

**TRADE MARKS ACT 1938 (AS AMENDED)
TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No. 1582742
BY L&D, S.A. TO REGISTER A TRADE MARK IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 43306
BY JULIUS SAMANN**

**TRADE MARKS ACT 1938 (AS AMENDED)
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**IN THE MATTER OF Application No. 1582742
by L & D, S.A. to register a Trade Mark in Class 5**

and

**IN THE MATTER OF Opposition thereto under No. 43306
by Julius Samann**

DECISION

1. On 25 August 1994 L & D, S.A. applied to register the trade mark shown below:



in respect of the following goods:

Air freshening preparations; room deodorisers; deodorants; deodorising preparations; all included in Class 5.

2. The application is numbered 1582742.
3. The applicants in the course of the examination process, and under the provisions of Section 14 of the Act, agreed to disclaim rights to the exclusive use of the word "AIRE" and the letters "LD". The application also states that the Spanish words "Aire Alpino" appearing in the mark mean "Alpine Air". Nothing hangs on these facts.

4. On 19 October 1995 Julius Samann of Zurich, Switzerland, filed a notice of opposition to this application. The grounds of opposition are as follows:

1. Under the provisions of Sections 9 and 10 of the Act in that the trade mark the subject of the application is neither adapted to distinguish nor capable of distinguishing the applicants goods from those of other traders.
2. Under the provisions of Sections 11 and 12 of the Act because the opponent says that he is the proprietor of and has used the following trade marks which are the subject of the following registrations:

<u>Registration No.</u>	<u>Mark</u>	<u>Class</u>	<u>Journal</u>	<u>Specification</u>
790315		05		Deodorants.



833966		05		Deodorants.
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Thus, the opponent contends that the application for the trade mark covers the same goods, or goods of the same description, as the goods for which his trade marks are registered and that the applicant's trade mark so nearly resembles each of his trade marks such that the application contravenes Section 12. Also, having regard to the use the opponent has made of the registered trade marks, use of the trade mark applied for in relation to the goods covered by the specification would deceive and cause confusion and therefore the applicants' trade mark would be disentitled to protection in a court of justice. Registration would be contrary to Section 11 of the Act.

5. The opponents also state that the trade mark applied for comprises a tree device of similar appearance to that sought to be registered by the applicants under No. B1262675. That application, was refused under the provisions of Sections 11 and 12 of the Act following opposition by the current opponent - the Registrar's decision (dated 14 May 1992) was upheld on appeal to the High Court by the Honourable Mr Justice Mummery in a decision dated 8 October 1993. The opponent asks that the application for registration be refused on the above grounds or in the exercise of the Registrar's discretion. He also seeks an award of costs.
6. The applicants deny the grounds of opposition. In particular they deny that the opponent has any exclusivity in devices of trees in respect of air freshening products. They also deny that the grounds of refusal of their earlier application which was refused registration are applicable here. They state that the silhouette of the trade mark the subject of the application in suit is very different from that of the trade mark which the applicant sought to register under the earlier application and that the current trade mark incorporates a picture of scenery which again is very different from the detail on the trade mark the subject of the earlier application. They add that their registered trade mark No. B1377790 has a silhouette which is almost identical to the trade mark of the application in suit. That trade mark has been registered since March 1989 in Class 5 and no incidents of confusion have arisen. They ask that the opposition be dismissed and for any discretion of the Registrar to be exercised in their favour. The applicants too seek an award of costs.
7. Both sides filed evidence in these proceedings and the matter came to be heard on 8 January 2001. The opponents were represented by Mr Christopher Morcom of Her Majesty's Counsel instructed by Rowe and Maw and the applicants by Mr Benedict Bird of Linklaters.

8. By the time this matter came to be heard, 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, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

Opponent's evidence

9. This consists of Statutory Declarations by Mr Julius Samann, Mr Samuel Jonathan Linn and Mr Timothy James Hazzard.
10. Mr Julius Samann's Statutory Declaration is dated 2 September 1996. He states that until recently he was the beneficial owner of Car-Freshner Corporation of Watertown, New York, United States of America. The company is still wholly owned by members of his family. He has been associated with the manufacture of air freshening products for more than 40 years, during which period he has become well acquainted with the trade in such products in many countries, including the United Kingdom.
11. Mr Samann states that he is the registered proprietor of the trade marks referred to in the grounds of opposition. In his view the principle feature of these trade marks is the tree device and these trade marks have been used for many years in the United Kingdom on labels, packaging and wrappers, as well as in advertising and in the form of air-freshening products themselves made from thin felt cardboard or other materials in the shape of the tree device. Mr Samann states that products have been sold under the trade mark in the United Kingdom since 1952 directly or through distributors under licence from himself. He exhibits a collection of photocopies as samples of the products sold in the United Kingdom from the mid 1960's. He states that the products were marketed in a variety of colours and a variety of different fragrances and have been particularly aimed at the market for motorists, they were widely sold and promoted from motor accessory retail outlets and garages. Mr Samann goes on to provide details of sales in the United Kingdom together with advertising and promotion figures. These show that in 1978 some 250,000 units were sold with a retail value of £94,000. In that same year £1000 was spent on advertising and promotion. In 1993 (the last full year which I can take into account) 3.3 million units were sold with a retail value of £3.4 million, £85,000 was spent on advertising and promotion. All the figures rose steadily over the 15 year period.
12. Mr Samann goes on to exhibit copies of press articles and press extracts showing the type of publicity which has been used over the years in marketing the products. He states that, apart from the activities of the applicants in this case, he has not been aware of any trade marks comprising tree devices being used in the United Kingdom for air fresheners for motor cars other than those marketed under his trade marks. And in support of this he produces a bundle of leaflets relating to air freshening products marketed by others in the trade in the United Kingdom. He goes on to refer to the applicants' earlier application No. B1262675 which he successfully opposed and exhibits a copy of the judgement of the High Court which confirm that decision of the Registrar on appeal. He goes on to refer to the applicants' registration No. B1377790 which they claim has a silhouette which is almost identical to the mark the subject of this application for registration. Mr Samann states that this registration is now the subject of Rectification proceedings brought by him and as an indication of this he attaches part of the evidence he has filed in those proceedings. This, he considers, demonstrates that there have been actual instances of confusion as between the applicants earlier registration and his

own trade marks. I note here that these Rectification proceedings are complete and that Mr Samanns' application under the Trade Marks Act 1938 to have the register rectified by the removal of the applicants registration was dismissed by the Registrar's Hearing Officer and by the Court on appeal.

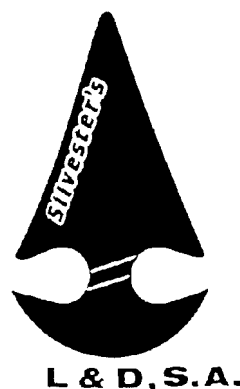
13. The Statutory Declaration of Mr Samuel Jonathan Linn, is dated 5 December 1996. He is a registered Trade Mark Agent and partner of Mewburn Ellis who have conduct of the opponent's affairs. Mr Linn states that he conducted a survey among car accessory dealers and petrol filling stations in relation to the trade mark in suit. He describes how he selected the outlets to be surveyed and exhibits the letter and questionnaire which was sent to the 180 selected addresses. A total of 16 of the 180 questionnaires sent out were returned completed (10 were returned undelivered). The respondents who referred in their responses to the questionnaire to the opponent's trade marks confirmed subsequently their responses in declarations. These declarations are exhibited. Mr Linn states that in his view that these demonstrate that the evidence shows that there has been confusion in the trade as between the applicants' and the opponents' respective trade marks. Further he believes that the presence of the words, letters and scenic material in the applicants trade mark is insufficient to avoid such deception and confusion.
14. The Statutory Declaration by Mr Timothy James Hazzard is dated 16 December 1996. Mr Hazzard provides details of the forms of the air freshening products marketed by his company, Saxon Industries, under licence from Julius Samann (via Car Freshner Corporation). In all cases, the product in question have been in the form of fragrances cards in the shape of a tree device. Details of the various fragrances and details of recent sales are provided.

Applicants' evidence

15. This consists of a Statutory Declaration by Mr David Fernandez Torres of Almeria, Spain. This is dated 14 April 1999. This was a re-sworn Statutory Declaration, an earlier declaration dated 16 June 1997 having been found to contain a number of errors.
16. Mr Torres is the Managing Director of the applicants; he has full access to that company's records and the evidence therefore comes both from his own personal knowledge and those records. He has a reasonable understanding of English.
17. He first of all confirms that the applicants are the registered proprietor of trade mark No. B1377790 in respect of the following goods:

Air freshening preparations; deodorants; deodorising preparations and substances; all included in Class 5.

The trade mark itself is shown below:



18. Mr Torres says that the applicants have been selling scent impregnated card air fresheners throughout Europe and in the United Kingdom for 9 years and since 1988 the products have included air fresheners in the shape of the trade mark shown above which is the same shape as the trade mark in suit, he says. He provides details of the products distributors in the United Kingdom between 1988 and 1992. He also provides copies of invoices to confirm sales between the applicant and their distributors. He also exhibits copies of a catalogue produced by one of the distributors which, he claims, shows pictures of his company's air fresheners. In his view it is substantially the same in appearance as the trade mark in suit. The only differences are, in his words, "that the product does not have "L&D S.A." underneath; and it does not have extra words on it such as "Pino, Silvestos, Aire Fresco, and Air Freshener". Mr Torres goes on to express views based upon the comparison of the applicants' and the opponent's trade marks. In relation to his company's earlier application which was refused registration following opposition by the current opponent he says that he believes that the application which was refused is very much closer to the opponent's trade mark than the stylised trade mark in suit. Indeed, that is one of the reasons why his company spent time and money creating the stylised arrow and crescent device.
19. Mr Torres goes on to state that having regard to the use which his company has made of their trade mark and the use the opponent has made of his, both selling in motor vehicle accessory shops and other outlets such as supermarkets and chemists, no incidents of confusion have come to his notice, either in relation to trade purchases or in relation to ultimate retail customers. Further, in his view, the public are very familiar with the use of tree symbols in relation to air fresheners and other deodorants of manufacturers and there are a number of such symbols in use which are, in his view, closer to the opponent's trade marks than the trade mark of the applicants. He exhibits examples.

Opponents' evidence in reply

20. This consists of a Statutory Declaration by Mr Ronald F Samann dated 10 December 1997. He is the son of Julius Samann, the opponent in these proceedings and he is authorised by him to make the declaration on his behalf. He is also the President of Julius Samann Limited, based in Bermuda, which is a service company which, among other things, administrates and manages his father's Intellectual Property including his trade marks, which are relevant to these proceedings. He also confirms that the approximate United Kingdom sales and advertising expenditure figures given by Mr Samann in his earlier Statutory Declaration are in respect only of the products associated with the trade marks the subject of the three registrations.
21. That concludes my summary of the evidence insofar as I consider it relevant to these proceedings.

DECISION

22. First of all I dismiss the grounds of opposition based upon Sections 9 and 10 of the Act. No evidence has been filed in support of either ground and nothing else has been brought to my attention in that regard. I go on therefore to consider the other grounds which are based upon Sections 11 and 12 of the Act which state:

11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

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:-

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

23. For the purposes of this decision I consider all of the opponents' registrations for what they term their tree devices (with or without added matter) against the opponents application for what they in turn term their arrow and crescent device. The established tests for the Section 11 and 12 objections raised in this case are set down in Smith Hayden & Co Ltd's application (Vol 1946) 63 RPC 101 as adapted by Lord Upjohn in the Bali trade mark case (1969) RPC 496. In relation to the present case the tests may be expressed as follows:-

- (a) (under Section 11). Having regard to the user of the tree devices (with or without added matter) is the tribunal satisfied that the mark applied for, the arrow and crescent device if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?
- (b) (under Section 12) Assuming user by the opponents of their tree devices (with or without added matter) in a normal and fair manner for any of the goods covered by the registrations of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception among a number of persons if the applicants use their mark the tree and arrow device with added matter, normally and fairly in respect of any goods covered by their proposed registration?

24. Dealing with Section 12(1) first, I only need to determine whether the respective trade marks are confusingly similar because there was no dispute at the Hearing that the respective specifications cover the same goods. In doing so I employ the test propounded by Parker J in the Pianotist case (1906) 23 RPC at page 777, line 26 et seq:

"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 circumstances; and you must further consider what is likely to happen if each of those 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, 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."

25. I also take note of Vaporoub 68 RPC [1951] 226, which was drawn to my attention.
26. I should say at the outset that both parties to this dispute referred me to earlier decisions in respect of proceedings between the two parties in respect of other trade marks. The trade marks in suit in those cases were different, however, to the trade mark in issue before me. In those circumstances, whilst I have due regard to the law set out in their decisions by my fellow Hearing Officers and the Courts I believe each of those cases was determined on their own facts and I therefore pay them little regard in my deliberations on this case.
27. As indicated earlier, the goods of the parties are the same and therefore this dispute is centred around the similarity or otherwise of the respective trade marks. The applicants' trade mark consists of what they term to be an arrow and crescent device together with the words Aire Alpino, the letters L & D and devices of what would appear to be pine trees all appearing within the trade mark. The opponent's trade marks consist of what they term to be a tree device. One contains no added matter, other than a blank space across the centre of the tree device (presumably which could be used for the name of the fragrance of the air freshener), another consists of the same device but with the words Magic Tree appearing in the blank space and the third trade mark consists of the tree device together with the words Wunder. Baum! together with the words Arbre Magique and Magic Tree appearing within it. The German and French words which appear in the mark also mean magic tree. Both the applicants' and the opponent's trade mark are intended for use, principally, upon air fresheners for motor vehicles. And, as Mr Morcoms' skeleton argument put it, "there appears to be no dispute that "normal and fair use" of the mark applied for would include use in the form of the product itself and in the car accessories market. The application is not limited to products of any particular fragrance and therefore the mark must be treated as being capable of use for any products of the shape in question, regardless of the fragrance." That, I believe, must be so. Therefore the trade marks in question could well appear on packaging and labels as well as being the shape of the product itself. I note too that when the opponent's trade marks are sold in the shape of their trade marks they are contained within clear plastic packaging. It seems to me therefore that normal and fair use of both the applicants' and the opponent's trade marks could be use of the trade marks as shapes and shapes contained within clear, or perhaps opaque, packaging and sold on stands. Indeed some of the evidence indicates that that is precisely the way in which the opponent's products are sold. They are then intended to hang inside the car and progressively release a scent as the packaging is released periodically to reveal more of the shape.
28. On the basis of a comparison of the trade marks side by side it would be very easy to see and distinguish the differences between the respective trade marks - the opponent's device is very definitely the outline of a tree whereas the applicant's is not such a definite outline it is a much more abstract device and where other words or matter appear in the respective trade marks those words and matter are different. I have no difficulty in finding therefore that the trade marks when compared alongside each other do not resemble or nearly resemble each other. But, as the Vaporub case suggests, I go on to consider the matter from the point of view of the ordinary consumer who does not have the advantage of the two marks side by side and I bear in mind the comments of Sargant J. in

Sandow [1914] 31 RPC 196 at 205:

"The question is not whether if a person is looking at two trade marks side by side there would be a possibility of confusion; the question is whether the person who sees the proposed trade mark in the absence of the other trade mark, and in view only of his general recollection of what the nature of the other trade mark was, would be liable to be deceived and to think that the trade mark before him is the same as the other, of which he has a general recollection."

29. Also, Luxmore L J in *Rysta* (1943) 60 RPC 87 at 108.

"The answer to the question whether the sound of one word resembles too nearly the sound of another so as to bring the former within the limits of section 12 of the Trade Marks Act 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable pronounced with the clarity to be expected from a teacher of elocution. The court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description but also of the shop assistant ministering to that person's wants."

30. I note too, Kerly's Law of Trade Marks & Trade Names 12th Edition which at 17-08 states:

"The "Idea of the mark" is to be regarded

Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Thus, for example, a mark may represent a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed by each might be simply a game of football. It would be too much to expect that persons dealing with trade-marked goods, and relying, as they frequently do, upon marks, should be able to remember the exact details of the marks upon the goods with which they are in the habit of dealing. Marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in details might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their own." (Footnotes excluded).

31. It seems to me that the applicants have legitimately sought to devise a trade mark which is sufficiently different in idea from that of the opponents such that the latter's rights are not trespassed upon. They have come up with what they call an arrow and crescent device. In addition they have added to it a landscape with devices of pine trees and the words Aire Alpino and the letters LD. But, bearing in mind the goods covered by the respective specifications and the way in which they are sold have they done enough?

32. The goods concerned are air freshners for motor vehicles which are relatively cheap products - I note that the opponent sold 3.3 million of them in 1993 with a retail value of £3.4m - they therefore cost about £1. Perhaps picked up on impulse whilst paying for petrol. They are not therefore going to be purchased with much if any care or attention. The goods could be sold [and as far as the opponent's goods are concerned are sold] in the shape of the trade mark and the evidence shows that these shapes can be sold in plastic bags hanging on stands, thereby revealing the shape (and the trade mark). They are also designed to be hung in a case in order to release their scent.
33. Bearing all of these considerations in mind I reach the view that the most significant detail of both these trade marks is their shape and that both convey the idea overall of a tree device. The opponent's because it clearly is a tree device; the applicant's because, although its shape is more abstract, there is other visual matter (the devices of pine trees) which are likely to lead the viewer to the conclusion that it is an abstract tree device. The fact that would-be purchasers of both the applicants and the opponents goods are likely to see the shape through packaging reinforces the likelihood of the general idea of a tree device being conveyed.
34. The fact that the opponent's trade marks also include some with words which differ from those which appear in the applicants trade mark does not help here where it is the idea, in my view, which is imparted first of all in the viewers mind. This idea then will overwhelm the other considerations in this case because, as I have said, little attention will be paid when purchasing these low cost impulse purchases. That then will give rise to confusion such as described by Parker J.
35. I therefore reach the view, not without difficulty, and not without regard to the applicants earlier registration that the applicants trade mark in this case so nearly resembles that of the opponents' earlier registered trade marks such that the provisions of Section 12(1) of the Act apply.
36. In reaching this view I have not needed to rely on the 'survey' evidence supplied by the opponent which in any event is flawed in a number of ways.
37. I do not believe that any different finding is possible under Section 11 from that under Section 12(1). I have already taken into account in reaching my decision in relation to Section 12(1) notional and fair use of both the applicants and the opponents trade marks and of all the surrounding circumstances. The opponent therefore succeeds also under Section 11 because there is every likelihood of deception amongst a number of persons if the applicants use their trade mark on the goods covered by their application.
38. The opponent having succeeded in these proceedings are entitled to a contribution towards their costs from the applicant for registration. Taking into account a Preliminary Hearing on the matter of evidence I order the applicant to pay to the opponent the sum of £800.

Dated this 23rd day of March 2001

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

