

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2017358
IN THE NAME OF CONCEPT MARKETING PTY LTD
TO REGISTER THE MARK LEATHERWOOD IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 45417
BY CUSSONS (INTERNATIONAL) LTD AND CUSSONS (UK) LTD**

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in the name of Concept Marketing Pty Ltd
to register the mark LEATHERWOOD in Class 3

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10

IN THE MATTER OF Opposition thereto under No 45417
by Cussons (International) Ltd and Cussons (UK) Ltd

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DECISION

On 12 April 1995 Concept Marketing Pty Ltd applied to register the mark LEATHERWOOD
in Class 3 for a specification of goods which reads “Soap, bath gel, hair conditioner,
20 perfumery, cosmetics, hair care products, talcum powder, lotion, cream and tonic, for care of
the skin.”

The application is numbered 2017358.

25 On 16 September 1996 Cussons (International) Ltd and Cussons (UK) Ltd, as joint
opponents, filed notice of opposition to this application. The grounds of opposition are in
summary:

- 30 i under Section 5(2)(b) in that the mark applied for is similar to registrations
standing in the name of the opponent companies (individually) and covers
identical or similar goods (see Annex A for details).
- ii under Section 5(4)(a) in that use of the mark applied for is liable to be
prevented by virtue of the law of passing off.

35 The opponents also say that the trade mark IMPERIAL LEATHER is entitled to protection
under the Paris Convention as a well known trade mark and therefore that the subject
application offends against Section 6(1)(c). This Section gives a definition of the term
“earlier trade mark “ rather than in itself providing a further basis for refusing registration of a
40 mark. In view of the opponents’ claims to be the proprietors of earlier trade marks by virtue of
the registrations at Annex A I do not think the well known mark claim needs to be considered
as a separate issue.

45 The applicants failed to file a counterstatement within the statutory period. However both
sides filed evidence in these proceedings. Neither side requested a hearing. Acting on behalf
of the Registrar and after a careful study of the papers I give this decision.

Opponents' evidence

The opponents filed three statutory declarations as follows:

5 Alaric Paul McDermott - dated 13 June 1997
 Julian Hill - dated 13 June 1997
 Nicholas Francis Preedy - dated 17 June 1997

10 Mr McDermott is the Company Secretary of each of the joint opponents and has held that position for 7 years.

15 He exhibits (APM1) details of the registrations referred to in Annex A. He says that Cussons (UK) Ltd have used the mark LEATHER or a trade mark incorporating that word since 1938. The choice of words was fanciful in relation to the goods of interest and sufficiently
20 distinctive to enable registration to be obtained in Classes 3 and 5. He exhibits (APM2) the results of a Trade Mark Register search carried out on 2 June 1997 for all trade marks registered in Classes 3 and 5 incorporating the word or prefix LEATHER. He says his companies are proprietors of all save for those registered in respect of goods for non-personal use being for the treatment of leather.

25 Use of the trade mark IMPERIAL LEATHER commenced in 1938 in relation to soap and has continued to date. Since then the range of goods in respect of which this mark has been used in the UK has expanded to cover deodorants, shave foam, shave gel and bath creme. He exhibits (APM3) a collection of advertisements showing the range of goods sold under the mark. Turnover is said to be as follows:

	1991/92	£23,191,000
	1992/93	£24,041,000
	1993/94	£25,924,000
30	1994/95	£28,905,000
	1995/96	£32,266,000
	1996/97	£33,541,000

and advertising expenditure

35	1991/92	£5,109,000
	1992/93	£5,131,000
	1993/94	£8,131,000
	1994/95	£7,715,000
40	1995/96	£7,699,000
	1996/97	£5,813,000

45 Mr McDermott says that many of the products sold under the trade mark IMPERIAL LEATHER enjoy a large share of their respective markets in the UK. Thus soap sales are said to constitute 25.4% of total soap sales and shaver creme/gel 10.6% of the market for such goods. He adds that he is not aware of any product other than those of his companies sold in

the UK in relation to toiletries under or incorporating the trade mark LEATHER. As a result of this he considers the applied for mark LEATHERWOOD would be associated with his company's products and would cause confusion on the part of the public. Finally he gives information on the use of the mark overseas as a result of which he considers that it has the status of a well known mark.

Mr Hill is a Director of Julian Hill Associates Ltd, a firm of private investigators specialising in the intellectual property field. He was instructed by Mr Preedy of Trade Mark Owners Association Ltd, the opponents' trade mark agents, to search the aisles of supermarkets and "attached chemists" as well as Boots for non-prescription cosmetics and cleaning products, all for personal use marked with the word LEATHER or with the prefix LEATHER. He lists the supermarkets or stores where investigations were made and exhibits (JH1) a copy of the survey produced. He also made enquiries at the Head Office of the companies concerned and exhibits (JH2) a copy of the report produced following telephone conversations with staff at these offices. The only products clearly identified as a result of these enquiries were IMPERIAL LEATHER products. A search of the Chemist and Druggist Directory revealed no product which met the criteria laid down. The only exceptions to the above findings were personal recollections of an aftershave called "Leather something" and a lipstick (no further information supplied).

Mr Preedy is a registered trade mark attorney with Trade Mark Owners Association Ltd. He confirms certain information already supplied by Mr McDermott in relation to use of the mark. The main purpose of his declaration is to exhibit (NFP1) five photographs showing products available for purchase in the UK under the trade mark IMPERIAL LEATHER. All are said to have been available at the date of application for registration of the mark at issue save for two antiperspirant deodorants that are identified in the relevant photograph.

Applicants' evidence

The applicants filed a declaration dated 28 January 1998 by Barry Ross Matulick, their Managing Director, a position he had held since 1983.

Mr Matulick says his company has not yet used the mark applied for in the United Kingdom in relation to the goods at issue but intends to do so. He exhibits (CM1) examples of packaging for toilet soap, a shower cap, a soap box and a shampoo bottle.

He denies that there is any similarity between the get up of the IMPERIAL LEATHER products and those of his company and likewise between the names IMPERIAL LEATHER and LEATHERWOOD. He says that his company adopted the name LEATHERWOOD because it is the name of a flowering shrub native to Australia (though it does not have a scent which can be commercially extracted).

In relation to the opponents' position he comments that

"None of the evidence submitted by the opponents shows use of any other mark than IMPERIAL LEATHER. There is apparently no use of the name LEATHER in

isolation (which I understand to be registered in the United Kingdom under Number B879287). It may well be the case that the only toiletries sold in London which incorporate the word LEATHER are those of the opponent but this does not demonstrate to me that the public would confuse the name IMPERIAL LEATHER with LEATHERWOOD or that they would think there was some connection between my company and the opponents.”

Finally he refers to his company’s use of their mark in a number of countries and notes that the opponents’ IMPERIAL LEATHER products are said to be on sale in Australia. To the best of his knowledge there have never been any instances of confusion arising from the companies’ respective use in that country.

That completes my review of the evidence.

I will deal firstly with the ground based on Section 5(2)(b). This reads as follows:-

“5.-(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.”

The term “earlier trade mark” is itself defined in Section 6 of the Act as follows:-

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

In considering the matter I also bear in mind the approach adopted by the European Court of Justice in *Sabel v Puma* 1998 RPC 199. The Court considered the meaning of Article 4(1)(b)

of the Directive (EC Directive 104/89) which corresponds to Section 5(2) of the Act and stated that:

5 “... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors
10 relevant to the circumstances of the case.

15 That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - ‘... there exists a likelihood of confusion on the part of the public ...’ - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”
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25 Whilst the opponents have a number of registrations consisting of or containing the word LEATHER it will be convenient to consider the matter on the basis of No 879287 which is for the word LEATHER solus. That registration includes a broad range of non-medicated toilet preparations and cosmetic items in Class 3. The applicants have not suggested that the goods of their application are other than identical or similar to those of the opponents’ registration. For the record I confirm that in my view there is a clear and direct overlap in the respective sets of goods.

30 So far as the marks themselves are concerned it is immediately apparent that the applicants’ mark contains the whole of the mark LEATHER. It is also of course the first and most prominent element in the mark applied for. Against this it can be said that the words are in overall terms dissimilar in length and appearance and can also be distinguished aurally. The test set out in *Sabel v Puma* also requires me to consider the conceptual similarity between the marks and to consider the matter from the point of view of the average consumer. The
35 word LEATHER is a common English word and would convey a clear meaning to most people. So far as I am aware that meaning is a wholly distinctive one in relation to the goods at issue. No evidence has been placed before me to indicate what the average consumer would make of the word LEATHERWOOD. The applicants say that it is the name of a flowering shrub native to Australia. That may be the case but no dictionary material has been provided to confirm the point. Nor, even if it had, would I necessarily have been persuaded that this meaning would have been immediately apparent to consumers in this country who cannot generally speaking be expected to be familiar with the names of shrubs in distant countries. Certainly I am not prepared to accept that such an understanding would prevail in the absence of supporting evidence confirming the point. What then would the average
40 consumer make of the word LEATHERWOOD?. It appears to be the juxtaposition of two words, “leather” and “wood”, which in their own right have clear meanings but which at best,
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from the applicants' point of view, make a slightly unusual combination. However the word LEATHER is not lost or subsumed within the totality nor does the combination create any discernible new meaning such as might lead to a clear conceptual difference between the marks. On the contrary it seems to me that consumers familiar with the mark LEATHER would, if they encountered the mark LEATHERWOOD, think it was connected in some way with the mark with which they were familiar. Taking all these factors into account I consider that there is a likelihood of confusion between the respective marks. The opposition, therefore, succeeds under Section 5(2)(b).

As my above finding determines the opposition it is not necessary for me to reach a formal view on the Section 5(4)(a) objection but I will give a brief indication of how I see the parties' positions in relation to this ground. The Section reads as follows:-

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

To succeed under Section 5(4)(a), an opponent must be able to show that, at the date of application, he was likely to have succeeded in a passing off action. To succeed in a passing off action, it is necessary for the opponents to establish that at the relevant date, they had acquired goodwill under their mark, that use of the applicants' mark would amount to a misrepresentation likely to lead to confusion as to the origin of the applicants' goods, and that such confusion is likely to cause real damage to their goodwill. A fuller summary of the position can be found in WILD CHILD Trade Mark 1998 RPC 455 at page 460 et seq.

Although the opponents have a number of different marks registered the evidence filed does not show use of the word LEATHER on its own. In practice a number of different formats and get-ups are used but the exhibits to Mr McDermott and Mr Preedy's declarations clearly show the main and essential feature of the marks used are the words IMPERIAL LEATHER. These words are often associated with other indicia such as the house mark CUSSONS with or without an accompanying device but these supplementary features do not detract from the importance of the words IMPERIAL LEATHER themselves. This mark has a long history and the recent years' turnover figures combined with a significant market share (particularly for soaps) confirm a substantial level of use. Use does not always translate into reputation but I accept on the basis of the evidence before me that the mark IMPERIAL LEATHER can claim a significant reputation certainly in relation to soap, shower creme/gel and probably a number of closely related products. In the absence of a more detailed breakdown of sales figures I would not accept that the reputation extends to, for instance, perfumes but that is

probably not a significant matter for current purposes. In short for a wide selection of toiletry items the opponents have in my view satisfied the first part of the passing off test.

5 The issue of potential misrepresentation is less clear cut. I say “potential” because the applicants have not yet used their mark so I am considering the matter in effect as a quia timet action. I decided in relation to Section 5(2)(b) that there was a danger of the applicants’ mark being confused with the opponents’ registration of the word LEATHER. The mark used, IMPERIAL LEATHER, gives rise to rather different considerations to the word LEATHER on its own. Not only is LEATHER the second element but its association with the word
10 IMPERIAL creates an unusual and distinctive combination. It is true that Mr Hill’s researches revealed no other traders in this product area using the word LEATHER on its own or as prefix to a mark (I regard the references to “personal recollections of an aftershave called ‘Leather something’ and a lipstick” as being too vague to detract from the general point being made). But even accepting this state of affairs it cannot of itself determine
15 whether use of the applicants’ mark would involve a misrepresentation. As there has been no hearing I have had no submissions on the matter to help me. The test set down by Lord Oliver in Reckitt & Colman Products Ltd v Borden Inc (1990 RPC 341 at page 406) is that:

20 “..... he (the plaintiff) must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff.”

25 Given the differences between the opponents’ mark IMPERIAL LEATHER and the applicants’ mark LEATHERWOOD I am by no means convinced that the purchasing public will consider that goods sold under the latter mark emanate from the plaintiff. The mere fact that no other trader currently uses LEATHER or a word prefixed with LEATHER in this goods’ area does not carry the necessary consequence that any subsequent entry into that marketplace of a ‘LEATHER-’ mark must involve a misrepresentation. At the end of the day
30 it is a matter of judgement based on the circumstances of the case before me. It follows also from this that I am unable to conclude that there will be any real tangible damage to the opponents’ business if the applicants were to use their mark LEATHERWOOD. In short though I do not need to make any formal finding in relation to Section 5(4)(a) I am of the view that the opponents would be unlikely to succeed under this head.

35 As the opponents have been successful in these proceedings they are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of **£600**.


40 Dated this 21st day of September 1998

45 M REYNOLDS
For the Registrar
the Comptroller-General

ANNEX A

In the name of Cussons (International) Ltd

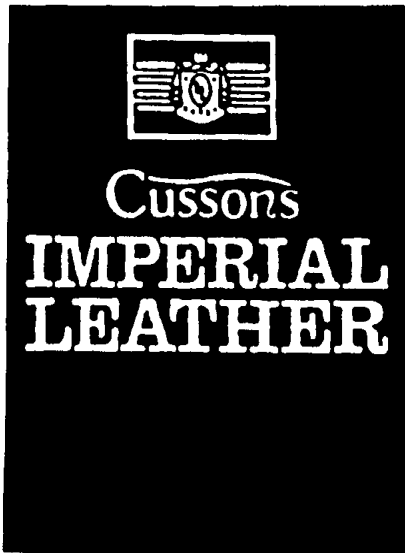
NUMBER	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
5				
879287	LEATHER	3, 5	4549/ 01451	<u>Class 3:</u> Perfumes, non-medicated toilet preparations, cosmetic preparations, dentifrices, depilatory preparations, toilet articles (not included in other classes), sachets for use in the waving the hair, shampoos, soaps and essential oils. ++ In so far as they relate to goods for sale in the United Kingdom.
10				
15				
20				<u>Class 5:</u> Deodorants for personal use, for export.
879288	IMPERIAL LEATHER	3, 5	4565/ 00227	<u>Class 3:</u> Perfumes, toilet preparations (not medicated), cosmetic preparations, dentifrices, depilatory preparations, toilet articles (not included in other classes) sachets for use in waving the hair, toilet soaps and essential oils. in so far as they relate to goods for export..... Perfumes, toilet preparations (not medicated), cosmetic preparations, dentifrices, depilatory preparations, toilet articles (not included in other classes) sachets for use in waving the hair, toilet soaps and essential oils. except in so far as they relate to goods for export.
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30				
35				
40				
45				

NUMBER	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
5	<u>879288 continued</u>			<u>Class 5:</u> Deodorants for personal use, for export. Deodorants for personal use all for sale in the United Kingdom.
10				
940968		3	4787/ 00835	Perfumes, non-medicated toilet preparations, cosmetic preparations, dentifrices, depilatory preparations, toilet articles included in Class 3, sachets for use in waving the hair, shampoos, soaps and essential oils, all being goods for export.
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20				
1195522	IMPERIAL LEATHER CLASSIC	3	5562/ 00860	Perfumes; non-medicated toilet preparations; cosmetics; dentifrices; shampoos; soaps; preparations for the hair; non-medicated preparations in the form of lotions and of creams, all for the care of the skin, scalp and the body; anti-perspirants; all for export from the United Kingdom..... Perfumes, non-medicated toilet preparations, cosmetic preparations, dentifrices, shampoos for supply in sachets for use in waving the hair, and toilet soaps; all for sale in the United Kingdom.
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35				
40				
45				

NUMBER	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
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5	1235977	3	5615/ 00938	Anti-perspirants; deodorants for personal use; perfumes; non-medicated toilet preparations; cosmetics; shampoos; dentifrices; toilet soaps; all for sale in the United Kingdom.
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1236717	3	5621/ 01292	Anti-perspirants; deodorants for personal use; perfumes; non-medicated toilet preparations; cosmetics; dentifrices; shampoos; toilet soaps; all for export from the United Kingdom.
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In the name of Cussons (UK) Ltd

5	NUMBER	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
10	940967		3	4787/ 00835	Perfumes, non-medicated toilet preparations, cosmetic preparations, dentifrices, depilatory preparations; toilet articles included in Class 3, sachets for use in waving the hair, shampoos, soaps and essential oils, all being goods for sale in the United Kingdom.
20	1122632	IMPERIAL LEATHER CLASSIC	5	5457/ 00652	Deodorants for personal use, for sale in the United Kingdom.
25	1132296		3	5427/ 02115	Anti perspirants; perfumes, non-medicated toilet preparations, cosmetic preparations, dentifrices, shampoos and soaps.
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NUMBER	MARK	CLASS	JOURNAL/ PAGE	SPECIFICATION
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5	1132297	5	5446/ 00120	Deodorants for personal use.
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1248614	IMPERIAL LEATHER COOL	3	5667/ 00835	Talcum powders for toilet use; non medicated powders for the care of the body, toilet soaps; shampoos; deodorants for personal use; all for sale in the United Kingdom.
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