

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2157878
TO REGISTER A SERIES OF THREE TRADE MARKS
IN THE NAME OF MAJID YOUSEFI MORIDANI
IN CLASSES 3 AND 5**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No 49205
BY COLGATE-PALMOLIVE COMPANY**

BACKGROUND

On 12 February 1998 Majid Yousefi Moridani then of 158 Walpole Road, Tottenham, London, N17 6BW applied under the Trade Marks Act 1994 for registration of the following trade marks:

**Collegiate
Colligate
Colegiate**

The application was published in respect of the following goods:

Class 03 “Cleaning and polishing preparations for care of tooth, face, hands, skin and body; soaps and liquid soaps for bath, shampoo for bath, shaving soaps and foam; cosmetics preparation for care of hands and face; non-medicated preparation lotion and cream for face and hands and scalp; creams and lotion for skin; cosmetic suntanning and suncreening; skin cleaning preparation; perfumery (after shave for men); hair lotions and hair spray; toothpaste (dentifrices); essential oils (bath oil).”

Class 05 “Pharmaceutical preparations for the care and health of mouth and care of face, hand and skin; dental wax for cleaning teeth; antiseptic preparations and solutions being mouthwash; antseptic and disinfectant solutions for skin, hand and body.”

Following publication of the application opposition to the registration was filed by Colgate-Palmolive Company on 19 November 1998. The grounds of opposition in summary are:

1. The opponent is a major international oral healthcare product manufacturer and produces and sells oral healthcare products on a very large scale.
2. The opponent is registered proprietor of the UK trade mark registrations details of which appear in the Schedule hereto.
3. The opponent has made extensive use of trade marks consisting of or comprising the word COLGATE in relation to oral healthcare products.

4. The opposed application is in respect of goods being identical or similar to the goods of the UK trade mark registrations of which details appear in the Schedule hereto.
5. The marks applied for offend against Sections 3(6), 5(2)(b), 5(3), 5(4)(a) and 56 of the Act.

The opponent further requested that the Registrar refuse application No 2157878 in the exercise of her discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as she did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects.

The applicant subsequently filed a counterstatement denying all grounds of opposition. Both sides ask for an award of costs. Only the opponent filed evidence in these proceedings, and the matter came to be heard on 15 January 2001 when the opponent was represented by Mr Ashmead from trade mark agents Kilburn & Strode. The applicant did not attend and was not represented.

OPPONENT'S EVIDENCE

The opponent's evidence is in the form of a Statutory Declaration dated 21 July 1999, by Ann Alexandra Harper. Ms Harper states that she is Company secretary and a director of Colgate-Palmolive (UK) Limited and that she also holds the position of Director of Legal Services. Colgate-Palmolive (UK) Limited is a wholly owned subsidiary of Colgate-Palmolive Company, the opponent in this matter. She further states that she is authorised to make this declaration on behalf of both companies. The statements made in this declaration are from her own knowledge and recollection; are derived from records and papers of both companies to which she has access. She provides the following information by way of background:

“This matter concerns the very well known trade mark COLGATE. Some history may assist. The business centred around the trade mark COLGATE dates back in the United States to the early years of the 19th century when Robert Colgate entered a soap and candle manufacturing business. By 1806 his son William Colgate had established his own starch, soap and candle factory in New York and the business, and knowledge of the name COLGATE, then started to grow. By the 1870's Colgate & Company were firmly established as a leading soap manufacturer and decided to branch out into the production of dental cream dentifrice sold under the trade mark COLGATE then as it is today. The product was originally sold in jars until the mid-1890's when flexible tubes were adopted much in the form we now have them.”

And

“The Palmolive Company (of England) Limited was incorporated in January 1922 and in 1929, as a result of the American merger became Colgate-Palmolive-Peet Limited. For the first few years, in fact until 1933, the COLGATE and PALMOLIVE branded products sold by the UK company were imported, but in 1933 an Agreement was signed to enable manufacture of COLGATE products to start in the United Kingdom.

Production started initially in a factory in London, but in 1938 the old established soap maker G.W.Goodwins & Sons were purchased providing a large manufacturing facility in Salford.”

Ms Harper states that the majority of oral care products produced by the applicant are sold under the trade mark COLGATE. One exception to this is toothpaste sold under the trade mark ULTRABRITE. Ms Harper also refers to products sold under the trade marks PALMOLIVE and AJAX and goes on to provide total turnover figures for the applicant from 1994 to 1997. However, I do not accept that these are of any relevance in these proceedings which are in respect of the COLGATE marks only. Ms Harper subsequently goes on to provide sales figures for COLGATE toothpaste as follows:

1994	£47,269,861
1995	£53,441,793
1996	£59,808,768
1997	£65,183,209
1998	£69,914,498

Ms Harper further states that COLGATE products are sold through all types of retail outlets from major supermarkets to corner shops and claims that the mark COLGATE is one of the best known trade marks in the country and is of “household name” status.

Ms Harper claims that the marks applied for will be confused with the trade mark COLGATE. Ms Harper states that:

“COLGATE is an unusual trade mark. It has its origins in Robert Colgate’s surname, but the distinctiveness of the name has long since been demonstrated to the Registrar and indeed to the courts in litigation from time to time. The name stands out as a trade mark and one known to be the property of my company and its parent company. I have set out below the trade mark COLGATE and the marks of Mr. Moridani’s application in a typeface similar to that generally used in Colegate packages. I think it will become clear from those side-by-side references how similar the marks look in their entirities, and the pronunciation is not clearly and unmistakably distanced from COLGATE, particularly but not exclusively in the forms not being correctly spelled dictionary words. Confusion in my view seems distinctly possible particularly in hand-written forms.”

Colgate *Collegiate*

Colgate *Colligiate*

Colgate *Colegiate*

APPLICANT'S PLEADINGS

The applicant's position is set out in the Statement of Grounds filed with the Form of Counterstatement. In this Statement of Grounds Mr Moridani explains that whereas COLGATE is an invented word COLLEGIATE is a word which can be found in any dictionary and is a derivative of the word COLLEGE. Mr Moridani enclosed a copy of the relevant entry in the Oxford English Dictionary (1989) which defines the word COLLEGIATE as:

“Designed for use by college students and at college level.”

Mr Moridani further states that the word COLLEGIATE was chosen for the following reasons:

- (i) to direct potential consumers to the high quality of the products in terms of science (Designed at college level for use) and also
- (i) to promote the product through the other part of the definition “Designed for use by college people (those who can appreciate the science which used in developing health care and personal care products especially when bearing our name; collegiate).

Mr Moridani is a Chemist and studied a Ph.D. degree in Pharmaceutical Chemistry at King's College London and claims to have a background knowledge in health care issues and high level knowledge in formulation, chemistry and science behind the good quality health care and personal care products.

Mr Moridani goes on to outline differences between the marks at issue:

- (i) The word “Collegiate” (Colligate) comprises of **ten** characters whereas that of opponent has **seven** characters. Nearly 50% longer.
- (ii) The word “Colegiate” (the third mark in series) comprises of **nine** characters.
- (iii) The word “Collegiate” comprises of two syllables which separate as coll-egiate (and similarly, colli-giate & cole-giate). In terms of syllables, the opponent's trade mark breaks in different location, col-gate. Each syllable is different in view of the length and pronunciation from that of respective syllables in Coll-giate.
- (iv) That appropriate pronunciation for Collegiate (Colligate and Colegiate) is that presented in a dictionary. This is the pronunciation the applicant says he intends to use to promote the products.
- (v) The appropriate pronunciation for that of the opponent is **kol:geit**. This has differences in pronunciation and length of each syllable in terms of audio and visual presentations.

Finally the applicant states that their trade marks were advertised in the Trade Marks Journal dated 19 August 1998 but that the opponents opposition was not filed until 20 November 1998 which is one day after the non-extendable period for the filing of opposition had expired. However, The Notice of Opposition was actually received, on Form TM7, on 19 November

1998. Therefore the Notice of Opposition was filed within the 3 months period allowed under Rule 13(1) of the Trade Marks Rules 2000.

That concludes my review of the evidence. I now turn to the decision.

DECISION

At the hearing Mr Ashmead withdrew the grounds of opposition under Sections 3(6), 5(3) and 56 of the Trade Marks Act 1994.

I first turn to the grounds of opposition under Section 5(2) which reads as follows:

5.- (2) A trade mark shall not be registered if because -

(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 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.”

An earlier right is defined in Section 6, the relevant parts of which state:

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.

I have to determine whether the marks and goods are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding this issue I rely on the guidance of the European Court of Justice in *Sabel Bv v Puma AG [1998 RPC 199 at 224]*, *Canon v MGM [1999 ETMR 1]* and *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel BV [1999 ETMR 690 at 698]*. It is clear from these cases that:-

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer, of the goods/services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2);

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section.

I also take into account the recent case of *Marca Mode CV v Adidas AG and Adidas benelux BV [2000] ETMR 723*. The European Court of Justice said of Article 4(1)(b) (transposed into UK law in Section 5(2)(b):

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character.....Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

The court felt that the concept of association of marks in the global assessment of the likelihood of confusion was over emphasised. It is not sufficient for the average consumer to merely associate marks in the sense that if prompted a consumer will call to mind another mark. Thus a mere possibility of confusion, even in situations where a mark clearly has a strong reputation, is not a valid ground for opposition to a trade mark under Section 5(2) of the Act.

First I will consider the marks. The application consists of three marks and I will deal with them in the order they appear on the form of application.

It is clear from the evidence that the opponent is relying on a number of registered trade marks. Some of these registrations are for the word COLGATE alone, others have additional words and devices. I have considered all of the marks referred to in the statement of grounds and take the view that where words or devices are present in addition to the word COLGATE the opponent is generally in a less favourable position as the additional matter serves to further differentiate the opponents marks from the marks in suit. In my view the registrations of the word COLGATE alone provides the opponent with the best chance of success. Examples of such registrations are 433585, 619519, 1166576 and 1413710 which between them cover most goods in Classes 3 and 5. Details of these trade marks are attached at Annex A.

At the hearing Mr Ashmead conceded that the first mark COLLEGIATE is a dictionary word with predictable pronunciation and its own distinct meaning and went on to say:

“ It is recognised as a dictionary word. It has the double LL aspect to it and there are other distinctions. We have no problems with that one.”

In my view Mr Ashmead is correct in this analysis and I believe that there is no likelihood of confusion with any of the opponent's marks.

The second mark is for the word COLLIGIATE. This is not a dictionary word but appears to be a misspelling of the dictionary word COLLEGIATE. The opponent's marks are for the word COLGATE solus or the word COLGATE with other matter. The opponent's use of the word COLGATE over a long period of time has ensured that it is pronounced in the same way by the vast majority, if not all, of the relevant public. In his counterstatement Mr Moridani states that the appropriate pronunciation of the word COLGATE is KOL:GEIT (as in COAL GATE). The applicant's second mark differs from the dictionary word COLLEGIATE in that the letter "I" replaces the first letter "E". Mr Ashmead suggested that this difference is important as it introduces doubt which could lead to it being pronounced in a similar way to his client's mark. Clearly the letters which form the word COLGATE are present in the second mark but they are not immediately obvious. The appearance of the two words are, in my view, quite different, with the applicant's mark bearing a much closer resemblance to the dictionary word COLLEGIATE than to the word COLGATE. The opponent's mark has two clearly distinct syllables while the applicant's mark has up to four. In my view the second mark is more likely to be seen as a misspelling of the word COLLEGIATE. Having taken full account of the goods involved and the reputation referred to in the opponent's mark I conclude that there is no likelihood of confusion between these marks, even used in relation to identical goods.

The applicants third mark is the word COLEGIATE. Again, the letters which form the word COLGATE are present in the applicant's mark. Visually these marks have similarities. The applicant's mark may again be seen as a misspelling of the dictionary word COLLEGIATE, the only difference being that the applicant's mark has a single letter L. However, I find that difference, albeit small, to have significance in the way it affects the marks' identity. In the applicant's mark the letters COLE may now be pronounced COAL as would the letters COL in the opponent's mark. The word COLEGIATE has two or three syllables depending upon whether the element GIATE is pronounced as GEE-ATE or GATE. In their pronunciation COAL-GEE-ATE is similar to COAL-GATE whereas COLE-GATE and COAL-GATE are identical. It follows that if the marks are interpreted in such a way then their visual similarities will be more striking. I have also taken into account the fact that when comparing marks the first syllables of the words are important as there is a tendency to slur the endings of words. I also have regard to the fact that these marks will rarely be viewed side by side but, more likely, will be compared at different locations at different times when it will be necessary to rely on the imperfect picture of the marks which the consumer has kept in his mind.

The opponent's mark COLGATE may have had it's origins in a surname but it has enjoyed a substantial reputation for many years particularly in relation to oral care products. It is clear from the above cases that in the overall assessment of the likelihood of confusion, the similarity of marks is but one aspect. I must also have regard to the closeness of the respective goods, the reputation that the earlier mark enjoys in respect of the goods for which it is

registered and any other relevant factors.

At the hearing Mr Ashmead submitted that the goods in question are either identical or similar. This was, in fact, conceded by the Applicant in the Statement of Grounds filed with the Form of Counterstatement where he said at paragraph 2:

“Although the goods which described in my application are similar to those of opponent, but this should not be considered as grounds on which my application should be refused.”

Taking all of these factors into account, in my view, notional and fair use of the applicants' trade mark COLEGIATE could include use in the stylised versions of the word COLGATE which are registered trade marks in the name of the opponent. Registered trade marks Nos 2006269, 2006271 and 2112730 are all examples of stylised versions of the word COLGATE. Details of these trade marks are at Annex B. Essentially this stylisation consists of the word COLGATE in a stylised font. If such use of the mark was made, it could result in a real likelihood of association between the marks such as to cause the purchaser to wrongly believe that the respective goods come from the same or economically linked undertakings.

However, taking all of the above factors into account, even if the word COLEGIATE is used in a standard font in either upper or lower case there would, in my view, still exist a likelihood of confusion.

I therefore find that in respect of the trade mark COLEGIATE there is a likelihood of confusion within the terms of Section 5(2)(b) of the Trade Marks Act 1994.

Finally I consider the ground of opposition under Section 5(4)(a). However, as I have taken their reputation into account in considering the objection under Section 5(2) I do not consider that there is any further or separate matter which falls to be dealt with under Section 5(4). There is nothing in the evidence to support a more advantageous attack under section 5(4)(a).

This application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the applicants file a form TM21 deleting the mark **Colegiate** from their form of application. If the applicants do not file form TM21 deleting that mark the application will be refused in its entirety.

As the opposition has been partly successful, the opponent is entitled to a contribution towards their costs. I order the applicant to pay the opponent the sum of £600. This sum to be paid within seven days of the expiry of the appeal period or with seven days of the final determination of this case if any appeal against this decision is unsuccessful.




Dated this 19 day of March 2001

George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

Number	Mark	Class	Specification
433585	COLGATE	03	Perfumed toilet soap, shaving soap in tablet, stick, powder and cream form, tooth powder, tooth paste, perfumes and talc powder for toilet use.
619519	COLGATE	03	Perfumed toilet soap; shaving soap in tablet, stick, powder and cream form; tooth powder, tooth paste, perfumes, talc powder for toilet use, and brushless shaving cream.++This Trade Mark is hereby altered under Section 35 of the Trade Marks Act, 1938. Representations of the Mark as altered were deposited on the 23rd October, 1957.
1166576	COLGATE	03	Preparations and substances, all for laundry use; detergents (not for use in industrial or manufacturing processes or for medical use); cleaning, polishing and scouring preparations; soaps; shampoos; abrasive preparations (not for dental use)
1413710	COLGATE	05	Pharmaceutical and sanitary preparations and substances; plasters; materials for dressing; disinfectants; all included in Class 5.

ANNEX B

Number	Mark	Class	Specification
2006269		03	Toothpaste and mouthwash; preparations for the care of the oral cavity, mouth and teeth.
2006271		03	Toothpaste.
2112730		03	Toothpaste and mouthwash.