

**IN THE MATTER OF Application
No 1576454 by Perfetti S.p.a. to
register a trade mark in Class 30**

AND

**IN THE MATTER OF Opposition
thereto under No 42254 by Warner
Lambert Company**

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BACKGROUND

15 On 24 June 1994, Perfetti S.p.a., an Italian company, applied under Section 17 of the Trade
Marks Act 1938 for the registration of the trade mark CHLORMINT. The goods specified in
the application are:

20 Confectionery, chewing gum and bubble gum; all being mint flavoured; all included in
Class 30.

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The application contained a claim under the Paris Convention to a priority date of 23 March 1994
based upon an earlier filing of the same mark in Italy, but nothing appears to turn on this.

25 On 29 March 1995, the Warner Lambert Company of New Jersey, USA, filed notice of
opposition. The grounds of opposition are as follows:

30 1. The applicants' mark CHLORMINT so nearly resembles the opponents' trade
mark number 881882 as to be likely to deceive or cause confusion and the
application covers goods being the same as or of the same description as those for
which the opponents' trade mark is registered. Accordingly, the application
should be rejected in accordance with the provisions of Section 12(1) of the Trade
Marks Act 1938 (as amended).

35 2. The opponents have made substantial use of the trade mark CLORETS in relation
to the goods covered by their registration and have acquired a considerable
reputation in the goods sold under the said trade mark. In view of the substantial
goodwill and reputation acquired by the opponents in their aforesaid trade mark,
the use by the applicants of the mark CHLORMINT being confusingly similar to
40 the opponents' trade mark, would by reason of its being likely to deceive or cause
confusion or otherwise, be disentitled to protection in a Court of Justice or would
be contrary to law. Therefore application number 1576454 should be rejected in
accordance with the provisions of Section 11 of the Trade Marks Act 1938 (as
amended).

45 3. The applicants did not have, at the date of application, a *bona fide* intention to use
the mark CHLORMINT in relation to all of the goods for which the registration
is sought, or any of them and the application should be refused accordingly.

4. The Registrar should refuse application number 1576454 in the exercise of his discretion.

5 The opponents initially also opposed the registration of the mark on the grounds that CHLORMINT is descriptive and non-distinctive for mint confectionery containing chlorophyll, but this ground of opposition was subsequently dropped.

10 The applicants admit that the opponents are the registered proprietors of the registered trade mark CLORETS and that the opponents have used that mark in the United Kingdom. All the other grounds of opposition are denied. Both sides seek an award of costs.

15 The matter came to be heard on 16 June 1998 when the applicants were represented by Mr Daniel Alexander of Counsel instructed by A A Thornton & Co, Trade Mark Agents, and the opponents were represented by Mr Guy Tritton of Counsel, instructed by Gill Jennings and Every, Trade Marks Agents.

20 By the time this matter came to be heard the Trade Marks Act 1938 had been repealed. However, under the transitional provisions set out in the Trade Marks Act 1994, I must continue to apply the provisions of the old law to these proceedings. All further references in this decision to Sections of the Act are therefore references to Sections of the old law.

OPPONENTS' EVIDENCE

25 The opponents' evidence consists of a Statutory Declaration dated 4 March 1996 by Caroline Horrell who is a Director of Marketing of Warner Lambert Confectionery, a division of Parke-Davis & Company, whose ultimate parent company is Warner Lambert Company, the opponents.

30 Ms Horrell says the opponents are the registered proprietors of United Kingdom registration number 811882 CLORETS, which is registered in respect of 'chewing gum and mint flavoured confectionery, none being medicated'. Ms Horrell further states that the mark CLORETS has been in use in the United Kingdom since at least 1960. The products concerned are said to be a non-medicated mint flavoured breath freshening confection (BFC), which is sold in the form of chewing gum and as a sweet. Ms Horrell states that CLORETS are sold in at least 83,000 retail outlets throughout the United Kingdom in virtually every conceivable type of confectionery outlet.

35 Ms Horrell provides figures for television advertising expenditure during the period 1988 through to 1995 which show that, from 1989 onwards, the opponents have spent approximately £1½m to £2m per annum promoting products under their CLORETS trade mark. Ms Horrell further states that, in addition to television advertising, CLORETS has been advertised in the trade press and on poster hoardings. The total amount spent on such advertising since 1988 is said to be £13.8m.

40 Ms Horrell's declaration also includes sales figures for confectionery sold under the mark CLORETS. These show that in the years 1991 to 1993, annual sales of Clorets BFC products varied between approximately 36 million packets and 41 million packets.

Exhibit CH3 to Ms Horrell's declaration consists of samples of goods sold under the CLORETS

mark. An example of the packaging for one of the products is attached to this decision as Annex A. Ms Horrell further states that BFC confectionery and gum products are usually sold from counter displays or free-standing display trays that are usually arranged near the cashier. Exhibits CH4 and CH5 to Ms Horrell's declaration consist of copy photographs illustrating typical multi-product point of sale displays, which show the opponents' goods on sale adjacent to a number of competing products. Ms Horrell also states that, to the best of her knowledge and belief, there are no other such products on the UK market that bear a name in any way similar to the opponents' trade mark. She lists the main competing products which all have clearly different trade marks.

APPLICANTS' EVIDENCE

The applicants' evidence consists of a Statutory Declaration dated 14 November 1996 by Enrico Alberto Bottazzi, who is the International Marketing Director of Perfetti S.p.a.. Mr Perfetti states that the CHLORMINT trade mark was devised in late 1993 for use on the applicants' new range of chewing gum and mint products. He explains that the trade mark CHLORMINT was chosen because CHLOR is the first part of the word chlorophyll, which Mr Bottazzi says is a substance commonly used in breath freshening/oral hygiene products both as a green colorant and as a flavouring. He states that the suffix MINT was chosen in order to convey the taste of the products themselves. Mr Bottazzi claims that chlorophyll is in fact used as a green colorant in both the applicants and the opponents' products. He further claims that a number of manufacturers of BFC products draw attention to the fact that the product contains chlorophyll on the packaging. Exhibit EAB/1 to Mr Bottazzi's declaration consists of a copy of a photograph illustrating a range of BFC products which advertise the use of chlorophyll as a feature on the packaging.

OPPONENTS' EVIDENCE IN REPLY

The opponents' evidence in reply consists of a Statutory Declaration dated 16 June 1997 by John O'Shea, who is the Assistant General Council of Warner Lambert Company. His declaration consists mainly of legal argument about the similarity and confusability of the respective marks. However, I note that Mr O'Shea does claim that all the products listed in the exhibit EAB/1 to Mr Bottazzi's declaration are in fact from other jurisdictions outside the UK.

That concludes my review of what I consider to be the relevant evidence. With this in mind I now move on to the decision.

DECISION

At the hearing, Mr Tritton for the opponents, indicated the ground of opposition under Section 17 of the Act based upon the absence of any *bona fide* intention on the applicants part to use their mark was not being pursued.

The remaining grounds of opposition are under Sections 11 and 12 of the Act. The established tests under Sections 11 and 12 are set down in Smith Hayden & Co Ltd's application (1946) 63 RPC 101 as adapted by Lord Upjohn in the Bali trade mark case 1969 RPC 496. In relation to the present case the tests made be expressed as follows:

(Under Section 11) Having regard to the user of the mark CLORETS is the tribunal satisfied that the mark applied for, CHLORMINT if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

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(Under Section 12) Assuming user by the opponents of their mark CLORETS in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception or confusion among a number of persons if the applicants use their mark CHLORMINT normally and fairly in respect of any goods covered by their proposed registration?

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Mr Tritton accepted, rightly in my view, that his case under Section 12 stood or fell together with his case under Section 11. Arguably the opponents' case is stronger under Section 11 because the use claimed by the opponents of their mark CLORETS could be argued to go beyond the 'normal and fair' use to be assumed under Section 12. Therefore, in practice, I need only consider the ground of opposition under Section 11 of the Act.

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As the goods sold by the respective parties are identical the only matter to be decided is whether, having regard to all the opponents' user and all the surrounding circumstances, CHLORMINT is likely to be confused with CLORETS.

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Before me Mr Tritton contended that:-

1. The marks should be compared successively not side by side, making due allowance for the danger of imperfect recollection. In this respect he referred me to the well-known comments of Luxmore L.J. in *Rysta v. Aristoc* (1945) 62 RPC page 72.
2. When comparing trade marks the first syllable is usually most important because of the tendency of the public to slur or swallow the endings of words, as per Sargant L.J. in *Tripcastrid* (1925) 42 RPC at page 278.
3. The word MINT appearing as the suffix of the applicants' mark should effectively be discounted when comparing the marks because it is wholly descriptive.
4. Having regard to the opponents' reputation for goods sold under that mark, and having regard to the uniqueness of the CLOR- prefix in trade marks for BFC products in the UK, the opponents' mark is likely to be directly confused with the opponents.
5. The fact that the opponents' mark was used in combination with the terms 'mini mints' as shown in the evidence was another factor which added to the risk of confusion.
6. The low cost of the respective goods combined with the fact that such goods are not bought with any great care of attention added still further to the risk of confusion.

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For his part Mr Alexander pointed out that this was the second dispute between the parties concerning the opponents' trade mark CLORETS. On appeal from an earlier decision of the Registrar, Mr Justice Laddie decided on 9 March 1998 that the trade marks CHLORALIT and CLORETS were not confusingly similar when used in respect of the same goods as are at issue here. Mr Alexander contended that much of the reasoning in that case was applicable to these trade marks also. He drew my attention to the evidence which showed that chlorophyll is a common ingredient in BFC products and drew my attention to Mr Justice Laddie's comments to the effect that where part of a mark is descriptive or suggestive it should be given less emphasis than when it is artificial. Mr Alexander invited me to follow the approach of Mr Justice Laddie and decide the matter of likely confusion of the marks as a matter of first impression. In his submission there was insufficient similarity between the two marks so as to bring about a real tangible risk of confusion.

I must of course give Mr Justice Laddie views due weight, but it appears to me that as he decided that CHLORALIT and CLORETS were not confusingly similar principally as a matter of first impression, I do not think that his decision in that case can weigh heavily in my judgement as to whether CLORETS is likely to be confused with a different mark.

In comparing the two marks I do not intend to adopt the approach advocated by Mr Tritton, effectively discounting the suffix MINT from the applicants' mark and focussing on the degree of similarity between CHLOR and CLORETS. In the ERECTIKO trade mark case (1935) 52 RPC page 151, Mr Justice Farwell stated that:

"I do not think it is right to take a part of the word and compare it with a part of the other word; one word must be considered as a whole and compared with the other word as a whole."

Comparing the marks at issue as wholes, I do not think there is any likelihood of direct visual confusion. Even allowing for imperfect recollection, the low cost of the goods and the opponents' reputation under their mark, I do not think there is any real risk of confusion. The only visual similarity between the marks is the prefix, and even these are not the same.

To the ear the ending of CHLORMINT is, in my view, unlikely to be swallowed in use. Overall I do not regard the two words as similar enough as to be likely to be confused. I have not overlooked the fact that the opponents sell a mint product which they market as a 'Mini Mint' (as shown in Annex A). However, there is, in my view, a significant difference to the ear between CLORETS 'mini mints' and CHLORMINT. The fact that CLORETS is in the plural rather forces one to express the former as three words, whereas the applicants' mark would, I think, be expressed as a single word. Moreover, I must be careful to guard against notionally adding the word MINT to the opponents' trade mark for the purposes of comparison, when it is clear from the evidence that it forms no part of their *trade mark*.

In deciding that there is no real tangible risk of aural confusion, I also bear in mind that, on the opponents' own evidence, these goods are generally bought from point of sale displays where they are generally picked up following visual selection. In those circumstances the likelihood of aural confusion is considerably lessened. I am fortified in this view by the following comments of Whitford J. In the case of Mars GB Ltd and another v Cadbury Ltd, 1987 RPC 395 at lines 35-37:

“...when the goods are, for the most part, picked up by the customers, and on the goods as picked up the marks will be clearly visible, the question of sound is perhaps becoming of diminishing importance.”

5 The evidence of Mr O’Shea, on behalf of the opponents, raises the possibility of confusion arising under another heading. He argues that, even if the public do not directly confuse the marks, they might expect the respective goods to originate from the same source. This argument is based on the similarity of the respective prefix, the uniqueness of the prefix CLOR- on the UK market for BFC products, and the opponents’ extensive reputation under their mark.

10 As I have already noted the prefix of these marks are not identical. And as Mr Alexander pointed out during the hearing, the opponents are not in the position of being able to show that they have a family of CLOR- marks in use in the United Kingdom, so that it might reasonably be claimed that the applicants’ mark would be seen as an extension of their existing range. I cannot see any
15 grounds for concluding that the public will expect all BFC goods sold under a trade mark with the prefix CLOR- or CHLOR- to originate from a common source. I have not overlooked the applicants’ contention that the prefix CHLOR- is, in any event, likely to be seen as an allusion to the presence of chlorophyll in their goods rather than as a connection with the opponents. However, in view of my earlier findings, I see no need to say any more about that submission.
20 I am not satisfied that there is any real tangible risk of confusion if the mark which it is sought to register is put on the register and used in a normal and fair manner (per Lord Upjohn in *Berlei v. Bali* 1969 RPC 496) The opposition under Section 11 therefore fails. In the light of my earlier comments it follows that the opposition under Section 12 also fails.

25 There remains the question of the Registrar’s discretion. At the hearing Mr Tritton tentatively suggested that I should consider whether if, as the applicants contend, the prefix CHLOR- is descriptive of BFC products containing chlorophyll, and the suffix of the applicants’ mark is entirely descriptive, the mark as a whole can be said to be distinctive and therefore to qualify for registration under Section 9 or 10 of the Act. I believe that Mr Tritton’s submission may have
30 overlooked the distinction between a true description and an allusion. In any event, I think that Mr Tritton accepted in the end that it was not appropriate for the Registrar to consider using his discretion under Section 17(2) of the Act to refuse an application on grounds that were originally pleaded in an opposition but subsequently specifically withdrawn by the opponents. I can see no other grounds for using the Registrar’s discretion adversely to the applicants.

35 The opposition having failed the opponents would normally be entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £850.

Dated this 25th Day of June 1998

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**ALLAN JAMES
For the Registrar
the Comptroller General**

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ANNEX A

