

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 1564115
IN THE NAME OF LIDL STIFTUNG & CO KG
TO REGISTER THE TRADE MARK SIEMPRE AND DEVICE IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITION NO. 43395
THERE TO BY THE PROCTOR & GAMBLE COMPANY**

AND

**IN THE MATTER OF APPLICATION NO. B1564125
IN THE NAME OF LIDL STIFTUNG & CO KG
TO REGISTER THE TRADE MARK SEMPRE AND DEVICE IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITION NO. 43396
THERE TO BY THE PROCTOR & GAMBLE COMPANY**

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25 **BACKGROUND**

On 2 March 1994 Lidl Stiftung & Co Kg applied under Section 17 of the Trade Marks Act 1938 (as amended) to register the following marks:

30 1564115

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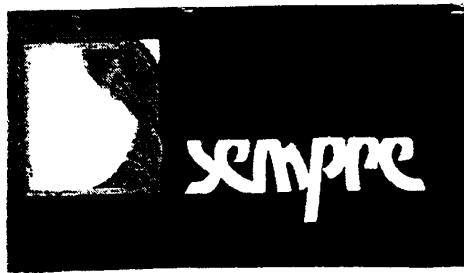


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45 in respect of "Plasters, materials for dressings; sanitary towels, panty liners, tempons, cotton wool; all included in Class 5".

and B1564125

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in respect of "Plasters, materials for dressings; sanitary towels, panty liners, tampons, cotton wool; all included in Class 5".

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The applicants have disclaimed any right to any exclusive use of the device of a flower in the trade mark the subject of no. B1564115, but nothing hangs on that.

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The applicants claim priority from 15 September 1993 by virtue of German applications. On 2nd November 1995, the Proctor & Gamble Company filed notice of opposition to these applications. The grounds of opposition were amended during the proceedings and are now, in summary:-

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1. Under Section 12(1) because the opponent is the proprietor of the trade mark ALWAYS which is the subject of the registrations set out below:

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Mark	No.	Class	Journal
ALWAYS (Word & Device)	1183049	5	5657
ALWAYS DRI WEAVE	1208916	5	5822
ALWAYS (DESIGN & COLOURS)	1219120	5	5716
ALWAYS (LABEL IN COLOURS)	1183048	3	5657

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and the proprietor of the following application:

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Mark	No.	Class
ALWAYS	1533870	5

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This is because the applicants trade marks have the word Siempre/Sempre as an essential feature; this is a Spanish/Italian wording meaning ALWAYS; given that the applications are for the same or similar goods as covered by the opponents trade mark registrations these applications is likely to deceive or cause confusion.

2. Under Sections 9 and 10 in respect of application no. 1564115 because the word SIEMPRE is the Spanish equivalent of the word ALWAYS and, as a new and previously unused trade mark, it lacks distinctiveness and is neither adapted nor capable of distinguishing the goods of the applicant.

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3. Under Section 10 in respect of application no. B1564125 because the word SEMPRES is the Italian equivalent of the word ALWAYS and, as a new and previously unused trade mark it lacks distinctiveness and is therefore not capable of distinguishing the goods of the applicant.

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4. The opponents also seek the exercise of the Registrar's discretion in their favour.

The applicants filed a counterstatement denying these grounds and each side seek an award of costs in their favour.

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The applicants filed evidence in these proceedings, the opponent did not, relying on submissions at the hearing. The matter came to be heard on 21 October 1998 when the opponents were represented by Mr J Groom of Trade Mark Owners Association Ltd and the applicants by Mr D Brown of Counsel, instructed by Page Hargrave & Co. It was agreed at the hearing that both cases would be dealt with in one decision, although they have not been consolidated.

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By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, the relevant provisions of the old law must apply to these proceedings. Accordingly, all references in this decision, are references to the provisions of the old law.

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Evidence

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The applicants filed a declaration dated 8 April 1997 by Howard Nicholas Matthews of Page Hargrave, the trade mark agent acting for the applicant. Mr Matthews states that he instructed Gibbins & Co, trade mark searchers, to effect a United Kingdom trade mark search in all classes for the marks ALWAYS, TOUJOURS, IMMER, SIEMPRE and SEMPRES. He exhibits the resultant search reports which, he says, show that the words TOUJOURS and SIEMPRE are registered by the applicants in Class 3 and the word SEMPRES is registered by the applicants and by others in other classes.

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No other evidence was filed by either party.

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Decision

I turn to consider the grounds of opposition and deal first with those falling under Sections 9 and 10 of the Act which state:-

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9.-(1) In order for a trade mark (other than a certification trade mark) to be

registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- 5 (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- 10 (c) an intended word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- 15 (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registerable under the provisions of this paragraph except upon evidence of its distinctiveness.
- 20

(2) For the purposes of this Section “distinctive” means adapted in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

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(3) In determining whether trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which-

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- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.
- 35

10.-(1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

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(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which-

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- (a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

5 (3) a trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part of parts thereof.

10 I deal first of all with application no. 1564115 which is for the word SIEMPRE and device and which was accepted by the Trade Marks Registry in Part A. I am not able, in these opposition proceedings, if I find that the trade mark in suit is not one which can be accepted in Part A, to consider it as one for registration in Part B of the Register (See Parison Fabrics (1949) 66 RPC 217). Therefore, in respect of the grounds of opposition based upon Sections 9 and 10 of the Act, the application stands or falls on whether the trade mark is adapted to distinguish the applicant's goods as required by Section 9.

15 Clearly the mark is not acceptable under Section 9(1)(a) or (b). As the applicant does not appear to have used the mark prior to the material date (15 September 1993), it would not be acceptable under Section 9(1)(e). Mr Groom submitted that the trade mark was not acceptable as an invented word and referred me to the registry practice manual. I agree that the Registrar's current practice is that foreign equivalents of English words are not deemed invented words and thus the application is not acceptable under that head.

25 Is the mark then one which would be acceptable under section 9(1)(d)? Mr Groom argued that it was not because the mark was the equivalent of the English word ALWAYS and was non-distinctive. First of all, I have had no evidence before me which would allow me to confirm the meaning of the word put forward by Mr Groom, nor to suggest that the word SIEMPRE would be understood by a significant number of people in this country. Further, even if the word did translate from the Spanish into English as "always", I have had no evidence to show how the word would be used - for example, is it a word that could be used on its own or would it only be used as part of a sentence? Absent such evidence, I am unable to find that the word SIEMPRE is one which has a direct reference to the character or quality of the goods.

35 I note that in any event the trade mark does not consist only of the word SIEMPRE but consists of the word in combination with a device element. Given my comments above, and considering the trade mark in question as a whole, I do not consider that it is one which has a direct reference to the character or quality of the goods covered by the specification. Certainly no evidence has been filed which leads me to overturn the examiner's decision to accept the application in Part A.. The opposition under Sections 9 and 10 in respect of application no.1564115 fails accordingly.

40 I now turn to application no. B1564125 for the mark SEMPRES and device and the grounds of opposition based upon Section 10 of the Act. In considering this I turn to the advice of Mr Justice Lloyd Jacob in the Torq-Set case ((1959) RPC 344 at page 346) where he said:-

50 "Part B of the Register is intended to comprise marks which in use can be demonstrated as affording an indication of trade origin without trespassing upon the legitimate freedom of other traders".

Considering application no. B1564125 as a totality, and in the light of my findings above, I have no hesitation in concluding that the application satisfies the guidance given by Mr Justice Lloyd Jacob and accordingly the opposition under Section 10 of the Act, fails.

5 All other grounds of opposition relate to both applications and the remainder of this decision reflects this.

The opponents object to the registration of this application under Section 12 of the Act. All of the marks used to support this ground are now on the register, thus I need only refer to the provisions of Section 12(1) of the Act.

This section of the Act reads as follows:

15 “**12(1)** Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- 20 a. the same goods.
- b. the same description of goods, or
- 25 c. Services or a description of services which are associated with those goods or goods of that description”.

The reference in this section to a near resemblance is clarified by Section 68(2B) of the Act which says that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

30 It is not disputed by the parties that the specification of the applications contains the same goods and goods of the same description as those covered by the opponent’s registrations. I therefore need only to consider whether the marks at issue are “identical with or nearly resemble” the marks of the opponent.

35 For ease of reference, I set out each party’s respective marks below:

Applicant

40 1564115

B1564125

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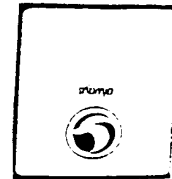
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Opponent

B1183049

B1183048

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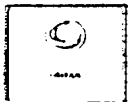


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B1219120

1208916

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1533870

25 ALWAYS

30 The opponent relies on five trade marks that are already on the register. The standard test for opposition under Section 12(1) has been laid down in Smith Hayden's & Co Ltd's application ([1946] 63 RPC 97). Applied to the facts of the present case, the test may be expressed as follows:

35 Assuming use of the opponent's marks ALWAYS, ALWAYS & device and ALWAYS DRI-WEAVE & device in a normal and fair manner for any of the goods covered by these registrations, is the tribunal satisfied that there will be no reasonable likelihood of deception or confusion amongst a substantial number of persons if the applicant uses the mark SIEMPRE & device or SEMPRE & device normally and fairly in respect of any goods covered by the proposed registration?

40 So far as I am aware, the test put forward by Mr Justice Parker in the Pianotist case ([1906] 23 RPC 774) remains the appropriate test for similarity of marks in proceedings under the 1938 Act. He said:

45 "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 circumstance; 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,

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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”.

5 The essence of the opponent’s submission is that there was a likelihood of confusion between the words SIEMPRE/SEMPRE and ALWAYS. Mr Groom submitted that Spanish and Italian are modern languages known to an increasing number of UK residents and that there would be a likelihood of confusion between the applicants and the opponents marks because they all mean ALWAYS. I am not persuaded.

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Clearly the words are easily distinguishable from the word ALWAYS from both a visual and aural point of view. The possibility of any confusion between the respective trade marks is therefore negligible. Even allowing for the fact that the respective goods are everyday feminine hygiene products they are nevertheless likely to be chosen with some care simply because of their nature. That reinforces my view that the applicants and the opponents trade marks, one consisting in essence of an ordinary word of the English language (plus a device and/or another word) and the other of either a Spanish or Italian word each with a device, are not confusingly similar when used in a normal and fair manner. The opposition therefore fails under Section 12.

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The opponents also sought the exercise of the Registrar's discretion in their favour but as the effect of Section 12 is mandatory I see no reason to consider that matter.

25 The oppositions having failed the applicants are entitled to a contribution towards their costs. As these two sets of proceedings were not consolidated, separate costs in respect of each set are appropriate. I order the opponents to pay the applicants the sum of £535 in respect of each of the two oppositions, making a total of £1070.

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Dated this 26 day of February 1999

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