

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK
NO. 2246862 IN THE NAME OF
THORNTON & ROSS LTD AND AN
APPLICATION FOR A DECLARATION OF
INVALIDITY NO. 80014 THERETO
BY CUSSONS (INTERNATIONAL) LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF Trade
Mark No. 2246862 in the name
of Thornton & Ross Ltd and an
Application for a Declaration
of Invalidity No. 80014 thereto
by Cussons (International) Ltd**

Background

1. On 27 September 2000 Thornton & Ross Ltd applied under the Trade Marks Act 1994 to register the following as a series of two trade marks:



The first mark in the series is limited to the colours blue, turquoise and white as shown in the representation on the application form. The specification of goods reads:

Class 3

Cosmetics, toilet preparations, make-up, perfumes, skin care and hair care preparations, essential oils; cleaning preparations.

2. The application was accepted and published. It proceeded to registration on 20 July 2001. On 30 July 2001 Cussons (International) Ltd filed an application for a declaration of invalidity of the registration. In summary the grounds in support of the application are:

- (a) under Section 5(2)(b) and Section 6(1)(a) in that the trade mark is similar to the applicant's earlier trade marks (details of which are set out below) and is registered for goods which are identical or similar to those for which the applicant's earlier trade marks are protected;
- (b) under Section 5(4)(a) in that the applicant has acquired a reputation through use of the earlier rights and the packaging of the products marketed under those earlier rights include the colours of the first mark in the series of the registration in suit.

3. The registered proprietor filed a counterstatement essentially denying the grounds of invalidity. Both parties sought an award of costs and both filed evidence in support of their respective cases. In line with current Registry practice the parties were informed at the conclusion of the evidence rounds that having reviewed all the papers filed there was sufficient information available to enable a decision to be reached. The parties were, however, reminded of their right to be heard or to make written submissions in lieu thereof. Neither party requested a hearing and only the applicant filed submissions. After a careful study of all the papers, I now give this decision.

Applicant’s evidence

4. This takes the form of a witness statement of Alaric Paul McDermott dated 15 January 2002. Mr McDermott says he is the Company Secretary of Cussons (International) Ltd (“his company”), a post he has held since 1989, that he has full access to the company’s records and that he is authorised to make the statement on the company’s behalf.

5. Mr Mc Dermott states that the trade mark CAREX was first used by his company in 1993 and has been in continuous use since that date for an expanding range of products. He gives details of the first use on the following products:

Product	First Use
Liquid soap	1993
Bodywash	1996
Bar Soap	1996
Bathwash	1997
Hand Lotion	1998
Hand Gel	1998

6. He confirms that the CAREX logo mark is used on all these products and exhibits copies of the labels for a selection of these products. Mr McDermott gives details of UK sales volumes of products sold under the CAREX range of goods, sold for an average of £1.41 per product as follows:

Product	93/94 ‘000	94/95 ‘000	95/96 ‘000	96/97 ‘000	97/98 ‘000	98/99 ‘000	99/00 ‘000	00/01 ‘000	01/02 forecast
Liquid Soap	610	2162	3522	5511	7266	9267	10567	10947	10906
Bodywash				890	822	2032	1961	1888	2312
Bathwash					867	1236	843	660	515
Bar Soap				236	514	572	612	463	422
Hand Lotion						553	499	186	
Hand Gel						355	215	132	
Total	610	2162	3522	6637	9469	14015	14697	14276	16184(sic)

7. Mr McDermott also gives details of the advertising expenditure on products sold in the United Kingdom under the trade marks.

1993	1994	1995	1996	1997	1998	1999	2000
£1.1m	£1m	£1.7m	£2.8m	£3.1m	£4.7m	£3.6m	£3.4m

8. Advertising has, he says, been through television, the press, posters and shopping trolley placements, as well as through promotional sample packs and information leaflets being delivered to households. Mr McDermott exhibits a selection of copies of various advertising material. He also exhibits copies of informational leaflets produced by his company and distributed at shows and exhibitions and to mothers of new born babies.

9. Mr McDermott states that CAREX products are sold in a variety of different coloured packaging, including purple, green and blue/turquoise and exhibits samples of these. He goes on to say that the CAREX mark itself appears in white on a blue oval background. He explains that the blue/turquoise combination is used on 51% of packaging, green on 30%, purple on 12% and other colours on 7%.

10. Mr McDermott concludes that by virtue of their long and extensive use, the CAREX and CAREX logo marks have acquired a reputation in the United Kingdom in relation to goods in class 3 and, as a result, if the similar mark CARE and device were to be used on class 3 goods produced by other undertakings, such goods would be likely to be confused or associated with the goods of his company.

Registered proprietor's evidence

11. This takes the form of a statutory declaration of Neville Geoffrey Edwards dated 22 February 2002. Mr Edwards confirms he is the Sales and Marketing Director of Thornton & Ross Ltd, a post he has held since 1998 and that he has access to all records and documents of the company.

12. Mr Edwards states that the marks the subject of registration No. 2246862 were first used in 1990 in relation to products covered by the registration and that since that date have continued in use in relation to a wide range of products in class 3. He exhibits a table setting out in detail the first three year's sales figures for each of the products referred to. He goes on to confirm that the turnover of products sold under the CARE and device trade mark throughout the United Kingdom was £5.1m in 1999 and £4.9m in 2000.

13. In terms of advertising, Mr Edwards states that the trade mark CARE and device has been used widely throughout the United Kingdom and is of great value to his company. He exhibits a photocopy of the 1991 price list showing the trade mark in use together with specimens of label proofs for a number of products.

14. Mr Edwards asserts that the trade mark CARE and device has been used by his company since before the Applicant for Invalidity used the mark CAREX in 1993. Mr

Edwards says he is not aware of any confusion between CARE and device and CAREX and would not expect the two marks to be confused.

15. Mr Edwards concludes by stating that his company has used the trade mark CARE and device in relation to a wide range of products including those covered by the registration since 1990 and has acquired a very substantial reputation in relation to those products.

Applicant's evidence in reply

16. There is a further witness statement of Alaric Paul McDermott, dated 6 June 2002 however, it contains only submissions not evidence of fact. I have taken these into account.

Decision

17. The applicant claims that the registration should be declared invalid as per section 47 of the Act on the basis of the provisions of sections 5(2)(b) and 5(4)(a). The relevant parts of the Act are as follows:

“47.-(1)

- (2) The registration of a trade mark may be declared invalid on the ground-
 - (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
 - (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(3)

(4)

- (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.
- (6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.

- 5.- (1)
- (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.

- (3)
- (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.”

The term “earlier trade mark” is 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,”

18. The two registrations on which the applicant relies are earlier trade marks within the definition of section 6 of the Act. I will deal first with the applicant’s ground of invalidity under section 5(2)(b). In determining the question under section 5(2), I take into account

the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*, paragraph 23;
- (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; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (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; *Sabel BV v Puma Ag*, paragraph 24;
- (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); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) 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; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

19. Under section 5(2) the test is a composite one, involving a global appreciation taking into account a number of factors. With these comments in mind, I go on to consider the applicant's case under section 5(2)(b).

20. For ease of reference the registered proprietor's marks and the applicant's earlier marks are reproduced below.

2246862 Registered proprietor



Specification:

Cosmetics, toilet preparations, make-up, perfumes, skin care and hair care preparations, essential oils; cleaning preparations.

1503803 Applicant for Invalidity

Carex

Specification:

Anti-bacterial hand-washing preparations; all included in Class 3. perfumes, essential oils; non-medicated toilet preparations; cosmetic preparations; dentifrices; depilatory preparations; anti-perspirants, deodorants for personal use; preparations for the hair, shampoos; soaps; all included in Class 3; but not including any such goods containing or being made from herbs.

2225517 Applicant for Invalidity



Specification:

Non-medicated toilet preparations; preparations for cleansing the skin; preparations for cleansing the skin and having anti-bacterial properties; facial and body moisturising preparations; shower gels and shower creams; bath creams and bath foams; soap; deodorants and anti-perspirants; talc; shaving preparations; after-shaving preparations; perfumes, eau de toilettes and after-shaves; hair preparations; shampoos.

21. The goods of the respective trade marks are identical. The registered proprietor's marks are for a series of two consisting of three common elements; the dictionary word CARE, the device of a perpendicular cross within a circle and the dark background having straight edges top and bottom but rounded side edges. The word CARE is defined in the Collins English Dictionary as; "-2: to have regard, affection or consideration for; 4: to provide physical needs, help or comfort". The perpendicular cross device is suggestive of a first aid, medical or hygiene symbol. The background has no special features. Although none of the elements are distinctive for the goods in question, there is some distinctiveness in the combination.

22. The applicant's mark No. 2225517 also has three elements; the word CAREX, the word CUSSONS and the dark oval background. The applicant's mark No. 1503803 consists of a single element, the word CAREX. In both of the applicant's marks the word CAREX is the dominant or only element. The word CAREX is not a dictionary word, but is the word CARE with a letter X affixed. The word CAREX has a reasonably high distinctive character. Although it contains the word CARE, it is different from it. It is this difference which distinguishes between CARE and CAREX and which, I believe, makes CAREX distinctive.

23. In addition to the three common elements detailed above, the registered proprietor's first mark in the series is also subject to a limitation to the colours blue, turquoise and white. The applicant's marks are not registered in colour. Notional and fair use could, however include use in colour. The applicant has submitted evidence showing the marks in use in a variety of colours including blue. Blue, blue/green and turquoise are not, however, distinctive colours when applied to the packaging of personal care products.

24. The applicant has, however, provided evidence of use of the trade marks and I therefore go on to consider whether the marks have acquired a higher distinctive character through use. The gross sales volume figures provided show that the sales have been increasing from £610K in 1993/4 to over £14m in 2000/01. These appear to be significant sales, especially so given the average retail price of an individual CAREX product is quoted as being £1.41. The sales are supported by significant advertising expenditure of between £1m and £4.7m per year. I am given no information to explain what the overall market share is for these goods, however, it seems to me that given the volume of sales and the level of advertising expenditure, the applicant's trade marks had accrued an enhanced level of distinctiveness through use by the relevant date of 27 September 2000.

25. Despite this enhanced level of distinctiveness, and taking all factors into account, I find the trade marks are not sufficiently similar in distinctive features to create a likelihood of confusion, even in respect of identical goods. The application under S5(2)(b) fails.

Section 5(4)(a)

26. The requirements for this ground of invalidity have been restated many times but can be found in the decision of Mr Hobbs QC sitting as the Appointed Person in *Wild Child* [1998] RPC 455. Adapted to invalidity proceedings, the three elements necessary for a positive finding under this ground can be summarised as follows;

1. that the applicant's goods have acquired a goodwill or reputation in the marks and are known by some distinguishing feature;
2. that there is a misrepresentation by the registered proprietor (whether or not intentional) leading or likely to lead the public to believe that goods or service offered by the registered proprietor are goods or services of the applicant; and,
3. that the applicant has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the registered proprietor's misrepresentation.

27. When considering the ground under 5(2)(b) I dealt with the applicant's evidence showing use of their marks. I found that it was sufficient to find that the applicant owns a goodwill under the mark CAREX.

28. To succeed under this ground, there must be deception or confusion which is dependant upon the similarity of the respective trade marks. I have already found that the respective trade marks are not similar enough to cause confusion and use of the applicant's mark cannot therefore constitute a misrepresentation. If I had come to a different conclusion on the likelihood of confusion/deception, the registered proprietor's claim to have made antecedent use of his mark would have to have been considered.

29. Section 72 of the Act provides:

“72. In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the registration and of any subsequent assignment or other transmission of it.”

30. As the mark in suit is a registered trade mark, the onus in this case is on the applicant to show that the mark is invalid. Despite there having been concurrent use of the respective trade mark on identical goods, the applicant has not provided any evidence of confusion. The applicant's main area of interest appears to be in cleaning preparations. The applicant suggests that the registered proprietor has not used his mark on these goods but that if such use were to start there would be a likelihood of confusion. I reject this suggestion. Whilst, as I indicated above, the evidence of use provided by the registered proprietor is not extensive, use from 1990 has been shown on goods which the evidence confirms are used as cleaning preparations eg. soap spirit, emulsifying ointment. The application under S5(4)(a) fails.

Conclusion

31. The application for invalidity has failed on all grounds and the registered proprietor is entitled to a contribution towards costs. I order the applicant to pay the registered proprietor the sum of £1,100 towards his costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against the decision is unsuccessful.

Dated this 10th day of December 2002

**Ann Corbett
For the Registrar
The Comptroller-General**