

O-016-10

THE TRADE MARKS ACT 1994

**APPLICATION NO. 2384901 BY RDPR LIMITED TO REGISTER THE TRADE
MARK**

“ROJA DOVE”

IN CLASSES 3 AND 42

OPPOSITION THERETO NO. 94284 BY UNILEVER PLC

APPEAL OF RDPR LIMITED TO THE APPOINTED PERSON

DECISION

Introduction

1. This is an appeal by RDPR Limited, the applicant, against the decision of the hearing officer in favour of the opposition of Unilever Plc.
2. The application is to register the name ROJA DOVE for the following specifications of goods:

Class 3

Perfumes and perfumery products, aromatic substances for use in the manufacture of perfumes; perfumed products; perfumed bath foam preparations; perfumed bath salts; perfumed milks; perfumed lotions; perfumed sprays; perfumed creams; perfumed soaps

Class 42

Research services into the development of perfume products.

3. The opposition is brought by Unilever Plc (“Unilever”). It was based on s5(2)(b), s5(3) and s5(4)(a) of the Trade Marks Act 1994. The hearing officer upheld the opposition on the basis of s5(2)(b) and did not consider s5(3) and s5(4)(a). These are not asserted by the Respondent by way of Respondent’s Notice and are therefore not relevant to this appeal.
4. The opposition under s5(2)(b) was based on a single earlier registered trade mark of Unilever Plc, no. 2371471. This is for the word “DOVE”. It is registered for a wide range of goods and services in classes 3, 8, 21, 24, 25, 35 and 44. I will refer to it hereafter as “the DOVE mark”. There is no point in reciting the specification in full, since many of the goods and services are irrelevant to this appeal.
5. The significant goods and services for which the DOVE mark is registered are those in class 3 and class 44:

Class 3

Soaps; detergents; bleaching preparations, cleaning preparations; perfumery, toilet water, aftershave, cologne; essential oils; aromatherapy products; massage preparations, deodorants and anti-perspirants; preparations for the care of the scalp and hair, shampoos and conditioners; hair colourants; hair styling products; toothpaste; mouthwash; preparations for the care of the mouth and teeth; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun-protections preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, cotton sticks; cosmetic pads,

tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks, facial packs.

Class 44

Beauty salon services; hairdressing services; manicure and pedicure services; aromatherapy; sun tanning services; sauna, solarium and massage services; information and advisory services relating to health, diet, exercise, lifestyle, healthcare, beauty care, skin care, perfumery, deodorants, nutrition and hygiene; research services relating to health, diet, exercise, lifestyle, healthcare, beauty care, skin care, perfumery, deodorants, nutrition, hygiene.

6. The trade mark DOVE has been used by Unilever on a very substantial scale, particularly in relation to soap, but also in relation to deodorant and skin care products. It has not been used at all in relation to many of the goods and services covered by the registration, even within class 3. In the end it was common ground between the parties that the mark DOVE had established a reputation (sufficient for s5(3) and therefore a fortiori sufficient to be taken into account in relation to likelihood of confusion under s5(2)(b)) in relation to soaps, deodorants, antiperspirants, shampoos and conditioners, bath and shower preparations and skin care preparations.
7. The applicant, RDPR Limited, is the corporate vehicle for Mr Roja Dove, a perfumier of international repute. Mr Roja Dove spent some 20 years as head perfumier at the Guerlain perfume house in Paris, and now operates as an independent fragrance expert. He has designed a series of limited edition and “bespoke” perfumes, and since 2004 has operated the Roja Dove Haute Parfumerie within Harrods and other high end stores. In 2007 he launched a more accessible range of 3 fragrances bearing his name, although these are still sold at around £350 for a 100ml atomiser.
8. A great deal of evidence was filed about Mr Roja Dove’s reputation. The hearing officer set this out at some length in her decision. I think the effect of the evidence can be summarised as follows (I use the present tense but should be taken as referring to the date of application for the trade mark which is February 2005). Within the perfume industry itself and those involved in the perfume business (whether as retail buyers, writers for magazines, the advertising industry etc.) he is very well known. Amongst the

general public he is not well known save to those who take a special interest in perfumery.

9. At the hearing before the hearing officer and in the evidence, the applicant stressed that his “haute parfumerie” products were in a completely different category from the DOVE products sold by Unilever. There is no doubt that this is true. It seems to me unlikely in the extreme that anyone purchasing even the cheapest ROJA DOVE fragrance (at £350) would consider for one moment that it was connected with the DOVE soap and skin care products which can be bought off the shelf in Boots for pence rather than pounds. It is in fact almost inconceivable that anyone could buy a ROJA DOVE product as it is sold at the moment without becoming aware of Mr Roja Dove and therefore the true origin of the mark.
10. However, the hearing officer rightly pointed out that this was strictly irrelevant to the question to be considered under s5(2). The trade mark is not limited by price or exclusivity of product. Nor is it event limited to perfumes. Likelihood of confusion must be considered on the basis of any “normal and fair use” of the trade mark. Such use would include applying it to products including cheaper perfumes or basic perfumed soaps sold in direct price competition with DOVE soap through the same retailers.
11. In paragraph 37 of her decision, the hearing officer set out the legal principles underlying the assessment of likelihood of confusion by reference to the well known ECJ authorities including Sabel v Puma [1998] RPC 199, Canon KK v Metro-Goldwyn-Mayer [1999] RPC 117 and Medion v Thomson C-120/04. There is no dispute that this was an accurate account. She proceeded to consider the various factors which those authorities suggest are of importance in the overall “global” assessment which the tribunal is obliged to make.
12. The hearing officer’s findings on the various factors may be summarised as follows:
 - (a) The relevant consumer for the class 3 goods is a member of the general public. The relevant consumer for the class 42 services is a manufacturer of perfume products.

- (b) The level of attention which would be paid by the relevant consumer when purchasing the class 3 goods would vary depending on the goods on question. Depending on the goods it would be “at either end of the spectrum and at various points in between.” In the case of the class 42 services, the level of attention would be “reasonably high since business decisions/investment will be based upon the results of the research.”
- (c) The class 3 goods applied for are identical with the class 3 goods which are the subject of Unilever’s DOVE trade mark. The class 42 services applied for are identical or almost identical with the class 44 services which are the subject of Unilever’s DOVE trade mark.
- (d) There is a high degree of similarity between the marks. The relevant consumer would not understand the word ROJA to have any particular meaning, and would therefore “fasten upon” the word DOVE, the primary significance of which is a white bird or symbol of peace.
- (e) The mark DOVE has an inherently high degree of distinctive character since it “does not describe the goods or services in any way”. However, it does not have the highest degree of distinctive character since it is not a wholly invented word.
- (f) The extensive use of the mark DOVE has increased its distinctive character.

13. The hearing officer considered the question of likelihood of confusion in the light of her findings on these factors and the various submissions which were made to her. She considered the position in relation to the class 3 goods and the class 42 services separately but her conclusion was the same on both. She concluded that the average consumer would not directly confuse the marks with each other, but that he or she would believe that the goods and services sold under the marks DOVE and ROJA DOVE were associated in that they came from the same or economically linked undertakings.

14. I shall deal with the attacks made on that decision separately with respect to class 3 and class 42.

Class 3

15. The primary attack on the decision in relation to the class 3 goods is that it fails to distinguish between the various products covered by the application. In particular, it fails to recognise that there is a major difference in terms of likelihood of confusion between “*Perfumes and perfumery products*” and the other categories of product covered by the application in class 3.
16. I consider that this is a valid criticism of the decision. There are two reasons why the question of likelihood of confusion in relation to perfumes and perfumery products deserved separate consideration in this case.
17. The first reason is that these are not products in relation to which Unilever has used the DOVE mark, nor are they closely similar to such products. It will be recalled that the hearing officer held that the mark DOVE benefited from “enhanced distinctiveness” as a result of its extensive reputation in relation to soaps, deodorants, antiperspirants, shampoos and conditioners, bath and shower preparations and skin care preparations. This “enhanced distinctiveness” tends to increase the likelihood of confusion [Sabel v Puma] and was clearly regarded by the hearing officer as a relevant factor in her ultimate decision.
18. It seems to me that any increase in the likelihood of confusion as a result of enhanced distinctiveness through reputation inevitably diminishes as one moves away from the core products in relation to which the mark has been used. Particularly with marks which are not fanciful or invented words, the “trigger” which creates an association in the mind of the public between a mark and its proprietor is not simply familiarity with the mark, but familiarity with the mark in a particular context. Here the public have become used to seeing the word DOVE as a trade mark in the particular context of soap, deodorants, shampoos etc. – what Mr Malinicz calls “fast moving consumer products” - not in the context of perfumes. Inherently, therefore, they are much less likely to see a connection with the DOVE mark when they see a similar mark being used as the name

of a perfume than when they see it being used as the name of (for example) a bar of soap.

19. The question of the significance of the reputation of the mark DOVE in relation to goods which had not been sold under the mark (in particular perfume) was considered by the hearing officer in paragraph 61 of her decision. The argument put to her may have been somewhat overstated – namely that the reputation of the mark was irrelevant in respect of such goods. However, she appears to have considered that she ought not to take any account of the fact that the DOVE mark had no reputation in respect of perfume. Her reasoning is puzzling:

“I agree that it is a novel concept to preclude a likelihood of confusion when a mark is less than five years old because it has a large reputation through use on certain goods within its specification and not on others. This seems to penalise a proprietor for having a reputation and place him in a worse position than if he hadn’t traded under a sign at all.”

20. The argument was not that likelihood of confusion was “precluded” in relation to the goods for which the mark had no reputation. Rather that confusion was less likely in relation to those goods. Further, I do not understand the idea that the argument “penalises” a proprietor for having a reputation. It simply places a limit on the extent to which that reputation is treated as increasing the likelihood of confusion.
21. The hearing officer also pointed out that she had already held that perfume was “similar” to the goods which had been sold under the DOVE mark, and that Unilever themselves used to own certain brands of perfume. I do not see that either of those points takes away from the validity of the underlying submission. In my view it is self-evident that the reputation of the DOVE brand is of far less significance in terms of likelihood of confusion in respect of goods (specifically perfume) on which it has never been used than in respect of those goods for which it is well known.
22. The second reason is that the process which the consumer goes through when purchasing perfume is materially different from the process of purchasing a fast moving consumer product such as soap. The hearing officer herself remarked that most people

will try perfume before they buy it and may retain a loyalty to a particular scent for years (decision para 42). Whether perfume is being purchased by an individual for her or his own use, or by someone as a present, the purchasing process will be carried out with particular care, and certainly with more care than the purchase of a bar of soap or a bottle of shampoo. This will obviously reduce any prospect of confusion.

23. In the circumstances, I consider that the factors to be taken into account on the question of likelihood of confusion were materially different in respect of perfumes/perfumery products than in respect of the other products which are the subject of the class 3 application. The hearing officer ought to have considered those products separately, and recognised the difference. I believe this was a material error, not least because it is clear that the reputation of the DOVE mark played an important part in her reasoning on the question of likelihood of confusion. In paragraph 65 of her judgment, she says as follows:

“ROJA DOVE does not have a blend of meaning and significance for the UK English-speaking average consumer for the goods in issue. DOVE is a highly distinctive mark for these goods and is a household name.”

This statement could not be made without qualification in respect of perfumes because, DOVE is not a household name for those products.

24. This error is sufficient to overcome the “real reluctance” which I am required to have before interfering with a decision of a specialist tribunal on a jury-type question such as likelihood of confusion [“Reef” Trade Mark [2003] RPC 5 at 28], and I will therefore consider the question of likelihood of confusion afresh.

25. In my view the hearing officer’s conclusion on likelihood of confusion was wrong insofar as it relates to “*perfumes and perfumery products*”. On balance, I believe that the average purchaser of such products, reasonably circumspect and observant, and taking the care which one would normally expect to take in the purchase such products, would not be likely to conclude that ROJA DOVE and DOVE came from the same or an economically linked undertaking. In coming to that conclusion, I differ from the hearing officer’s assessment of the relevant factors in the following respects:

- (a) As I have said, DOVE does not enjoy a reputation in respect of perfume, and there is no reason to believe that the public would expect a soap manufacturer to “branch out” into perfume (no evidence of diversification in that direction was provided);
- (b) I do not agree with the hearing officer’s view that the mark DOVE enjoys a “high degree of inherent distinctive character”. It is certainly inherently distinctive but to my mind the word “high” overstates the position. The word DOVE is a common word and also a surname. More significantly, its symbolic association with positive concepts of purity and peace is well-known, and the public would therefore not be greatly surprised to find it being used by a variety of traders, particularly for beauty care products and the like. It is therefore less strikingly distinctive than another choice of bird would be - for example, “PHEASANT” or “WAGTAIL”;
- (c) I consider that it is highly significant that the word ROJA has no obvious meaning to the average consumer, and would therefore be taken as an invented word. This gives it a high degree of distinctive significance in the mark as a whole, particularly given the fact that it is the first part of the mark.
- (d) The hearing officer’s conclusion implies that the public may take one mark as a kind of “brand extension” or “sub-brand” of the other. But a brand extension would not normally bring in a new and highly distinctive word as the first element of a composite mark. This in my view makes it less likely that the public would believe that the marks were associated, certainly in the context of goods for which the mark DOVE had no reputation.

26. I also consider that there is no likelihood of confusion in relation to “*aromatic substances for use in the manufacture of perfumes*”. The same points made above apply, with the additional factor that such products would generally be supplied to the perfume industry, rather than the general public. This would plainly reduce the likelihood of confusion still further (see below).

27. So far as the other products within class 3 are concerned, I see no reason to interfere with the decision of the hearing officer.

Class 42

28. The hearing officer rightly identified the relevant consumer in respect of the class 42 “*research services into the development of perfume products*” as being a manufacturer of perfume products. She went on to conclude that the level of attention of such a consumer of such services as being “reasonably high”. This seems to me to be an understatement. As she pointed out, business decisions and investment would be based on the results of such research. It is therefore of obvious and critical importance to ensure that research is carried out by the right people. The level of attention to the selection of the provider of such services can therefore be expected to be extremely high.
29. In the circumstances, it is hard to imagine how any kind of operative confusion could arise in relation to the class 42 services. As the hearing officer held, there is no question here of someone simply mixing up the two marks. Anyone would immediately recognise that the marks are different. The finding of confusion therefore requires the existence of some kind of thought process by which the consumer concludes from the similarity of the marks that the services being provided must come from the same source. It seems to me to be entirely improbable that this would occur in the context of the provision of research services to the perfume industry. Even if someone in the perfume industry did ask himself whether research services being offered under the name ROJA DOVE were from the same source as those being offered under the name DOVE, he would be most unlikely to make any assumptions without checking the facts for himself. Of course, the very nature of research services demands personal dealings between the consumer and the provider of the service, so this would be easy to achieve.
30. It is also worth pointing out that Mr Roja Dove is an extremely well-known figure in the perfume industry. To an average consumer of the class 42 services, therefore, the conceptual similarity found by the hearing officer (para 56) to exist in the mind of the average member of the public between DOVE and ROJA DOVE would simply not

apply. One would indicate the white bird of peace. The other would indicate the well-known perfumier. Once again, in those circumstances it is hard to see how any confusion could arise. The hearing officer does not appear to have taken this into account when considering the likelihood of confusion in relation to the class 42 services.

31. I therefore consider that the hearing officer's decision on the class 42 application cannot be supported, and that the opposition should be rejected in relation to those services.

Conclusion

32. I reverse the decision of the hearing officer in relation to *perfumes and perfumery products, aromatic substances for use in the manufacture of perfumes and research services into the development of perfume products* and direct that the trade mark be granted in respect of those goods and services. I uphold the decision in relation to the other goods covered by the application.

33. The opposition having partially succeeded and partially failed, it seems to me that there should be no order for costs either of the opposition or of the appeal.

IAIN PURVIS QC

7 January 2009