

TRADE MARKS ACT 1994
AND TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

**IN THE MATTER OF INTERNATIONAL
REGISTRATION NO. 657165 AND THE
REQUEST BY MATTHIAS GIESEN TO
PROTECT A TRADE MARK IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 70002 BY UNILEVER PLC & ELIDA
FABERGE LTD (JOINT OPPONENTS)**

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On 10 May 1996, Matthias Giesen of Koln, Germany, on the basis of a registration in that country, requested protection in the United Kingdom of the trade mark “MIRADENT” under the provisions of the Madrid Protocol. The international registration is numbered 657165 and protection was sought in Class 3 for a specification of goods which reads as follows:

“Non-medical toothpaste, mouth-wash, products for oral hygiene”.

The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration, specifying the goods for which protection was to be conferred, were published in accordance with Article 10.

On 11 June 1997, Unilever PLC and Elida Faberge Limited (Joint Opponents), filed notice of opposition to the conferring of protection on this international registration. The grounds of opposition are:-

- i) under Section 3(1)(a) because the trade mark is not capable of distinguishing the requester’s goods.
- ii) under Section 3(3)(a) because the trade mark is contrary to public policy.
- iii) under Section 5(2)(b) because the trade mark “MIRADENT” is similar to the opponents’ earlier trade mark “MENTADENT” for the same or similar goods.
- iv) under Section 5(4) because of the opponents’ reputation and goodwill in the trade mark “MENTADENT” the applicant would be prevented from using their trade mark under the common law tort of passing off

The opponents’ trade mark number 1292857 is registered for the following goods:

Class 3: Dentifrices and non-medicated mouthwashes.

Class 5: Medicated preparations having cleaning and protective properties, for the treatment or prophylaxis of the mouth, teeth and of the gums; medicated mouthwashes; denture polishes; tablets for oral use for

- 5 disclosing dental plaque.
- Class 10: Dental floss, dental apparatus, dental mirrors
- Class 21: Toothbrushes, toothbrush holders, toothpicks and toothpick holders
10 (not of precious metals or coated therewith); sponges (not for surgical purposes), combs, brushes included in Class 21, and toilet utensils.....toothbrushes.
- Class 41: Educational services included in Class 41, relating to the health of the
15 mouth, teeth and gums.
- Class 42: Health care services included in Class 42 relating to the mouth, teeth
and gums

20 The opponents ask the Registrar to refuse the request to protect the international registration and award costs in their favour.

25 In accordance with Article 10(4) of the Trade Marks (International Registration) Order 1996, the form TM7 and notice of opposition was sent to the International Bureau and to the international registration holders on 19 June 1997. No counter-statement or address for service in the United Kingdom was filed and therefore no evidence in support of the application has been adduced by the requester.

30 The opponents have not filed any evidence in support of their opposition to the request for protection but have requested that a decision be taken from the Notice of Opposition on file, on the basis of which, and after careful study, I give the following decision.

35 First of all, in the absence of any evidence, from the opponents in support of their opposition to this request for protection based upon the provisions of Section 3 of the Act, I have no information available to me which was not available to the Trade Marks Examiner. I see no reason therefore to reconsider the Trade Mark Examiner’s decision that this request for protection satisfies the requirements for registration, as required by Article 3 of the Order and Section 3 of the Act. However, in case I am wrong in summarily dismissing the opposition
40 based upon the provisions of Section 3, I go on to consider the matter in some detail.

Section 3 of the Act so far as it is relevant states:

3.(1) The following shall not be registered -

- 45 (a) signs which do not satisfy the requirements of section 1(1)

Section 1(1) in turn states:

50 **1.(1)** In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking

5 from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

10 **3.(3)** A trade mark shall not be registered if it is -

- (a) contrary to public policy or to accepted principles of morality, or
- (b)

15 The opponents submit that the trade mark applied for is not capable of distinguishing the applicants' goods from the opponents and as such is contrary to Section 3(1)(a). In my view this objection, under Section 3(1)(a) of the Act has no substance. This Section is concerned with the inherent capacity of a sign to function as a trade mark, and there is nothing as far as I am aware which would prevent this word from doing that. This ground of opposition fails.

20 The opponents go on to contend that the trade mark applied for contravenes Section 3(3)(a) of the Act, in that the mark applied for is contrary to public policy. There is nothing before me to show that the mark is contrary to public policy the opponents having offered no evidence to support this pleading. Therefore I do not consider this ground proven and dismiss the
25 opposition so far as it is based upon Section 3(3)(a).

I turn to the ground of opposition based upon Section 5(2)(b), which states:

30 **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,

35 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

40 An earlier trade mark is defined in Section 6(1)(a) which states:

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
45 that of the date of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

I consider this ground on the basis of 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:
50

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
10 of confusion must therefore be appreciated globally, taking into account all factors
relevant to the circumstances of the case.

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,
15 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
20 whole and does not proceed to analyse its various details.”

I also have regard to the approach adopted by the European Court of Justice in *Canon
Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. (Case C-39/97) (as yet unreported)* which
also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering
25 the relationship between the nature of the trade mark and the similarity of the goods stated:

“A global assessment of the likelihood of confusion implies some interdependence
between the relevant factors, and in particular a similarity between the trade marks and
between these goods or services. Accordingly, a lesser degree of similarity between
30 these goods or services may be offset by a greater degree of similarity between the
marks, and vice versa. The interdependence of these factors is expressly mentioned in
the tenth recital of the preamble to the Directive, which states that it is indispensable to
give an interpretation of the concept of similarity in relation to the likelihood of
confusion, the appreciation of which depends, in particular, on the recognition of the
35 trade mark on the market and the degree of similarity between the mark and the sign and
between the goods or services identified.”

40 and

“It follows that, for the purposes of Article 4(1)(b) of the Directive, registration of a
trade mark may have to be refused, despite a lesser degree of similarity between the
goods or services covered, where the marks are very similar and the earlier mark, in
particular its reputation, is highly distinctive.”

45 Finally the court gave the following judgement on the interpretation of Article 4(1)(b):

“On a proper construction of Article 4(1)(b) of First Council Directive 89/104/EEC of
21 December 1988 to approximate the laws of the Member States relating to trade
50 marks, the distinctive character of the earlier trade mark, and in particular its
reputation, must be taken into account when determining whether the similarity

5 between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

10 There may be a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 89/104 even where the public perception is that the goods or services have different places of production. By contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings.”

15 Comparing the two trade marks, I assume that the existing registered trade mark is used in a normal and fair manner on the goods covered by the registration. However, I am given no indication and have no evidence as to whether the opponents’ trade mark has a reputation and whether that extends to some or all of the goods of the registration. Nor am I given any indication or evidence of whether the relevant trade might regard any of the goods covered by the opponents’ registration as the same or similar to the goods covered by the specification of goods of the request for protection. I am therefore left to consider the matter without any evidence or assistance from the parties.

25 It seems to me that the specification of goods of the requestor is the same as the goods of the opponents, in so far as the respective goods fall into class 3. And I regard the goods of the requester as similar to the goods of the opponents which fall into class 5. They are, in essence, the same as the opponents’ class 5 goods but without the medicated ingredient. However, I do not consider that the goods of the opponent which fall into Classes 10 and 21, or the services which fall into Classes 41 and 42 are similar in any way to the goods of the requester. In the absence of any information from either party, I am not able to see in particular, how the services provided under the trade mark “MENTADENT” would be confused with goods provided under the trade mark “MIRADENT” (and vice versa). Nor do I think that the general public would associate the goods of the opponents such as toothbrushes, combs, sponges and dental mirrors with the mouthwash and toothpaste provided by the requester under the trade mark. Therefore, in my view only the goods of the opponents which fall into classes 3 and 5 are the same or similar to the goods of the requester. The remainder of the goods or services of the opponent are so far removed from those of the requester that even if the two trade marks were identical (which they are not) that they do not form a barrier to the request for protection under the provisions of Section 5(2).

40 I turn therefore to consider whether taking into account the fact that the goods covered by the request are the same or similar to some of the goods covered by the opponents’ prior registration, the trade marks themselves are similar. In that respect I note that the two trade marks each consist of three syllables and have the same suffix “DENT”. But there the similarity ends. Taking account of the following note in *Kerly’s Law of Trade Marks & Trade Names* [17-13, page 445]:

45 “It has been accepted in several recent reported cases that the first syllable of a word mark is generally the most important. It has been observed in many cases that there is a “tendency of persons using the English language to slur the terminations of words” “.

50 The prefix “MENTA” is different from the prefix “MIRA” both in visual and phonetic terms

5 such that no one is likely, in my view, to confuse the trade marks as a whole. Particularly as
they both have the suffix “DENT” (presumably an abbreviation for the word DENTAL) and
thus not distinctive in relation to the goods of the respective specifications. Even when the
precise nature of the goods is considered - everyday household items for use by all family
10 members - I do not regard the two trade marks as similar. The visual and phonetic differences
are such as to distinguish one trade mark from another even when not viewed side by side,
because the differences are such as to militate against a conceptual similarity between the two
trade marks even where, as Luxmoore L J said in *RYSTA (60 RPC 87)*, “...the person who
only knows the one word and has perhaps an imperfect recollection of it...”

15 In all of the circumstances the trade marks are neither the same nor similar and the opposition
based upon Section 5(2) is therefore dismissed.

I turn now to consider the opposition under Section 5(4) of the Act.

20 This Section of the Act in so far as it is relevant reads as follows:

5.(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 -

25 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

30 Again I have no evidence before me to support the opposition under Section 5(4) of the Act,
and am unable to consider whether the opponent has any reputation let alone use to support an
action for passing off, “*Wild Child*” 1998 RPC No.14 Page 455 refers, this ground of
opposition is unfounded and as such fails.

35 The opponents have failed on all their grounds of their opposition and in the circumstances it
would be usual to award costs against them. However, as the requesters have not played any
part in these proceedings and therefore have not incurred any costs, so far as I am aware, I
make no order for costs in this case.

40 In the event of no appeal against this decision within the prescribed period the international
registration no. 657165 stands protected in the United Kingdom.

Dated this 24th day of November 1998

45

M KNIGHT
For the Registrar
50 **The Comptroller General**