(b) requires me to consider whether there are similarities in the marks and similarities in the goods that cumulatively, lead to a likelihood of confusion. The leading guidance from the European Court of Justice is contained in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

10. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG* paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V. paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; Sabel BV v. Puma AG paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; Sabel BV v. Puma AG paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; Sabel BV v. Puma AG paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); Sabel BV v. Puma AG paragraph 26;
- (h) further, 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; Marca Mode CV v. Adidas AG and Adidas Benelux BV paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc, paragraph 29.

Basis for the comparison of goods

11. It will be apparent from my above review of the applicant's evidence that it places considerable emphasis on the specialised nature of the product, the particular method by which it is marketed (through associated companies) and the controlled nature of the use generally. None of these considerations is reflected in the specification of goods. Furthermore it will generally be inappropriate to refer to such matters in specifications.

12. In contrast it is said that the opponent has not demonstrated any sort of presence in the UK market. The earlier trade mark relied on by the opponent did not complete its registration process until 20 November 2001. Accordingly, the opponent was not

subject to the requirement to make a statement of use pursuant to The Trade Marks (Proof of Use, etc) Regulations 2004 at the date of publication of the application in suit (see Section 6A(1)(c)).

13. The consequence of that state of affairs is that I must proceed on the basis of assumed notional use of the earlier trade mark across the full range of goods for which it is registered. Likewise with the applied for goods I must consider the matter on the basis of what it is notionally open to the applicant to do within the scope of the specification and not what its current trading and marketing methods are. The latter point is well established in the case law of the European Court of First Instance. Thus in *Daimler Chrysler v OHIM*, [2003] E.T.M.R. 61:

“Whether or not there is a marketing concept is of no consequence to the right conferred by the Community trade mark. Furthermore, since a marketing concept is purely a matter of choice for the undertaking concerned, it may change after a sign has been registered as a Community trade mark ...”.

14. Although that observation arose in the context of assessing a mark’s distinctiveness, it is also relevant in the context of assessing relative grounds objections. As to the latter the following is from *Croom’s Trade Mark Application* [2005] R.P.C. 2 where the Appointed Person, on appeal, held that:

“31 When assessing the objections to registration in the present case, it is necessary to assume normal and fair use of the marks for which registered trade mark protection has been claimed. The context and manner in which the marks have actually been used by the applicant and the opponent in relation to goods of the kind specified may be treated as illustrative (not definitive) of the normal and fair use that must be taken into account.”

15. That comment arose in the context of a suggestion to exclude haute couture clothing as a means of distinguishing between the competing claims of the parties in that case. It follows from all this that I am obliged to consider notional use of the respective specifications as they stand and not restrict the comparison to the particular circumstances of the applicant’s current trade. There are good reasons why this should be the case. Commercial plans and marketing methods change over time. Trade marks can also be assigned. A new owner would be entitled to make normal and fair use of the mark across the full breadth of the specification. A new owner’s use would not be circumscribed by the marketing methods or particular trading circumstances of the previous owner.

Comparison of goods

16. The goods are:

Applicant’s	Opponent’s
Paints, varnishes, lacquers, protective coatings.	Paints, varnishes, lacquers, elastic coatings (paints) reinforced with fibres, for the waterproofing and protection of walls and facades against atmospheric, chemical and corrosive influences.

17. It was held by Professor Annand in *Galileo Trade Mark*, O-269-04, that "... overlapping specifications satisfy the test for identical goods or services in Section 5(1) of the TMA. There is no necessity for such specifications to co-extend". On that basis it is immediately apparent that the opponent's paints, varnishes, lacquers are described in somewhat more detailed and specific terms than those of the applicant. They are in effect particular examples of the types of goods covered by the applied for specification. To put the matter another way the applicant's specification embraces the goods of the earlier trade mark. They cover identical goods. The term protective coatings in the applied for specification has no direct equivalent but 'elastic coatings ... for protection ...' are again simply a sub-category of the broad term. I find that these goods, too, are identical.

Comparison of marks

18. The marks to be compared are DURAGARD HY-BUILD and **Anduraguard**. The distinctive and dominant components of marks must be taken into account. An issue arises in relation to the earlier trade mark as to where its distinctive character lies. Is it evenly spread throughout the mark or dominated by one or other of the elements? In this respect it is well established that consumers will generally place less emphasis on elements of marks that are descriptive of the characteristics of the goods.

19. Key guidance on how to approach issues of similarity involving composite signs can be found in the ECJ's judgment in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case C-120/04 where it was held that:

"29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

20. The parties differ in their approach to the mark DURAGARD HY-BUILD. The opponent claims that the element DURAGARD forms the most distinctive part of the mark. The applicant denies this and submits in its counterstatement that “The mark comprises the combination of 4 descriptive elements: “DURA” for durable; “GARD” meaning guard or protect; “HY-BUILD” meaning that the protective coating builds up to give a high/thick layer. The DURAGARD element is no more distinctive than the HY-BUILD element”.

21. The applicant’s submission seeks to break down the earlier trade mark into what it considers to be its constituent parts. As a matter of record DURAGARD is presented as a single word/element and HY-BUILD in hyphenated form.

22. Firstly, as regards the element DURAGARD, DURA- is not to the best of my knowledge an acknowledged abbreviation of the word ‘durable’. Though it may hint at that word it is an extreme contraction or part word. GARD is not an alternative spelling for ‘guard’ but may in certain contexts be readily understood to be a contraction of that word. Deciphering the possible meanings behind the component parts of DURAGARD therefore relies in large measure on the mark being seen in a context where durable protection would be a relevant feature or characteristic. I accept that that may well be the case in the context of masonry coatings. But even then one would normally talk about protective coatings/protection rather than using the word guard (as to which see the words used in the respective specifications). In summary DURAGARD is made up of a part word (DURA) coalesced with a misspelling (GARD) of a word that is not naturally employed in the context of the goods. That is not to say that the word as a whole would not be taken as carrying some allusive reference to desirable properties of the underlying goods. However, the whole is an invented word which employs a measure of disguise. Given that the average consumer is not usually credited with analysing marks I would go so far as to say that some people might not pause to work out the possible derivation. Others may understand the underlying allusion but would regard it as being several steps removed from an outright descriptive reference.

23. The opponent has not commented on the element HY-BUILD as such. The applicant says that it means that “the protective coating builds up to give a high/thick layer”. Evidence as to the terminology used in the trade would have been helpful on this point. I note that the applicant uses the words ‘builds up’ in interpreting this element of the earlier trade mark. There are pointers to how the term is used/seen in Exhibit DB1. I note in particular that the website page shows the opponent’s mark presented as Duraguard® Hy Build. That sends the clear message that the opponent regards the first word as being the distinctive and registrable element. The product

sold under the mark is described as “a high solids, acrylic based wall coating ...” The inference is that the solids in the coating product give it a high or textured finish. Without more evidence on the point I cannot comment further save to say that HY-BUILD appears to lend itself to a descriptive interpretation. On the other hand I am not prepared to say that it has no capacity to contribute to the overall distinctive character of the mark. My overall conclusions on distinctive and dominant components are that:

- the component elements of the mark do not create a meaningful totality
- DURAGARD is the first and more distinctive element
- it may be taken by some as alluding to certain qualities of the underlying goods but only obliquely so
- it has an independent distinctive role within the composite sign (per *Medion* paragraph 30)
- HY-BUILD is less disguised in its make up and may be taken as a descriptive reference to a characteristic of the product though without evidence I cannot be wholly confident on this point.

24. That brings me to the normal visual, aural and conceptual comparison. The comparison must be a whole mark comparison but bearing in mind my above findings on the distinctiveness of the individual components.

25. The applied for mark incorporates in slightly contracted form the whole of the first element of the earlier trade mark. I say contracted form because there is the difference between the –GUARD and –GARD endings. In reality this is a slight difference and one that is likely to go unnoticed when the suffixes appear in longer words. The first element of the applied for mark, AN-, has no counterpart in the earlier trade mark. The element HY-BUILD is not present in the later mark. The visual similarities and differences are evenly balanced.

26. Phonetically, **Anduraguard** consists of four syllables whereas DURAGARD HY-BUILD is a three syllable and two syllable combination. In my view the stress is likely to be on the second syllable of Anduraguard but on the first syllable of DURAGARD. The significances of that is that the emphasis in each is on the common element and also that it weakens the importance of the first syllable An-. The structure, stress and rhythm of the two words is, therefore, highly similar and the different spelling of the final syllable will not be apparent in oral references to the marks.

27. On the other hand I do not accept the opponent’s submission that distinguishing will be made more difficult because “... a customer ordering the Opponents product could say “I will have xyz and DURAGARD ...” which could then easily be confused with ANDURAGUARD”. That seems to me to be altogether too strained. I do not forget that the opponent’s mark contains an additional element, HY-BUILD. However, it has a subordinate position in the mark and is more likely to be seen and heard as being a subordinate characteristic or feature of the main mark that is to say the HY-BUILD version of the DURAGARD product.

28. I have already commented on the potential descriptive/allusive qualities of the elements/marks. I regard both marks as being invented words notwithstanding that

varying degrees of descriptiveness/allusiveness can be discerned in their make-up. But I regard the visual and phonetic similarities to be more important than conceptual ones in appraising these marks.

The average consumer and the purchasing process

29. Paints, varnishes, lacquers and protective coatings may be sold either to the public at large through the normal retail outlets or to trade or specialist users. The applicant's goods are said to be directed at the latter market and to require special equipment. This state of affairs is not reflected in the specification of goods. I must, therefore, consider the full range of potential customers. Trade users or those with specialist skills and knowledge are likely to be more informed about branding matters and to be better placed to differentiate between brands not least because of their day to day familiarity with what is available. Members of the public purchasing products of this kind for home use are likely to be far less familiar with the market. Items such as masonry coatings are by their nature applied on an infrequent basis. Imperfect recollection will play a part in the purchasing process in these circumstances.

30. I might just add for the benefit of the applicant who is not professionally represented in these proceedings that the Court of First Instance has held that where there is not a single homogenous consumer group it is possible for a likelihood of confusion to exist for one group but not another. An example of this can be found in *Mundipharma AG v OHIM* Case T-256/04. That case involved prescription pharmaceuticals but the principle involved is equally applicable where, as here, there is a professional user group as well as members of the general public.

31. In terms of the amount of care that is likely to be exercised, paints and coatings etc. are not particularly expensive items. Nor are they necessarily cheap. Some care needs to be exercised in the purchasing process to ensure that the chosen product is suitable for the intended purpose, has the desired characteristics, is the desired colour etc. I would expect a reasonable degree of care to be exercised in the purchasing process but as I have suggested above familiarity in relation to branding issues is likely to be tempered by the occasional nature of purchases of these products by the non-professional consumer.

Likelihood of confusion

32. It is well established that likelihood of confusion is a matter of global appreciation taking all relevant factors into account. In *esure Insurance Limited* and *Direct Line Insurance plc* [2007] EWHC 1557(Ch) Mr Justice Lindsay held that:

“56. A “likelihood” is not a probability; the requirement is less stringent than that. Learning from a quite different area of the law suggests that where “likelihood” is unqualified by other words (e.g. “more likely than not”) then it requires no more than that there is a real prospect that the material consequence – here confusion – should exist – consider *In re Harris Simons Construction Ltd* [1989] 1 WLR 368 per Hoffmann J. and the cases cited in the 2007 White Book at note 24.2.3.”

33. The judge also noted the distinction that is to be drawn between direct confusion, where the public confuses the sign and the mark in question, and indirect confusion where the public does not mistake one mark for the other but makes a connection between them and as a consequence is confused into thinking they have a common trade source. These situations are to be distinguished from mere association where the public connects the mark and the sign (a bringing to mind) but is not led to make any consequential inference as to common trade origin.

34. I have already commented on the distribution of distinctiveness in the opponent's composite word mark and found it to be front-end loaded on the element DURAGARD. That element is an invention that, for some at least, may carry an allusion to certain underlying properties of the goods but in general terms enjoys an average degree of distinctiveness. The mark ANDURAGUARD is similar to DURAGARD HY-BUILD when the marks are compared as wholes and they are for use in relation to identical goods.

35. Assuming in the applicant's favour that HY-BUILD is taken to make a contribution to the overall character of the earlier trade mark then the difference between the respective marks are sufficient to prevent direct confusion. However, the similarities are such that, allowing for imperfect recollection, there is a real likelihood of indirect confusion. This would arise because consumers, particularly non-professional ones, would see the applied for mark either as a derivative form of the earlier trade mark or would consider that it was being used on a related product line from the same supplier or an economically linked undertaking. The opposition succeeds under Section 5(2)(b).

36. The opponent is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1000. 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 28th day of August 2007

**M REYNOLDS
For the Registrar
The Comptroller-General**