

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION m 2030358
BY BIANCA DENISE ABRAHAM
TO REGISTER THE TRADE MARK



AND

IN THE MATTER OF OPPOSITION
THERE TO UNDER OPPOSITION m 44829 BY
THE GILLETTE COMPANY

TRADE MARKS ACT 1994

IN THE MATTER of trade mark
application m2030358 by
Bianca Denise Abraham

5 and

IN THE MATTER OF opposition
thereto under opposition m44829
by The Gillette Company.

DECISION

10 Bianca Denise Abraham applied on 9 August 1995 to register the mark NATURELLE (in the form shown below) in classes 3 and 5. The class 3 application was in respect of :

“Skin care, sun care and hair care preparations; skin care wipes; cosmetics; dentifrices; perfumery; essential oils; bleaching preparations and other substances for laundry use; soaps.”

15 The class 5 application was in respect of:

“Infants’ foods; medicinal drinks.”

The mark, reproduced below, was advertised for opposition purposes on 3 April 1996.



The application in class 3 is opposed by the Gillette Company (hereafter “Gillette”). I summarise the grounds of opposition as follows:

5 Ž The opponent has a number of trade mark registrations in class 3 for NATREL and NATREL PLUS for identical and/or similar goods. They claim that there would be a likelihood of confusion if the applicant were to use her mark in respect of the goods identified in class 3 of her application.

10 Ž Gillette further claim that use by the applicant of her mark may give rise to an action for passing off, and that consequently the application contravenes section 5(4). (The notice of opposition refers to section 3(4), but I accepted at the hearing that this was a typographical error, and that the opposition on this ground goes to section 5(4).)

15 The opponent also asks the Registrar to refuse application m 2030358 in the exercise of his discretion. However, under the Trade Marks Act 1994 the Registrar does not have discretion to refuse an application as he did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects.

The applicant filed a counterstatement in support of her application in which she states that her mark is visually distinct from Gillette’s, and that the goods are not the same. In particular, she claims that Gillette’s reputation in the NATREL mark is limited to deodorants and razor blades.

20 Both parties ask for an award of costs in their favour.

25 Only the opponent filed evidence in these proceedings. The matter came to be heard on 11 February 1998. At the hearing, the opponent was represented by Mr Christopher Morcom of Her Majesty’s Counsel. The applicant chose not to be represented, and did not attend the hearing, although she did file a statutory declaration (after the period allowed for filing evidence) which I have considered in lieu of submissions at the hearing

The Evidence

The opponent’s evidence comprises a statutory declaration by Andrew James Redpath dated 6 February 1997. Mr Redpath is an Assistant Secretary of Gillette, and has been employed by Gillette or a subsidiary company for approximately twenty eight (28) years.

30 Mr Redpath’s evidence concerns Gillette’s registration and use of their NATREL marks. He provides details of his company’s sales and advertising in relation to these marks, primarily in support of the opposition under section 5(4). However, at the hearing Mr Morcom helpfully agreed that if the opposition under section 5(2)(b) were to fail, then, in the particular circumstances of this case, the opposition under section 5(4) would necessarily fail. On this basis Mr Morcom suggested that I might choose not to reach a decision on the section 5(4) point. I agreed. Consequently the only parts of Mr Redpath’s evidence that I need to review

in any detail are the three registrations which form the basis of the opposition under section 5(2)(b). Copies of the three registration certificates are exhibited at AJR1 to Mr Redpath's declaration. The relevant details are:

1312710 - NATREL

5 This mark has been registered in class 3 as of 11 June 1987 for the following specification of goods:

“Perfumes; cosmetics; non-medicated toilet preparations; soaps; shampoos; preparations for the hair; dentifrices; anti-perspirants; deodorants for personal use; all included in class 3.”

10 *1489701 - NATREL PLUS & Natrel Plus* (a series of two marks)

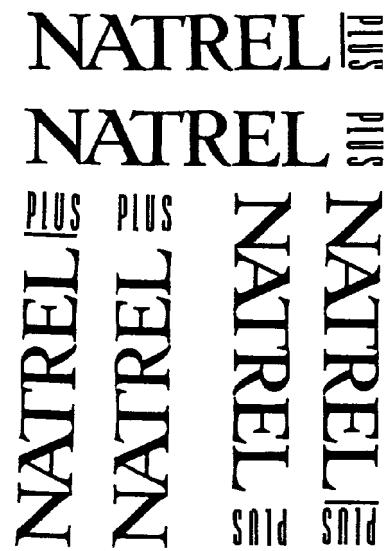
This series of marks has been registered in class 3 with effect from 1 February 1992 for the following specification of goods:

“Deodorants, anti-perspirants, perfumery and perfumed body sprays; all included in class 3.”

15 *1578031* (A series of six marks as reproduced right)

This series of marks has been registered in class 3 with effect from 12 July 1994 for the following specification of goods:

20 “Deodorants, anti-perspirants, perfumery and perfumed body sprays; all included in class 3.”



This completes my review of the evidence, but before turning to consider the opposition under section 5(2)(b), there is one further matter that I should comment upon. The notice of opposition includes the following paragraph:

25 “7. By reason of the matters set forth, the Applicant can claim no valid proprietary rights as the mark applied for is not distinctive of the Applicant's goods.”

Mr Morcom submitted that this represented an opposition on absolute grounds inasmuch as it decries the distinctiveness of the applicant's mark. Although no specific section of the Act is identified in the paragraph, Mr Morcom invited me to consider it under section 3(1)(b) and/or

section 3(1)(c). After giving the matter some thought, I do not accept that this is a fair interpretation of the words. The other grounds of opposition listed are each clearly identified with a particular section of the act, and I believe it would be wrong for me to admit a new ground of opposition (which has not hitherto been clearly identified) at such a late stage in the proceedings - not least because the applicant was not represented at the hearing.

Section 5(2)(b)

The only issue which remains for me to decide therefore is whether, in view of Gillette's registrations for their NATREL marks, registration of Ms Abraham's mark NATURELLE (plus logo) would be contrary to Section 5(2)(b). This section of the Act reads:-

(2) A trade mark shall not be registered if because -
(a)
(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.'

Ms Abraham denies that her application is in respect of the same goods as those for which Gillette's marks are registered. Mr Justice Jacob proposed a test for similar goods in the "Treat" case¹, but on this occasion it is not necessary for me to apply this test in meticulous detail because it is clear that the specifications overlap. For example, the opponent's registration 1312710 covers (among other things) perfumes, cosmetics, soaps, hair care preparations and dentifrices; all of which appear in the applicant's class 3 specification. To that extent I am satisfied that the goods are identical, and I need only decide whether the marks are so similar that there exists a likelihood of confusion on the part of the public.

So far as I am aware, the test advanced by Parker J in *Pianotist Co's application* [1906] 23 RPC is still good law. At page 777 line 26, he says:-

"You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

¹British Sugar plc v James Robertson & Sons Ltd [1996] RPC 281.

Mr Morcom reminded me that the goods in question are inexpensive goods which might often be purchased as part of a household's weekly shopping, rather than expensive goods which one would expect to be specified and/or selected with greater care. With this in mind, he invited me to take account of the test established by Luxmoore LJ (and approved by the House of Lords) in the *Aristoc Ltd v Rysta Ltd* case²:

“The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of Section 12 of the Trade Marks Act, 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word and has perhaps an imperfect recollection of it who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants.”

For the purposes of comparison, I need only consider Gillette's NATREL mark (1312710). I note that the applicant's mark (right) is visually different from Gillette's NATREL mark in several respects. To begin with, the characters in the applicant's mark are presented in a stylised form, and the flower devices further distinguish the mark. Strictly speaking, the letter 'u' also contributes an additional syllable, although I am not convinced that it would always be clearly articulated in ordinary everyday speech.



On the other hand, even if I accept that when seen side by side the applicant's mark can easily be distinguished from the opponent's marks, it does not follow that the applicant's mark is registrable. As the Privy Council stated in *de Cordova and others v Vick Chemical Co*³ at page 106:

“A trade mark is undoubtedly a visual device; but it is well-established law that the ascertainment of an essential feature is not to be by ocular test alone. Since words can form part or indeed the whole, of a mark, it is impossible to exclude consideration of the sound or significance of those words..... The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole.”

²[1945] RPC 62. Page 72 line 46 to page 73 line 4.

³[1951] 68 RPC 103. Page 106 lines 17-23.

It seems to me that the first syllable and the last syllable of both marks are likely to be pronounced identically. Consequently, if the additional syllable ('u') in the applicant's mark is not clearly stressed in pronunciation, the two marks sound extremely similar. As suggested by Parker J in *Pianotist* (above) I have judged the two words by their sound, repeating them alternately to myself a number of times, and I have come to the conclusion that they are similar and that there exists a likelihood of confusion on the part of the public. Bearing in mind the impact of imperfect recollection, the potential for confusion between these two marks increases. Consequently, the opposition under Section 5(2)(b) succeeds and the application for registration in class 3 is refused.

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In reaching this decision I am aware that Section 5(2) of the Act closely resembles Section 10(2), which deals with infringement, and that perhaps I should also (or instead) take account of any guidance given by the Court with regard to Section 10(2). Section 10(2) reads:

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'(2) A person infringes a registered trade mark if he uses in the course of trade a sign where because-

(a)

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.'

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In view of the similarities between these two sections of the Act, it seems reasonable to infer that a mark that would infringe a registered trade mark under Section 10(2)(b), is disqualified from registration by Section 5(2)(b) with respect to that same registered trade mark. By analogy therefore, a test for similarity of marks albeit in relation to infringement under Section 10(2)(b) should, at the very least, be a useful guide to similarity of marks under Section 5(2)(b). With this in mind, I turn to the approach to be adopted when considering similarity of marks in relation to Section 10 which was set out by Jacob J in *Origins Natural Resources Inc. v Origin Clothing Limited* [1995] FSR 280, in which he said:-

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'section 10 of the Trade Marks Act presupposes that the plaintiff's mark is in use or will come into use. It requires the court to assume the mark of the plaintiff is used in a normal and fair manner in relation to the goods for which it is registered and then to assess the likelihood of confusion in relation to the way the defendant uses its mark, discounting external added matter or circumstances. The comparison is mark for mark.'

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Laddie J further developed the approach laid down by Jacob J in the *Origins* case (above) in *Wagamama Ltd v City Restaurants plc* [1995] FSR 713. He said:-

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'A judge brings to the assessment of marks his own, perhaps idiosyncratic, pronunciation and view or understanding of them. Although the issue of infringement is one eventually for the judge alone, in assessing the marks he must bear in mind the impact the marks make or are likely to make on the minds of those persons who are likely to be customers for goods or services under the marks. Not all customers are the same. It is therefore sometimes of assistance for the court

to hear evidence from witnesses who will help him to assess the variety of ways in which members of the target market will pronounce the marks and what, to them, will be the visual or phonetic impact of the marks. When considering infringement it is also necessary to bear in mind the possible impact of imperfect recollection on the part of members of the target market.’

- 5 It seems to me that the test adopted by the Court in these cases is not significantly different from that which was established in law and practice, prior to the coming into force of the 1994 Act. Consequently, even if I were to have adapted the guidance of the Court in these more recent infringement actions to the present opposition proceedings, the outcome would in my view have been the same. The opponent still succeeds under Section 5(2)(b).
- 10 There is now no need for me to decide whether the opposition would also have succeeded under section 5(4), and in the circumstances I decline to decide this further ground of the opposition.

The application to register the mark in class 5 has not been opposed and, subject to any appeal against this decision, the application can proceed to registration in class 5 as advertised.

- 15 The opponent has been successful in these proceedings and he is entitled to a contribution to his costs. I hereby order the applicant, Bianca Denise Abraham, to pay to Gillette the sum of **£600**.

Dated this 18th day of February 1998

Mr S J Probert
Principal Hearing Officer
20 **For the Registrar, the Comptroller-General**