

TRADE MARKS ACT 1994

**APPLICATION No 2154506 BY ALEXANDER DUCKHAM & CO
LIMITED TO REGISTER A TRADE MARK IN CLASS 4**

THE TRADE MARK BEING REPRESENTED AS:

“The mark consists of the colour green added to and integrated with the goods covered by the registration, which as a result are wholly and inseparably green as defined by Pantone No 3435”

**AND OPPOSITION TO THE PROPOSED REGISTRATION BY FUCHS
LUBRICANTS (UK) Plc UNDER No 50834**

BACKGROUND

1. On the 24 December 1997 Alexander Duckham & Co applied to register a trade mark represented by the words:

“The mark consists of the colour green as added to and integrated with the goods covered by the registration, which as a result are wholly and inseparably coloured green.”

2. The goods for which registration is sought are “engine oils for road vehicles”.

3. The Registrar’s Examiner raised a number of objections to the application, including an objection that the trade mark as presented in the application was not graphically represented. On 20 February 1998 the applicant provided a revised representation of the trade mark, which is as follows:

“The mark consists of the colour green added to and integrated with the goods covered by the registration, which as a result are wholly and inseparably green as defined by Pantone No 3435.”

4. The Examiner accepted this revised representation of the trade mark as being sufficiently precise as to satisfy the requirements of the Act and the Rules. The application was subsequently accepted on the basis that the applicant had shown that the mark had acquired a distinctive character through use prior to the date of the application, and it was published for opposition purposes.

5. On 22 March 2000, Fuchs Lubricants (UK) Plc filed Notice of Opposition to the proposed registration. The grounds of opposition (insofar as they are pursued before me) are that registration would be contrary to:

i) Sections 1(1) and 3(1)(a) in that the mark is not capable of distinguishing the applicant’s goods because the colour of oil is not visible at the point of purchase and does not therefore serve a trade mark function, and further that colour alone, divorced from any other identifying matter, is not capable of distinguishing the applicant’s goods;

ii) Section 3(1)(b) of the Act in that the mark applied for is devoid of distinctive character;

iii) Section 3(1)(c) of the Act in that the mark consists exclusively of a sign which may serve, in trade, to designate the kind, quality or other characteristics of the goods;

iv) Section 3(1)(d) of the Act in that the mark consists exclusively of a sign that has become customary in the practice of the trade;

v) Section 39(2) of the Act because the representation of the mark in the original application failed to comply with Section 32(2) of the Act, and the subsequent amendment was not permissible because it was not an error of wording or copying and it substantially affected the identity of the mark.

6. In the alternative to grounds i-iii above, the opponent contends that registration would be contrary to Section 5(4)(a) of the Act because the opponent, and other oil retailers, have used the colour green in engine and other oils and gained reputation and goodwill in such products so that use of the mark applied for would be contrary to the law of passing-off.

7. The applicant filed a counterstatement denying that the mark applied for is excluded from registration by section 3(1)(a) or 3(1)(d) of the Act, refusing to admit the trade mark is excluded by Section 3(1)(c) and claiming that the opponent had insufficiently particularised its case under this section for it to be able to respond effectively, and refusing to admit the ground pleaded under Section 5(4)(a). In response to the allegation of lack of distinctive character, the applicant claims that it has used the mark applied for since 1951, that it has extensively advertised the goods in such a way as to communicate the fact that its goods are coloured green, and that as a consequence of such use and promotion the trade mark had become distinctive in fact by the date of the application for engine oils for motor vehicles. The applicant denies that the amendment of the trade mark was contrary to Section 39(2) of the Act or, in the alternative, argues that until the revised version of the mark was filed there was no application and that the applicant is therefore at least entitled to the date when the revised version of the mark was received by the Registrar.

8. Both sides seek an award of costs.

9. The matter came to be heard on 5 February 2003 when the applicant was represented by Ms E Himsworth of Counsel, instructed by BP Trade Marks, and the opponent was represented by Ms J Reid instructed by Swindell & Pearson.

10. Shortly before the hearing took place, Advocate General Leger gave his Opinion in case C-104/01 Libertel before the European Court of Justice (ECJ). The case arose as a result of a reference from a Benelux court seeking clarification from the ECJ on the registrability of colours as trade marks under the Trade Marks Directive 104/89. As the law in the UK is based upon the same Directive, there was clear scope for the decision of the ECJ to have a bearing on this case. Consequently, I allowed the parties a period of time to submit further written submissions as to the significance, if any, of this case. I have had the benefit of written submissions from both parties.

THE EVIDENCE

11. Both sides filed a considerable volume of evidence, much of which consists of arguments about the other side's evidence or relates to matters that I consider to be of limited relevance to the outcome of these proceedings. I have carefully considered all this

evidence. The summaries that follow concentrate of what I consider to be the important aspects of the evidence.

SUMMARY OF THE APPLICANT'S EVIDENCE

12. Mr Robert Hadfield gives evidence on behalf of the applicant. He explains that in 1955 the applicant brought a new multi-grade engine oil to the market designed for car drivers. A means was sought to distinguish the new oil from the applicant's existing oils and it was decided to do this by adding a dye known as Sudan Green. Mr Hadfield says that the applicant has worked to maintain the colour of its oil, although there is some evidence that the dyes used to achieve the colour were changed in 1975.

13. Mr Hadfield provides sales figures for the applicant's green coloured engine oils from 1973 to 1997. These figures show that the applicant sold nearly 38 million litres of green coloured oil in 1973. Sales subsequently reduced through the 1970s. Sales in 1980 were running at just over 20 million litres per annum. Despite the introduction of new oils (branded Hypergrade and Hypergrade Plus) the volume of sales continued a slow decline whilst nevertheless continuing to represent a substantial volume of engine oil. By 1997, the applicant's sales of green oils had reduced to just over 6 million litres per annum. The applicant provides prices for its oils per 5 litre pack, suggesting that this is the most usual unit of sale. As one would expect with such a product, sales have occurred throughout the UK.

14. Mr Hadfield also provides figures for the amount the applicant spent promoting its engine oils in the years 1971-1988. The amount spent increased steadily during this period peaking at £2.4M in 1988. However, these figures appear to comprise the applicant's total promotional spend on its green coloured engine oils and not just the amount spent on adverts promoting the colour green as a feature of the goods. Rather oddly, although Mr Hadfield provides an estimate of £3M for promotional expenditure in 1998 (following a major relaunch in that year) he does not provide such figures for the 9 year period prior to the filing of the application (1989-1997).

15. Examples of the applicant's promotional material are exhibited to Mr Hadfield's evidence. Exhibit RFK6 contains some promotional material from the 1960s, which includes a rather low key message that the applicant's engine oil is green. Exhibits RFH7-9 consist of photographs of publicity stands for the applicant's products. The applicant points out that these feature an enlarged green oil droplet and the slogan "Duckhams – pure, green protection". However, there is no evidence as to the dates of these particular photographs.

16. The applicant further relies upon exhibit RFH10, which consists of a copy of the applicant's "Quest" magazine from the early 1970s. It appears to have been a magazine the applicant offered for sale to motoring enthusiasts. Somewhat buried in the text of an article on page 3 is a statement that the applicant's new Q20-50 engine oil will still be green.

17. RFH12 consists of some promotional material from the early 1980s for the applicant's then new Hypergrade engine oil. The device of a green oil droplet is used in some of these adverts, which also reveal that the get-up of the applicant's blue and yellow can was changed at this time to include a stylised representation of green oil pouring down the front of the can. Exhibit RFH14 shows a picture of the applicant's "top-up pack" of engine oil with luminous green oil being poured into an engine.

18. Exhibit RFH16 consists of copy pages from the applicant's in-house magazine from Spring 1998. On one of the pages there is an inset box with the question "Did you know" and the statement "Duckhams is the only lubes product which is actually coloured green". Exhibit RFH17 consists of a video made by the applicant in 1997 entitled "Duckhams Vox Pop", wherein one member of the public (out of a number in the video) makes an apparently spontaneous association between the colour green and Duckhams oil. Mr Hadfield provides no information about the circumstances in which this video came to be made or what its purpose was. It could therefore be a promotional video scripted by the applicant or its advisors. I do not therefore consider it to have any evidential value. I mention it only because my attention was specifically drawn to it at the hearing.

19. Evidence of further adverts linking the colour green with the applicant's oils is contained in exhibit RFH25. These are adverts from the period 1979-82 featuring the green oil droplet symbol, and the slogans "pure, green protection" and "pure green success".

20. Exhibit RFH26 is a video consisting of the applicant's TV advertising for the period 1978-1993 some of which inform the public through imagery or words that the applicant's oils are green.

21. Mr Michael Lynskey is the Consumer Technical Support Team Leader for Lubricants UK Limited whose ultimate parent company is BP plc (BP). The applicant is also a member of the BP group of companies and Mr Lynskey therefore gives evidence on the applicant's behalf. He has relevant experience in the trade in lubricants. Mr Lynskey says that, in his experience, most engine oils for road vehicles are naturally coloured brown. He lists the disadvantages of dyeing engine oils green. These are essentially that adding a green dye increases the cost of manufacture and distribution of the finished product (because of the potential for contamination of non-dyed oils). He accepts that oil that is to be used in petrol/oil two stroke mixes is generally dyed. Mr Lynskey says that the colour varies from company to company but is generally red or blue.

22. Mr David Martyn also works for Lubricants UK Limited. He gives evidence that in April 2002 (when he completed his witness statement) the total engine oil market in the UK amounted to 150 million litres per year. He explains that this is comprised of workshop sales (to garages and dealers), which accounts for 90 million litres, and retail sales, which account for the rest. Retail sales are broken down into forecourt sales accounting for 16-17 million litres per annum (which are not audited), and the rest of the retail market, which is audited by GfK Marketing Services. Mr Marten says that the applicant had 11% of the total audited retail market in the period February 1997-January

1998 with a sales volume of 3.9 million litres representing turnover of approximately £7.6M. He notes that the opponent's product is not listed in the GfK figures.

23. Mr Martyn accepts that the colour of the applicant's engine oil is not visible to the consumer at the point of purchase. However, he points out that up until about ten years ago lubricants were sold in cans that were too cumbersome for personal users to pour oil directly into their engine. Consequently, the user would decant the oil into a receptacle before use and would therefore see the colour of the oil. He says that users may also see the green colour on the dipstick of their car for the first 200 miles of use after an oil change. After this the colour of the oil is no longer green but changes to a brown colour. The significance of this is said to be that a consumer who has asked for Duckhams oil to be used in his car during servicing can see by the colour of the oil on their dipstick that their request has been met.

24. Mr Martyn also says that the applicant supplies oil direct to the garage trade, and that this is generally delivered in bulk tanks of 1000-2000 litres. However, most garages will have more than one product and the storage tanks will be carefully labelled with the grade of oil and the brand. He points out that the applicant has three grades of oil which are coloured green and suggests that garage staff can identify the manufacturer of the oil from the colour but must then read the label on the tanks to tell the grade of oil.

25. Michael Frost is a technical manager who works for ExxonMobil. Between 1996 and 2000 Mobil (which now forms part of ExxonMobil) had a joint venture with BP. Mr Frost worked on Duckhams products during the period of the joint venture. He has technical and marketing expertise in the field of lubricants. Mr Frost gives evidence that the principal occasion when the colour green identifies the applicant's engine oils is during maintenance of the vehicle. He says that it is not uncommon for unscrupulous operators to substitute a cheaper oil than that specified by the customer. Accordingly, the dark green colour of Duckhams oils enables the public to be sure that they have been given the oil specified.

26. Mr Frost also gives evidence about the general use of dyes in lubricants of various kinds. In relation to engine oils, he says that it is common practice for two stroke engine oils intended to be added to petrol to be coloured green or blue so that it is possible to tell when it has been added to the petrol.

27. The applicant's evidence also includes eight statutory declarations from trade users of engine oil attesting to the fact that the colour green is distinctive of Duckhams oils. I will return to this evidence in more detail later.

SUMMARY OF THE OPPONENT'S EVIDENCE

28. Mr Alan Walker is the opponent's Technical Manager Automotive. Mr Walker gives evidence that most base oils are amber in colour and that additives are added to these base oils for a variety of purposes, which has the effect of darkening or changing the colour of the final oil composition. Nevertheless, Mr Walker accepts that most

engine oils are varying shades of amber in colour but he says that the opponent, or its predecessor in business, has sold two green coloured engine oils under the names CENTURY SUPREME and CENTURY STERLING since 1971 and 1978, respectively. Sales of the latter product were discontinued in the year 2000, but the former product continues to be marketed, and since 1996/97 has also been sold under the brand SILKOLENE PERMAVISO.

29. Mr Walker explains that a green dye is added to the base oils to give these products their green appearance. He says that he is advised (but he does not say by whom) that the opponent's products were originally coloured green to make the oils look thicker, and that CENTURY engine oils were historically sold direct to the garage trade for use when servicing vehicles. The oils have also been sold through garage forecourts and motor factors, but only to a limited degree. Mr Walker explains that this is because the garage forecourt market is dominated by the major fuel suppliers. Further, his company has not been able to develop a market amongst the larger independent retailers of motor vehicle accessories.

30. Mr Walker estimates that total turnover of his company's green coloured oils since 1971 has been around £8M. He provides a copy of a declaration made by a David Splisbury, who was a Director of the opponent's predecessor in business. The declaration was made in 1983 for use in earlier proceedings. It indicates that the turnover under the mark CENTURY SUPREME up until 1983 was £5M. It appears that sales in more recent times have declined to a much smaller level. Mr Walker gives evidence that sales of all the opponent's green coloured engine oils in 1997 amounted to only 75K litres representing a turnover of just £53K.

31. Mr Walker makes it clear that his company's oils have never been sold by reference to their colour and that he is not aware of any user of his company's oils having regard to the particular colour of the oil when purchased, or at all.

32. John Rowland is the opponent's Development Chemist. He gives evidence that he carried out certain tests to compare the colour of CENTURY SUPREME oil and the applicant's green oil sold under the brand DUCKHAMS HYPERGRADE. He says that on the basis of these tests he found the oils to be virtually indistinguishable to the eye.

33. The opponent's evidence includes two witness statements from Graham Lord, who is the Technical Director of Miller's Oils Limited. Mr Lord gives evidence that his company makes extensive use of dyes to add colour to its products. He lists eight products that are coloured green. However, only three of these are engine oils and two of these were not introduced until after the date of the application. The other, an oil known as PISTONEEZE ACE 20W 50 was introduced in the early 1960s and was coloured green to identify it as a multi-grade engine oil. The product was discontinued in 1985. Mr Lord says that it was sold in "particularly large quantities" during the twenty five years that it was on sale, but he does not provide sales figures to quantify what he means by this. He says that his company's products are sold through garages, distributors and

“more recently” through DIY stores. I take this to mean that the reference to DIY stores applies to the more recently introduced oils and not to the PISTONEEZE product.

34. Darryl McNey is the Product Manager, Auto Specialist Department, of Halfords Limited. He has three years experience in the sale of engine lubricants. Mr McNey gives evidence Halfords is the UK’s largest retailer of car engine lubricants with a volume market share of 26%. Halfords sell leading brands of motor oil including Duckhams. He says that in his company’s experience, customers’ purchasing decisions for engine oils are not based upon the colour of the oil itself, but on price, brand or on promotional activity. Mr McNey says that he is aware that Duckhams engine oils have been dyed green for some time. However, he says that he is not aware of customers ever purchasing such oil by reference to its colour rather than the Duckhams name.

35. David John Margaronni is the Technical Officer of the British Lubricants Federation, which he says is the principal UK trade association for companies engaged in the manufacture and sale of lubricants. The Federation represents some one hundred and ten members ranging from giant oil corporations to small companies. Mr Margaronni states that the Federation is opposed to the applicant’s application because:

- i) there are a number of green oils on the market (although he does not claim that these are all engine oils) and it is therefore felt that the colour green is not distinctive of Duckhams;
- ii) the Federation does not consider it to be in the interests of its members or the industry as a whole to inhibit the production and marketing of oils of any particular colour;
- iii) there is already use of coloured oils to distinguish those suitable for particular uses and this could well be extended in future for health, safety or environmental reasons, and the monopolisation of the colour green by one undertaking would severely curtail the extension of such coding;
- iv) if the applicant were to educate the public that a green oil is an engine oil it could cause the public to mistakenly use other green non-engine oils in their vehicles.

In connection with the first of the points listed above, Mr Margaronni points out that two stroke engine oils have traditionally been dyed green or blue.

36. There is also a witness statement from Stephen Edwards M.Sc., who lectures in applied physics and has a particular interest in colour physics. Mr Edwards observes that colour is not a physical property but a human sensation. He says that Pantone 3435 does not define a unique colour sensation but a range of sensations depending upon the illuminate and the eyesight of the observer. He further says that liquid colours are usually measured by transmitted light, but that it is not clear in the Duckhams’ trade mark whether the colour of the oil is to be assessed by reference to transmitted light or by

reflected light, which would affect the way the colour is perceived. He concludes that a Pantone sample is an inappropriate standard to be used to define the colour of an oil.

37. The opponent provided witness statements from Brian Walpole, Malcolm Elder, Doug Smith, Robert Ringwood, Peter Beeley, Graham Murrell and Richard Ford, who are all trade witnesses. Messrs Kirby, Walpole, Elder and Smith appear to be trade users of engine oils. Messrs Ringwood, Beeley, Murrell and Ford appear to be engaged in the supply of engine oils. Mr Murrell identifies himself as a distributor of the opponent's oils, and Mr Ford as a re-seller. All give evidence to the effect that engine oil is not selected by its colour. The majority are aware that the parties to these proceedings produce green coloured engine oils, although Mr Walpole initially thought that a green coloured sample shown to him was Castrol GTX and, he says, so did his mechanic, a Mr Mears. Mr Walpole later recalled that Duckhams was also green in colour. It does not appear that he had used the products of either party in recent years.

THE OBJECTION UNDER SECTION 39 OF THE ACT

38. The opponent submits that the representation of the mark filed on 24 December 1997 was not sufficient to constitute a "representation of the trade mark" for the purposes of section 32(2)(d) of the Act. The Appointed Person, in the form of Mr Geoffrey Hobbs Q.C. found in Ty Nant Spring Water Ltd's Application [2000] RPC 55, that the representation of the trade mark filed under section 32(2)(d) must be sufficient so as to clearly and unambiguously disclose the identify the mark. A further decision of the same Appointed Person has confirmed that a word consisting of the name of a colour is not sufficient to satisfy the requirement of section 32(2)(d): See Robert McBride Ltd's Application [2003] RPC 19.

39. The applicant's original representation of its trade mark plainly did not represent the trade mark clearly and unambiguously. That is why the applicant had to add a colour standard reference on 20 February 1998 in order to clarify what it meant by "green".

40. The opponent says that this amendment was not permissible because section 39 of the Act imposes strict limitations, both with regard to the circumstances and extent to which an application can be amended. In particular, the trade mark itself can only be amended to correct errors of wording or copying or obvious mistakes. Further, even if the amendment falls under one of those heads, it cannot be allowed if the correction substantially affects the identity of the trade mark.

41. Ms Himsworth submitted that the correction of the trade mark did not substantially affect its identity, but her main argument was that the representation of the trade mark was incomplete until the Registrar received the colour standard reference. Section 33(1) makes it clear that the date of filing of the application is to be regarded as the date on which the Registrar receives everything required by section 32(2). Consequently, if the original filing was defective, the Registrar was not seized of an application until 20 February 1998 when the colour standard was filed, and that should be regarded as the filing date. On this view of the matter, section 39 is irrelevant because the application has

not been amended since the last of the essential components was filed on 20 February 1998.

42. I accept Ms Himsworth's principal submission. The approach she advocates is essentially that which the Appointed Person invited the applicant to follow in the Ty Nant Spring Water case. It is not, therefore, without precedent.

43. Ms Reid drew my attention to a decision of Mr Simon Thorley Q.C. , also as the Appointed Person, in the case of Swizzels Matlow Ltd's Application [1999] RPC 879. Mr Thorley rejected an attempt by that applicant to cure a deficiency in the representation of its trade mark by adding a voluntary limitation under section 13 of the Act. I see no inconsistency between this decision and the decisions of Mr Hobbs. The common line that runs through these decisions is that a) until the Registrar receives a satisfactory representation of the trade mark there is no application, and b) deficiencies in this respect cannot be cured by amending the mark under section 39, or by adding a limitation of rights under section 13. This is objectionable because it would allow the applicant to retain the original filing date even though the requirements of section 32(2) are only satisfied at a later date, and this is contrary to the plain language of section 33(1).

44. The applicant in this case is prepared to accept the later filing date. In my view, that is the date that should have been accorded to the application under section 33(1). I believe that Rule 66 of the Trade Mark Rules 2000 gives the Registrar the power to correct the irregularity in procedure that has resulted in the application being accorded an incorrect filing date. Hereinafter, I will take 20 February 1998 to be the effective date of filing.

45. The opposition under section 39 of the Act is therefore rejected.

THE OBJECTION UNDER SECTION 5(4)(a) OF THE ACT

46. The necessary requirements to support a passing off action are well established. Before questions of misrepresentation and damage can arise the claimant must be able to show that his goods have acquired a goodwill in the market and that they are known by some distinguishing feature: see Halsbury's Laws of England (4th Edition).

47. Mr Walker's evidence on behalf of the opponent is crystal clear on this point. He says that the opponent's goods have never been marketed by reference to their colour and that, as far as he is aware, his company's customers have no regard to the colour of its oil.

48. On this evidence, the opponent's case under section 5(4)(a) is hopeless. Further, the applicant claims to have used its mark continuously from a date that precedes any use by the opponent of a green dye for its oils. This suggests that even if (contrary to its own evidence) the opponent could show that its oils are distinguished by their colour, it would be unable to show that the applicant's continued use of the green should now be regarded as a misrepresentation.

49. I therefore reject the opponent's case under section 5(4)(a) of the Act.

THE OBJECTION UNDER SECTIONS 1(1) & 3(1)(a) OF THE ACT

50. The ECJ indicated in case C-299/99 , Philips v Remington, [2003] RPC 2 (at paragraph 37 on page 23), that Article 3(1)(a) of Directive 89/104 must be interpreted as being:

“.....intended essentially to exclude from registration signs which are not generally capable of being a trade mark and thus cannot be represented graphically and/or are not capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

51. The court concluded that there is no category of marks that is not excluded from registration under Articles 3(1)(b),(c) and (d) and 3(3) of the Directive, but which are none the less excluded from registration by Article 3(1)(a). It is common ground that Section 3(1) of the Act, which corresponds with Articles 3(1) and 3(3) of the Directive, must be interpreted in a manner consistent with the Directive.

52. Ms Reid advanced no separate arguments under Section 3(1)(a) at the hearing, but in her subsequent written submissions she makes points, reflected in the opponent's pleadings, that seem to me to logically fall for a determination under Section 3(1)(a) because they pose the question of whether a mark of this type is generally capable of being a trade mark for the goods in question.

53. The opponent submits that colour divorced from other identifying matter is not capable of distinguishing. Ms Reid's supplementary skeleton argument, addressing the Advocate General's Opinion in the Libertel case, submitted that colour without contour or shape was not capable of being a trade mark. There must be some doubt about whether that submission is in support of the pleadings as they stand but, perhaps with something of a stretch, it may be approximated with the ground that colour divorced from other identifying matter is incapable of constituting a trade mark. The applicant has raised no objection that the point is outside the pleadings. Mr Himsworth's supplementary written submissions regarding the Libertel Opinion simply argues that it does not exclude the possibility of registration of the applicant's mark.

54. I accept that submission. Despite his choice of words, it is plain from the Opinion that the distinction the Advocate General was seeking to draw was between colour in the abstract and colour as applied to an object. Indeed in paragraph 93 of his Opinion he cites with approval the registration in the UK of a single colour, defined by a Pantone number, as applied to the surface of particular goods. I am aware that the ECJ has since indicated that, contrary to the Advocate General's Opinion, even an abstract colour may, in principle, be registered. However, I take the view that even if the Advocate General's Opinion had been accepted on this point, the mark before me would still not be excluded from registration on the ground that it lacks contour or shape.

55. The opposition under sections 1(1) and 3(1)(a) therefore also fails. In reaching this conclusion I have not overlooked the evidence of Mr Edwards which seeks to cast doubt on whether the applicant's mark was properly represented even after the Pantone reference was added. That is not a point taken in the opponent's pleadings, and I have not been asked to consider an amendment of the pleadings so it may be raised. In these circumstances, I do not think that it would be appropriate for me to express any view on that point.

THE OBJECTIONS UNDER SECTIONS 3(1)(b), (c) & (d)

56. The applicant does not accept that the trade mark is excluded from registration under section 3(1)(c) & (d) because it consists exclusively of a sign that may serve, in trade, to designate a characteristic of the goods and/or is a sign that has become customary in the current language or in the bona fide and established practices of the trade. However, the applicant accepts that it must rely upon the acquisition of a distinctive character through use in order to avoid an adverse finding under section 3(1)(b) of the Act. It therefore accepts that, as an unused mark, the sign applied for could not be regarded as possessing a distinctive character as a trade mark.

57. I believe that this was a realistic view for the applicant to take. The ECJ of the Court of First Instance have stated on a number of occasions that even though the legal criteria for registration is the same for all categories of trade marks, it does not follow that perception of the relevant public is necessarily the same. This is because the public is not accustomed to recognising the appearance of the goods themselves as a trade mark for the product. Consequently, it is usually necessary for the public to be educated to the perception that this type of sign is a trade mark. I suspect that Mr Walpole's evidence would represent the reaction of an average consumer of engine oil to the applicant's mark. Despite being in the vehicle servicing business, he thought that most engine oils were a greeny amber colour. He may not have been right about that but his reaction illustrates how little attention consumers are likely to pay to the colour of engine oils unless prompted to do so by marketing activity.

58. It is now well established that a trade mark may be excluded on any one of the grounds set out in section 3(1) of the Act. The result is that the applicant can only secure registration if it can successfully rely on the proviso to the section, which states that:

“...a trade mark shall not be refused registration by virtue of paragraphs (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

The applicant's case is that the evidence filed supports such a conclusion.

59. In the light of the applicant's position, it is unnecessary for me to say any more about the prima facie objections under sections 3(1)(c) and (d), and I decline to do so.

ACQUIRED DISTINCTIVENESS

THE LAW

60. In the *Windsurfing Chiemsee* case [1999] ETMR 585, the ECJ set out the test to be applied in order to determine whether a trade mark has acquired a distinctive character under Article 3(3) of the Directive (Section 3(1) proviso). It held that the national courts may take into account evidence from a variety of sources, but a finding that the mark has come to denote the goods as coming from a particular undertaking must necessarily mean that the provisions of Article 3(3) are met. The Court held that:

“In determining whether a mark has acquired distinctive character following the use made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.” (paragraph 49);

“In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.” (paragraph 51);

Alf, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify the goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general abstract data such as predetermined percentages.” (paragraph 52).

61. The ECJ has described the essential function of a trade mark a number of times. In *Philips*, the court stated that:

“...the essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin, and for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality.”

The court went on (at paragraph 47) to equate distinctive character with the ability of the trade mark to perform its essential function. Recognition of a sign as a trade mark therefore depends upon the mark giving rise to a concrete expectation on the part of the relevant public that goods bearing that sign originate from a single undertaking. Mere association, in the sense that use of the sign simply reminds consumers of a particular undertaking or makes them wonder whether that undertaking or another is responsible for the goods, does not amount to recognition of the sign as a trade mark. Posed in relation to the facts of this case, the question is not simply whether the relevant public know that Duckhams oils are a shade of green but whether there exists a concrete expectation that engine oils of that colour originate from Duckhams.

62. In assessing the public's likely reaction to the mark, account must be taken of the presumed expectations of an average consumer of the category of goods in question, who is deemed to be reasonably well informed, observant and circumspect. Further, the identification of a mark consisting of the shape of the goods as originating from a given undertaking must be as a result of the use of the mark as a trade mark and thus as a result of the nature and effect of such use: see the Philips judgement at paragraphs 63- 65. Although that requirement was expressed in relation to marks consisting of the shape of the goods, it seems to me that the same considerations must equally apply to any mark which consists of the appearance of the goods.

63. The requirement for the mark to have been used as a trade mark has caused some to question what is required, in addition to product recognition. In *Societe de Produits Nestle v Unilever plc* [2002] EWHC 2709, Jacob. J. referred a number of questions to the ECJ, one of which was whether, in addition to product recognition, it is necessary for an applicant to show that the public use and rely upon the shape as a guarantee of origin. I understand that the case has since settled. The judge's question will therefore stay unanswered for the time being. The judge's suggested answer was that the mark must be used and relied upon by the public as a badge of origin.

64. The Philips judgement indicates that the nature and effect of the applicant's use must be considered together. The judge's suggested answer in *Nestle* appears to focus mainly on the effect of the applicant's use of the mark. I respectfully agree with his view about that. A mark that is said to have acquired a distinctive character must be shown to have come to operate as a guarantee of origin. For that to be so consumers must rely upon it as a means of returning to the same undertaking if their experience of its products is positive, or to avoid that undertaking if their experience is negative.

65. I am not suggesting that the applicant must necessarily have used the mark as the only means of identifying the trade origin of the product. There is no rule that two or more trade marks cannot operate alongside each other, and the legal criteria for protecting marks consisting of the appearance of the goods is no different to those which apply to other types of trade marks. However, when it comes to identical signs used in the course of the trade in the goods covered by the registration, section 10(1) of the Act affords absolute protection to the registered trade mark. The justification for granting such protection without proof of a likelihood of confusion is that such confusion may be

presumed in these circumstances: see the Opinion General Jacobs in *LTJ Diffusion v S.A.Sadas* [2002] E.T.M.R. 40, at paragraphs 34 and 35. A trade mark should not therefore be regarded as having acquired a distinctive character in circumstances where (after discounting the distinguishing effect of other marks) it could not be presumed that confusion would occur even if a third party used an identical sign for the same goods. And this cannot be presumed if, in practice, the public place no reliance on the mark.

66. The requirements for securing protection under the proviso to section 3(1) therefore appear to me to be that:

- a) the mark must have been used by an undertaking as a means of identifying the trade origin of the goods;
- b) the effect of this use is that the relevant public (or a significant proportion thereof) have come to rely upon the mark, in the course of trade, as a means of identifying the trade origin of the goods;
- c) if the mark is but one of a number used by the undertaking to identify the trade origin of the goods, the competent authority must be satisfied that the mark applied for has, by itself, come to foster a concrete expectation amongst the relevant public that goods bearing that mark originate from, or under the control of, a single undertaking.

THE FACTS

67. The opponent accepts that the applicant has used a green colour in certain types of its engine oils for a number of years, and that this fact is known to the trade. The opponent also recognises that the applicant has spent considerable sums marketing its products. The opponent's case is that:

- a) the marketing relied upon by the applicant does not exclusively support the mark applied for but the main Duckhams brand and a number of sub-brands;
- b) the marketing that does identify the applicant's oils as being green does not portray the actual shade of green in the mark, and this is reflected in the witnesses' evidence;
- c) educating the public that the applicant's goods have a certain quality is not the same as educating the public that that quality has trade mark significance;
- d) there is no evidence of reliance upon the colour of the applicant's oil as a designation of trade significance;
- e) the applicant is not the only source of green oil, although it is recognised that other traders do not sell the same quantities of such products as the applicant.

The Average Consumer

68. I find that that there are two classes of consumers for engine oils. Firstly, vehicle owners who either change their own engine oil, or who select their own oil but have it changed by a garage. Secondly, the trade buyer who selects his own engine oils for use in his workshop.

The Length and Scale of the Applicant's Use, including its Promotional Efforts and Market Share

69. It is apparent from the evidence that the applicant has marketed green coloured engine oils since the mid 1950s. There was some discussion at the hearing as to whether the evidence indicated that the shade of green changed in 1975 (as Ms Reid contends) or whether (as Ms Himsworth submits) the applicant merely changed the dye used, but continued to produce oils of the same colour. Whatever the answer, I do not think it can have a material bearing on the position at the relevant date in early 1998.

70. The applicant's green oils have been sold on a substantial scale. Mr Hadfield gives evidence that in 1973 the applicant sold 38 million litres of its green engine oils, but this seems to have gradually declined so that, by 1997, the corresponding figure was 6 million litres. Mr Martyn gives evidence that, in 2002, the total UK market was 150 million litres of engine oil per annum, of which 90 million was accounted for in the "workshop" market. He says that between February 1997- February 1998, the applicant had 11% of the audited section of the retail market (which excludes forecourt sales) with sales of 3.9 million litres. The overall picture that emerges is of a longstanding product which was very popular indeed at one point, but which has gradually lost sales to other products over the years, whilst still retaining a not insignificant market share. A comparison of the sales figures in Mr Martyn and Mr Hadfield's evidence suggests that, by 1997, the applicant's presence in the retail market (excluding forecourt sales) must have been proportionally much greater than its presence in the larger "workshop" market.

71. The applicant's evidence shows that it has brought the green colour of its oil to the public's attention through some of its promotional material. Various exhibits show that the applicant has drawn attention to the fact that its oil is green through promotional material featuring pictures of a green oil in use, a green oil droplet, and through the use of a stylised representation of green oil running down the front of its blue and yellow oil cans, and through the use of slogans such as "pure, green protection". Much of the applicant's evidence dates back to the 1970s and early 1980s. The evidence of the applicant's TV advertising indicates that the green colour of its oil was given greater prominence when the applicant's product was at its height than has been the case more recently. The TV advert for 1978 shows green oil and features the slogan "pure, green, protective, Duckhams". An advert run in the Republic of Ireland in 1982 (which the applicant points out could be received in Northern Ireland) had a similar theme. However, the UK adverts for 1984-90 featured the slogan "the engine's choice" and make no reference to the colour green. Nor do the TV adverts run in 1991-93, although the advert run in the last two of those years does show green coloured oil at work in a cut-away view of an engine. The applicant has not supplied adverts for later years and, as I noted earlier, has not provided figures for the amounts spent on advertising for the years 1989-1997. I am left with the impression that the amount spent promoting the applicant's products diminished in the 1990s in line with sales, and that the green colour of the applicant's engine oil was featured more heavily in earlier years than in later years.

72. Mr Hadfield gives evidence that the product was the subject of a major re-launch in 1998 (after this application was filed) but it is not clear whether this began before or after what is now the relevant date of 20 February 1998.

73. I find that the applicant's evidence demonstrates that a significant proportion of trade customers of engine oil are aware that the applicant's oil is green and that this is not the usual colour of such goods. I am also prepared to infer from the applicant's promotion of its product that a significant proportion of the non-trade users of engine oils would have known of Duckhams oils at the relevant date, and a proportion of these would have known that they were green.

The Nature of the Applicant's Promotion of the Mark

74. As the opponent points out, the applicant's marketing effort has not featured the actual shade of green applied for. If the applicant's use of green colours and the word 'green' in its promotional material has prompted the public to pay attention to the actual colour of its oil, it is not fatal to the applicant's case that its promotional material has not featured the trade mark applied for as such.

75. There is some force in the opponent's submission that the applicant's promotional effort has not expressly sought to educate the public as to the significance of its green coloured oil. The closest one gets to this is the evidence of the applicant's internal magazine from Spring 1998 (in exhibit RFH16). This document included a page with the question "Did you know?" and the statement "Duckhams is the only lubes product which is actually coloured green." If anything this evidence assists the opponent's case. Not only was the magazine published internally and after the relevant date, but the very fact that a question like this appeared in the applicant's in-house magazine makes one wonder whether the applicant doubted its own employees appreciation of the trade source significance of the colour of its oils.

76. I find that there is no evidence of the applicant having expressly identified the green colour of its oil as having trade mark significance. The most that can be said is that the applicant's repeated use of the colour (and word) green in its advertising was intended to act as a prompt suggesting a connection in trade between green engine oils and itself.

Reliance

77. Turning to the question of reliance, the opponent submits that the public cannot have come to rely upon the applicant's mark to distinguish its goods because the mark is not visible at the point of sale. Trade marks serve to distinguish products in the course of trade. They usually do this by attracting customers to a particular trade source through advertising, and by identifying the goods or services of that undertaking at the point at which they are offered for sale. Trade marks may continue to function as an indication of trade origin after goods have been sold and are in use, but this is only relevant to the extent that such use may affect future trade in the goods. Consequently, where a mark that is a) not used as such in advertising, and b) not visible at the point of sale, is claimed

to have acquired a trade mark character, it is plainly important to consider how else that mark has come to operate as a trade mark in the course of trade.

78. The applicant points to three situations in which the relevant public has come to rely upon the colour of its oil to distinguish its commercial origin, and hence for it to operate as a trade mark. Firstly, when ordinary members of the public pour the oil into their engines. Secondly, when customers who have had their oil changed by a garage check their dipsticks to verify that the applicant's oil has been used. And thirdly, by trade customers, who identify the trade source of the applicant's engine oil by its colour whilst it is stored in tanks in garages and other workshops.

79. I would not discount any of these uses as being wholly immaterial, but it appears to me that more weight could be attached to evidence of reliance in the second instance (which I will call "dipstick use") than in the other two. This is because it is easier to equate that use of the colour green with a guarantee of origin in the course of trade than is the case with the other two instances. In particular, it seems to me that I ought to attach little weight to the proposition that the public rely upon the colour of oil at the point at which it is poured into an engine. In this situation it must be assumed that the user will have already fully satisfied himself as to the trade source of the goods.

80. The applicant has provided evidence from a number of trade witnesses in the form of statutory declarations from Robert Luxton, Anthony Catten, Frederick Coultas, Anthony Crisp, Philip Crossland, Douglas Hill, Raymond Holloway, Micheal Penn, Neil Sinclair and Michael Frost. All give evidence that they associate green engine oil with Duckhams, and most claim to have been aware of the colour of Duckhams oils for many years.

81. Mr Sinclair teaches motorcycle engineering at Merton College in Surrey. The College is supported by Duckhams, which supplies products for use by the students, including engine oils. Mr Sinclair says that based upon his experience as a lecturer and as an engineer, he would always recognise a green engine oil as Duckhams because of its colour. He does not say whether any other undertakings of engine oils are used at his college or explain how in practice the colour of the applicant's oil assists him in guaranteeing the origin of its goods.

82. Mr Hill is the chief engineer at the National Motor Museum at Beaulieu, which the applicant sponsored throughout the 1980s when the applicant's oils were used in all post war cars. Mr Hill also regards the colour (and smell) of the applicant's oil as distinctive. The closest he comes to explaining how he relies upon the colour is that he says that if a can of oil engine was tipped up and the oil was green, he would presume it to be Duckhams.

83. Mr Penn is the curatorial director of Haynes Motor Museum. He is an engineer and runs the engineering side of the collection of motor vehicles. He says that he is not aware of any other engine oil that is green and that the green colour applied to engine oils tells him just as clearly as any label that the oil is Duckhams.

84. Mr Luxton works for the Rover Group to whom the applicant provides special oils for test purposes. He has been an engineer all his working life and has been aware of Duckhams green engine oil for 30 years. He would assume that green engine oil is Duckhams.

85. Mr Coultas is the managing director of British Motor Heritage Group. He is also an engineer. He explains that the applicant worked with his company to produce a Heritage Motor oil which it sells for classic cars, and which is coloured green. Mr Coultas says that if he purchased oil, not in a marked container, which was coloured green, he would expect it to be Duckhams.

86. Mr Holloway is the director of the Petrol Retailers Association, although he appears to give evidence reflecting his own views and experience. He has always worked in the retail service station industry. He worked for BP for 28 years, during which time the applicant became a subsidiary of BP. He was responsible for the service stations within the BP network, which included workshops. It was during his visits to these workshops that the green colour of the applicant's oil came to his notice and became fixed in his mind. He now regards it as distinctive of Duckhams engine oils.

87. I regard these witnesses' evidence as confirming the fact (which is not in dispute) that the trade know of the applicant's engine oil and that it is green. Further, it provides support for the view that many in the trade regard the applicant's product as the only green engine oil. These witnesses do not appear to be well placed to speak for the average non-trade consumer of engine oil. I do not therefore regard this evidence as particularly useful in helping me to assess that type of consumer's perception of the matter, nor does this evidence offer much assistance in clarifying how the colour of the applicant's engine oil is liable to affect consumers choices of engine oils in the course of trade .

88. Mr Catten is a retired motor mechanic. His evidence, in part, seeks to address this last point. He was the service manager at Elite Motors in Tooting for 26 years, and then he worked as the Lecturer Supervisor at Merton College for a further 22 years where he taught motor engineering. Mr Catten says that Duckhams is the only engine oil he has known which is green, and he suggests that if another green engine oil came on the market it would cause confusion. In support of this suggestion, he points out that many garages buy Duckhams engine oil in bulk without seeing the product's packaging.

89. I don't understand Mr Catten to be saying that the oil is directly selected by its colour. I assume that what he means is that it is selected by its brand name but that the name is not visible when the goods are subsequently delivered in bulk. The inference being that the trade rely upon the colour of the oil at this point to identify the trade source of the goods. Mr Martyn provides more detailed evidence (included in the evidence summary above) on the same point. He says that most garages will have more than one product and the storage tanks will be carefully labelled with the grade of oil and the brand. He points out that the applicant has three grades of oil which are coloured green and suggests

that garage staff can identify the manufacturer of the oil from the colour, but must then read the label on the tanks to establish the grade of oil. I find it rather surprising that garage staff, who have to check the labelling on the tanks to see what grade of oil it contains, would then rely largely upon the colour of the oil rather than the brand name (which Mr Martyn says is also carefully labelled) to identify its trade source. I am prepared to accept that within the trade, some reliance is placed upon the colour of the applicant's oils, in combination with traditional branding, to identify its trade source whilst it is stored in tanks in workshops. This is not use in the course of trade as such, but it could affect such use, for example, by ensuring that the customer who orders Duckhams oil at a service does receive the oil he has selected.

90. Three of the applicant's trade witnesses give evidence that goes to "dipstick use". Mr Frost's evidence is summarised above. It confirms evidence that he gave in an earlier statutory declaration submitted prior to acceptance of the application. Mr Frost is an automotive technical manager for Mobile Oil Ltd, which at one point promoted the applicant's products. He does not say that he has worked in a garage servicing vehicles. Nor does he explain how else he comes to be aware of the consumer's reliance on "dipstick use". His evidence that the public rely on "dipstick use" as a means of guaranteeing the trade source of the applicant's engine oil is therefore little more than an assertion.

91 . The evidence of Messrs Crisp and Crossland is potentially of more assistance because they have long experience of the garage business and the motor trade. Both say that they regard green engine oil as distinctive of the applicant. Mr Crossland says that the colour of the oil is very important to him when he checks the level of the oil in the vehicle prior to changing or topping up the oil. If the dipstick is stained green he would assume that the customer uses Duckhams oil and would replace or top up the oil using the same product. He qualifies this statement by acknowledging that this would only be the case if there had been a recent oil change because after the oil has been in the engine for a time it becomes contaminated and appears the same colour as other engine oils. He does not therefore appear to draw a distinction between the colour of the oil and that of the dipstick.

92. The applicant's witnesses offer varying estimates as to the time that it takes for the applicant's oil to lose its green colour through use. It was accepted at the hearing that I should go by the evidence of Mr Martyn who says that the green colour lasts around 200 miles after an oil change. I think that I can take judicial notice of the fact that, certainly in modern times, cars and motor cycles go much further than 200 miles between changes of engine oil. As a mechanic, Mr Crossland would know this. His evidence that he relies on the colour of the dipstick at the time of oil changes to identify the trade source of the old oil is therefore either implausible or he is referring to the rare occasion when an engine oil needs changing again very soon after a previous change. Such a situation would hardly be representative. I have not overlooked the fact that Mr Crossland also refers to "dipstick use" in relation to the practice of topping up a customer's engine oil. No doubt there are cautious customers who take their vehicles back to the garage to have their oil level checked after less than 200 miles from a service, but I find it hard to believe that

this is particularly common. I also note that Mr Crossland says that it is he, rather than his customers, that relies upon this “dipstick use”.

93. Mr Crisp gives similar evidence and I subject it to the same criticism. However, he also gives evidence as to his perception of his customers’ practice. He says that:

“Based upon my dealings with the public whilst running my own business I can say that the public in general, when checking the oil in their car, would know that Duckhams oil was used if the dipstick stained green. They would then request Duckhams engine oil be used when their car was serviced.”

94. This appears to me to be the applicant’s best evidence of the colour of its oil serving a trade mark function in the course of trade.

The Use of Colour for Oils other than as Trade Marks

95. It is not in dispute that dyes are sometimes added to oils for purposes unconnected with identifying their trade source. For example, it is common ground that automatic transmission fluid is dyed red to stop it being confused with other products. Mr Lord of Millers Oils Ltd gives evidence that his company produced a green engine oil called PISTONEEZE that was on sale from the early 1960s to 1985, and which he claims was sold in “large quantities”. And of course, the opponent has since 1971, continuously sold a green engine oil, which appears to have had small but not insignificant sales in the past, although more recent sales appear tiny. I also note that one of the applicant’s witnesses, Mr Luxton of Rover Group, mentions that Rover adds a fluorescent green dye to the oil put into its cars at the point of sale. This appears to be done to make it easier to find any leaks. The oil is removed at the first service. However, Mr Luxton says that the oil Rover uses, although green, looks quite different to Duckhams green engine oil. Another of the applicant’s witnesses, Mr Coultas, says that the applicant worked with British Motor Heritage Group to produce a green engine oil for classic cars, which it sells under the name Heritage Motor Oil. It is not clear whether this use of the colour green for engine oil is attributed to Duckhams.

96. There is also evidence that engine oil for two stroke engines, which I believe are mainly used in small motorcycle engines, is dyed in order to allow the user to detect whether it has been pre-mixed with petrol. Significantly, Mr Margaroni of the British Lubricants Federation states that green is one of the colours customarily used for this purpose, and Mr Martyn for the applicant, agrees with him.

97. Mr Margaroni also expresses concern about the possible future use of green in trade to signify environmentally friendly oil. I do not believe that the potential future use of a colour in trade can prevent the registration of that colour if it has genuinely acquired a distinctive character as a trade mark. If that is so there should already exist the potential for confusion of the public if third parties were to use the mark, and this must be given precedence over maintaining the availability of the colour for other uses in future.

98. I do not believe that the pre-existing uses of green dyes for engine oils necessarily excludes the possibility of the applicant's mark having acquired a distinctive character at the relevant date. That does not mean that distinctive character can be equated with simply being the best known user of a particular feature of get-up. It is a matter of degree. It is, in particular, difficult to see how the mark could have acquired a trade mark character for the type of engine oil used in two stroke engines.

99. I bear in mind that the result of the applicant's registration will almost certainly be that the opponent may be required to cease the use that it has made of green engine oil for over thirty years. I believe that such a conclusion inevitably follows from the judgement of the ECJ in Case C- 206/01, Arsenal v Reed, [2003] RPC 9, where the court stated (at paragraph 51 of its judgement) that:

“...the exclusive right under Art 5(1)(a) of the Directive was conferred in order to enable the trade mark proprietor to protect his specific interests as proprietor, that is, to ensure that the trade mark can fulfil its functions. The exercise of that right must therefore be reserved to case in which a third party's use of the sign affects, in particular, its essential function of guaranteeing to consumers the origin of the goods.”

100. If I were to accept the applicant's evidence of the three ways in which consumers rely upon its mark to guarantee the trade source of its goods, it would seem very likely that the opponent's continued sale of green oil to the workshop market would be bound to have a clear potential to affect the essential function of the applicant's trade mark. As the outcome of the Arsenal case demonstrated, that does not necessarily mean that the registration should be refused. It does mean that, before granting registration, I should fully satisfy myself that the applicant's evidence of acquired distinctiveness meets the burden of proof that rests on the applicant in these circumstances: see Dualit's Application [1999] RPC 890 at paragraph 30 on page 898.

Conclusion

101. My overall assessment of the evidence is that the applicant has not made out its case. My reasons are that:

- a) Although the applicant has taken steps to educate consumers that its oil is green, such promotional activity appears to have been in decline in the years leading up to the date of the application;
- b) Further, the green “prompts” given in the applicant's promotional material are not use of the mark applied for but merely a means of encouraging the public to pay attention to the specific colour of its engine oil;
- c) Although a significant proportion of trade consumers are aware of the applicant's mark and believe that the applicant is the only producer of green engine oil, the opponent's evidence (and indeed some of the applicant's evidence)

shows that there are a significant number of trade consumers who are aware of other green engine oils, including those of the opponent;

d) It appears that in recent years the applicant has had a relatively small share of the “workshop” market (which is also the market the opponent has a presence in) but has retained a proportionally larger share of the retail market for engine oil;

e) However, the applicant has provided no evidence from end consumers in its largest market sector from which it could be properly inferred that its advertising has had the desired effect on the ordinary vehicle owning public;

f) The existence of green dyed two stroke engine oil is a reason to believe that at least one section of the ordinary vehicle owning public would not have regarded green engine oil per se as distinctive of the applicant at the relevant date;

g) There is not sufficient evidence that trade or end consumers rely upon the colour of the applicant’s engine oil in order to distinguish its products in the course of trade.

102. I have not found this an easy decision to make, and I acknowledge that if the question was limited to whether an average consumer of engine oils was, at the relevant date, aware that the applicant produced a green engine oil, and was not aware of another producer making an engine oil (other than two stroke engine oils) with this feature, it would be possible to arrive at more than one answer on this evidence. However, if as I have found, it is also necessary for the applicant to show that the public place reliance on the colour as something which affects their future choice of engine oil in the course of trade, then I believe that the applicant’s evidence more clearly falls short. This part of the opponent’s case depends mainly on the evidence that the colour of the applicant’s oil is used by traders to distinguish it whilst it is stored in tanks, to which I feel able to attach only a limited amount of weight for the reasons given above, and the evidence that the public rely on the colour green to check the source of engine oil by use of the dipstick. This evidence must be weighed against the evidence of the opponent’s trade witnesses who say that oil is not selected by colour and is immaterial. These witnesses include Mr McNey from Halfords, who I understand to be the largest supplier of engine oil to the public in the UK. Further, this part of the applicant’s case faces the not inconsiderable practical obstacle that, not only is the colour of its oil not visible at the point of sale, but it is only apparent for some 200 miles after a service. This necessarily limits the circumstances in which the public could rely upon it to, effectively, not much more than when a garage hands a car back after servicing. I therefore regard the absence of any evidence from end consumers on this point as a particular weakness in the applicant’s case.

103. For these reasons the application will be refused.

COSTS

104. These proceedings started on 22 March 2000 and therefore costs fall to be determined by reference to the Registrar's previous scale of costs.

105. There were two interlocutory hearings (one of which was adjourned and reconvened) to determine the applicant's objections to the opponent's requests for extensions of time to file evidence, and also the admissibility of certain evidence which the opponent supposedly filed in reply to the applicant's evidence. The opponent was successful at the first hearing, but unsuccessful at the second. The costs of those hearings were reserved to be determined with the outcome of the opposition.

106. Additionally, Ms Himsworth asked me to take into account the number of grounds pleaded by the opponent which were not supported or supportable by evidence, and the inconvenience caused to the applicant by the vagueness of the opponent's pleadings, which resulted in several requests for particularisation and revised Statements of Grounds.

107. As far as the interlocutory hearings are concerned, I regard the outcome as a score draw. I therefore do not intend to award costs to either party for these hearings and the work that went with them.

108. As far as the pleadings are concerned, I do regard it as unfortunate that the opponent introduced at least three grounds - under sections 3(3)(b), 5(2) and 5(4) - in respect of which it had no arguable case. The last of these was even pursued at the hearing. Further, Ms Himsworth had to seek clarification from Ms Reid at the hearing as to whether the ground under section 3(3)(b) (and a related ground under section 3(3)(a)) was being pursued. This became necessary because Mr Reid's skeleton was unclear on this point. The result of this ambiguity was that Ms Himsworth felt obliged to cover grounds in her skeleton argument that were no longer being pursued.

109. Parties to proceedings before the Registrar should not act in ways that cause the other party to undertake nugatory work. Ideally, unsupported grounds should not be run in the first place. Inevitably, there will be occasions when it only becomes clear at some later time that a particular ground can no longer be supported. In these circumstances the ground should be expressly dropped, and without delay.

110. I do not intend to depart from the normal rule that costs should follow the event. And given that both sides justifiably felt that this was a case in which the services of counsel was justified, and given the evidential burden on the opponent (not just in filing its own evidence but in digesting all the applicant's evidence), I would have awarded the opponent the sum of £1600, which is towards the top end of the old scale. However, in view of the behaviour described above, I intend to reduce that figure by £600. I therefore order the applicant to pay the opponent the sum of £1000 as a contribution to its costs. This sum to be paid within 35 days of the date of this decision, or in the event of an unsuccessful appeal, within 7 days of the final determination of the matter.

PERIOD ALLOWED FOR APPEAL

111. The period allowed for filing an appeal to the Appointed Person is 28 days. Given the complexity of the case, I direct that the period allowed for an appeal to be filed with the court be 28 rather than the usual 14 days.

Dated this 30 Day of May 2003

**Allan James
For the Registrar**